UNITED STATES PATENT AND TRADEMARK OFFICE

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

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE WA 98111-1247

COPY MAILED

MAY 03 2004

OFFICE OF PETITIONS

In re Application of :
Linlin Chen et al. :
Application No. 09/931,268 : DECISION REFUSING STATUS
Filed: August 16, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 291958183US :

This decision is in response to the petition filed March 5, 2002 (certificate of mail date, February 19, 2002), under 37 CFR 1.47(a), in response to the Notice to File Missing Parts "Notice" mailed September 17, 2001.

The petition is **DISMISSED.**

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. 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.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 16, 2001, naming Linlin Chen and Lyndon W. Graham but without a signed declaration. Accordingly, on September 17, 2001, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

In response, on March 5, 2002 (certificate of mail date, February 19, 2002), the present petition was filed with a request for a three month extension and the oath and declaration signed by inventor Linlin Chen only. Petitioners seek status under 37 CFR 1.47(a) based on the fact that on two occasions the declaration and power of attorney were mailed to Mr. Graham at the last known address. Additionally, the petition indicates that telephone calls were made to Mr. Graham's last known phone number but to date Mr. Graham has neither acknowledged receipt of the mailings, returned an executed oath or declaration or returned the telephone calls. Petitioner claims that they have put forth diligent efforts to have the oath or declaration executed and that Mr. Graham has refused to comply.

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.

The present petition lacks item (1).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventor. The statement made by Janice Pike (Legal Assistant for the assignee, Semitool) avers that the "declaration" was sent to Mr. Graham but Ms. Pike's statement does not reveal that the complete application was sent. Thus, there is no evidence to show that Lyndon W. Graham had the benefit of seeing the application.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

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

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

By FAX: (703) 872-9306
Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703)305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

EDELL, SHAPIRO, FINNAN & LYTLE, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE MD 20850

COPY MAILED

JUN 2 9 2004

OFFICE OF PETITIONS

In re Application of
Linlin Chen et al.
Application No. 09/931,268
Filed: August 16, 2001
Attorney Docket No. 291958183US

:DECISION NOTING JOINDER OF
:INVENTOR AND PETITION UNDER
:**37 CFR 1.47(a) DISMISSED** AS
:INVOLVING MOOT ISSUES :

A petition under 37 CFR 1.47(a) was filed March 5, 2002 (certificate of mail date, February 19, 2002) and was dismissed in a decision mailed May 3, 2004.

In response, papers filed on June 14, 2004, in reply to the "Decision Refusing Status Under 37 CFR 1.47(a)" mailed May 3, 2004, included copies of the letter forwarding complete copies of the application, as filed, to joint inventor Lyndon W. Graham and a declaration signed by the previously non-signing inventor, Lyndon W. Graham, in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is unnecessary.

The renewed petition filed June 14, 2004 is **dismissed** as involving moot issues.

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 will be forwarded to Technology Center 1753 for continued examination, in due course.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

PATENT

Attorney Docket No.: A-68950-1/DJB/RMS/DCF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DICKINSON, et al.

Serial No. 09/931,271

Filed: August 16, 2001

For: ALTERNATIVE SUBSTRATES AND FORMATS FOR BEAD-BASED ARRAY OF ARRAYS™

Examiner: Not assigned

Group Art Unit: Not assigned

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Box Missing Parts, Assistant Commissioner for Patents, Washington, DC 20231 on 1/15/01.

Signed: _____

Fern S. Marder

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

Box Missing Parts
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is in response to the Notice to File Missing Parts of Nonprovisional Application mailed September 7, 2001.

Applicant claims small entity status in accordance with 37 CFR 1.27.

Enclosed are the following documents:

(1) Copy of Notice to File Missing Parts of Nonprovisional Application;

(2) Declaration and Power of Attorney;

(3) Assignment (copy);

(4) Power of Attorney by Assignee;

(5) Check for $489.00 to cover the filing fee ($370.00), 6 claims over 20 ($54.00), and the missing parts surcharge ($65.00) for a small entity (at the post-10/1/01 fee rates); and

(6) Return receipt postcard.

The Commissioner is authorized to charge any fees, including extension fees, which may be required, or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-68950-2/DJB/RMS/DCF).

It is believed that submission of the above serves to satisfy all of the requirements of the outstanding Notice of Missing Parts.

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP

David C. Foster, Reg. No. 44,685
Patent Agent for
Robin M. Silva, Reg. No. 38,304

Four Embarcadero Center
Suite 3400
San Francisco, CA 94111-4187
Telephone: (415) 781-1989
1067190

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
09/931,271	08/16/2001	Todd Dickinson	A-68950-2/DJB/RMS/DCF

CONFIRMATION NO. 2224

FORMALITIES LETTER

OC000000006530996

Robin M. Silva, Esq.
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

OIPE JC26 JAN 15 2002 PATENT & TRADEMARK OFFICE

Date Mailed: 09/07/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

01/22/2002 BABRAHA1 00000155 09931271

01 FC:201 370.00 OP
02 FC:205 65.00 OP
03 FC:203 54.00 OP

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

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

- The statutory basic filing fee is missing.
  Applicant must submit $ **355** *to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
- Total additional claim fee(s) for this application is $54.
  - **$54** for **6** total claims over 20.
- The oath or declaration is missing.
  A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 474.**

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 1450Alexandria, VA 22313-1450
www.uspto.gov

HOWARD R. RICHMAN
EDELL SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD SUITE 400
ROCKVILLE MD 20850-3164

COPY MAILED

MAY 03 2004

OFFICE OF PETITIONS

In re Application of :
Lyndon W. Graham et al. :
Application No. 09/931,283 : DECISION REFUSING STATUS
Filed: August 16, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 291958184US :

This decision is in response to the petition filed March 5, 2002 (certificate of mail date, February 19, 2002), under 37 CFR 1.47(a), in response to the Notice to File Missing Parts "Notice" mailed September 17, 2001.

The petition is **DISMISSED.**

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. 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.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 16, 2001, naming Lyndon W. Graham and Dakin Fulton but without a signed declaration. Accordingly, on September 17, 2001, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

In response, on March 5, 2002 (certificate of mail date, February 19, 2002), the present petition was filed with a request for a three month extension and the oath and declaration signed by inventor Dakin Fulton only. Petitioners seek status under 37 CFR 1.47(a) based on the fact that on two occasions the declaration and power of attorney were mailed to Mr. Graham at the last known address. Additionally, the petition indicates that telephone calls were made to Mr. Graham's last known phone number but to date Mr. Graham has neither acknowledged receipt of the mailings, returned an executed oath or declaration or returned the telephone calls. Petitioner claims that they have put forth diligent efforts to have the oath or declaration executed and that Mr. Graham has refused to comply.

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.

The present petition lacks item (1).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventor. The statement made by Janice Pike (Legal Assistant for the assignee, Semitool) avers that the "declaration" was sent to Mr. Graham but Ms. Pike's statement does not reveal that the complete application was sent. Thus, there is no evidence to show that Lyndon W. Graham had the benefit of seeing the application.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

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

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

By FAX: (703) 872-9306
Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703)305-4497.

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

HOWARD R. RICHMAN
EDELL SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD SUITE 400
ROCKVILLE MD 20850-3164

COPY MAILED

JUN 2 9 2004

OFFICE OF PETITIONS

In re Application of
Lyndon W. Graham et al.
Application No. 09/931,283
Filed: August 16, 2001
Attorney Docket No. 291958184US

:DECISION NOTING JOINDER OF
:INVENTOR AND PETITION UNDER
:**37 CFR 1.47(a) DISMISSED** AS
:INVOLVING MOOT ISSUES

A petition under 37 CFR 1.47(a) was filed March 5, 2002 (certificate of mail date, February 19, 2002) and was dismissed in a decision mailed May 3, 2004.

In response, papers filed on June 14, 2004, in reply to the "Decision Refusing Status Under 37 CFR 1.47(a)" mailed May 3, 2004, included copies of the letter forwarding complete copies of the application, as filed, to joint inventor Lyndon W. Graham and a declaration signed by the previously non-signing inventor, Lyndon W. Graham, in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is unnecessary.

The renewed petition filed June 14, 2004 is **dismissed** as involving moot issues.

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 will be forwarded to Technology Center 1753 for continued examination, in due course.

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

Patricia Faison-Ball
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

AT&T Legal Department - HFZ
ATTN. Patent Docketing
One AT&T Way
Room 2A-207
Bedminstor, NJ 07921

Mail Date: 04/21/2010

Applicant	: Robert Wesley Bossemeyer	: DECISION ON REQUEST FOR
Patent Number	: 7596129	: RECALCULATION of PATENT
Issue Date	: 09/29/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/931,288	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1134** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AT&T Legal Department - HFZ
ATTN. Patent Docketing
One AT&T Way
Room 2A-207
Bedminstor, NJ 07921

Mail Date: 05/18/2010

Applicant : Robert Wesley Bossemeyer
Patent Number : 7596129
Issue Date : 09/29/2009
Application No: 09/931,288
Filed : 08/16/2001

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

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

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

The patent term adjustment has been determined to be **1170** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days** from the mail date of this notice, whichever is longer, to file a request for reconsideration of this PTA calculation. See 35 U.S.C. § 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4).

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

Patentee should be aware that in order to preserve the right of review of the USPTO's PTA determination in the United States District Court for the District of Columbia, patentee must ensure that the steps required under 35 U.S.C. § 154 (b)(4) are taken in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. § 154(b)(4).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 17, 2006

TO SPE OF : ART UNIT 2141 · Rupal Dharia

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/931,290 Patent No.: 6993571 B2

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

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

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

Certificates of Correction Branch

703-308-9390 ext. 111

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: _____

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER
SPE

2141
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 17, 2006

Rupal Dharia

TO SPE OF : ART UNIT 2141

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/931,290 Patent No.: 6993571 B2

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

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

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

Certificates of Correction Branch

703-308-9390 ext. 111

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: _____

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER
SPE

2141
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

FERENCE & ASSOCIATES LLC
409 BROAD STREET
PITTSBURGH, PA 15143

COPY MAILED

MAY 21 2008

OFFICE OF PETITIONS

In re Application of :
CHAUDHARI, et al. :
Application No. 09/931,316 :
Filed: August 16, 2001 :
Attorney Docket No. **YOR920010425US1** :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed November 5, 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, January 29, 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 April 30, 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 $1540; and (3) an adequate statement of unintentional delay.

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

The application is being referred to Technology Center Art Unit 2626 for consideration of the amendment filed November 5, 2007.

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

NOV 14 2003

Paper No. 9

In re Application of :
Randy G. Cowan : DECISION ON PETITION
Application No. 09/931,336 :
Filed: August 16, 2001 :
Attorney Docket No. 00-1914

This is a decision on the petition filed by facsimile transmission on October 16, 2003 by which petitioner requests withdrawal of the abandoned status of this application. Although a Notice of Abandonment has not been mailed, the application is currently technically abandoned for failure to file a proper and timely reply to the Office action dated April 1, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that a proper reply to the Office letter in question was in fact filed by facsimile transmission on September 2, 2003, the next business day after September 1, 2003. Petitioner further alleges that this reply was timely filed. In support of these allegations, petitioner has furnished a copy of the reply and a filing receipt therefor showing that petitioner's facsimile transmission was received in the Office on September 2, 2003. A review of the file shows that the file contains an authorization to charge any necessary 37 CFR 1.17 fees during the prosecution of this application, exclusive of filing and issue fees. Therefore, this file authorizes the charge of a two month extension of time fee against Deposit Account No. 11-0020, and such authorization constitutes a constructive petition for the two month extension of time. See 37 CFR 1.136(a)(3).

Accordingly, the technical status of this application as abandoned is hereby vacated, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner in Technology Center 3700 to charge the two month extension of time fee, and any other 37 CFR 1.17 fees that are necessary with respect to the reply filed on September 2, 2003. Thereafter, the application will be forwarded to the examiner for action on the reply filed on September 2, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Ivar M. Kaardal
Kaardal & Associates, P.C.
3500 South First Avenue Circle
Suite 250
Sioux Falls, SD 57105-5807

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

COHEN, PONTANI, LIEBERMAN & PAVANE
551 Fifth Avenue, Suite 1210
New York, NY 10176

COPY MAILED

JUN 2 0 2002

OFFICE OF PETITIONS

In re Application of :
Matti Hiltunen, Jukka Liukkonen and:
Harri Vatanen :
Application No. 09/931,338 :
Filed: August 16, 2001 :
Title: METHOD FOR TRANSMISSION OF :
SECURE MESSAGES IN A :
TELECOMMUNICATIONS NETWORK :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the "Petition under 35 U.S.C. §116 and 37 C.F.R. §1.47(a)," filed Monday, April 22, 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 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on August 16, 2001, with an unexecuted declaration. Matti Hiltunen, Jukka Liukkonen and Harri Vatanen were named as joint inventors. Accordingly, on September 21, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under §1.136(a).

In response, applicants filed a declaration executed by joint inventors Hiltunen and Liukkonen on behalf of themselves and on behalf of joint inventor Vatanen; the surcharge under §1.16(e); and the instant petition under §1.47(a). This response was made timely by an accompanying petition for extension of time within the fifth month. Applicants assert that status under §1.47(a) is proper because inventor Vatanen has refused to execute the subject U.S. Patent Application despite diligent efforts to have him sign a declaration in support the application.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification,

claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Rule 47 applicants have not submitted adequate proof of refusal. Petitioner has not shown that inventor Vatanen by his conduct refuses to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that the combined declaration and power of attorney were sent to inventor Vatanen. The evidence indicates that Sonera was forwarded a copy of the application as filed, but Sonera forwarded only a declaration and assignment to inventor Vatanen for signature. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to the non-signing inventor and he refused to sign. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Furthermore, 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. Thus, on renewed petition, a new declaration of facts from European Patent Attorney Markku Simmelvuo or other proper party, such as the employee of Sonera who presents the papers, is required.

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
ATTN: NANCY JOHNSON

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

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

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

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

COHEN, PONTANI, LIEBERMAN & PAVANE
551 Fifth Avenue, Suite 1210
New York, NY 10176

COPY MAILED

NOV 1 5 2002

OFFICE OF PETITIONS

In re Application of
Matti Hiltunen, Jukka Liukkonen and
Harri Vatanen
Application No. 09/931,338
Filed: August 16, 2001
Title: METHOD FOR TRANSMISSION OF SECURE MESSAGES IN A TELECOMMUNICATIONS NETWORK

DECISION NOTING JOINDER OF INVENTOR AND PETITION UNDER 37 CFR 1.47(a) MOOT

This is in response to the "Request for Reconsideration of Petition under 37 CFR § 1.47(a)," filed November 7, 2002.

The petition is **DISMISSED AS MOOT**.

The above-identified application was filed on August 16, 2001, with an unexecuted declaration. Matti Hiltunen, Jukka Liukkonen and Harri Vatanen were named as joint inventors. In response to a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)" mailed September 21, 2001, applicants filed the initial petition under § 1.47 to accept declarations executed by joint inventors Hiltunen and Liukkonen on behalf of themselves and on behalf of joint inventor Vatanen. The petition was dismissed for failure to provide adequate proof of the refusal of inventor Vatanen to join in the application (Decision mailed June 20, 2002).

On instant request for reconsideration, applicants filed a declaration executed by previously non-signing inventor Harri Vatanen. This reply was made timely by an accompanying petition (and fee) for a three-month extension of time.

The declaration filed November 7, 2002, has been reviewed and found in compliance with 37 CFR 1.63.

In view of the joinder of the joint inventor, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered moot. This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this Office for further consideration under 37 CFR 1.47(a).

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

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

Nancy Johnson
Petitions Attorney
Office of Petitions
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 LLP
1114 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

COPY MAILED

APR 2 9 2008

OFFICE OF PETITIONS

In re Application of :
Brendon Conlan et al. :
Application No. 09/931,342 : DECISION ON PETITION
Filed: August 16, 2001 : TO WITHFRAW
Attorney Docket No. : FROM RECORD
:

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 CFR 1.36(b) filed January 26, 2005.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Baker & McKenzie LLP has been revoked by the assignee of the patent application on May 4, 2005. Accordingly, the request to withdraw under 37 CFR 1.36(b) is moot.

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

Telephone inquiries concerning this decision should be directed to Carl Friedman at 571-272-6842.

Carl Friedman
Petitions Examiner
Office of Petitions

Cc: MORGAN LEWIS & BOCKIUS LLP
1111 PENSYLVANIA AVENUE NW
WASHINGTON DC 20004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCNEES, WALLACE & NURICK LLC
100 PINE STREET
P.O. BOX 1166
HARRISBURG PA 17108-1166

COPY MAILED

DEC 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Nagaraj et al :
Application No. 09/931,347 : DECISION GRANTING PETITION
Filed: August 16, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 13DV14035 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 24, 2004, 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 final Office action of December 9, 2003 is accepted as having been unintentionally delayed.

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

The application file is being referred to Technology Center AU 1775.

Karen Ceasy

Karen Ceasy
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

JONES WALKER WAECHTER
POITEVENT, CARR & DENEGRE, LLP
5TH FLOOR, FOUR UNITED PLAZA
8555 UNITED PLAZA BULEVARD
BATON ROUGE, LA 70809

COPY MAILED

NOV 2 5 2002

OFFICE OF PETITIONS

In re Application of
Stephen M. Dawson et al
Application No. 09/931,370
Filed: August 16, 2001
Attorney Docket No. 16409/93578-00

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.137(f) AND
:NOTICE RESETTING PERIOD FOR
:REPLY TO NONFINAL OFFICE
:ACTION

This is a decision on the petition filed October 28, 2002, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on August 13, 2002. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

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

(1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

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

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Corrected Filing Receipt which sets forth the projected publication date of March 6, 2003 accompanies this decision on petition.

There is no indication that a reply to the nonfinal Office action of July 29, 2002 has been filed. Accordingly, a shortened statutory period of three (3) months for reply to the nonfinal Office action of July 29, 2002 is restarted with the mailing date of this decision. Extensions of time pursuant to the provisions of 37 CFR 1.136(a) are permitted. Failure to timely reply within the period restarted by this decision will result in the abandonment of this application.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 3677 to await a reply to the July 29, 2002 nonfinal Office action, the period of which is restarted to run from the mailing date of this decision on petition as noted above.

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

ATTACHMENT: Corrected Filing Receipt

#17
DW

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

AUG - 4 2003

Warner J. Delaune, Jr.
Adams and Reese L.L.P.
451 Florida Street, Bank One Centre
North Tower, 19th Floor
Baton Rouge, LA 70801

MAILED

AUG - 4 2003

OFFICE OF THE DIRECTOR
TC 3600

In re application of
Stephen M. Dawson et al.
Application No.09/931,370 : DECISION ON REQUEST
Filed: August 16, 2001 : FOR WITHDRAWAL OF
For: MAGNETIC SEAL : ATTORNEY

This is a decision on the request filed on April 29, 2003, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED as MOOT**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney is not approved as moot since the revocation of the power of attorney filed on June 26, 2003 was accepted on July 25, 2003.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0868

SNM/dxn: 7/31/03

Cc: Bernard F. Meroney
Jones, Walker Waechter, Poitevent, Carrrere
& Denegre, L.L.P.
4th Floor, Four United Plaza
8555 United Plaza Boulevard
Baton Rouge, Lousiana 70809

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

LEE & HAYES
421 W RIVERSIDE AVENUE
SUITE 500
SPOKANE, WA 99201

COPY MAILED

NOV 2 6 2001

OFFICE OF PETITIONS

In re Application of
Gary J. Sullivan
Application No. 09/931,388
Filed: August 15, 2001
Attorney Docket No. MS1-751US

DECISION GRANTING
PETITION

This is a decision on the paper styled "Request For Correction Of Filing Receipt" filed on October 5, 2001, which is being treated as a petition under 1.10(c), requesting that the above-identified application be accorded a filing date of August 15, 2001, rather than the presently accorded filing date of August 16, 2001.

Applicant alleges that the application was deposited in "Express Mail" service with the U.S. Postal Service, on August 15, 2001. In support, applicant provided a copy of the Express Mail label, receipt no. EL792821701US, showing a Date-In of August 15, 2001. The same Express Mail number was referred to in the copy of the original transmittal letter submitted with the present application. Applicant requests that the application be accorded a filing date of August 15, 2001.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on August 15, 2001.

The petition is granted.

No petition fee is required and none has been charged.

The application is being returned to Initial Patent Examination Division to await applicant's response to the Notice mailed September 26, 2001, and for correction of the filing date to August 15, 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

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

APR - 4 2002

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

In re Application of	:
Guru V. Betageri	:
Serial No.: 09/931,199	: PETITION TO MAKE SPECIAL
Filed: August 16, 2001	:
Attorney Docket No.: WESTU1.001A	:

This is in response to applicants' petition filed March 19, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, XII. Therefor the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230

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

Patent
Atty. Docket: J466-001 CON

CERTIFICATE F MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to Box DAC, Commissioner for Patents, Washington, D.C. 20231 on February 12, 2003.

Annita Lisé
Dated: 2/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Herve Laurent
Serial No.	:	09/660,686
Filing Date	:	September 13, 2000
Examiner	:	N/A
Group Art Unit	:	N/A
For	:	ARRANGEMENT FOR RESEALING CARBONATED BEVERAGE CONTAINERS

COPY

Box DAC
Commissioner for Patents
Washington, D.C. 20231

FAX RECEIVED
MAR 19 2003
PETITIONS OFFICE

PETITION TO REVIVE
UNAVOIDABLY ABANDONED APPLICATION
UNDER 37 C.F.R. 1.117(I)

Sir:

The Commissioner is respectfully requested to revive the above-identified application as being abandoned unavoidably.

On February 5, 2003, while doing a status check with the USPTO, the undersigned learned that the above-identified application had been abandoned for failure to respond to a Notice to File Corrected Application Papers, which counsel learned was mailed on Septemb r 13, 2001, but never received by the undersigned. Enclosed is a facsimile copy

of the Notice, which was forwarded to the und rsigned, via facsimile, on February 5, 2003.

The undersigned receives all mail concerning patents and patent applications prosecuted by Notaro & Michalos P.C., and verifies that the Notice to File Corrected Application Papers dated September 13, 2001 was never received at the firm's office address which was then 350 Fifth Avenue, Suite 6902, New York, New York 10118.

As evidence that the Notice was never received, attached please find copies of pages from the undersigned's docket sheets which he personally updates, spanning the period between October 12, 2001 and November 17, 2001. Also attached is a copy of the cover of the file folder for this application, Serial No. 09/931,400 and for comparison, a copy of the file folder for Application No. 09/221,461, which was eventually issued as a patent to the same inventor.

It is the undersigned's usual docketing procedure when a document is received from the U.S. Patent and Trademark Office which requires reply, to enter the file number and a brief description of what is due one month earlier than the actual due date, as well as on the actual due date.

The Notice being mailed on September 13, 2001 would have been entered for call-up at October 13, 2001 and November 13, 2001. The dates for October 13, 2001 and November 13, 2001 do not include file number J466-001 CON 2, evidencing that the Notice was docketed. It will be seen that various and numerous other entries were made both in typing and by hand entry for other file numbers with other various actions due.

The undersigned, at the same time, enters a due date on the face of the file wrapper itself, as evidenced by the file wrapper for file number J466-001 US. No such entries appear on the file wrapper for the present application, J466-001 CON 2.

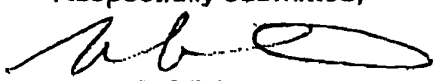
This Petition is also being submitted with the missing parts; specifically, the drawing she ts with corrected margins.

For the foregoing reasons, the Commissioner is respectfully requested to revive this application as being unavoidably abandoned and forward the application to the appropriate examiner for examination.

Since this application has become unavoidably abandoned through no fault of the undersigned, Counsel believes that no fee should be required. However, to expedite this matter, Counsel is submitting herewith a check in the amount of $55.00 for the petition fee based on small entity status.

Favorable and prompt action is respectfully requested, particularly in view of the abandonment of this application.

Respectfully submitted,



Peter C. Michalos
Reg. No. 28,643
Attorney for Applicant(s)
Phone: 845-359-7700

Dated: 2/12/03

NOTARO & MICHALOS P.C.
100 Dutch Hill Road
Suite 110
Orangeburg, New York 10962-2100

Customer No. 21706

PCM:al
Encs.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

E I du PONT de NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

COPY MAILED

APR 2 4 2007

OFFICE OF PETITIONS

In re Application of :
Saverio Carl Falco et al :
Application No. 09/931,457 : DECISION ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. BB1116 US :
CIP

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

The petition is **GRANTED.**

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 9, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 10, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b),[1] (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of February 9, 2006 is accepted as being unintentionally delayed.[2]

---

[1] To facilitate processing, any petition for an extension of time (or petition to revive under 37 CFR 1.137(b)) in which a continuing application is filed in lieu of a reply should specifically refer to the filing of the continuing application and also should include an express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

[2] The letter accompanying the petition to revive improperly references this application as Application No. 09/932,457.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 11/501,425, filed August 9, 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). Since the $1,020 extension of time fee submitted with the petition on August 28, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Rockwell Collins, Inc.
Attention: Kyle Eppele
M/S 124-323
400 Collins Rd. NE
Cedar Rapids IA 52498

COPY MAILED
MAR 3 0 2007
OFFICE OF PETITIONS

RECEIVED
MAR 30 2007
OFFICE OF PETITIONS
CANCELLED

In re Application of
Maurice W. Peterson et al.
Application No. 09/931,493
Filed: August 16, 2001
Attorney Docket No. 99CR098/KE

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 2, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of April 1, 2005. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is July 2, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $790, and the submission required by 37 CFR 1.114; (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 2611 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.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 14

LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

COPY MAILED

MAY 0 3 2005

OFFICE OF PETITIONS

In re Application of :
Robert G. Gibson, et al. :
Application No. 09/931,498 : ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. CUS3-BP54 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 18, 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 July 22, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 23, 2003.

Receipt is acknowledged of the Amendment filed January 18, 2005, with the instant petition.

The Revocation of Power of Attorney and Change of Correspondence Address has been accepted and recorded.

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.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application file is being forwarded to Technology Center 3600, Art Unit 3636 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

HUSCH BLACKWELL SANDERS LLP
190 CARONDELET PLAZA
SUITE 600
ST. LOUIS, MO 63105-3441

MAILED

NOV 1 3 2009

OFFICE OF PETITIONS

In re Patent No. 6,902,555 :
Issue Date: June 7, 2005 :
Application No. 09/931,562 : ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. 39868/24659 :

This is a decision on the petition under 37 CFR 1.378(c), filed August 26, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on June 7, 2009 for failure to pay the 3 ½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Petitioner will not receive future correspondence related to maintenance fees for the patent unless a "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) are submitted.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

The patent file is being forwarded to Files Repository.

April M. Wise
Petitions Examiner
Office of Petitions

Cc: GREGORY E. UPCHURCH
C/O LEGALMETRUC
1000 DES PERES ROAD
SUITE 210
ST LOUIS, MO 63131

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAW OFFICE OF RICHARD B. KLAR
28 EAST OLD COUNTRY ROAD
HICKSVILLE, NY 11801

COPY MAILED

MAR 1 4 2005

OFFICE OF PETITIONS

In re Application of :
James Russell Hornsby et al :
Application No. 09/931,570 : ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. 6881.01 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 2, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 9, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 10, 2004.

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

This matter is being referred to Technology Center 3714.

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

JJGJR.: 06-05

Paper No: __

ROBERT E. MUIR, ESQ.
HUSCH & EPPENBERGER, LLC
SUITE 1400
401 MAIN STREET
PEORIA IL 61602-1241

COPY MAILED

JUN 22 2005

OFFICE OF PETITIONS

In re Application of	:	
Theidig, et al.	:	
Application No. 09/931,606	:	DECISION ON PETITION
Filing Date: 16 August, 2001	:	
Attorney Docket No. 64251-030	:	

This is a decision on the petition filed on 11 March, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

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

NOTE: The address of record is different from that on the instant petition. If Petitioner desires to receive future correspondence regarding this application at the latter address, the appropriate Notice of Change of Address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

BACKGROUND

The record indicates:

- Petitioner failed to reply timely and properly to the final Office action mailed on 6 January, 2004, with reply due absent extension of time on or before 6 April, 2004;
- on 5 April, 2004, Petitioner filed as a reply an after-final amendment, which Examiner found was not a proper reply (in that it did not place the application in condition for allowance[1]), and on 11 February, 2005, the Examiner mailed an Advisory Action;
- the application went abandoned after midnight 6 April, 2004;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;
- the instant petition was filed on 11 March, 2005, and was accompanied by a request for continued examination (RCE) with fee and submission under 37 C.F.R. §1.114, and Petitioner alleges unintentional delay and makes the required statement in support thereof.

STATUTES, REGULATIONS AND ANALYSIS

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

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

---

[1] A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or a CPA or RCE (with fee and submission). (See: MPEP §711.03(c).)

[2] 35 U.S.C. §133 provides:

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

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

the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

Petitioner has satisfied the petition, fee, reply and statement/showing requirements of the regulation.

The record (including the petition filed on 11 March, 2005) does not necessitate a finding that the delay between midnight 6 April, 2004 (the date of abandonment), and 11 March, 2005 (the date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Applicants and their Counsel Robert C. Haldiman (Reg. No. 45,437) when accepting Petitioner's representation that the delay in filing the response was unintentional.[8]

---

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

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

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

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

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

[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).

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby is **granted**, and fees charged as authorized.

The instant application is released to Technology Center 3700 for further processing in due course.

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

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

cc:
ROBERT C. HALDIMAN
HUSCH & EPPENBERGER LLC
190 CARONDELET PLAZA
ST. LOUIS, MO 63105

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJr.: 08-05

Paper No. __

ROBERT E. MUIR, ESQ.
HUSCH & EPPENBERGER, LLC
SUITE 1400
401 MAIN STREET
PEORIA IL 61602-1241

COPY MAILED

SEP 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Thiedig, et al. :
Application No. 09/931,606 :
Filed: 16 August, 2001 : ON PETITION
Attorney Docket No: 64251-030 :

This is a decision on the petition under 37 C.F.R. §1.55(c), filed 28 March, 2004, for acceptance of an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit, as the continuation of foreign application PCT/DE00/00428, of the filing date of foreign Applications identified as "PCT/DE00/00428, 199 06 021.5, filed 15 February, 2000," and "PCT/DE00/00428, 199 06 021.5, filed 15 February, 1999" (sic).

The petition is **DISMISSED**.

A petition under 37 C.F.R. §1.55(c) to accept an unintentionally delayed claim for priority requires:

- The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

- The claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be

included either in an oath or declaration (37 C.F.R. §1.63(c)(2)) or in an Application Data Sheet (ADS) (37 C.F.R. §1.76(b)(6);

- The surcharge as set forth in 37 C.F.R. §1.17(t);

- A statement that the entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional); and

- The above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant petition fails to comply with the second and fifth items, above.

Specifically:

- Petitioner sets forth conflicting information as to the applications—i.e., identifying the claims two applications with the same application number but two different filing dates; and

- Petitioner states at the last paragraph of the petition that he "respectfully petitions for leave to claim priority to August 16, 1999;" however, the data set forth in the ADS specifies dates in February of 2000 and February of 1999—not August of 1999.

In this regard, a review of the file record fails to disclose at this writing that the priority information was included properly in an oath or declaration or in an Application Data Sheet in accordance with 37 C.F.R. §1.76(b)(6). Unless provided in an application data sheet, 37 C.F.R. §1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 C.F.R. §1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP §201.14, page 200-77 (Rev. 2, May 2004), last paragraph, second column.

In view of the above, compliance with 37 C.F.R. §1.63(c)(2) or 37 C.F.R. §1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign applications noted in the ADS. Any future petition should include a cover letter and be entitled A Renewed Petition under 37 C.F.R. §1.55(c).

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

Inquiries concerning this decision may be directed to John Gillon, Senior Attorney, Office of Petitions at (571) 272-3214.

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

JJGJr.: 08-05

Paper No. __

ROBERT E. MUIR, ESQ.
HUSCH & EPPENBERGER, LLC
SUITE 1400
401 MAIN STREET
PEORIA IL 61602-1241

COPY MAILED

SEP 2 9 2005

OFFICE OF PETITIONS

In re Application of :
Thiedig, et al. :
Application No. 09/931,606 :
Filed: 16 August, 2001 : ON PETITION
Attorney Docket No: 64251-030 :

This is a decision on the (renewed) petition under 37 C.F.R. §1.55(c), filed 20 September, 2005, for acceptance of an unintentionally delayed claim under 35 U.S.C. §119(a) - (d) for benefit, as the continuation of foreign application PCT/DE00/00428, of the filing date of foreign Applications identified as "PCT/DE00/00428, 199 06 021.5, filed 15 February, 2000," and "PCT/DE00/00428, 199 06 021.5, filed 15 February, 1999."

The petition is **GRANTED**.

A petition under 37 C.F.R. §1.55(c) to accept an unintentionally delayed claim for priority requires:

- The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

- The claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be

included either in an oath or declaration (37 C.F.R. §1.63(c)(2)) or in an Application Data Sheet (ADS) (37 C.F.R. §1.76(b)(6);

- The surcharge as set forth in 37 C.F.R. §1.17(t);
- A statement that the entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional); and
- The above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

All requirements being met, the petition under 37 C.F.R. §1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. §119(a)-(d) is **granted**.

A Corrected Filing Receipt which reflects the above-noted foreign application accompanies this decision on petition.

This application is being forwarded to Technology Center 3700 for examination in due course and for consideration by the examiner of record of the foreign priority claim under 35 U.S.C. §119(a)-(d).

Inquiries concerning this decision may be directed to John Gillon, Senior Attorney, Office of Petitions at (571) 272-3214.

Frances Hicks
Petitions Examiner
Office of Petitions

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6568234	2003-05-27	09931618	2001-08-17	D-1175

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

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
◉	3 ½ year	(1551)
○	7 ½ year	(1552)
○	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Maurice E. Gauthier/	Date (YYYY-MM-DD)	2007-06-04
Name	Maurice E. Gauthier	Registration Number	20798

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. 6568234
Issue Date: May 27,2003
Application No. 09931618
Filed: August 17,2001
Attorney Docket No. D-1175

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

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

The petition is GRANTED.

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

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

UNITED STATES 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

OCT 0 2 2006

OFFICE OF PETITIONS

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON, WI 53701-1497

In re Application of :
Abbott, et al. : LETTER REGARDING PTA
Application No. 09/931,635 :
Filed: August 16, 2001 :
Atty. Dkt. No.: 032026:0573 :

This letter is in response to the "STATEMENT REGARDING PATENT TERM ADJUSTMENT" filed May 8, 2006. The Office thanks applicants for their good faith and candor in bringing this to our attention. No fee is due in connection with this matter.

The correct Patent Term Adjustment ("PTA") at the time of the issuance is ~~354~~ 392 days. The Office will adjust the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the instant letter reflects an adjustment of 392 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

The Determination of Patent Term Adjustment mailed April 21, 2006 indicated that at the time of allowance, the above-identified application was entitled to an adjustment of 396 days.

Applicants, however, indicate that the proposed adjustment of 396 days disagrees with applicants' own calculation, and request verification of the calculation.

A review of the application history reveals that at the time of allowance an adjustment of 552 days can be attributed to the Office. An adjustment of 530 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1). A further adjustment of 22 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(2) and 1.703(a)(2).

The adjustment of 552 days is properly reduced a total of 160 days for applicants' failure to engage in reasonable efforts to conclude prosecution (or processing) within the meaning of 37 CFR 1.704.

The adjustment of 552 days is properly reduced four days in accordance with 37 CFR 1.704(b). The adjustment began December 28, 2001, the day after the date that is three months after the date

the Notice to File Missing Parts was mailed, and ended December 31, 2001, the date a reply thereto was filed.

The adjustment of 552 days is further reduced 30 days in accordance with 37 CFR 1.704(b). The reduction began June 30, 2004, the day after the date that is three months after the date the non-final rejection was mailed, and ended July 29, 2004, the date a response thereto was filed.

The adjustment of 552 days is further reduced 36 days in accordance with 37 CFR 1.704(b). The reduction began January 26, 2005, the day after the date that is three months after the date that the second non-final rejection was mailed, and ended March 2, 2005, the date a response thereto was filed.

The adjustment of 552 days is further reduced 90 days in accordance with 37 CFR 1.704(b) in connection with the amendment filed November 30, 2005. The adjustment began September 2, 2005, the day after the date that is three months after the date the final rejection was mailed, and ended November 30, 2005, the date the amendment placing the application in condition for allowance was filed.

In view thereof, at the time of allowance, the application was entitled to an adjustment of 392 days.

The patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

As this letter was submitted as an advisement to the Office of an error in applicants' favor, no fee is due in connection with this matter.

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

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

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

Enclosure: Copy of Adjustment PAIR Calculation

Day : Saturday
Date: 9/30/2006

PALM INTRANET

Time: 14:36:27

PTA Calculations for Application: 09/931635			
Application Filing Date:	08/16/2001	PTO Delay (PTO):	552
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	156
Post-Issue Petitions:	0	Total PTA (days):	392
PTO Delay Adjustment:	-4		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
51	09/30/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		4	
44	04/21/2006	MAIL NOTICE OF ALLOWANCE	22		35
43	03/30/2006	ISSUE REVISION COMPLETED			
42	03/30/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
41	03/30/2006	CASE DOCKETED TO EXAMINER IN GAU			
40	10/26/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
39	03/28/2006	NOTICE OF ALLOWABILITY			
38	02/06/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
37	12/05/2005	NOTICE OF APPEAL FILED			
36	03/08/2006	DATE FORWARDED TO EXAMINER			
35	11/30/2005	AMENDMENT AFTER FINAL REJECTION		90	27
34	11/30/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	10/26/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
29	08/02/2005	DATE FORWARDED TO EXAMINER			
28	07/25/2005	AMENDMENT AFTER FINAL REJECTION			
27	06/01/2005	MAIL FINAL REJECTION (PTOL - 326)			
26	08/02/2005	FINAL REJECTION			
23	03/15/2005	DATE FORWARDED TO EXAMINER			
22	03/02/2005	RESPONSE AFTER NON-FINAL ACTION		36	20
21	03/02/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
20	10/25/2004	MAIL NON-FINAL REJECTION			
19	10/22/2004	NON-FINAL REJECTION			

18	08/10/2004	DATE FORWARDED TO EXAMINER			
17	07/29/2004	RESPONSE AFTER NON-FINAL ACTION		30	14
16	07/29/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
15	07/29/2004	WORKFLOW INCOMING AMENDMENT IFW			
14	03/29/2004	MAIL NON-FINAL REJECTION	530		-1
13	03/22/2004	NON-FINAL REJECTION			
12	10/22/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
11	07/06/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	12/10/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	10/23/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	01/09/2002	TRANSFER INQUIRY TO GAU			
7	01/08/2002	APPLICATION DISPATCHED FROM OIPE			
6	01/04/2002	APPLICATION IS NOW COMPLETE			
5	09/27/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	09/26/2001	CORRESPONDENCE ADDRESS CHANGE			
3	09/25/2001	CORRESPONDENCE ADDRESS CHANGE			
2	08/22/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/16/2001	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

RICHARD I. SAMUEL, ESQ.
GOODWIN PROCTER, LLP
820 EIGHTH AVENUE
NEW YORK NY 10018

COPY MAILED

JUN 17 2008

OFFICE OF PETITIONS

In re Application of	:	
Hanisch et al.	:	
Application No. 09/931,638	:	ON PETITION
Filed: August 16, 2001	:	
Attorney Docket No. 050001	:	

This is a decision on the petition under 37 CFR 1.181, filed January 5, 2007, requesting the withdrawal of the holding of abandonment in the above-identified application and has been so treated.

The petition to withdraw the holding of abandonment is **GRANTED.**

The petition under 37 CFR 1.137(b) is **DISMISSED as moot**.

The above-identified application was deemed abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 18, 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 was deemed abandoned on December 19, 2001.

Petitioner states that the reply was in fact timely filed. To support this assertion, petitioner has submitted copies of the return postcards, which acknowledges receipt by the U.S. Patent and Trademark Office (USTPO) on January 10, 2002 of 1. Declaration signed by inventors; and 2. Certified Copy of German patent application; on January 22, 2002 of 1. Response in the form of a sequence listing. Additionally, petitioner has supplied a copy of the previously mailed correspondence, which bears a certificate of mailing date of November 6, 2001 and November 29, 2001.

The reply acknowledged as having been received in the USPTO on January 10, 2002 and January 22, 2002 (certificate of mailing dates of November 6, 2001 and November 29, 2001) is not of record in the application file and cannot be located, although it does appear on the jacket file list of contents. However, MPEP 503 states that "A post card receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the reply was timely received in the USPTO but was apparently lost after receipt thereof.

In view of the above, the holding of abandonment is hereby withdrawn and the application restored to pending status.

A petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 does not require a fee. The $750.00 petition fee submitted with the instant petition will be refunded to petitioner's credit card.

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

This matter is being referred to the Office of Patent Application Processing for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206. Any inquiries concerning the status thereafter should be directed to the Office of Patent Application Processing.

Liana Walsh
Petitions Examiner
Office of Petitions

cc:

BUCHANAN INGERSOLL & ROONEY PC
ONE OXFORD CENTRE
301 GRANT STREET, 20TH FLOOR
PITTSBURGH, PA 15219

UNITED STATES PATENT AND TRADEMARK OFFICE

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

McGUINNESS & MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

COPY MAILED

APR 10 2007

OFFICE OF PETITIONS

In re Application of :
Bruce A. SCHOFIELD et al. :
Application No. 09/931,643 : ON PETITION
Filed: August 15, 2001 :
Attorney Docket No. 120-173 :

This is a decision on the petition, filed May 31, 2002 and resubmitted November 4, 2002, which is being treated as a petition under (1) 37 CFR 1.47(a) to accept this application notwithstanding the absence of the signature of a non-signing inventor and (2) the petition, filed February 6, 2007, under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.48(a)(2).

The petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(2) and amend the inventive entity to delete Andre N. Fredette is **GRANTED.**

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

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.

MPEP 409.03(a) states:

> All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

37 CFR 1.48(f)(1) states:

> Nonprovisional application—filing executed oath/declaration corrects inventorship. If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.

37 CFR 1.64(a) states:

> The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

In the instant application petitioner initially filed on August 15, 2001 both an application data sheet and an unexecuted oath or declaration naming three inventors. On May 31, 2002, petitioner submitted the instant petition along with a Rule 47 oath or declaration which was executed by Bruce A. Schofield but was not executed by James V. Luciani and an added a fourth inventor Andre N. Fredette. According to 37 CFR 1.48(f)(1) the named inventive entity was fixed by the partially executed May 31, 2002 declaration. On November 4, 2002 petitioner filed a substitute Rule 47 petition that named only the actual inventors of the subject matter of the instant application, i.e., Bruce A. Schofield, James V. Luciani, and Michael J. Craren along with a petition under 37 CFR 1.48(a) to remove Andre N. Fredette as a named inventor. The petition under 37 CFR 1.48(a) was dismissed in the decision mailed January 29, 2007. A petition under 37 CFR 1.183 waive the requirement of 37 CFR 1.48(a)(2) and amend the inventive entity to delete Andre N. Fredette was filed February 6, 2007.

Under the circumstances of this case, and in view of the petition requesting waiver of the rules granted by this decision, the USPTO will amend, on petition, the inventive entity to delete Andre N. Fredette.

In view of the above, the application contains an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116.

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

The 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 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being forwarded to Technology Center Art Unit 2613 for further processing commensurate with this decision.

Telephone inquiries concerning this decision should be directed to David Bucci at (571) 272-7099.

Brian Hearn
Petitions Examiner
Office of Petitions

Encl. 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

JAMES V. LUCIANI
9 SHADY LANE
ACTON, MA 01720

COPY MAILED

APR 10 2007

OFFICE OF PETITIONS

In re Application of
Bruce A. SCHOFIELD et al.
Application No. 09/931,643
Filed: August 15, 2001
For: FORMULATIONS FOR THE TREATMENT OF PAIN

Dear Mr. Luciani:

You are named as a sole inventor in the above-identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a sole 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 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 the Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington, DC area).

Telephone inquiries regarding this communication should be directed to David Bucci at (571) 272-7099.

Brian Hearn
Petitions Examiner
Office of Petitions

cc: McGUINNESS & MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
09/931,643	08/15/2001	2613	1830	120-173	52	4

CONFIRMATION NO. 2705

CORRECTED FILING RECEIPT

34845
McGUINNESS & MANARAS LLP
125 NAGOG PARK
ACTON, MA 01720

OC000000023308746

Date Mailed: 04/10/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Bruce A. Schofield, Tyngsboro, MA;
James V. Luciani, Acton, MA;
Michael J. Craren, Holliston, MA;

Power of Attorney: The patent practitioners associated with Customer Number **28901**.

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/225,594 08/15/2000

Foreign Applications

If Required, Foreign Filing License Granted: 04/09/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/931,643

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

OPTICAL SWITCH ROUTER

Preliminary Class

398

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof

unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

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

NOT GRANTED

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

UNITED STATES 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

OCT 0 2 2006

OFFICE OF PETITIONS

McGUINNESS & MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

In re Application of :
Monga, et al. : DECISION ON PETITION
Application No. 09/931,645 :
Filed: August 15, 2001 :
Atty. Dkt. No.: 14983BAUS01U :

This is a decision on the petition under 37 CFR 1.137(b), filed August 7, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely submit a proper reply to the final Office action mailed October 11, 2005. The final Office action set a three (3) month shortened statutory period of time for reply. The reply submitted January 3, 2006 failed to place the application in condition for allowance, as indicated in the Advisory Action mailed January 25, 2006. Notice of Abandonment was mailed June 6, 2006.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(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(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition 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 file is being forwarded to Technology Center 2100 for processing of the RCE submitted herewith.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02-19-10

TO SPE OF : ART UNIT 2194

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/931650 Patent No.: 7076785

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Angela Green 703-756-1541
Certificates of Correction Branch
703-756-1814

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 2194 Art Unit

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450 ALEXANDRIA VA 22313-450
WWW.USPTO.GOV

NOV. 10, 2003

Steven J. Trzaska
Cognis Corporation
Patent Department
2500 Renaissance Boulevard, Suite 200
Gulph Mills, PA 19406

In re Application :
Ansmann et al :
Serial No. : 09/931,670 : Petition Decision
Filed: August 16, 2001 :
Attorney Docket No.: H 2674A PCT/US

This is in response to Petition from requirement for restriction under 37 CFR 1.144 filed March 19, 2003.

On December 12, 2002, a restriction requirement was made. Claims were directed to the following groups:

I. Claims 11-14 and 18-22, drawn to compositions and uses thereof comprising a dialkyl ether, a cationic polymer, and a fatty acid N-alkyl polyhydroxyalkyl emulsifiers;
II. Claims 11-13, 15, and 18-22, drawn to compositions and uses thereof comprising a diakyl ether, a cationic polymer, and an alkyl ether sulfate emulsifier;
III. Claims 11-13 and 16-22, drawn to compositions and uses thereof comprising a diakly ether, a cationic polymer, and a betaine emulsifier.

The examiner stated in the restriction that Groups I-III are unrelated because they do not have the same claimed limitations, they each require a different emulsifier, and the emulsifiers of each group neither anticipate no render obvious emulsifiers of the other groups. The examiner further required a election of species within the elected group for search purpose.

Applicants elected Group II with traverse in the response filed December 16, 2002. Applicants' traversal is on the grounds that all the compositions have the same mode of operation, perform the same function, and provide the same effect. The examiner found the traversal non-persuasive for the reasons of record in the office action mailed December 12, 2002. On March 19, 2003, the present petition was filed.

Applicants urge that all groups are definitely related, they are all possess the same mode of operation, i.e., they are al capable of being introduced/admixed into cosmetic composition for the purpose of imparting a pearlescent appearance to a cosmetic composition, they all perform the

same function, i.e., impart a pearlescent appearance to a cosmetic composition, and they all provide the same effect, i.e., pearlescence. Applicants also indicate that all groups are classified in the same class/subclass. Applicants further assert that the election of species is improper because that the examiner did not show that each species is "independent and distinct.

The restriction and applicants' argument have been carefully considered. The various emulsifiers recited in the groups are of diverse structures. The class and subclass for the different emulsion as set forth in Groups I-III are different. In addition to search in class/subclass 424/401, Group I requires search in class 507 subclass 116, Group II requires search in class 524 subclass 747, and Group III requires search in class 546 subclass 339. There is also additional search burden in literature search. Therefor, Groups I-III are independent and distinct, and there is burden of search. The requirements of restriction are met. With regard to the election of species, the examiner clearly indicated on the bottom of page 3 of restriction mailed December 12, 2002, and on page 2 of office action mailed on February 21, 2003, that the election is only for search purpose.

The restriction requirement is deem proper. Applicants' petition is denied. Group II, Claims 11-13, 15 and 18-22 are to be examined.

John Doll
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AFS / ANGIODYNAMICS
666 THIRD AVENUE
FLOOR 10
NEW YORK NY 10017

COPY MAILED
NOV 0 5 2008

In re Application of :
Chomenky et al. :
Application No. 09/931672 : DECISION ON PETITION
Filing or 371(c) Date: 08/17/2001 : UNDER 37 CFR 1.78(a)(6)
Title of Invention: APPARATUS AND METHOD FOR REDUCING SUBCUTANEOUS FAT DEPOSITS, VIRTUAL FACE LIFT AND BODY SCULPTURING BY ELECTROPORATION :

This is a decision on the Petition Under 37 C.F.R. § 1.78(a)(6) to Accept Unintentionally Delayed Claim for Benefit Under 35 U.S.C. 119(e)," filed September 23, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to 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 Director may require additional information where there is a question whether the delay was unintentional.

This petition fails to satisfy item (1) above. In this regard, 37 CR 1.78(a)(5)(ii) requires that a claim for benefit of priority to a prior-filed provisional application must be submitted during the pendency of the application. Further to this, the MPEP 201.11(E) provides: If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during

the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e). (Emphasis supplied).

As such, a Certificate of Correction is not a valid mechanism for adding or correcting a priority claim under 35 U.S.C. § 119(e) after a patent has been granted on an application filed on or after November 29, 2000. *See* MPEP 1481.03. Therefore, as this application matured into Patent No. 6,697,670 on February 24, 2004, a claim for benefit of priority to the above-noted provisional application cannot now be added by way of a Certificate of Correction.

Applicant may attempt to add the benefit claim by way of reissue. The MPEP 1481.03 provides:

> Where the application, which became the patent to be reissued, was filed on or after November 29, 2000, reissue may be employed to correct an applicant's mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e). A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) would not be required in addition to filing a reissue application.
> Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:
>
> > No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (Emphasis added.)
>
> The court in Fontijn held that 35 U.S.C. 251 was sufficiently broad to correct a patent where the applicant failed to assert or failed to perfect a claim for foreign priority during the prosecution of the original application even though 35 U.S.C. 119(b) at that time required a claim and a certified copy of the foreign application to be filed before the patent is granted. Similarly, the Office may grant a reissue for adding or correcting a benefit claim under 35 U.S.C.119(e) that requires the benefit claim to a provisional application be submitted during the pendency of the application. (Emphasis supplied).

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

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

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

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

Any questions concerning this matter may be directed to Derek Woods at (571) 272-3232.

Anthony Knight
Supervisor
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

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

COPY MAILED

DEC 2 1 2005

OFFICE OF PETITIONS

In re Application of

Martin Khang Nguyen

Application No. 09/931,677

Filed: August 15, 2001

Attorney Docket No. Nguyen.M-01

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 3, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed January 27, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on April 28, 2005. A Notice of Abandonment was mailed on August 11, 2005.

The amendment filed November 3, 2005, is noted and made of record.

The "Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address" filed November 3, 2005, is noted and made of record.

The application is being forwarded to Technology Center 3600, GAU 3622 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: "Notice Regarding Change of Power of Attorney"

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. 6

Law Offices of Karl Hormann
86 Sparks Street
Cambridge, MA 02138-2216

AUG 28 2002

In re Application of :
Frank Puttkammer :
Application No.: 09/931,694 :
Filing Date: August 16, 2001 :
Attorney Docket No.: 010469-US :

DECISION ON REQUEST
TO ACCEPT LATE PAPERS

This is a response to the communication filed via facsimile transmission on August 15, 2002. The communication is being treated as a request to accept papers as timely filed pursuant to 37 C.F.R. § 1.8(b) for the above-identified application.

The request is DISMISSED.

A non-final Office action was mailed December 10, 2001, setting a three month shortened statutory period for filing a response. A timely response to the Office action was not received at the USPTO. Before sending out a Notice of Abandonment, the examiner called applicant's attorney, Mr. Karl Hormann, to verify that a response to the Office action was not in fact filed by applicant. Mr. Hormann asserted that a response to the Office action was filed and sent the above-noted communication to support this assertion.

The communication filed via facsimile transmission on August 15, 2001 included: 1) a copy of an amendment dated 1 May 2002; 2) a copy of a postcard (not stamped by the USPTO) which lists a "Response to Official Action of 10 December 2001"; 3) an Amendment Transmittal Letter which bears a Certificate of Mailing under 37 C.F.R. § 1.8(a) dated May 2002; 4) a statement under 37 C.F.R. § 1.8(b)(3); and 5) a Certificate of Transmission by Facsimile dated August 15, 2002.

The papers filed as parts of the communication do not satisfy the conditions for accepting a response using a Certificate of Mailing under 37 C.F.R. § 1.8(a) but not received by the USPTO for the following reasons: 1) the Certificate of Mailing although clearly dated May 2002 does not clearly indicate the specific day of May 2002 and 2) the statement under 37 C.F.R. § 1.8(b)(3) is not signed.

In addition, even if the response was received at the USPTO on May 3, 2002 (the mailing date specified on the 37 C.F.R. § 1.8(b)(3) statement), the response would still not have been timely filed. The shortened statutory period for response expired as of March 10, 2001. Although this time period could have been extended under the provisions of 37 C.F.R. § 1.136 to June 10,

2001, there is no evidence that a petition for an extension of time with the requisite fee was ever filed before June 10, 2001. In addition, there was no authorization given to charge a Deposit Account for fees associated with the response. Consequently, the petition is **dismissed.**

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision.

The application file is being forwarded to the group Central Files area to await a request for reconsideration. If no request for reconsideration is filed within the given time period, the application will be forwarded to the examiner for preparation of a Notice of Abandonment.

Any inquiries regarding this decision should be directed to Edward Westin at (703) 308-4823.

Howard N. Goldberg, 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.gov

Law Offices of Karl Hormann
86 Sparks Street
Cambridge MA 02138-2216

COPY MAILED

MAR 1 6 2006

OFFICE OF PETITIONS

In re Application of :
Frank PUTTKAMMER :
Application No. 09/931,694 : ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. 3407 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 18, 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 December 10, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 11, 2002.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of December 10, 2001 is accepted as having been unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand 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 of 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

A revocation of power of attorney by the assignee was filed December 8, 2005. The revocation is not acceptable because the statement under 37 CFR 3.73(b) did not include 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). A courtesy copy of this decision is being mailed to the address given on the petition; however, the office will mail all future correspondence solely to the address of record

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 2858 for appropriate action on the concurrently filed amendment.

David Bucci
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DRW Sep-06

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

COPY MAILED

SEP 22 2006

OFFICE OF PETITIONS

In re Application of	:	
Frank Puttkammer	:	
Application No. 09/931,694	:	DECISION ON PETITION
Filed: 16 August, 2001	:	
Atty Docket No. HENN0021U-US	:	

This is a decision on the petition filed on 8 August, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 23 June, 2006, for failure to timely submit corrected drawings as required by the Notice of Allowability mailed on 22 March, 2006, which set a three (3)

---

[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)).

month statutory period for reply. Notice of Abandonment was mailed on 1 August, 2006.

Receipt of the corrected drawings is acknowledged.

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

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

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

JJGJR.: 06-04

Paper No: 7

NOVOZYMES NORTH AMERICA, INC.
500 FIFTH AVENUE
SUITE 1600
NEW YORK NY 10110

COPY MAILED
JUN 2 9 2004
OFFICE OF PETITIONS

In re Application of
Outtrup, et al.
Application No. 09/931,701
Filing Date: 16 August, 2001
Attorney Docket No. 10065.200-US

DECISION ON PETITION

This is a decision on the petition filed on 12 December, 2003, alleging, *inter alia*, timely filing and reply, requesting withdrawal of the holding of abandonment and considered under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, it is noted that Petitioner placed an incorrect application number on the papers submitted on 12 December, 2003.

For the reasons set forth below, the petition as considered under 37 C.F.R.§1.181 is **DISMISSED**;

NOTES:

(1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.181, or 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) **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)"; and/or "Petition under 37 C.F.R. §1.137(b)";

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

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Missing Parts mailed on 23 October, 2001, with reply due absent extension of time on or before 24 December, 2001;
- the application went abandoned by operation of law after midnight 23 December, 2001;
- the Office mailed a Notice of Abandonment on 4 December, 2003;
- with the instant petition, Petitioner submitted a copy of a reply (with receipt card) alleged to have been submitted on 9 January, 2002, over an 18 December, 2001, certificate of mail, however, it is clear from the copies of the papers submitted and the instant petition that all of these materials were misfiled by Petitioner into the wrong application, to wit: rather than the instant Application No. 09/931,701, Petitioner filed the materials into Application No. 09/913,701.

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

---

[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).

a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6] And petitions calling upon the authority of the Commissioner to act, such as that under 37 C.F.R. §1.181,[7] require diligence as to their filing–i.e., the petition must be filed within two months of the action complained of.

Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal

---

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

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

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

[7] The regulations at 37 C.F.R. §1.181 provide:

§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by orreviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

of a holding of abandonment.[8]

Petitioner has evidenced that he did not file papers into the instant application. Rather, he filed papers into another application.

Thus, Petitioner fails to satisfy his burden under 37 C.F.R. §1.181

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

The instant file is held in the Office of Petitions to consider another matter.

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

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

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

UNITED STATES 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.: 06-04

Paper No: 9

NOVOZYMES NORTH AMERICA, INC.
500 FIFTH AVENUE
SUITE 1600
NEW YORK NY 10110

COPY MAILED

JUL 0 2 2004

OFFICE OF PETITIONS

In re Application of
Outtrup, et al. :
Application No. 09/931,701 : DECISION ON PETITION
Filing Date: 16 August, 2001
Attorney Docket No. 10065.200-US :

This is a decision on the petition filed on 28 June, 2004, alleging, *inter alia*, unintentional delay under 37 C.F.R. §1.137(b), and in light of the record and the allegations considered under 37 C.F.R. §1.137(a) as an allegation of unavoidable delay.

For the reasons set forth below:

- the petition as considered under 37 C.F.R.§1.137(a) is **GRANTED**, and the fee ($110.00) is charged to Deposit Account 50-1701, as authorized; and

- the petition under 37 C.F.R.§1.137(b) is **DISMISSED as moot**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Missing Parts mailed on 23 October, 2001, with reply due absent extension of time on or before 24 December, 2001;

- the application went abandoned by operation of law after midnight 23 December, 2001;

- the Office mailed a Notice of Abandonment on 4 December, 2003;

- previously, Petitioner submitted a copy of a reply alleged to have been submitted on 9 January, 2002, over an 18 December, 2001, certificate of mail, however, it is clear from the copies of the papers submitted and the instant petition that all of these materials were misfiled by Petitioner into the wrong application, and the request to withdraw the holding of abandonment was dismissed;

- in the instant petition Petitioner makes the statement of unintentional delay, authorizes fees, and the reply previously was submitted, however, the petition also is considered in light of events as one under 37 C.F.R. §1.137(a), and there is a showing of unavoidable delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[1]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[2]

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not

---

[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, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6] And petitions calling upon the authority of the Commissioner to act, such as that under 37 C.F.R. §1.181,[7] require diligence as to their filing–i.e., the petition must be filed within two months of the action complained of.

Allegations as to Unavoidable Delay
and Unintentional Delay

Petitioner has evidenced that, while he did in fact err in entering the application number on the papers submitted, he was diligent in his reply to the Office action in question, though the reply was filed into the wrong application. Petitioner has made a showing of unavoidable delay.

Thus, Petitioner has satisfied his burden under 37 C.F.R. §1.137(a).

CONCLUSION

Therefore, the petition as considered under 37 C.F.R. §1.137(a) hereby is **granted**, and the

---

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

[7] The regulations at 37 C.F.R. §1.181 provide:

§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by orreviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

petition under 37 C.F.R. §1.137(b) hereby is **dismissed as moot**.

The instant file is forwarded to Technology Center 1600 for further processing in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 02-02

Paper No. 5

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

COPY MAILED

MAR 0 7 2002

OFFICE OF PETITIONS

In re Application of :
Ulrich Certa :
Application No. 09/931,733 : DECISION GRANTING PETITION
Filed: 17 August, 2001 :
Attorney Docket No. 20676 :

This is a decision on the petition filed on 8 January, 2002, requesting that the above-identified application, without drawings, be accorded a filing date of 17 August, 2001.

The application was filed on 17 August, 2001, without drawings.[1] Accordingly, on 2 October, 2001, Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application" stating that no filing date had been assigned because the application was deposited without drawings, and requiring drawings be filed if necessary.

In response, on 8 January, 2002 (certificate of mailing date 28 November, 2001), the present petition was filed. Petitioner asserts that drawings are not necessary for an understanding of the subject matter sought to be patented. Petitioners request that the application, without drawings, be accorded a filing date of 17 August, 2001.

It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).[2] A review of the record

[1] 35 U.S.C. § 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented."

[2] MPEP 601.01(f).

reveals that Claims 1-5, 11-13, and 15-21 are method claims. Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date.

The petition is granted. The petition fee of $130.00 will be refunded to counsel's deposit account, No. 08-2525.

The "Notice" mailed on 2 October, 2001, was sent in error and is hereby vacated.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 17 August, 2001, and for an indication on the bib-data sheet that no sheets of drawings were present on filing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Douglas I. Wood at 703 308-6918.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LEONG C. LEI
PMB#1008, 1867 YGNACIO VALLEY ROAD
WALNUT CREEK CA 94598

COPY MAILED

OCT 0 3 2005

OFFICE OF PETITIONS

In re Application of	:	
Sze-Huen Chong	:	
Application No. 09/931,742	:	ON PETITION
Filed: October 11, 2004	:	
For: ELECTRO-LUMINESCENT DEVICE FOR A MOBILE PHONE	:	

This is a decision on the petition filed October 11, 2004, which is being treated as a Petition under 37 CFR 1.181(a) to Withdraw Holding of Abandonment.

The petition is **DISMISSED**.

The application was held abandoned for failure to timely pay the issue fee and publication fee in reply to the Notice of Allowance and Fee(s) Due mailed on April 20, 2004.

A review of the application file reveals no irregularities in the mailing of the Notice of Allowance and Issue Fee Due on April 20, 2004. The showing required to establish nonreceipt must be from the inventor in this instance since the Notice of Allowance was mailed to the address of record at the time of mailing the Notice of Allowance. Therefore, the application remains abandoned. A copy of the Notices mailed April 20, 2004 is attached.

Petitioner may file a petition under 37 CFR 1.137(a) or (b) and pay the required fees. A copy of the petition forms are attached for your convenience.

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

This matter is being referred to the Files Repository.

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

Attachment: Blank Petitions Forms: PTO/SB/61
PTO/SB/64
Copy of the Notices mailed April 20, 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

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

COPY MAILED
MAY 0 2 2006
OFFICE OF PETITIONS

In re Patent of	:	
Rozen	:	
Patent No. 6,833,243	:	
Issue Date: December 21, 2004	:	Decision on Request
Application No. 09/931,795	:	
Filing Date: August 16, 2001	:	
Attorney Docket No. 04844/005005	:	

This is a decision on the petition under 37 CFR 1.183 to correct assignee, which is being treated as a request filed under 37 CFR 3.81(b) to accept the correction of the assignee data after the patent has issued.

The request under 37 CFR 3.81(b) is **granted**.

37 CFR 3.81(b) currently states:

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

In other words, the request under 37 CFR 3.81(b) will be granted when:

(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

Petitioner has met the requirements set forth above. Therefore, the request is granted.

Petitioner's deposit account was erroneously charged an additional $270.00. This amount will be refunded to petitioner's deposit account.

The file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
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

HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
PO BOX 272400
FORT COLLINS CO 80527-2400

COPY MAILED

JUN 2 0 2006

OFFICE OF PETITIONS

In re Application of
Blair, et al. :
Application No. 09/931,825 : DECISION ON
Filed: August 16, 2001 : PETITION
Attorney Docket No. 10010714-1 :

This is in response to the "REQUEST TO WITHDRAW HOLDING OF ABANDONMENT", filed May 26, 2006, which is being treated as a petition under 37 CFR 1.181.

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

The holding of abandonment is **WITHDRAWN**.

The above-identified application was held abandoned for failure to timely file a reply to the non-final Office action mailed September 13, 2005. No response having been received, the above-identified application became abandoned on December 14, 2005. A Notice of Abandonment was mailed on March 22, 2006.

Petitioner has supplied a copy of an Amendment, bearing a Certificate of Mailing under 37 CFR 1.8 dated December 13, 2005. In view of the above, the holding of abandonment is withdrawn.

Given the basis for granting this petition, no petition fee was required.

The application file is being forwarded to Group Art Unit 3629 for consideration of the Amendment filed May 26, 2006 (Certificate of Mailing dated December 13, 2005), a copy of which has been supplied with the instant petition.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ARTZ & ARTZ, P.C.
SUITE 250
28333 TELEGRAPH ROAD
SOUTHFIELD MI 48034

COPY MAILED

DEC 29 2005

OFFICE OF PETITIONS

In re Application of :
Leon Yulkowski :
Application No. 09/931,828 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. YUL 0105 PUS :

This is a decision on the petition under 37 CFR 1.137(b), filed October 18, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

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

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

---

[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The proposed reply required for consideration of a petition to revive this application must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a submission under 37 CFR 114 (RCE) or a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ARTZ & ARTZ, P.C.
SUITE 250
28333 TELEGRAPH ROAD
SOUTHFIELD, MI 48034

COPY MAILED

JAN 27 2006

OFFICE OF PETITIONS

In re Application of :
Leon Yulkowski :
Application No. 09/931,828 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. YUL 0105 PUS :

This is a decision on the renewed petition under 37 CFR 1.137(b) filed January 10, 2006, to revive the above-identified application.

The petition is GRANTED.

The Office acknowledges receipt of the Notice of Appeal filed January 10, 2006.

The 2-month period for filing the Appeal Brief under 37 CFR 41.37(a)(1), accompanied by the fee set forth in 37 CFR 41.20(b)(2), runs from the date of this decision.

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

This application is being referred to Technology Center AU 3635.

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

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

COPY MAILED

SEP 0 6 2007

OFFICE OF PETITIONS

In re :
Shiraga, et al. : DECISION REGARDING
Application No. 09/931,887 : PATENT TERM ADJUSTMENT
Filed: August 20, 2001 :
Patent No. 7,139,919 :
Issued: November 21, 2006 :
Attorney Docket No. 03500.015684 :

This decision is in response to the "REQUEST FOR REVIEW (PATENT TERM ADJUSTMENT)", filed January 11, 2007, requesting correction of the patent term adjustment (PTA).

The request is **DISMISSED**.

On November 21, 2006, the instant application issued as Patent No. 7,139,919, with a patent term adjustment of seven hundred eighty-seven (787) days. Patentees state that they believe there was an error in their favor in the patent term adjustment calculation.

The Office determined a patent term adjustment of seven hundred eighty-seven (787) days based on an adjustment for PTO delay of eight hundred seventy-two (872) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by thirty five (35) and thirty-two (32) days of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and eighteen (18) days of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(10).

A review of the application does not reveal any errors in the calculation of the patent term adjustment. To the extent that Patentees are aware of any errors, Patentees should so advise the Office.

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 C.F.R. § 1.18(e). The Office thanks Patentees for their good faith and candor.

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

Kery A. Fries
for

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

THOMAS F. MEAGHER
KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

COPY MAILED

FEB 2 8 2003

OFFICE OF PETITIONS

In re Application of :
Min-Hao Lu et al :
Application No. 09/931,948 : NOTICE
Filed: August 20, 2001 :
Attorney Docket No. 10052/1601 :

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 2800.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

MAY 16 2003

OFFICE OF PETITIONS

BENNET K. LANGLOTZ
BOX 759
GENOA NV 89411

Applicant: Snowberg et al.
Appl. No.: 09/931,992
Filing Date: August 16, 2001
Title: METHOD AND FACILITY FOR STORING AND INDEXING WEB BROWSING DATA
Attorney Docket No.: AA-11
Pub. No.: US 2003/0034776 A1
Pub. Date: February 20, 2003

Patent application publication No. US 2003/0034776 A1 published on February 20, 2003 with the contents of another application.

This is a decision to *sua sponte* issue a corrected patent application publication, publishing the application as originally filed.

The corrected patent application publication will be published in due course.

The application is being forwarded to the Office of PreGrant Publication (PG-PUB) in Crystal Park 3-905 for further processing.

Inquires concerning this communication should be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

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

UNITED STATES 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, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

FEB 2 4 2005

OFFICE OF PETITIONS

In re Patent No. 6,797,975 :
Issue Date: September 28, 2004 :
Application No. 09/931,997 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 16869S-032100US :

This is a decision on the petition filed November 18, 2004, which is being treated as a petition under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

Telephone inquiries concerning this matter may be directed to Retta Williams at (571) 272-3229. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

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

Karen Creasy for

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

[1] *See* Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

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

MAIL

SEP - 3 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application Serial No.:
09/932,010

ON REQUEST TO
WITHDRAW AS ATTORNEY

The Request to Withdraw as Attorney is **GRANTED**.

Further communications will be directed to the address listed below until such a time as applicant properly notifies the Patent and Trademark Office of a change of address. This address has been provided by the withdrawing attorney(s).

Kenneth A. Wieder

KENNETH WIEDER
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 2600

Rick Dunning
Law Office of Richard A. Dunning, Jr.
325M Sharon Park Drive, Suite 208
Menlo Park, CA 94025

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

JAN 30 2007

OFFICE OF PETITIONS

In re Application of :
EVERETT et al :
Application No.: 09/932,013 : DECISION ON PETITION
Filing Date: August 17, 2001 : UNDER 37 CFR 1.55
Attorney Docket No.: 017268-0352595 :

This is a decision on the petition under 37 CFR 1.55(c), filed November 20, 2006, for acceptance of an unintentionally delayed claim under 35 U.S.C. 119(a)-(d) for benefit of the filing date of foreign Application No. GB 9703591.9, filed February 21, 1997.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);
(2) the surcharge as set forth in 37 CFR 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) 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.)

The instant petition fails to comply with item (1) above. In this regard, a review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet in accordance with 37 CFR 1.76(b)(6). Unless provided in an application data sheet, 37 CFR 1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. Note MPEP 201.14, page 200-84 (Rev. 5, August 2006), last paragraph, second column.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign applications noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

Applicant is advised that a certified copy of the foreign priority application along with any required processing fee under 37 CFR 1.17(i) must be filed before a patent is granted on the present application. 37 CFR 1.55(a)(2). If the certified copy has been filed in a parent or related application, applicant need only identify the application containing the certified copy. MPEP 201.14(b), Section II. Later Filed Applications, Reissues.

Applicant is further advised that the amendment to the specification filed November 20, 2006 fails to state the relationship of U.S. Application No. 09/023,057, filed February 12, 1998, to the instant application in compliance with 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims priority to Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. See MPEP Section 201.11, Rev. 5, August 2006, Reference to Prior Application.

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

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

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

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

Any questions concerning this matter may be directed to Bryan Lin at (571) 272-3303.

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

Boris Milef
Legal 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

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

COPY MAILED

JUN 29 2007

OFFICE OF PETITIONS

In re Application of :
EVERETT et al :
Application No.: 09/932,013 : DECISION ON PETITIONS
Filing Date: August 17, 2001 : UNDER 37 CFR 1.55 and 1.78
Attorney Docket No.: 017268-0352595 :

This is a decision on the renewed petition under 37 CFR 1.55(c), filed March 2, 2007, for acceptance of an unintentionally delayed claim under 35 U.S.C. 119(a)-(d) for benefit of the filing date of foreign Application No. GB 9703591.9, filed February 21, 1997. The present submission is also being treated as a petition under 37 CFR 1.78 to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional application number 09/023,057, filed February 12, 1998. No additional petition fee is due.

The petitions are **DISMISSED**.

I. Petition Under 37 CFR 1.55

The present application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and

the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) 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); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

With regard to item (2) above, the petition states that because a declaration identifying the prior foreign application was submitted in prior-filed U.S. application number 09/023,057, the instant application has always been in compliance with the requirements of 37 CFR 1.63. While the instant application was in compliance with 37 CFR 1.63(d)(iv) in that a newly executed declaration was not required under 37 CFR 1.51(b)(2) and 1.53(f) for the present application to be a complete application, the instant application was not in compliance with 37 CFR 1.63(c)(2) with regard to the foreign priority claim. 37 CFR 1.63(c)(2) specifies that the declaration must identify any foreign application for which priority is claimed, unless such information is supplied on an application data sheet. See also MPEP 201.13, Rev. 5, August 2006, Section II. A., The Priority Claim. The copy of the declaration filed on August 17, 2001 does not contain the required foreign application information, nor does the fact that a declaration containing the foreign priority claim was filed in the "grandparent application" satisfy the requirement under 37 CFR 1.63(c)(2), *ab initio*, as 37 CFR 1.63(d)(iv) requires, *inter alia*, that a copy of such declaration must be submitted in the child application. The copy of the declaration submitted in U.S. application number 09/023,057 accompanying the renewed petition is not acceptable as the provisions of 37 CFR 1.63(d) are limited to continuation and divisional applications, and the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to U.S. application number 09/023,057 for the reasons set forth in §II below.

Furthermore, with regard to item (5) above, as set forth in §II below, applicant has not established a proper priority claim under 37 CFR 1.78 to an application which was filed within 12 months of the filing date of the foreign application.

In view of the above, the requirements of 37 CFR 1.78 must be satisfied as set forth below if applicant desires to claim priority to the foreign application noted in the petition.

II. Petition Under 37 CFR 1.78

A petition for acceptance of a late claim for 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 37 CFR 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(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.

The specification as filed does not properly indicate the relationship between U.S. application number 09/023,057 and U.S. application number 09/076,551. 37 CFR 1.78(a)(2)(i) provides that a nonprovisional application claiming the benefit of one or more prior-filed nonprovisional applications must indicate the relationship of the applications. MPEP 201.11, Rev. 5, August 2006, Section III. A., Reference to Prior Nonprovisional Applications, further specifies that "if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications."

The renewed petition attempts to correct this defect. However, the petition does not satisfy item (1) above. Although the petition states that the priority claim language is "being amended" and requests the USPTO to "enter the requested language in the first paragraph of the specification", an amendment after payment of the issue fee is not permitted under 37 CFR 1.312. Furthermore, the purported amendment is not in compliance with 37 CFR 1.121 as the amendment to the specification does not begin on a separate sheet. 37 CFR 1.121(h). Moreover, the proposed language does not include a proper benefit claim to U.S. provisional application numbers 60/046,514 and 60/046,543 because the instant application was not filed within 12 months after the date on which the provisional applications were filed. See MPEP 201.11, Rev. 5, August 2006, Section III. C., Benefit Claims to Multiple Prior Applications (stating "[I]f the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application. . . ."

The petition also does not satisfy item (3) above in that a proper statement of unintentional delay has not been furnished.

A corrected filing receipt which indicates those applications to which priority is properly claimed accompanies this decision.

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

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

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

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

Any questions concerning this matter may be directed to Bryan Lin at (571) 272-3303.

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

Boris Milef
Legal Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
09/932,013	08/17/2001	2137	1090	40000059-0150	4	4

CONFIRMATION NO. 4815

CORRECTED FILING RECEIPT

OC000000024594478

26263
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

Date Mailed: 06/28/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

David Barrington Everett, East Sussex, UNITED KINGDOM;
Stuart James Miller, Berks, UNITED KINGDOM;
Anthony David Peacham, Kent, UNITED KINGDOM;
Ian Stephen Simmons, Cambs, UNITED KINGDOM;
Timothy Philip Richards, Herts, UNITED KINGDOM;
John Charles Viner, Windlesham, UNITED KINGDOM;

Power of Attorney: The patent practitioners associated with Customer Number **26263**.

Domestic Priority data as claimed by applicant

This application is a CON of 09/076,551 05/12/1998 PAT 6,317,832
which claims benefit of 60/046,514 05/15/1997
and claims benefit of 60/046,543 05/15/1997

Foreign Applications

If Required, Foreign Filing License Granted: 09/14/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/932,013

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS

Preliminary Class

713

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JUL 24 2007

OFFICE OF PETITIONS

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO IL 60606-1080

In re Application of :
David Barrington Everett et al :
Application No. 09/932,013 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 40000059-0150 :

This is a decision on the petition, filed July 20, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on November 22, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2137 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

COPY MAILED

JUL 0 1 2008

OFFICE OF PETITIONS

In re Application of :
EVERETT et al :
Application No.: 09/932,013 : DECISION ON PETITIONS
Filing Date: August 17, 2001 : UNDER 37 CFR 1.55 and 1.78
Attorney Docket No.: 017268-0352595 :

This is a decision on the renewed petition under 37 CFR 1.55(c), filed July 23, 2007, for acceptance of an unintentionally delayed claim under 35 U.S.C. 119(a)-(d) for benefit of the filing date of foreign Application No. GB 9703591.9, filed February 21, 1997, and the renewed petition under 37 CFR 1.78(a)(3), filed July 23, 2007, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional application number 09/023,057, filed February 12, 1998. No additional petition fee is due.

The petitions are **GRANTED**.

I. Renewed Petition Under 37 CFR 1.55

The present application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and

the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) 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); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The above-identified pending nonprovisional application was filed on August 17, 2001, which is after November 29, 2000 and claims priority under 35 U.S.C. 120 to a nonprovisional application which was filed within 12 months of February 21, 1997 (the filing date of the foreign application to which benefit is now being claimed). On June 12, 2008, applicant filed an application data sheet which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee has been received. Lastly, petitioner has provided an adequate statement of unintentional delay. All requirements being met, the petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(a)-(d) is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed foreign application under 37 CFR 1.55(c) should not be construed as meaning that this application is entitled to the benefit of the prior-filed foreign application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. 119(a)-(d) and 37 CFR 1.55 must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed foreign 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 this application is entitled to the benefit of the earlier filing date.

II. Renewed Petition Under 37 CFR 1.78

A petition for acceptance of a late claim for 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 37 CFR 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(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.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application appears in the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii), as a result of the amendment filed July 25, 2007; (2) the surcharge fee required under 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. 120 to the 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 this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this 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 and the prior-filed foreign application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Bryan Lin at (571)272-3303. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 2137 for appropriate action on the amendment filed July 25, 2007, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 120.

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

Boris Milef
Legal Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
09/932,013	08/17/2001	2137	1090	40000059-0150	4	4

CONFIRMATION NO. 4815

CORRECTED FILING RECEIPT

26263
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

Date Mailed: 06/27/2008

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

Applicant(s)

David Barrington Everett, East Sussex, UNITED KINGDOM;
Stuart James Miller, Berks, UNITED KINGDOM;
Anthony David Peacham, Kent, UNITED KINGDOM;
Ian Stephen Simmons, Cambs, UNITED KINGDOM;
Timothy Philip Richards, Herts, UNITED KINGDOM;
John Charles Viner, Windlesham, UNITED KINGDOM;

Power of Attorney: The patent practitioners associated with Customer Number 26263

Domestic Priority data as claimed by applicant

This application is a CON of 09/076,551 05/12/1998 PAT 6,317,832
which claims benefit of 60/046,514 05/15/1997
and claims benefit of 60/046,543 05/15/1997
and is a CON of 09/023,057 02/12/1998 PAT 6,575,372
which claims benefit of 60/046,514 05/15/1997

Foreign Applications

UNITED KINGDOM 9703591.9 02/21/1997

If Required, Foreign Filing License Granted: 09/14/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/932,013**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS

Preliminary Class

713

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

NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

COPY MAILED

JUN 0 3 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Koichi Fujimori et al :
Application No. 09/932,027 :
Filed: August 20, 2001 :
Attorney Docket No. 1035-336 :

This is a decision on the petition, filed May 26, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 4, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The file is being referred to Technology Center AU 2871 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

KOLISCH HARTWELL, P.C.
200 PACIFIC BUILDING
520 SW YAMHILL STREET
PORTLAND, OR 97204

MAILED

APR 0 8 2009

OFFICE OF PETITIONS

In re Patent No. 6,922,475	:	
Issue Date: July 26, 2005	:	
Application No. 09/932,057	:	NOTICE
Filed: August 16, 2001	:	
Attorney Docket No. TAI 309	:	

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

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

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

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

Inquiries related to this communication should be directed to Diane Goodwyn at (571) 272-6735.

Thurman K Page

Thurman Page
Petitions Examiner
Office of Petitions

04/09/2009 CKHLOK 00000004 111540 6922475
01 FC:1551 980.00 DA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Wu-Hong Hsieh

Serial No. : 09/932,057

Filed : August 16, 2001

For : SHOCKPROOF MICROPHONE SUPPORT DEVICE

Date: February 24, 2009

Patent No.: 6,922,475

Our Docket No.: TAI 3O9

RECEIVED
FEB 2 6 2009
OFFICE OF PETITIONS

Attention: Dorethea Allen
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313

02/25/2009 DALLEN 00000001 111540 6922475
01 FC:1559 490.00 DA

Sir:

CORRECTION OF ENTITY STATUS UNDER 37 CFR § 1.28(c)

The maintenance fee for the above identified application was paid as a small entity on January 5, 2009. Applicants have since learned that they inadvertently claimed small entity status in error. Consequently, applicant hereby authorizes the Director to charge Deposit Account No. 11-1540 in the amount of $490.00 to cover the deficiency in the payment of the issue fee. An itemization of the deficiency payment follows, pursuant to 37 CFR § 1.28(c)(2).

Type of fee	Amount paid as a small entity	Date payment was Made	Deficiency
3.5 year maintenance fee	$490.00	January 5, 2009	$490.00
		Total Deficiency:	$490.00

Adjustment date: 04/09/2009 CKHLOK
02/25/2009 DALLEN 00000001 111540 6922475
01 FC:1559 -490.00 CR

Applicants respectfully request that their error in claiming small entity status be excused.

Adjustment date: 04/09/2009 CKHLOK
01/06/2009 INTMTFEE 00003779 111540 6922475
01 FC:2551 490.00 CR

PAGE 2/3 * RCVD AT 2/24/2009 5:25:52 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/4 * DNIS:2736317 * CSID: * DURATION (mm-ss):01-52

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to: Attention: Dorethea Allen, Commissioner for Patents, at facsimile number (571) 273-6317 on February 24, 2009.

Allison M. Deverman Vietor

Respectfully submitted,
KOLISCH HARTWELL, P.C.

Anton E. Skaugset

Anton E. Skaugset
Customer No. 23581
Registration No. 38,617
Agent for Applicants
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679

PAGE 3/3 * RCVD AT 2/24/2009 5:25:52 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/4 * DNIS:2736317 * CSID: * DURATION (mm-ss):01-52

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

Jerry D. Haynes
19390 Collins Ave #1616
Sunny Isles Beach FL 33160

COPY MAILED

APR 21 2005

OFFICE OF PETITIONS

In re Application of :
Terence Wallace :
Application No. 09/932,065 :
Filed: August 17, 2001 :
Attorney Docket Number: 11596/2 :
Title: DEVICE AND METHOD FOR PREVENTING THE THEFT OR LOSS OF A PERSONAL ITEM :

DECSION ON PETITION

This is a decision on the petition filed October 25, 2004, pursuant to 37 C.F.R. §1.137(a)[1], to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed December 30, 2003, which set a shortened statutory period for reply of three (3) months. On March 30, 2004 an after-final amendment was received, and an advisory action was mailed April 29, 2004. No extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 31, 2004. A Notice of Abandonment was mailed October 1, 2004.

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

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

(2) the petition fee;

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

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

With the present petition, Petitioner has submitted a statement of facts from the attorney of record, an RCE as well as the associated fee, and a terminal disclaimer. It is noted that a terminal disclaimer is not required, since this application was submitted after June 8, 1995[2].

Petitioner has met requirements (1) and (2) above. Requirement (4) does not apply.

Regarding the third requirement above, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard

35 USC §133 states, "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." (emphasis added)

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference."[3]

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[4]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[5]

Nonawareness of a PTO rule will not constitute unavoidable delay[6]

---

2 See 37 C.F.R. 1.137(d)(1).

3 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."

4 Id.

5 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

The burden of showing the cause of the delay is on the person seeking to revive the application[7].

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[8].

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[9].

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account[10]."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[11]."

The regulations relevant to the abandonment of this application

37 C.F.R. § 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

---

6 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

7 Id.

8 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

9 In re Mattullath, 38 App. D.C. at (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

10 Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

11 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

37 C.F.R. §1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

37 C.F.R. § 1.136 Extensions of time.

(a)

(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to § 1.193(b);

(iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or

(v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and § 1.645 for extensions of time in interference proceedings.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time

specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in ex parte reexamination proceedings; and § 1.956 for extensions of time in inter partes reexamination proceedings.

(c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

(1) The period for submitting an oath or declaration in compliance with § 1.63;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

[47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 54 FR 29551, July 13, 1989, effective Aug. 20, 1989; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (c) revised, 66 FR 21090, Apr. 27, 2001, effective May 29, 2001]

Application of the standard to the current facts and circumstances

With the instant petition, Petitioner has set forth that the Applicant received the advisory action of April 29, 2004, and intended to submit an RCE, but was precluded from doing so due to financial difficulties and a death in the family.

The statement of facts was submitted in order to establish that the Applicant's delay in timely submitting the RCE was unavoidable. It is noted that the statement of facts has been made not by the Applicant, but rather by his attorney. This is not acceptable, as 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.

Petitioner should be aware that petitions filed under 37 C.F.R. §1.137(a) (where the cause of the abandonment is characterized as "unavoidable") have a very stringent standard associated with them, and carry a high bar of proof which must be submitted to show that the entire period of delay was truly unavoidable. As such, a delay caused by an applicant's inexperience with the patent system is not rendered "unavoidable."

The Issue of Financial Difficulty:

Petitioner has asserted financial difficulty in that the inventor lacked the funds necessary to submit the RCE until the filing of this petition. A showing of "unavoidable" delay based upon financial difficulty is very stringent, in that in order for a petitioner to demonstrate that he lacked the financial resources to pay the fee(s) associated with patent prosecution, substantial documentation must be provided. Such a showing must be supported by a **complete and thorough** showing of his financial condition during the entire period between March 31, 2004 and October 25, 2004, including income, expenses, tax return statements, bank records, assets, credit and obligations, which made the delay in payment of the fee associated with the filing of

an RCE unavoidable. Petitioner should provide copies of all documents or records pertaining to each of these so as to confirm the financial difficulty.

Petitioner is reminded that the period of delay with which he must be concerned is the *entire* period of delay in filing the required reply, from the due date for the reply up until the filing of a grantable petition.

The Issue of a death in the family:

As stated above, the showing required under §1.137(a) is extremely exacting. Petitioner has asserted that a death in the family prevented him from submitting the fee associated with the filing of an RCE for almost 7 months. Such a delay is not "unavoidable" within the meaning of §1.137(a). It is certainly understandable that the passing of a family member can take precedence over all other matters. However, this failure to treat the instant application as petitioner's most important business constitutes a showing of preoccupation with other matters. Therefore, an adequate showing of "unavoidable" delay is precluded[12].

Conclusion

For these reasons, the petition under 37 C.F.R. §1.137(a) must be **DISMISSED**.

Alternate venue

Petitioner may also wish to consider filing a petition under the unintentional standard, 37 CFR §1.137(b)[13]. Petitioner should be made aware that although the surcharge is significantly higher ($750 for a small entity), the standard associated with a petition filed under this section is far less stringent than the standard associated with a delay asserted to be "unavoidable". A form for this petition may be located at http://www.uspto.gov/web/forms/sb0064.pdf

---

12 In Smith v. Diamond, the Court held that an attorney's preoccupation with other matters that took precedence over

responding to the dismissal of the petition mailed December 16, 1986 in this case does not justify a lack of diligence in filing the renewed petition until March 8, 1988. 209 U.S.P.Q. 1091 (D.D.C. 1981). Likewise, a delay was not found to be unavoidable where the petitioner cited a heavy workload by the attorney handling the petition in the present application as being a factor in causing the delay. In re Takeo, 17 U.S.P.Q. 2d (BNA) 1155 (Comm'r Pat. & Trademarks Feb. 27, 1990).

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

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

Response

Any reply 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 reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.137(a) (*or 1.137(b), if applicable)*". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail[14], hand-delivery[15], or facsimile[16].

The Change of Correspondence Address has been entered and made of record.

The application file will be retained in the Office of Petitions for two (2) months.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

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

14 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

15 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

16 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.

SPE: U. Chauhan

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/15/07

Paper No.: _____

TO SPE OF : ART UNIT 2628

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/932088 Patent No.: 6722910

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.

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

Comments: _____

KEE M. TUNG
SUPERVISORY PATENT EXAMINER
SPE

2628
Art Unit

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,727,910

APPLICATION NO.: 09/932,088

ISSUE DATE : APRIL 27, 2004

INVENTOR(S) : MARK H. A. TIGGES

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

1. Claim 12, column 8, line 10: Insert the word -- is -- before the word "on".
2. Claim 12, column 8, line 17: Insert the word -- by -- before the word "comparing".
3. Claim 12, column 8, line 25: Insert -- (b) and -- before "(c)".
4. Claim 14, column 8, line 29: Insert the word -- said -- before the word "processor".
5. Claim 23, column 9, line 8: Insert -- P_i^D -- before the word "by".
6. Claim 23, column 9, line 17: Insert the word -- a -- before the word "next".
7. Claim 23, column 9, line 19: Replace the words "in anion" with the word -- inversion --.
8. Claim 34, column 10, line 25: Replace the word "x" with the word -- X --.
9. Claim 38, column 10, line 36: Replace " P_i^P " with -- P_i^D --.
10. Claim 38, column 10, line 43: Replace the word "o" with the word -- to --.
11. Claim 39, column 10, line 53: Insert the word -- to -- before the word "counter".

MAILING ADDRESS OF SENDER (Please do not use customer number below):

MCCARTHY TETRAULT LLP, BOX 48, SUITE 4700, 66 WELLINGTON STREET WEST
TORONTO, ONTARIO, CANADA M5K 1E6

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

QUALCOMM, INC
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

COPY MAILED
APR 13 2006
OFFICE OF PETITIONS

In re Application of :
CASACCIA, et al. : DECISION ON PETITION
Application No. 09/932,121 :
Filed: August 16, 2001 :
Atty. Dkt. No.: 010345 :

This decision is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181 filed March 14, 2006.

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

This application was held abandoned February 11, 2004, for failure to timely file a proper response to the final Office action mailed November 10, 2003. The final Office action set a three month shortened statutory period for reply. Notice of Abandonment was mailed October 5, 2005. It is noted for the record that the instant petition, filed March 14, 2006, fails to comply with 37 CFR 1.181(f) in that petitioners failed to submit the instant petition within two months of the mailing date of the action complained of (i.e., Notice of Abandonment).

Petitioners argues that a response to the final Office action was timely submitted February 10, 2004 in accordance with the Certificate of Mailing procedures outlined at 37 CFR 1.8. Petitioners have included a copy of the response to the final Office action along with a return postcard dated February 17, 2004 by the UPSTO evidencing received of the response.

A review of the application file does not indicate receipt of the response purportedly submitted February 10, 2004, however, the response will be considered timely as it complied with the requirements of 37 CFR 1.8(b) in that (1) the Office was promptly informed of the previous timely mailing, (2) a copy of the previously submitted correspondence with certificate of facsimile thereon has been supplied, and (3) statements attesting to the previous timely mailing have been submitted.

In view of the above, the Notice of Abandonment is hereby VACATED and the Notice of Abandonment is WITHDRAWN.

This application is being forwarded to Technology Center 2600 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

COPY MAILED

APR 0 2 2007

OFFICE OF PETITIONS

In re Application of :
CASACCIA et al. :
Application No.: 09/932,121 : DECISION ON PETITION
Filing Date: August 16, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: 010345 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 11, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed November 10, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time of under the provisions of 37 CFR 1.136(a) were obtained.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination and an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action mailed November 10, 2003 is accepted as having been unintentionally delayed.

This application is being referred to Technology Center AU 2616 for appropriate action, if any, on the reply in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3301.

Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NICHOLAS P. TRIANO, III, ESQ.
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON MA 02111

COPY MAILED

JUL 2 9 2005

OFFICE OF PETITIONS

In re Application of	:	
Tony Baker	:	DECISION
Application No. 09/932,122	:	ON PETITION
Filed: 16 August 2001	:	37 CFR 1.137 (b)
Attorney Docket No. 24219-CIP2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed 2 May 2005, to revive the above-identified application. The instant application became abandoned for failure to reply to the official action mailed 7 May 2003.

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.

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 pursuant to 37 CFR 1.111; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of 7 May 2003 is accepted as having been unintentionally delayed.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The application file is being referred to Technology Center AU 1634 for appropriate action on the amendment.

Telephone inquiries concerning this decision should be directed to Erik Kielin at (571) 272-6051, or in his absence, the undersigned at (571) 272-3217.

For

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Catalyst Law Group, APC
9710 Scranton Road, Suite S-170
San Diego, CA 92121

COPY MAILED

AUG 0 1 2007

OFFICE OF PETITIONS

In re Application of :

Tony Baker :
Application No. 09/932,122 : DECISION ON PETITION
Filed: August 16, 2001 : TO WITHDRAW
Attorney Docket No. 8089-002-US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed February 1, 2007.

The request is **NOT APPROVED**.

A review of the file record indicates that customer number 502235 (not a valid customer number) does not have power of attorney in this patent application nor is there any statement or evidence of record of employment in or otherwise being engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Baker Botts, LLP (Attn: Bruce W. Slayden II)**
1500 San Jacinto Center
96 San Jacinto Boulevard
Austin, TX 78701

This Page Is Inserted by IFW Operations
and is not a 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 may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

As rescanning documents *will not* correct images, please do not report the images to the Image Problem Mailbox.

Image
OIPE JC64
APR 16 2004
PATENT & TRADEMARK OFFICE

04-19-04

CASE D0020 NP

DAC/A

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV305489986US	April 16, 2004
Express Mail Label Number	Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
FEDER ET AL.
APPLICATION NO: 09/932,145
FILED: August 17, 2001
FOR: NOVEL IMIDAZOLINE RECEPTOR HOMOLOGS

ART UNIT: 1646
EXAMINER: JIANG, DONG

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO ACCORD FILING DATE
FOR EXPRESS MAIL CORRESPONDENCE NOT RECEIVED BY P.T.O. (37 C.F.R. § 1.10(e))

1. This is a petition to accord the correspondence in the above-identified application a filing date of September 17th, 2003, which is the date the correspondence was deposited with the U.S.P.S. with proper postage.

CERTIFICATION UNDER 37 C.F.R, §§ 1.8 and 1.10

I hereby certify that, on the date shown below, this correspondence was deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

as "Express Mail Post Office to Addressee", Mailing Label No. EV306636575US dated 9/17/03 and accepted by CB

2. Submitted herewith is the statement indicating when the discrepancy was discovered and establishing that this petition is being filed promptly thereafter. 37 C.F.R. § 1.10(e)(1).

The undersigned states that this discrepancy was first discovered during the week of March 22nd, 2004 during a docket review to identify any discrepancies between internal docket records and the U.S.P.T.O. PAIR system.

The undersigned further states that this discrepancy was confirmed via a telephone conversation with Examiner Dong on April 6th, 2004. Upon receiving this confirmation, the undersigned diligently addressed this discrepancy by preparing the instant petition in addition to the required showing.

OIPE JC64
APR 16 2004
PATENT & TRADEMARK OFFICE

CASE D0020 NP

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV305489986US	April 16, 2004
Express Mail Label Number	Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
FEDER ET AL.
APPLICATION NO: 09/932,145
FILED: August 17, 2001
FOR: NOVEL IMIDAZOLINE RECEPTOR HOMOLOGS

ART UNIT: 1646
EXAMINER: JIANG, DONG

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPORTING STATEMENT FOR PETITION TO ACCORD FILING DATE
FOR EXPRESS MAIL CORRESPONDENCE NOT RECEIVED BY P.T.O. (37 C.F.R. § 1.10(e))

The undersigned states that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying this petition were deposited as "Express Mail" with the U.S.P.S. on September 17th, 2003 at 3:24 P.M.

The undersigned further states that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying this petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(609) 252-3597

Joyce Whitlow
IP Legal Assistant II

Date: April 16, 2004

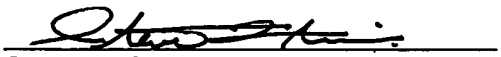
3. Submitted herewith, in accordance with 37 C.F.R. § 1.10(e)(3), are the following:

- A true copy of the originally-deposited paper(s) or fee(s).
- A true copy of the "Express Mail" mailing label showing the "date-in."
- A true copy of the returned Post Card showing receipt of these papers by the U.S.P.T.O.
- A true copy of the Express Mail bill sent to Bristol-Myers Squibb showing the Express Mail Label Number and the date of deposit as September 17th, 2004.
- Bristol-Myers Squibb U.S.P.T.O. Account log showing the withdrawal of the fees for the originally-deposited papers.

4. Submitted herewith is a statement signed by the person who deposited the documents as "Express Mail" with the U.S.P.S., setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying this petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(609) 252-5289



Stephen C. D'Amico
Agent for Applicants
Reg. No. 46,652

Date: April 16, 2004

TyvekEnvelopes

3454

Case No.: D0020

Application No.: 09/932,145

Mailing Date: 9/17/03

Due Date:

Express Mail No.: EV306636575US

The Patent & Trademark Office acknowledges, and has stamped hereon the date of receipt of the items checked below:

- ☒ Amendment/Response/Letter - Fee $
- ☐ Appln. Filing Papers - Fee $
  - ☐ Non-provisional
  - ☐ Provisional Application
    - ☐ CPA ☐ DIV ☐ CONT ☐ CIP
  - ☐ Specification _____ Pg's
- ☐ Executed/Unexecuted Decl. - Fee $
  - ☐ Missing Parts/Missing Req.
- ☒ Preliminary Amendment 5 Pg's
- ☐ Claim of Priority ☐ Certified Copy(s)
- ☐ Amendment After Final
- ☐ Notice of Appeal - Fee $
- ☐ Appeal Brief - Fee $
- ☐ Issue Fee Payment - $
- ☐ Assignment Rec. Req. - Fee $
- ☐ Formal Drawings _____ Pg's
- ☒ IDS 2 Pg's - Fee $ 180 (1 Ref.)
- ☒ PTO-1499 Form 1 Pg's
- ☐ Pet. for Ext. of Time - Fee $
- ☐ Seq. Listings _____ Pg's/Seq. Disk
- ☒ Response to Rest. Requirement w/o Traverse

SCD
Initials

EV 306636575 US

Mailing Label
Label 11-F June 2002

EXPRESS MAIL
UNITED STATES POSTAL SERVICE®

Post Office To Addressee

ORIGIN (POSTAL USE ONLY)			
PO ZIP Code	Day of Delivery ☐ Next ☐ Second	Flat Rate Envelope ☐	
Date In Mo. Day Year	☐ 12 Noon ☐ 3 PM	Postage $	
Time In ☐ AM ☐ PM	Military ☐ 2nd Day ☐ 3rd Day	Return Receipt Fee	
Weight lbs. ozs.	Int'l Alpha Country Code	COD Fee	Insurance Fee
No Delivery ☐ Weekend ☐ Holiday	Acceptance Clerk Initials	Total Postage & Fees $	

DELIVERY (POSTAL USE ONLY)		
Delivery Attempt Mo. Day	Time ☐ AM ☐ PM	Employee Signature
Delivery Attempt Mo. Day	Time ☐ AM ☐ PM	Employee Signature
Delivery Date Mo. Day	Time ☐ AM ☐ PM	Employee Signature

☐ WAIVER OF SIGNATURE (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.

NO DELIVERY ☐ Weekend ☐ Holiday

Customer Signature

CUSTOMER USE ONLY

METHOD OF PAYMENT:
Express Mail Corporate Acct. No. X085205

Federal Agency Acct. No. or Postal Service Acct. No.

FROM: (PLEASE PRINT) PHONE ( )

STEPHEN DAVIS
BRISTOL-MYERS SQUIBB CO
PO BOX 4000
PRINCETON NJ 08543-4000

D0020 NP SCT

TO: (PLEASE PRINT) PHONE ( )

MAIL STOP NEW - Fee Amendment
COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA VA 22313-1450

PRESS HARD.
You are making 3 copies.

FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com

EMS

106/ 1000 F:02 T:23

EV 306636575 US

EXPRESS MAIL
UNITED STATES POSTAL SERVICE®

Customer Copy
Label 11-F June 2002

Post Office To Addressee

ORIGIN (POSTAL USE ONLY)			
PO ZIP Code: 08648	Day of Delivery: ☑ Next ☐ Second	Flat Rate Envelope: ☐	
Date In: Mo. 9 Day 17 Year 03	☑ 12 Noon ☐ 3 PM	Postage: $ 13.65	
Time In: 3:23 ☐ AM ☑ PM	Military: ☐ 2nd Day ☐ 3rd Day	Return Receipt Fee	
Weight: 3.90 lbs. ozs.	Int'l Alpha Country Code	COD Fee	Insurance Fee
No Delivery: ☐ Weekend ☐ Holiday	Acceptance Clerk Initials: CS	Total Postage & Fees: $ 13.65	

DELIVERY (POSTAL USE ONLY)		
Delivery Attempt Mo. Day	Time ☐ AM ☐ PM	Employee Signature
Delivery Attempt Mo. Day	Time ☐ AM ☐ PM	Employee Signature
Delivery Date Mo. Day	Time ☐ AM ☐ PM SEP 17 2003	Employee Signature

☐ WAIVER OF SIGNATURE (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I/we wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.

NO DELIVERY ☐ Weekend ☐ Holiday

Customer Signature

CUSTOMER USE ONLY

METHOD OF PAYMENT:
Express Mail Corporate Acct. No. 10653205

Federal Agency Acct. No. or Postal Service Acct. No.

FROM: (PLEASE PRINT) PHONE ( )

STEPHEN DAVIS
BRISTOL-MYERS SQUIBB CO
PO BOX 4000
PRINCETON NJ 08543-4000

D0020 NP SCP

TO: (PLEASE PRINT) PHONE ( )

MAIL STOP Appeal - Fee Assignment
COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA VA 22313-1450

PRESS HARD.
You are making 3 copies.

FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com

EMS

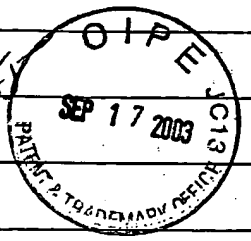
3454

Case No.: D0020

Application No.: 09/932,145

Mailing Date: 9/17/03

Due Date:



Express Mail No.: EV306636575US

OIPE JC13 SEP 17 2003 PATENT & TRADEMARK OFFICE

The Patent & Trademark Office acknowledges, and has stamped hereon the date of receipt of the items checked below:

- ☒ Amendment/Response/Letter - Fee $_____
- ☐ Appln. Filing Papers - Fee $_____
  - ☐ Non-provisional
  - ☐ Provisional Application
  - ☐ CPA ☐ DIV ☐ CONT ☐ CIP
  - ☐ Specification_____Pg's
- ☐ Executed/Unexecuted Decl. - Fee $_____
  - ☐ Missing Parts/Missing Req.
- ☒ Preliminary Amendment 5 Pg's
- ☐ Claim of Priority ☐ Certified Copy(s)
- ☐ Amendment After Final
- ☐ Notice of Appeal - Fee $_____
- ☐ Appeal Brief - Fee $_____
- ☐ Issue Fee Payment - $_____
- ☐ Assignment Rec. Req. - Fee $_____
- ☐ Formal Drawings_____Pg's
- ☒ IDS 2 Pg's - Fee $ 180 (1 ref.)
- ☒ PTO-1499 Form 1 Pg's
- ☐ Pet. for Ext. of Time - Fee $_____
- ☐ Seq. Listings_____Pg's/Seq. Disk
- ☒ Response to Rst. Requirement w/o traverse

SCD
Initials

BMS-PC-5035

IF ADDRESS IS INCORRECT, PLEASE NOTIFY POSTMASTER

PRINCETON NJ 08540-9998

EXPRESS MAIL
UNITED STATES POSTAL SERVICE ®

EXPRESS MAIL CORPORATE ACCOUNT
MAILING STATEMENT

ACCOUNT NO: 085205

DEPOSIT REQUIRED UPON RECEIPT

No deposit required at this time

Please make check payable to POSTMASTER.
Include Account Number on check and send to:

ERNIE FUSCO
BRISTOL-MYERS SQUIBB & CO
PO BOX 4000
PRINCETON NJ 08543-4000

POSTMASTER
BRA #1
213 CARNAGIE CENTER
PRINCETON NJ 08540-9998

Return Top Portion With Your Payment

SEP FY03

ACCOUNT NO.	ACCOUNT ZIP	STATEMENT DATE	BEGINNING PERIOD	ENDING PERIOD
085205	08540	10/01/03	09/01/03	09/30/03

BEGINNING BALANCE	DEPOSITS	REFUNDS	POSTAGE	ADJUSTMENTS	WITHDRAWALS	TRANSFERRED TO PM	ENDING BALANCE
3,879.70	0.00	0.00	890.50	0.00	0.00	0.00	2,989.20
NO. OF TRANSACTIONS	0	0	53	0	0	DEPOSIT REQUIRED BASED ON PREVIOUS MAILING ACTIVITY	
						$	0.00

See reverse side for important information. For statement inquiries, call your account representative within 90 days of statement date.

PLEASE NOTE THAT THIS STATEMENT COVERS SEPTEMBER 6 THROUGH SEPTEMBER 30, 2003.

BEGINNING ON OCTOBER 1, 2003 THE US POSTAL SERVICE IS SWITCHING FROM ACCOUNTING PERIODS (APS) TO MONTHLY REPORTING. YOUR FIRST STATEMENT IN THE NEW FORMAT WILL GENERATE ON NOVEMBER 1, 2003 AND WILL COVER OCTOBER 1 THROUGH OCTOBER 31, 2003.

FOR STATEMENT INQUIRIES CALL 732-819-3248
FOR PICKUP OR DELIVERY INFORMATION CALL 1-800-222-1811

THANK YOU FOR USING EXPRESS MAIL. WE VALUE YOUR BUSINESS AND LOOK FORWARD TO SERVING YOU AGAIN.

000 020 082

IF ADDRESS IS INCORRECT, PLEASE NOTIFY POSTMASTER

EXPRESS MAIL
UNITED STATES POSTAL SERVICE ®

EXPRESS MAIL CORPORATE ACCOUNT
MAILING STATEMENT

ACCOUNT NO: 085205 PERIOD: 09/01/03 - 09/30/03

DATE	CHARGE BACK	LABEL NUMBER	ORIG ZIP	DEST ZIP	ADJ # REF *	POSTAGE	FEES PICKUP	FEES DELIVERY	DEPOSITS	WITH-DRAWALS	CDA LEG
BEGINNING BALANCE:						3,879.70					
09/08/03		EV323497652US	08648	22313		13.65					
09/09/03		EV322166359US	08648	22313		13.65					
09/10/03		EV306636561US	08648	22313		17.85					
09/11/03		EV001831089US	08648	22313		17.85					
09/11/03		EV306636527US	08648	22313		13.65					
09/11/03		EV306636535US	08648	22313		17.85					
09/11/03		EV323501462US	08648	22313		17.85					
09/11/03		EV323501476US	08648	22313		17.85					
09/12/03		EV322166362US	08648	22313		24.20					
09/12/03		EV322166376US	08648	22313		13.65					
09/12/03		EV323498729US	08648	22313		13.65					
09/12/03		EV323498803US	08648	22313		13.65					
09/12/03		EV323501459US	08648	22313		21.05					
09/15/03		EL984308141US	08648	22313		33.45					
09/15/03		EV323497670US	08648	22313		13.65					
09/16/03		EL984308124US	08648	22313		13.65					
09/16/03		EV306636544US	08648	22313		17.85					
09/16/03		EV306636558US	08648	22313		17.85					
09/16/03		EV323497666US	08648	22313		13.65					
09/16/03		EV323497683US	08648	22313		13.65					
09/17/03		EV306636575US	08648	22313		13.65					
09/17/03		EV323497697US	08648	22313		13.65					
09/17/03		EV323497706US	08648	22313		13.65					
09/17/03		EV323498732US	08648	22313		17.85					
09/18/03		EL984308138US	08648	22313		13.65					
09/18/03		EV322166380US	08648	22313		13.65					
09/18/03		EV323497175US	08648	22313		13.65					
09/18/03		EV323501431US	08648	22313		17.85					
09/19/03		EV322166597US	08648	22313		13.65					
09/19/03		EV323498746US	08648	22313		17.85					
09/22/03		EV305484431US	08648	22313		17.85					
09/22/03		EV323497207US	08648	22313		13.65					
09/23/03		EV323501405US	08648	22313		13.65					
09/23/03		EV323501428US	08648	22313		13.65					
09/24/03		EV323498750US	08648	22313		13.65					
09/24/03		EV323501391US	08648	22313		13.65					
09/25/03		EL984308345US	08648	22313		17.85					
09/25/03		EV001831075US	08648	22313		17.85					
09/25/03		EV323497710US	08648	22313		21.05					
09/25/03		EV323501374US	08648	22313		21.05					
09/25/03		EV323501388US	08648	22313		13.65					
09/25/03		EV323501414US	08648	22313		17.85					
09/25/03		EV323501445US	08648	22313		21.05					
09/26/03		EV322166637US	07080	22313		27.30					
09/26/03		EV323498065US	08648	22313		27.30					
09/26/03		EV323498074US	08648	22313		17.85					
09/26/03		EV323501357US	08648	22313		13.65					
09/26/03		EV323501365US	08648	22313		17.85					
09/29/03		EL984308331US	08648	22313		17.85					
09/29/03		EV322166583US	08648	22313		17.85					
09/29/03		EV322166645US	08648	22313		13.65					
09/29/03		EV323499640US	08648	22313		17.85					
09/30/03		EV323501309US	08648	22313							
SUB-TOTAL:						890.50					
(A) TOTAL CHARGES :						890.50	0.00	0.00			
(B) TOTAL ADJUSTMENTS (#):						0.00	0.00	0.00			
(C) TOTAL REFUNDS (*):						0.00	0.00	0.00			
TOTAL (A + B - C):						890.50	0.00	0.00			
ENDING BALANCE:						2,989.20					

USPTO ACCOUNT
BMS withdrawals

Docket #	Mail Date	Postcard ID	Admin	Description	Account ID	Withdrawal Amount
D0020 NP	9/17/2003	3454	Whitlow,Joyce	1806	Domestic	$180.00
LA118 PSP	9/17/2003	3476	DeRuyter,Barbara	1005	Domestic	$160.00
DB33 NP /09/779,109	9/17/2003	3477	Markee, Tina	Issue fee, Publication fee, soft copies	Domestic	$1,630.00
LA0089 NP	9/17/2003	3478	DeRuyter,Barbara	Missing parts	Domestic	$130.00

UNITED STATES 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 19 2006

OFFICE OF PETITIONS

Alston & Bird LLP
Bank Of American Plaza
101 South Tyron Street, Suite 400
Charlotte, North Carolina 28280-4000

In re Application of
Helms et al
Application No. 09/932,148
Filed: August 17, 2001
Patent No. 6,947,612

: DECISION REGARDING PTA

This decision is in response to Applicants' "LETTER REGARDING PATENT TERM ADJUSTMENT)" filed on Nov. 1, 2005 asserting that applicants believe that they received too much PTA at the time of issuance.

The Office thanks applicants for their good faith and candor in bring this letter to the attention of the Office.

Applicants letter is **GRANTED.** The Office will adjust the amount of PTA from a determination of five hundred and twelve (512) days to a determination of four hundred and thirty-three (433) days. Applicants are given thirty days to respond to this decision if applicants disagree with such decision. No extensions of time will be granted pursuant to 37 CFR 1.136.

Applicants believe that they received too much PTA because the Office improperly entered the date of submission of the drawings as August 12, 2005 rather than the correct date of May 25, 2005.

The Office agrees that too much PTA was awarded at the time of the issuance of the patent. The determinations of six hundred and twenty-four (624) days under 37 CFR 1.702(a)(1) is accurate. In addition the seventeen day adjustment under 37 CFR 1.702(a)(2) is accurate. Furthermore, the eighty-nine day reduction under 37 CFR1.704 (b) is accurate. However, the forty day reduction under 37 CFR 1.704(c)(10) is inaccurate. A review of the file history reflects that the drawing reduction under 37 CFR 1.704(c)(10) should not have been forty (40) days. The correct amount of reduction under 37 CFR 1.704(c)(10) is 119 days.[1] Accordingly, the correct amount of PTA for the issued patent is 433 (624 + 17 -89 -119=433) days.

After the mailing of the Office action, the file will be forwarded to the Office of Patent Publications for a prompt issuance of the application.

Because applicants have submitted this letter in response to good faith and candor, the Office

[1]The reduction began on May 25, 2005 and ended on September 20, 2005, a 119-day reduction.

will not assess any fees concerning this decision concerning Patent Term Adjustment.

Any questions concerning this determination should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

/Kery Fries/

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

cc: Adjusted PAIR calculation
DRAFT cert. Of correction.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

OCT 1 2 2005

OFFICE OF PETITIONS

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET, SUITE 540
SAN FRANCISCO, CA 94105

In re Application of :
Amit Haller, et al. :
Application No. 09/932,180 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. IXIM-01001US0 :

This is a decision on the petition under 37 CFR 1.313(c), filed October 11, 2005, requesting that the above-identified application be withdrawn from issue.

The petition is dismissed as moot.

Petitioner requested that the application be withdrawn from issue to permit consideration of an information disclosure statement filed in a request for continued examination (RCE). Since the RCE is filed within the period set for paying the issue fee, as required by the Notice of Allowance and Issue Fee Due mailed July 13, 2005, prosecution is reopened in the present application. Consequently, no petition under 37 CFR 1.313 is necessary.

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

The application is being referred to Technology Center AU 2667 for further processing of the RCE under 37 CFR 1.114 filed October 11, 2005.

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

Myers Bigel Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

COPY MAILED

SEP 13 2002

OFFICE OF PETITIONS

In re Application of :
H. Holden Thorp, et al. :
Application No. 09/932,196 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 5470.277 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 19, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts of NonProvisional Application mailed September 20, 2001. The Notice set a period for reply of two(2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 21, 2001.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry Brinkley at (703)305-9220.

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

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

Sherry Brinkley
Petitions Examiner

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)
6826726	2004-11-30	09932209	2001-08-17	1102.VAUL0006U

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Michael C Cesarano/	Date (YYYY-MM-DD)	2009-03-17
Name	Michael C. Cesarano	Registration Number	31817

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. 6826726
Issue Date: November 30,2004
Application No. 09932209
Filed: August 17,2001
Attorney Docket No. 105462

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

This is a decision on the electronic petition, filed March 17,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 17,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NUMERICAL C/O
HAYNES BEFFEL & WOLFELD LLP
PO BOX 366
HALF MOON BAY, CA 94019

COPY MAILED

AUG 2 9 2005

OFFICE OF PETITIONS

In re Application of :
Christophe Pierrat, et al. :
Application No. 09/932,239 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No.: NMTI 1002-3 :
:

This is a decision on the petition, filed August 25, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on February 7, 2005, in the above-identified application, cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 1756 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

YOUNG LAW FIRM, P.C.
ALAN W. YOUNG
4370 ALPINE ROAD
SUITE 106
PORTOLA VALLEY, CA 94028

COPY MAILED

JUL 10 2007

OFFICE OF PETITIONS

In re Application of :
Jean-Marie Gatto et al. :
Application No. 09/932,282 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. CYB55753 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 8, 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 August 24, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is November 25, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) fee of $395.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $750.00; and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $510.00 extension of time fee submitted with the petition on March 8, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

This application is being referred to Technology Center AU 2623 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Frances Hicks
Petitions Examiner
Office of Petitions

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

Young Law Firm, P.C.
4370 Alpine Road, Suite 106
Portola Valley, CA 94028

Mail Date: 04/21/2010

Applicant	: Jean-Marie Gatto	: DECISION ON REQUEST FOR
Patent Number	: 7636931	: RECALCULATION of PATENT
Issue Date	: 12/22/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/932,282	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/17/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1486** 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. 9

Leon R. Yankwich
Yankwich & Associates
201 Broadway
Cambridge, MA 02139

COPY MAILED

APR 0 3 2003

OFFICE OF PETITIONS

In re Application of
Beltzer et al.
Application No. 09/932,322
Filed: August 17, 2001
Attorney Docket No. DYX-018.1US

ON PETITION

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the Notice to File Missing Parts (Notice) mailed in the above-identified application on October 22, 2001, which set a shortened statutory period for reply of (2) two months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the above-identified application became abandoned on December 23, 2001.

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

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

The application file is being forwarded to Technology Center AU 1651 for further processing.

Latrice Bond

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

cc: Leon R. Yankwich
Yankwich & Associates
130 Bishop Allen Drive
Cambridge, MA 02139

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.
09/932,373	08/17/2001	William P. Anderson	BLO1134-006D	5096

8698 7590 08/14/2006

STANDLEY LAW GROUP LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN, OH 43017

EXAMINER	
DHARIA, PRABODH M	
ART UNIT	**PAPER NUMBER**
2629	

DATE MAILED: 08/14/2006

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20060809

DATE : August 9, 2006

TO SPE OF : ART UNIT 2629

SUBJECT : Request for Certificate of Correction on Patent No.: 09932373

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

Typing errors only No new matters added and does not affect allowed claim limitations

BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

SPE: Bipin Shalwala **Art Unit** 2629

UNITED STATES 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 2 5 2005

OFFICE OF PETITIONS

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

In re Application of
CHAUVEL
Application No.: 09/932,382
Attorney Docket No.:TI-31356

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance mailed March 22, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned at midnight on June 22, 2004.

37 CFR 1.137(b)(b) 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)(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). 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 payment of the issue and publication fees, (2) the petition fee; and (3) an adequate statement of unintentional delay have been received. Accordingly, the issue and publication fees are accepted as having been unintentionally delayed.

The application is being referred to Publishing Division.

Telephone inquiries concerning this decision should be directed to Cynthia Kratz at (571) 272-3286 or in her absence, the undersigned at (571) 272-3217.

Frances Hicks for

Brian Hearn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 14

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

COPY MAILED

MAY 11 2004

OFFICE OF PETITIONS

In re Application of :
Hua et al. :
Application No. 09/932,385 : DECISION ON PETITION
Filed: August 17, 2001 :
Attorney Docket No: P/144-281 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 26, 2004, to revive the above-identified application.

This petition is hereby **Dismissed**.

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

This above-identified application became abandoned for failure to timely file a proper response to a final Office Action which was mailed on August 12, 2003. The final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 13, 2003. A Notice of Abandonment was mailed on March 23, 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(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03 (c)(III)(C) and (D).

The instant petition lacks item (1) the required reply. The proposed reply required for consideration of a petition to revive after a final Office Action must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that prima facie places the

application in condition for allowance, the filing of a continuing application or a Request for Continued Examination (RCE). See MPEP 711.03(c)(III)(A)(2) and 37 CFR 1.114. The examiner has determined the amendment submitted with the petition does not place the application in condition for allowance. Accordingly, this application cannot be revived.

It is also noted a review of Office records do not show petitioner was ever empowered to prosecute the instant application. If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted.

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

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 872-9306
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
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

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

COPY MAILED

JUN 2 4 2004

OFFICE OF PETITIONS

In re Application of
Hua et al.
Application No. 09/932,385
Filed: August 17, 2001
Attorney Docket No: P/144-281

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 9, 2004, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a proper response to a final Office Action which was mailed on August 12, 2003. The final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 13, 2003. A Notice of Abandonment was mailed on March 23, 2004. A petition filed under 37 CFR 1.137(b) was dismissed on May 11, 2004.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The Request for Continued Examination (RCE) and the amendment previously filed on April 26, 2004 (certificate of mailing April 22, 2004) will be forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES 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
NOV 16 2006
OFFICE OF PETITIONS

Christopher J. Gaspar
Milbank, Tweed, Hadley & McCloy, LLP
1 Chase Manhattan Plaza
New York, NY 10005-1413

In re Application of :
William R. Maulsby, et. al. :
Application No. 09/932,388 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 36891.0000 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 25, 2006, to revive the above-identified application.

The above application became abandoned for failure to reply to the final Office action mailed January 4, 2006. A Notice of Abandonment was mailed on July 20, 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) under 37 CFR 1.114, with the $395 filing fee and an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 3629.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

DANIEL P MCCARTHY
PARSONS BEHLE & LATIMER
201 SOUTH MAIN STREET, SUITE 1800
P.O. BOX 45898
SALT LAKE CITY, UT 84145-0898

COPY MAILED

MAR 0 7 2002

OFFICE OF PETITIONS

In re Application of	:	
Tony M. Pearce	:	
Application No. 09/932,393	:	NOTICE
Filed: August 17, 2001	:	
Attorney Docket No. 5050IP	:	

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 1712.

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

KAREN G. KAISER
NATIONAL STARCH AND CHEMICAL COMPANY
10 FINDERNE AVENUE
BRIDGEWATER, NJ 08807-0500

COPY MAILED

MAR 0 7 2005

OFFICE OF PETITIONS

In re Application of	:	
Cao et al.	:	
Application No. 09/932,435	:	ON PETITION
Filed: August 17, 2001	:	
Attorney Docket No. 1942.PC	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 27, 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 December 19, 2003. A two-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on May 20, 2004.

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 processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Jan. 11, 2005

TO SPE OF : ART UNIT 2875

SUBJECT : Request for Certificate of Correction on Patent No.: 6,722,772

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 see the references cited – should they be added?

Thank You For Your Assistance

_____
Certificates of Correction Branch

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

☒ **Approved** — All changes apply.

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

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

Comments:

Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800

SPE

2875
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

FLESHNER & KIM, LLP
PO BOX 221200
CHANTILLY, VA 20153-1200

COPY MAILED

SEP 29 2005

OFFICE OF PETITIONS

In re Application of	:	
Yi et al.	:	
Application No. 09/932,459	:	
Filed: August 20, 2001	:	ON PETITION
Attorney Docket No.	:	
HI-0035A	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 24, 2005, 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 **dismissed**.

A petition 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), and must be filed during the pendency of the nonprovisional application. In addition, the petition must accompanied by:

(**1**) the surcharge as 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 as unintentional; and

(**3**) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or as an amendment in the first sentence of the specification following the title. *See* 35 USC 120 and 37 CFR 1.78(a)(2). 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 applications 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 applications 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)(3) can be granted, a substitute amendment[1] deleting the incorporation by reference statement, 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:

---

[1] *Note* 37 CFR 1.121

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

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

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

Any questions concerning this matter may be directed to Attorney Derek L. Woods at (571) 272-3232.

Frances 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

FLESHNER & KIM, LLP
PO BOX 221200
CHANTILLY, VA 20153-1200

COPY MAILED

MAR 20 2006

OFFICE OF PETITIONS

In re Application of	:	
Yi et al.	:	
Application No. 09/932,459	:	
Filed: August 20, 2001	:	ON PETITION
Attorney Docket No.	:	
HI-0035A	:	

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed December 15, 2005, 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;
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.
>
> The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to

the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the 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 (571) 272-3232. 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 2661 for consideration by the examiner of applicant's

entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.

Frances 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

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/932,459	08/20/2001	2661	1918	HI-035A	6	12	6

CONFIRMATION NO. 3386

34610
FLESHNER & KIM, LLP
P.O. BOX 221200
CHANTILLY, VA 20153

CORRECTED FILING RECEIPT

OC000000018262163

Date Mailed: 03/10/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Seung June Yi, Seoul, KOREA, REPUBLIC OF;
Jin Young Park, Kyunggi-do, KOREA, REPUBLIC OF;

Power of Attorney: The patent practitioners associated with Customer Number **34610**.

Domestic Priority data as claimed by applicant

This application is a CIP of 09/863,400 05/24/2001 ABN

Foreign Applications

REPUBLIC OF KOREA 48144/2000 08/19/2000

If Required, Foreign Filing License Granted: 09/18/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/932,459

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Method for inserting length indicator in protocol data unit of radio link control

Preliminary Class

370

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof

unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

CAHN & SAMUELS LLP
2000 P STREET NW
SUITE 200
WASHINGTON DC 20036

COPY MAILED

MAY 1 3 2002

OFFICE OF PETITIONS

In re Application of :
Poier, Meharg, and Pankratov :
Application No.: 09/932,461 :
Filed: August 20, 2001 : DECISION ACCORDING
Attorney Docket No: 406.0005CIP : STATUS UNDER
For: METHOD AND APPARATUS FOR DATA : RULE 47(a)
COMMUNICATION BETWEEN A PLURALITY OF :
PARTIES :

This is in response to the petition under 37 CFR 1.47(a), filed January 24, 2002.

The petition is **GRANTED**.

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

A "Notice to File Missing Parts of Non-Provisional Application" ("Notice") was mailed to petitioner on September 24, 2001, indicating that petitioner neglected to remit required fees and file a proper oath or declaration in compliance with 37 CFR 1.63. The Notice also advised petitioner that a $130.00 surcharge was also due because a proper oath or declaration was not timely filed. The Notice further indicated that substitute drawings were required. The Notice set forth a period of reply of two months from the mailing date of the Notice and indicated that extensions of time for reply were available pursuant to 37 CFR 1.136(a).

In response thereto, petitioner filed a request for a two-month extension of time for reply, the instant petition, and the declaration of Jennifer Long. Petitioner also filed several accompanying exhibits establishing that diligent efforts were made to locate inventor Poier so as to present inventor Poier with a complete copy of the application papers. The above-cited application is hereby accorded Rule 1.47(a) status as petitioner's inability to locate inventor Poier after diligent efforts has been satisfactorily established.

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

The Information Disclosure Statement, filed January 25, 2002, is noted and made of record.

The substitute drawings, also filed January 25, 2002, are noted and made of record.

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

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 21

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

COPY MAILED

SEP 0 2 2004

OFFICE OF PETITIONS

In re Application of :
Jacobsen et al. :
Application No. 09/932,505 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 3424P008D :

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed March 15, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional Application No. 09/270,146, filed March 16, 1999.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR § 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed nonprovisional Application No. 09/720,146, filed March 16, 1999.

The instant pending nonprovisional application was filed on August 17, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(2)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR

§ 1.78(a)(3).[1] In the instant case, the Office noted the claim for priority of the nonprovisional Application No. 09/270,146 in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the $1,330.00 petition fee submitted is unnecessary and, as such, is refundable. Petitioner may request a refund of the $1,330.00 petition fee submitted by writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

Any questions concerning this decision on petition may be directed to Petitions Attorney Christina Tartera Donnell at (703) 306-5589. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 2871 for appropriate processing of the amendment, filed March 15, 2004.

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

[1] *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

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

MORGAN & FINNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK, NY 10154-0053

COPY MAILED

NOV 2 6 2002

OFFICE OF PETITIONS

In re Application of :
Edgar M. Fitzsimons et al :
Application No. 09/932,517 : DECISION ON PETITION
Filed: August 17, 2001 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 4301-4000 :

This is a decision on the petition under 37 CFR 1.78(a)(6), filed October 29, 2002, 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 **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 surcharge set forth in 37 CFR 1.17(t);

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(I) and the date the claim was filed was unintentional; and

(3) the reference to the prior-filed provisional application supplied in an application data sheet (ADS)(37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. *See* 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5)(iii). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on August 17, 2001 within twelve months of the filing date of the prior-filed provisional application,

Application No. 60/241,661, which was filed on October 20, 2000, 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 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. 60/241,661 is granted as of the date of filing the petition.

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 Karen Creasy at (703) 305-8859.

The application is being forwarded to Technology Center AU 2673 for processing the amendment filed October 29, 2002 and for consideration by the examiner of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional application, Application No. 60/241,661, filed on October 20, 2000.

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

MIRUS CORPORATION
505 SOUTH ROSA RD
MADISON, WI 53719

COPY MAILED

FEB 0 1 2008

OFFICE OF PETITIONS

In re Application of
Hans HERWEIJER et al.
Application No. 09/932,521
Filed: August 17, 2001
Attorney Docket No. Mirus.023.01

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 06, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed January 30, 2006, and a two (2) month extension of time under the provisions of 37 CFR 1.136(a) was obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on June 07, 2006. *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 and fee of $250; (2) the petition fee $750; and (3) the required statement of unintentional delay have been received. Accordingly, the appeal brief filed on May 19, 2006 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

The application file is being referred to Technology Center AU 1632 for examiners answer.

Michelle R. Eason
Paralegal Specialist
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. 5

PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND, OH 44114-1484

COPY MAILED

SEP 0 3 2002

OFFICE OF PETITIONS

In re Application of :
Britt et al. :
Application No. 09/932,532 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 33053 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed June 13, 2002, to revive the above-identified application. This is also a decision on the petition under 37 CFR 1.47(a), filed June 13, 2002.

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

The petition under 37 CFR 1.47(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. 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 petition under 37 CFR 1.137

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 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.

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

The petition under 37 CFR 1.47

The above-identified application was filed on August 17, 2001, with a declaration signed by only one of the two inventors. Accordingly, on September 19, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring a declaration signed by all the inventors (or a petition under 37 CFR 1.47) and a surcharge for its late filing. The surcharge of $130 will be charged to petitioner's deposit account.

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).

The instant petition fails to satisfy (1).

As to item (1), petitioner must establish that the non-signing inventor refused to sign the oath or declaration after being presented with the application papers. Petitioner has failed to establish that the non-signing inventor was presented with a copy of the application. An inventor cannot sign a declaration stating he or she has "reviewed and understands the application papers" when the inventor has not been presented with a copy of the application and therefore has not reviewed the application. Refusal within the meaning of 37 CFR 1.47 requires that the inventor be presented[1] with the application papers and given adequate time to review the contents of the application. Until the inventor reviews the papers and reads the specification and claims, he cannot know if he is actually an inventor of the claimed invention. Petitioner should send a copy of the application to the inventor along with instructions setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as a certified mail return receipt, cover letter of instructions, telegram, etc.

Petitioner should note that when there is an express oral refusal, if the non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47 by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

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 Petitions Attorney Steven Brantley at (703) 306-5683.

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

[1] It is not sufficient for an applicant to simply make the papers available. See MPEP, Section 409.03(d).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND OH 44114-1484

COPY MAILED

NOV 0 1 2002

OFFICE OF PETITIONS

In re Application of :
Britt, Bloemers, and Ford : DECISION GRANTING
Application No. 09/932,532 : PETITION UNDER
Filed: August 17, 2001 : 37 CFR 1.47
Attorney Docket No. 33053 :
For: CYLINDER HEAD AND CRANKCASE MANUFACTURING AND ASSEMBLY TECHNIQUES :

This is in response to the renewed petition under 37 CFR 1.47(a) filed August 17, 2001.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers.

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

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

The file will now be forwarded to the Office of Initial Patent Examination for further processing.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Alan Britt
4630 Renfroe Road
Talladega, AL 35160

COPY MAILED

NOV 0 1 2002

OFFICE OF PETITIONS

In re Application of :
Britt, Bloemers, and Ford :
Application No. 09/932,532 : LETTER
Filed: August 17, 2002 :
Attorney Docket No. 33053 :
For: Cylinder Head and Crankcase :
Manufacturing and Assembly Techniques :

Dear Mr. Britt:

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 Petitions Attorney Steven Brantley at (703) 306-5683.

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

cc: PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND, OH 44114-1484

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NICK A. NICHOLS
P O BOX 16399
SUGARLAND, TX 77496-6399

COPY MAILED

SEP 20 2004

OFFICE OF PETITIONS

In re Application of :
Robert Malcolm Thomas et al :
Application No. 09/932,557 : DECISION GRANTING PETITION
Filed: August 17, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. THOM/501US :

This is a decision on the petition under 37 CFR 1.137(b), filed August 10, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the nonfinal Office action of October 6, 2003. No extensions of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), this application became abandoned on January 7, 2004, after expiration of the three month shortened statutory period set for reply in the nonfinal Office action of October 6, 2003.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal Office action of October 6, 2003 is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 1753 for appropriate action in due course on the reply received August 10, 2004.

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

Paper No. 7

Ann Marie Mewherter
Conley, Rose and Tayon, P. C.
P. O. Box 398
Austin, TX 78767-0398

COPY MAILED

JUN 0 7 2002

OFFICE OF PETITIONS

In re Application of :
Scott Ashkenaz, et al. :
Application No. 09/932,580 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 5589-04400 :

This is in response to the Petition under 37 CFR 1.47(a), filed March 28, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 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) set forth above.

As to item (2), the declaration submitted fails to set forth a signature block for joint inventor C. Thomas Larson which also includes his citizenship, residence and mailing address. Accordingly, a declaration in compliance with 37 CFR 1.63 and 1.64 and signed by joint inventor Scott Ashkenaz on behalf of himself and Mr. Larson is REQUIRED. See MPEP 409.03(a).

In order to expedite consideration, petitioner may wish to submit the Request for Reconsideration under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of Marianne Morgan.

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

By Mail: Commissioner for Patents
Box DAC
Washington, DC 20231

OR

U.S. Patent and Trademark Office
P. O. Box 2327
Mail Stop DAC
Arlington, VA 22202

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

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

Any questions concerning this decision should be directed to Marianne Morgan at (703) 306-3475.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

Ann Marie Mewherter
Conley, Rose and Tayon, P. C.
P. O. Box 398
Austin, TX 78767-0398

COPY MAILED

JUL 30 2002

OFFICE OF PETITIONS

In re Application of :
Scott Ashkenaz, et al. :
Application No. 09/932,580 : ON PETITION
Filed: August 17, 2001 :
Attorney Docket No. 5589-04400 :

This is in response to the "Request for Reconsideration of Petition under 37 CFR 1.47(a)", filed July 12, 2002.

The petition is granted.

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

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

As provided in 37 CFR 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to Technology Center 1700.

Telephone inquiries regarding this decision should be directed to Marianne Morgan at (703) 306-3475.

Frances M. 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

C. Thomas Larson
1096 Jessica Drive
Livermore, CA 94550

COPY MAILED

JUL 3 0 2002

OFFICE OF PETITIONS

In re Application of
Scott Ashkenaz and C. Thomas Larson
Application No. 09/932,580
Filed: August 17, 2001
For: METHOD OF INTERFACING ANCILLARY EQUIPMENT TO FIMS PROCESSING STATIONS

Dear Mr. C. Thomas Larson:

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 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 Marianne Morgan at (703) 306-3475. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington, DC area).

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

cc: Ann Marie Mewherter
Conley, Rose and Tayon, P.C.
P. O. Box 398
Austin, TX 78767-0398

02 MAR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

02 MAR 2006

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

Ann Marie Mewherter
Daffer McDaniel, LLP
P.O. Box 684908
Austin, TX 78768-4908

In re Application of	:
ASHKENASZ, et al.	:
Application No. 09/932,580	: DECISION ON PETITION
Filed: August 17, 2001	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. KT-1040A	:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed 09 November 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 a previously 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 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 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

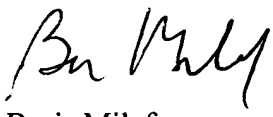
instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

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 Derek Putonen at (571) 272-3294. 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 2125 for appropriate action on the amendment submitted 27 December 2004, 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. 60/226,336.



Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

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. 3

COLUMBIA IP LAW GROUP PC
10260 SW GREENBURG ROAD
SUITE 820
PORTLAND, OR 97223

COPY MAILED

MAR - 4 2002

OFFICE OF PETITIONS

In re Application of :
Jonathan O. Nelson :
Application No. 09/932,592 : NOTICE
Filed: August 17, 2001 :
Attorney Docket No. 41051.P011 :

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 2683.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

SCHWABE WILLIAMSON & WYATT P.C.
PACWEST CENTER, SUITE 1600-1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

COPY MAILED

OCT 2 8 2003

OFFICE OF PETITIONS

In re Application of :
Jonathan O. Nelson :
Application No. 09/932,592 : DECISION GRANTING PETITION
Filed: August 17, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 41051.P011 :

This is a decision on the petition, filed June 16, 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 August 2, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m);

and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of January 29, 2004 accompanies this decision on petition.

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 2682 for examination in due course.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

COPY MAILED

APR 0 7 2003

OFFICE OF PETITIONS

In re Application of :
Donald E. Weaver et al :
Application No. 09/932,676 : ON PETITION
Filed: August 16, 2001 :
Attorney Docket No. NCI-006DV2

This is a decision on the petition under 37 CFR 1.182, filed on November 13, 2002 to correct the spelling of one of the named inventor from Donald E. Weaver to Donald F. Weaver.

The petition is granted.

A copy of the corrected filing receipt is enclosed.

The file is being forward to Publishing Division to be processed into a patent.

Telephone inquires concerning this matter may be directed to Wan Laymon at (703) 306-5685.

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

JAMES B MONEY
1360 SANTA INEZ DR.
SAN JOSE CA 95125

COPY MAILED

AUG 2 6 2008

Patent No. 6,713,909 :
Application No. 09/932,684 :
Filed: August 20, 2001 : ON PETITION
Issued: March 30, 2004 :
Title: A Digitally Controlled Variable Speed Integrated Planer Motor Assembly :

This is a decision on the petition under 37 CFR 1.378(c), filed June 19, 2008, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2).

This petition lacks items (3) above. Petitioner submitted $65.00 towards the $1640.00 requisite surcharge. Accordingly, to reinstate the instant patent, an additional $1575.00 is required.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration must include the lacking item(s) noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, a total of $1975.00 should be submitted with any renewed petition.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fees and post expiration surcharge are refundable. Petitioner may request a refund of the fees submitted on June 19, 2008. Please send all requests for refunds to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

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

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Window located at: U.S. Patent and Trademark Office Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-8300 ATTN: Office of Petitions

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

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES 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.

SEED INTELLECTUAL PROPERTY LAW GROUP
701 FIFTH AVENUE
SUITE 6300
SEATTLE, WA 98104-7092

COPY MAILED

NOV 12 2003

OFFICE OF PETITIONS

In re Application of
Thomas Schulte et al
Application No. 09/932,687
Filed: August 17, 2001
Attorney Docket No. MICRO1200

: 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 October 9, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of prior-filed provisional Application No. 60/281,114, filed April 3, 2001.

The petition is **DISMISSED**.

Any request for reconsideration must be filed within **TWO MONTHS** from the mail date of this decision. Note 37 CFR 1.181(f).

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;[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)(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 August 17, 2001. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

[1] Any nonprovisional application claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference (i.e., in an amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed provisional application, identifying it as a provisional application, and including the application number (consisting of the series code and serial number).

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)(6) can be granted, a substitute amendment [2] deleting the incorporation by reference statement to the prior-filed provisional application along with a renewed petition under 37 CFR 1.78(a)(6), is required.

In order to expedite consideration, petitioner may wish to submit the substitute amendment and renewed petition by facsimile transmission to the number indicated below and to the attention of Karen Creasy .

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

By mail:
U.S. Patent and Trademark Office
P.O. Box 2327
Mail Stop DAC
Arlington, VA 22202

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

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

---

[2]Note 37 CFR 1.121

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

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859.

Frances Hicks
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.

SEED INTELLECTUAL PROPERTY LAW GROUP
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

COPY MAILED

DEC 0 8 2003

OFFICE OF PETITIONS

In re Application of
Thomas Schulte et al
Application No. 09/932,687
Filed: August 17, 2001
Attorney Docket No. MICRO1200

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed November 24, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of prior-filed provisional Application No. 60/281,114, filed April 3, 2001.

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 surcharge set forth in 37 CFR 1.17(t);

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and

(3) the reference to the prior-filed provisional application supplied in an application data sheet (ADS)(37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. *See* 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5)(iii). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on August 17, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/281,114, which was filed on April 3, 2001, 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. 60/281,114 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. 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 Karen Creasy at (703) 305-8859.

The examiner of Technology Center AU 1723 will consider applicant's entitlement to claim benefit of priority under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No. 60/281,114, filed April 3, 2001.

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

ATTACHMENT: Corrected Filing Receipt

6

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
09/932,728	08/17/2001	Robert Gellibolian	10010543-1

CONFIRMATION NO. 6224

FORMALITIES LETTER

OC000000006582036

AGILENT TECHNOLOGIES, INC.
Intellectual Property Administration
Legal Department, DL429
P.O. Box 7599
Loveland, CO 80537-0599

OIPE JC97 JAN 15 2002 PATENT & TRADEMARK OFFICE

Date Mailed: 09/20/2001

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given **TWO MONTHS** from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a)

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

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

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

COPY OF PAPERS ORIGINALLY FILED

Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10010543-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

OIPE
JAN 15 2002
PATENT & TRADEMARK OFFICE
JC97

Inventor(s): Robert Gellibolian

Serial No.: 09/932,728 **Examiner:** Not yet known

Filing Date: Aug. 17, 2001 **Group Art Unit:** 1645

Title: METHOD AND SYSTEM FOR ARRAY SIGNAL GENERATION AND AMPLIFICATION

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

TRANSMITTAL LETTER FOR SUBMITTAL OF CORRECTED APPLICATION PAPERS

Sir:

This is in response to a Notice to File Corrected Application Papers mailed on **Sept. 20, 2001**. Enclosed is a copy of said Notice and the following documents and fees to complete the filing requirements of the above-identified application.

(X) Substitute drawings (16 sheets) in compliance with 37 CFR 1.84 with correction of margins.

( ) Statutory basic filing fee ( ) Utility $740.00 ( ) Design $330.00

( ) Additional claim fees of $

( ) Missing Parts Surcharge $130.00

( ) A Petition for Extension of Time for reply to Notice of Missing Parts is attached.

( )	one month	$110.00
( )	two months	$400.00
( )	three months	$920.00
( )	four months	$1440.00

Please charge to Deposit Account **50-1078** the sum of **$ 0.00**. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account **50-1078** pursuant to 37 CFR 1.25.

(X) A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Robert Gellibolian

By _____

Gordon M. Stewart
Attorney/Agent for Applicant(s)
Reg. No. **30,528**

Date: **Nov. 19, 2001**

Telephone No.: **(650) 485-2386**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: **Nov. 20, 2001**

Typed Name: **Elizabeth Miller**

Signature: Elizabeth Miller

COPY OF PAPERS ORIGINALLY FILED

20 JAN 15 02 02:22:50

UNITED STATES 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

A. Allen Schinkel
Indigo Wind Films Inc.
2268 West 45th Avenue
Vancouver, BC V6M 2J3
Canada

COPY MAILED

DEC 1 8 2003

OFFICE OF PETITIONS

In re Application of :
Andrew A. Schinkel :
Application No. 09/932,820 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. PAT 953-2 US :

This is a decision on the petition under 37 CFR 1.137(b), filed December 8, 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 December 9, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 10, 2003.

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

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

The application file is being forwarded to Technology Center 3727 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

cc: Borden Ladner Gervais, LLP
World Exchange Plaza
1100-100 Queen Street
Ottawa, ON K1P 1J9

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Frank C. Nicholas
Cardinal Law Group
Suite 2000
1603 Orrington Ave.
Evanston, IL 60201

COPY MAILED

MAY 2 1 2004

OFFICE OF PETITIONS

In re Application of
Chen et al.
Application No. 09/932,842
Filed: August 17, 2001
Attorney Docket No. 7780/17 (T00343)

Decision on Petition

In re Application of
Chen et al.
Application No. 09/929,509
Filed: August 14, 2001
Attorney Docket No. 7780/17 (T00343)

Letter

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment. The petition was filed for application no. 09/932,842.

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

Facts:

Application No. 09/929,509 was filed on August 14, 2001.

Application No. 09/932,842 was filed on August 17, 2001.

For both applications, Notices to File Missing Parts were mailed on September 20, 2001.

A timely response was filed for application no. 09/932,842.

A timely response was not filed for application no. 09/929,509.

On June 30, 2003, a Notice of Abandonment was mailed for application no. 09/929,509.

On July 11, 2003, various papers were filed by petitioner.

The papers located in the file for application no. 09/932,842 include:

(1) a transmittal form bearing application no. 09/929,842 - which is not one of petitioner's applications;
(2) a copy of the Notice of Abandonment mailed for application no. 09/929,509;
(3) a petition to revive bearing application no. 09/932,842;
(4) a postcard receipt bearing application no. 09/932,842; and
(5) copies of the papers for application no. 09/932,842, previously timely submitted.

The only paper located in the file for application no. 09/929,509, is a paper filed July 11, 2003. The paper is a copy of the declaration for 09/932,842.

Analysis:

Application No. 09/932,842 cannot be revived because it has never been abandoned or held to be abandoned.

Application No. 09/929,509 remains abandoned.

The file for Application No. 09/932,842 is being forwarded to the examiner in Technology Center 2686 for review in due course.

The file for Application No. 09/929,509 is being forwarded to Files Repository.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,637,259	2003-10-28	09/932,880	2001-08-20	33572-03905

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	/GeorgeRHoskins/	Date (YYYY-MM-DD)	2009-10-27
Name	George R. Hoskins	Registration Number	46780

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. 6637259
Issue Date: October 28,2003
Application No. 09932880
Filed: August 20,2001
Attorney Docket No. FX-TM

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

This is a decision on the electronic petition, filed October 27,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 27,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 20

MCDERMOTT, WILL & EMERY
4370 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO, CA 92122

COPY MAILED

FEB 17 2004

OFFICE OF PETITIONS

In re Application of :
Auger :
Application No. 09/932,976 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 67233-011 :

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

The petition is **GRANTED.**

On August 8, 2002, a final Office action was mailed, setting forth a 3-month shortened statutory reply period.

A proposed amendment (Amendment B) filed on November 8, 2002, as indicated in the November 20, 2002 Advisory Action, did not place the application in condition for allowance and was not entered by the Examiner. The Advisory Action pointed out that the period for responding to the August 8, 2002 final Office Action remained that set forth in that Office action.

However, a Notice of Appeal was filed concurrently with the November 8, 2002 proposed amendment. Accordingly, Applicant was permitted to file an appeal brief within 2 months of the November 8, 2002 filing date of the Notice of Appeal, i.e., on or before January 8, 2003. This 2-month period was extendable under 37 CFR 1.136(a), by up to 5 more months, through June 8, 2003.

No appeal brief was filed on or before June 9, 2003 (Monday), and no extension of time was obtained. The application became abandoned on January 9, 2003.

The instant petition encloses a Request for Continued Examination (RCE) as reply to the August 8, 2002 final Office Action; the $385 RCE filing fee (small entity); an amendment as the RCE "submission" required by 37 CFR 1.114; and the $665 petition fee (small entity). The petition also states that the entire delay in filing a proper reply to the August 8, 2002 final Office Action from the due date until the filing of a grantable §1.137(b) petition was unintentional. The petition is thus granted.

The application is hereby revived for establishing continuity with the RCE.

As requested, the new power of attorney and the new correspondence address have been entered and made of record.

Finally, the Office notes that the sole inventor named in the application, Stephen B. Auger, assigned his interest in the claimed invention to Wood Infusions, Inc. on August 9, 2001.[1] Another document, signed by Stephen B. Auger on May 17, 2003, is recorded in the USPTO as an "assignment" from Stephen B. Auger of his entire rights in this claimed invention to Stain, Inc.[2] The §3.73(b) statement in the file shows Stephen B. Auger as president of Wood Infusions, LLC. While it is conceivable that Stephen B. Auger signed the May 17, 2003 document on behalf of Wood Infusions, Inc., proper corrections in the assignment papers including the recordation cover sheet should be submitted directly to the USPTO Assignment Branch.

The application file is being returned to Technology Center 1700 for continued examination.

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

RC Tang
Petitions Attorney
Office of Petitions

Attachments: Notice Regarding Change of Power of Attorney (revoking prior powers of attorney)
Notice of Acceptance of Power of Attorney (accepting 10/24/03 Power of Attorney)

---

1 Recorded in the USPTO, Assignment Branch, at Reel/Frame 012121/0696 on 8/21/01.

2 Reel/Frame 013811/0445.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

APR 10 2003

Technology Center 2100

Paper No. 5

Wilmer Cutler & Pickering
2445 M Street, N.W.
Washington, DC 20037-1420

In re Application of: Todd Lagimonier, et al.)
Application No. 09/932,982)
Filed: August 21, 2001)
For: SYSTEM FOR EFFICIENTLY)
HANDLING CRYPTOGRAPHIC) **DECISION ON REQUEST FOR**
MESSAGES CONTAINING NONCE) **WITHDRAWAL AS ATTORNEY**
VALUES IN A WIRELESS)
CONNECTIONLESS)
ENVIRONMENT WITHOUT)
COMPRISING SECURITY)

This is a decision on the Request To Withdraw from Representation filed March 13, 2003.

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

The request is **GRANTED**.

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

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

cc: Brad Aaron
Aether Systems
11460 Cronridge Drive
Owings Mills, MD 21117

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

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

MAILED

APR 1 1 2003

Technology Center 2600

In re Application of :
Pezzaniti et al. :
Application No. 09/933,002 : DECISION ON REQUEST TO
Filed: August 21, 2001 : WITHDRAW AS ATTORNEY
For: COMMUNICATION SYSTEM AND :
METHOD TO AVOID LASER-PULSE :
BROADENING BY MULTI-PATH EFFECTS

This is a decision on the request to withdraw as attorney/agent of record filed on March 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 is **GRANTED.**

All of the attorneys of record are granted the request for withdraw of attorney/agent.
All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

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

cc: Patent Administrator
Mems Optical, Inc.
205 Import Circle, Suite 2
Huntsville, AL 35806

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JOHN T. WINBURN
BSH HOME APPLIANCES CORPORATION
100 BOSCH BLVD.
NEW BERN, NC 28562

COPY MAILED

OCT 1 9 2005

OFFICE OF PETITIONS

In re Application of :
Richard Horn et al :
Application No. 09/933,054 :
Filed: August 20, 2001 :
Attorney Docket No. ZTP 99 P 4011 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 22, 2005, to revive the above-identified application.

The petition is **GRANTED**.

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

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed January 13, 2005, which set a shortened statutory period for reply of three (3) months. Three months extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 14, 2005.

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

This matter is being referred to Technology Center AU 3634 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

Paper No. 18

C. STEVEN MCDANIEL
MCDANIEL & ASSOCIATES, P.C.
P.O. BOX 2244
AUSTIN, TX 78768-2244

COPY MAILED

NOV 1 8 2004

OFFICE OF PETITIONS

In re Application of :
Christophe Person :
Application No. 09/933,056 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. LXGN-00103 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 28, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 8, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 9, 2003.

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

The application is being forwarded to Technology Center AU 1631 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. 6

ZARETSKY & ASSOCIATES PC
8753 W. RUNION DR.
PEORIA, AZ 85382-6412

COPY MAILED

FEB 18 2004

OFFICE OF PETITIONS

In re Application of :
Dan Raphaeli, et al. :
Application No. 09/933,060 :
Filed: August 20, 2001 :
Attorney Docket No. 12407.0034 :

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed November 20, 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 August 19, 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 May 27, 2004 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center Art Unit 2134 for examination in due course.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817

COPY MAILED

JUL 21 2006

OFFICE OF PETITIONS

In re Application of :
Makoto INOUE, et al. :
Application No. 09/933,119 : DECISION ON PETITION
Filed: August 21,2001 : TO WITHDRAW
Attorney Docket No. LIN.001 : 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 28, 2006.

The request is **NOT APPROVED**.

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

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

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

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

David Bucci
Petitions Examiner
Office of Petitions

cc: Kenji Suzuki
2-1-10-206 Sasazuka, Shibuya-Ka
Tokyo, Japan 151-0073

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD, SUITE 200
VIENNA VA 22182-3817

COPY MAILED

NOV 27 2006

OFFICE OF PETITIONS

In re Application of :
INOUE, et al. :
Application No. 09/933,119 : DECISION ON REQUEST FOR
Filed: August 21, 2001 : REVOCATION OF POWER
Attorney Docket No. LIN.001 : OF ATTORNEY
:

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed October 12, 2006.

The request is **APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

The correspondence address of record remains unchanged.

There is an outstanding Office action mailed August 29, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
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

MICHELINE & GRAVELLE
Bereskin & Parr
Box 401
40 King Street West
Toronto ON M5H 3Y2 CA CANADA

COPY MAILED

MAY 2 6 2005

OFFICE OF PETITIONS

In re Application of :
Li Zhang, et al. :
Application No. 09/933,131 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 10723-26 :

This is a decision in response to the petition under 37 CFR 1.137(b), filed March 18, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely file an Appeal Brief within two months of the February 26, 2004 date of the Notice of Appeal. A Notice of Abandonment was subsequently mailed on March 23, 2005.

The application is being revived for consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114. Accordingly, the filing of the RCE on March 18, 2005, obviates the Notice of Appeal filed February 26, 2004.

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 1644, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

VAN PELT & YI, LLP
10050 N. Foothill Blvd.
Suite 200
Cupertino, CA 95014

MAILED

OCT 14 2004

Technology Center 2100

In re Application of:
Chiahwong Jack HWANG, et al.
Application No. 09/933,139
Filed: August 21, 2001
For: PROVIDING DATA SERVICES VIA WIRELESS MOBILE DEVICES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed July 19, 2004.

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

The request is **GRANTED**.

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

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

cc: Deborah Wang
W-Phone, Inc.
2336-E Walsh Ave.
Santa Clara, CA 95051

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA VA 22314

COPY MAILED

FEB 27 2007

OFFICE OF PETITIONS

In re Patent No.: 7,082,209 :
Issue Date: July 25, 2006 :
Application No. 09/933,164 :
Filed: August 21, 2001 : ON PETITION
For: OBJECT DETECTING METHOD AND :
OBJECT DETECTING APPARATUS AND :
INTRUDING OBJECT MONITORING :
APPARATUS EMPLOYING THE OBJECT
DETECTING METHOD

This is a decision on the petition filed July 10, 2006, styled as a "petition to withdraw terminal disclaimer before issuance of the patent under 37 CFR 1.182."

The petition is **dismissed.**

While it is recognized that the instant petition was filed shortly before issuance, it was unfortunately not brought to the attention of an appropriately empowered deciding official until after the patent issued. The delay is regretted. As explained in MPEP 1490, subsection B, once the patent has issued, the USPTO will not nullify the effect of a recorded terminal disclaimer.

Telephone inquiries related to this decision should be addressed to the undersigned at (571) 272-3217.

Brian Hearn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

FULWIDER PATTON LEE & UTECHT
200 OCEANGATE, SUITE 1500
LONG BEACH, CA 90802

COPY MAILED

NOV 12 2003

OFFICE OF PETITIONS

In re Application of
Kenneth N. Harel
Application No. 09/933,229
Filed: August 20, 2001
Attorney Docket No. CONTC.5758

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 August 15, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed design 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.

The instant pending application was filed on August 20. 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed design application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed design 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 design 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 applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed 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 design application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 3637 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed design Application No. 29/145,604, filed July 25, 2001.

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

ATTACHMENT: Corrected Filing Receipt

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100112A

DATE : February 10, 2009

TO SPE OF : ART UNIT 2475

SUBJECT : Request for Certificate of Correction on Patent No.: 09/933265

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

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

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

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

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100112B

DATE : February 10, 2009

TO SPE OF : ART UNIT 2475

SUBJECT : Request for Certificate of Correction on Patent No.: 09/933265

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:

/DANG T TON/
Supervisory Patent Examiner, Art Unit 2475

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WORKMAN NYDEGGER
1000 EAGLE GATE TOWER,
60 EAST SOUTH TEMPLE
SALT LAKE CITY UT 84111

COPY MAILED

NOV 16 2007

OFFICE OF PETITIONS

In re Application of :
Ginn et al. :
Application No. 09/933299 :
Filing or 371(c) Date: 08/20/2001 : ON PETITION
Patent No. 6632238 :
Issue Date: 10/14/2003 :
Title of Invention: :
VASCULAR SHEATH WITH :
PUNCTURE SITE CLOSURE :
APPARATUS AND METHODS OF USE :

This is a notice regarding request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

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

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

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

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 3

DANIELS & DANIELS, P.A.
POST OFFICE DRAWER 12218
RESEARCH TRIANGLE PARK, NC 27709-2218

COPY MAILED

NOV 0 5 2001

OFFICE OF PETITIONS

In re Application of :
John B. Terry (Deceased) & Jeffrey A. Hales :
Application No. 09/933,323 :
Filed: August 20, 2001 : DECISION ON PETITION
Docket No. 0960-020 :
:

This is in response to the petition filed August 20, 2001, which is being treated as a petition under 37 CFR 1.181 to accept the declaration filed concurrently with the instant petition.[1]

The petition is dismissed.

Any petition for reconsideration of this decision must be filed within two months from the mail date of this decision.

Petitioner states that joint inventor John B. Terry died recently and that it is uncertain when Mr. Terry's estate will be sent to probate court. Therefore, petitioner requests the Patent and Trademark Office to accept the oath/declaration filed concurrently with the instant petition.

As joint inventor John B. Terry is deceased, 37 CFR 1.42 applies. See MPEP 409.01(a). 37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 USC 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. Therefore, petitioner should carefully consider MPEP 409.03(c) as to under what circumstances Rule 47 is inapplicable as compared to 37 CFR 1.42, and make the appropriate showing as to whether 37 CFR 1.42 or 1.47 is controlling here. However, if the legal representative or heir(s) of the deceased inventor cannot be found or reached after diligent effort, or, having been found and presented with a **complete** copy of the

[1] Since 37 CFR 1.47 is not applicable at this time, the petition is being treated as a petition under 37 CFR 1.181.

application papers (specification, claims and drawings) refuses to sign the declaration, then 37 CFR 1.47(a) applies. Currently, the showing fails to establish that a diligent effort was made to locate the legal representative or heirs of the decedent. Assuming that Rule 47 is controlling, any future petition must establish, with a documented showing, the diligent effort that has been made, or will be made, to locate the legal representative or heir of the decedent.

The oath or declaration for the patent application must be in compliance with 37 CFR 1.63 and 1.64. The declaration under 37 CFR 1.63 and 1.64 must set forth the citizenship, residence, and post office address of the forthcoming legal representative or heir. Note also 37 CFR 1.76, except that the citizenship must be listed on the declaration. Attention is directed to 37 CFR 1.63(a)(3); MPEP §§ 605.02, 605.03.

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 Frances Hicks at (703) 305-8680.

Since 37 CFR 1.47(a), as explained above, does not apply to this application, this application is being returned to the Office of Initial Patent Examination Division for mailing of a Notice to File Missing Parts of Nonprovisional Application.

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

DANIELS DANIELS & VERDONIK, P.A.
SUITE 200 GENERATION PLAZA
1822 N.C. HIGHWAY 54 EAST
DURHAM, N.C. 27713

MAILED

JUN 8 - 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re application of:
Terry et al.
Application No. 09/933,323
Filed: August 20, 2001
For: CAPACITY SCALING AND FUNCTIONAL ELEMENT REDISTRIBUTION WITHIN AN IN-BUILDING COAX CABLE INTERNET ACCESS SYSTEM

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 May 2, 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.

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

All attorneys/agents listed in Customer No. 26108 withdrawal 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: 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

Paper No. 7

FISH & RICHARDSON PC
12390 EL CAMINO REAL
SAN DIEGO CA 92130-2081

COPY MAILED

JAN 3 0 2004

OFFICE OF PETITIONS

In re Application of :
Matthews, et al. :
Application No. 09/933,349 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. :
06618/590001/CIT3165

This is a decision on the petition to revive under 37 CFR 1.137(a), filed January 7, 2004 (Certificate of Mailing dated January 5, 2004), which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

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

A Notice of Abandonment was mailed in the above-identified application on December 1, 2003, informing applicant that the application had gone abandoned for failure to reply to a Notice to File Missing Parts mailed on June 14, 2001. A review of the application file does not indicate that a Notice to File Missing Parts was ever mailed in the above-identified application. The application file does contain a Notice to File Missing Parts of Provisional Application for application number 60/271,255. However, the above-identified application filing transmittal specifically identified the application as a filing under 37 CFR 1.53(b). The filing did not identify the application as a provisional application.[1]

In view of the above, the Notice to File Missing Parts of Provisional Application was mailed in error and is hereby **VACATED**.

The holding of abandonment is **WITHDRAWN**.

---

[1] See 37 CFR 1.53(c)(1).

Receipt is acknowledged of the $385 statutory basic filing fee, the $65 late surcharge, $86 independent claims fee, $40 assignment record fee, and $55 petition fee, all filed with the instant petition. Given the basis for granting this petition, the $55 petition fee has been refunded to Deposit Account No. 06-1050.

Receipt of the 37 CFR 1.63 declaration, also filed with the instant petition, is acknowledged.

The application file is being forwarded to the Office of Initial Patent (OIPE) for further processing. Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Jun-07

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

COPY MAILED

JUN 14 2007

OFFICE OF PETITIONS

In re Application of	:	
Ken W. Marr	:	DECISION ON PETITION TO
Application No. 09/933379	:	WITHDRAW HOLDING OF
Filed: 08/20/2001	:	ABANDONMENT
Attorney Docket No. 2008.000282	:	

This is a decision on the petition, filed on 22 December, 2004, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the final Office action mailed on 28 November, 2003. An amendment after final rejection was filed on 16 January, 2004. The amendment failed to place the application in condition for allowance, however, and an Advisory Action was mailed on 4 March, 2004. Notice of Abandonment was mailed on 11 October, 2006.

Petitioner asserts that a timely and proper response to the final Office action, in the form of a Request for Continued Examination (RCE), preliminary amendment as the submission under 37 CFR 1.114, and the required extension of time, were filed on 29 March, 2004, by facsimile.

A review of the Official file reveals that an RCE Request including authorization to charge the RCE fee and extension of time fee and an amendment as the submission filed under 37 CFR 1.114 were received on 29 March, 2004.[1]

[1] As 28 March, 2004, fell on a Sunday, the response filed on 29 March, 2004, is timely filed with a one (1) month extension of time.

The showing of record is that a proper and timely reply to the Office action mailed on 28 November, 2003, was in fact filed. Therefore, there is no abandonment in fact.

The holding of abandonment is withdrawn, and the Notice of Abandonment is vacated.

The RCE fee and one (1) month extension of time fee will be charged to counsel's deposit account as authorized in the RCE request transmittal

The application will be referred to Technology Center Art Unit 2814 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: MAY 11 2004

spg
Paper Number 10

In re application of
Richard Haight et al.
Serial No. 09/933,461
Filed: August 20, 2001
For: METHOD FOR MINIMIZING SAMPLE DAMAGE DURING THE ABLATION OF MATERIAL USING A FOCUSED ULTRASHORT PULSED LASER BEAM

DECISION ON PETITION

This is a response to the REQUEST TO WITHDRAW NOTICE OF ABANDONMENT originally filed July 30, 2003 and resubmitted by facsimile transmission on February 12, 2004. The request asks that the abandonment, as set forth in the Notice of Abandonment of July 22, 2003, for failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance be withdrawn. The requester asserts that a timely response in the form of a REQUEST FOR CONTINUED EXAMINATION was filed on June 10, 2003.

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response, REQUEST FOR CONTINUED EXAMINATION, was properly filed on June 10, 2003 in view of the fact that the originally filed papers having a fax receipt transmission indication of June 10, 2003 and Patent and Trademark Office fax receipt stamp of June 11, 2003 thereon have been located in the USPTO electronic application file. Accordingly, any holding of abandonment is hereby vacated, and the application has been returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers filed June 10, 2003.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

DR. DANIEL P. MORRIS, ESQ.
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT.
P.O. BOX 218
YORKTOWN HEIGHTS NY 10598

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

Renner Otto Boisselle & Sklar
1621 Euclid Avenue, 16th Floor
Cleveland, OH 44115

COPY MAILED

DEC 0 3 2001

OFFICE OF PETITIONS

In re Application of
Timothy P. O'Hagan
Application No. 09/933,500
Filed: August 20, 2001
For: Portable Data Collection Network with Telephone and Voice Mail Capability

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

This is a decision in response to the petition under 37 CFR 1.47(a), filed August 20, 2001 and which is a copy of the petition filed in application No. 08/867,076.

The petition under 37 CFR 1.47(a) is Granted.

The above-identified application was filed on August 20, 2001 as a divisional of Application No. 08/867,076, and with a copy of the declaration, and the petition under 37 CFR 1.47 from prior Application No. 08/867,076. Application No. 08/867,076 and the petition under 1.47 filed December 29, 1997 (certicate of mailing December 23, 1997) in that application was only recently received in the Office of Petitions. The petition has been granted and application no. 08/867,076 accorded rule 47 status.

37 CFR 1.63(d)(1) states, in part:

> A newly executed oath or declaration is not required under § 1.51(b) (2) and § 1.53(f) in a continuation or divisional application, provided that:
>
> (I) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
>
> (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;
>
> (iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and
>
> (iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(3) Where the executed oath or declaration of which is a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under 37 CFR 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(I) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(II) If one or more inventor(s) or legal representatives(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declarations(s) filed by the inventor or legal representative to join in the application.

Where status under 37 CFR 1.47 is granted in a first application and the non-signing inventor does not later join in the filing by executing an oath or declaration for the application, and another application (a child application) is later filed claiming the benefit of the filing date of the first application and using the declaration of the prior application, status under 37 CFR 1.47 continues to exist in the child application. In the instant case, the prior application, of which the instant application claims priority benefits under 35 U.S.C. 120, has been accorded 37 CFR 1.47 status.

The above-identified application and papers are now in compliance with 37 CFR 1.47(a). The instant application is hereby accorded Rule 1.47(a) status. A copy of the decision from the prior application will be placed in the instant application. As provided in Rule 1.47(c), no notice of this application's filing will be published in the Official Gazette since notice regarding the filing of the prior application was given to the nonsigning inventor.

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

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

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

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. 17

Mark D. Saralino
Renner Otto Boisselle & Sklar
1621 Euclid Avenue
Nineteenth Floor
Cleveland, OH 44115

COPY MAILED

DEC 0 3 2001

OFFICE OF PETITIONS

In re Application of
Timothy P. O'Hagan et al.
Application No. 08/867,076
Filed: June 2, 1997
For: Portable Data Collection Network with Telephone and Voice Mail Capability

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

This is a decision in response to the status inquiry filed December 8, 1997 and subsequent petition under 37 CFR 1.47(a), filed December 29, 1997 (certificate of mailing December 23, 1997). The petition was only recently received in the Office of Petitions for consideration. The Office of Petitions apologizes for the delay and regrets any inconvenience to petitioner.

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

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

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

In order to render the filing of the Notice of Appeal timely, Petitioner's deposit account will be charged $110 for a one month extension of time.

The file will be forwarded to Technology Center AU 2684 for further examination.

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

Margaret M. Koesel
Porter Wright Morris & Arthur
Huntington Building, Suite 1700
925 Euclid Avenue
Cleveland, OH 44115-1483

COPY MAILED

DEC 0 3 2001

OFFICE OF PETITIONS

In re Application of
Timothy P. O'Hagan and Ynjium P. Wang
Application No. 08/867,076
Filed: June 2, 1997
For: Portable Data Collection Network with Telephone and Voice Mail Capability

Dear Mr. Wang:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 118 (United States Code), and 37 CFR 1.47(a), Rules 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 patent 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 Latrice Bond at (703) 308-6911. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-6911. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington D.C. area).

Latrice Bond

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

Frances Hicks

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

cc: Mark D. Saralino
Renner Otto Boisselle & Sklar
1621 Euclid Avenue, 19th Floor
Cleveland, OH 44115

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JONES DAY
222 EAST 41ST ST
NEW YORK NY 10017

COPY MAILED

SEP 20 2005

OFFICE OF PETITIONS

In re Application of :
Catton, et al. :
Application No.: 09/933,502 :
Filing date: August 20, 2001 :
Attorney Docket No.: 11518-003-99 :
For: MEDICAL GAS ALARM SYSTEM :

Decision on Petition

This is a decision on the petition under 37 CFR §3.81, filed July 5, 2005, to waive the rules and accept the correction of the assignee data to be printed on the front page of the patent issued from the above-identified application.

The request under 37 CFR 3.81 is **dismissed**.

Effective June 25, 2004, 37 CFR 3.81(b) has been revised to no longer require the correction of the assignee data prior to issuance of the patent. Therefore, a petition to waive the rule is unnecessary. 37 CFR 3.81(b) currently states:

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

In other words, the request under 37 CFR 3.81(b) will be granted when:

(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

The instant petition is dismissed because petitioners have not submitted a completed PTOL-1050 (Certificate of Correction) and $100.00 fee.

Regarding finances, a $130.00 processing fee is due. Deposit account no. 50-3013 will be charged this amount shortly.

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

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

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

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

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20070823

DATE : August 23, 2007

TO SPE OF : ART UNIT 2612

SUBJECT : Request for Certificate of Correction on Patent No.: 6987448

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:

Change of assignee does not alter the scope of the invention

SPE: Brian Zimmerman Art Unit 2312

UNITED STATES 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 DOCKET ADMINISTRATOR
LOWENSTEIN SANDLER PC
65 LIVINGSTON AVENUE
ROSELAND NJ 07068

COPY MAILED

SEP 17 2007

OFFICE OF PETITIONS

Patent No. 6,987,448 :
Issued: January 17, 2006 :
Application No. 09/933,502 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. 7175-68263// 11518-003-999 :

This is a decision on the petition, filed March 22, 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) by way of a certificate of correction.

The request is **DISMISSED**.

Petitioner states that the correct assignee's name is Beacon Medical Products LLC and that an incorrect assignee's name was included on the Part B - Fee(s) Transmittal form at the time of payment of the issue fee. Accordingly, petitioner requests a certificate of correction.

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.

A review of the application file reveals that the request under 37 CFR 3.81(b) was not accompanied by a completed certificate of correction, as required by 3.81(b). *See also* MPEP 1481.01. As petitioner has failed to comply with the provisions of 37 CFR 3.81(b), the request cannot be granted at this time.

---

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

A review of Office database assignment records reflects that an assignment to Beacon Medical Products LLC has been recorded. Therefore, upon submission of the required certificate of correction , it would be appropriate for the Office to issue a certificate of correction to correct the front page of the Letters Patent to reflect that Beacon Medical Products LLC was the assignee of record at the time of issuance of the application into a patent. *Note also* 35 U.S.C. § 152.

In view of the above, **the Certificates of Correction Branch is instructed to issue a certificate of correction upon submission by petitioner of a completed a certificate of correction which sets forth Beacon Medial Products LLC, as the assignee**. *No certificate of correction will be issued which sets forth an assignee other than the assignee set forth in this request. A copy of this decision* ***must*** *accompany the request for a Certificate of Correction.*

No further renewed request under 37 CFR 3.81(b) is necessary for consideration by the Office of Petitions for issuance of a certificate of correction in the name of the assignee set forth in this request, since this decision operates as an instruction to the Certificates of Correction Branch to issue the requested certificate of correction.

Petitioner paid two $130.00 processing fees. Only one is required. $130.00 will be credited to deposit account no. 50-3013, which is the account from which the charges were made.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3230. Any questions concerning issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

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

TAROLLI, SUNDHEIM, COVELL & TUMMINO, L.L.P.
526 SUPERIOR AVENUE, SUITE 1111
CLEVELAND, OH 44114

COPY MAILED

AUG 1 1 2004

OFFICE OF PETITIONS

In re Application of	:	
Grilli et al.	:	
Application No. 09/933,534	:	ON PETITION
Filed: August 20, 2001	:	
Attorney Docket No. TRW(AP)5727	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed July 1, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the final Office action mailed August 15, 2003. A three-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on February 16, 2003. A Notice of Abandonment was mailed on April 5, 2004.

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

This matter is now being referred to Technology Center 3600 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

TAROLLI SUNDHEIM COVELL & TUMMINO LLP
1300 EAST NINTH STREET SUITE 1700
CLEVEVLAND OH 44114

COPY MAILED

JUN 05 2007

OFFICE OF PETITIONS

In re Application of :
Grilli, et al. :
Application No. 09/933,534 : DECISION ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. TRW(AP)5727 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed May 11, 2007.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed October 26, 2006. A Notice of Abandonment was mailed on May 2, 2007.

A review of the application file reveals the presence of an amendment, together with a three month extension of time, all filed on April 30, 2007, bearing a Certificate of Mailing dated April 26, 2007. In addition, a review of Office records reveals that the Office received the fee for the three month extension of time. Accordingly, it is obvious that the Notice of Abandonment was mailed in error.

In view thereof, **the holding of abandonment is withdrawn.**

The matter is being forwarded to Group Art Unit 2167 for consideration of the amendment filed April 30, 2007 (Certificate of Mailing dated April 26, 2007).

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

THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P O BOX 1967
MIDLAND, MI 48641-1967

COPY MAILED

DEC 0 1 2005

OFFICE OF PETITIONS

In re Application of :
Edward O. Shaffer II et al :
Application No. 09/933,535 : DECISION GRANTING PETITION
Filed: August 20, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60393B :

This is a decision on the petition, filed November 18, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 26, 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 2891 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

MAIL

MAR 1 7 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Ken D'Alessandro
Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline NV 89449

In re Application of
Lyon et al.
Application No. 09/933,545
Filed: August 20, 2001
For: **STORAGE AND PROCESSING SERVICE NETWORK FOR UNRENDERED IMAGE DATA**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

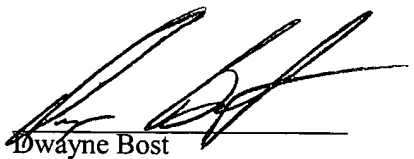
This is a decision on the Request to Withdraw as Attorney/Agent of record filed on June 3, 2003.

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

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

Attorneys requesting withdraw are not of record due to a Revocation of Power of Attorney executed by the assignee filed June 12, 2003.

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



Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

cc: Alan S. Hodes
755 Page Mill Road
Palo Alto, CA 94304-1018

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEB 10 2004

PATREA L. PABST
HOLLAND & KNIGHT LLP
SUITE 2000, ONE ATLANTIC CENTER
1201 WEST PEACHTREE STREET, N.E.
ATLANTA GA 30309-3400

In re application of Christopher W. Ogden :
Serial No. : 09/933,548 : DECISION ON PETITION
Filed : August 20, 2001 :
Attorney Docket No.: NORT 100 :

This is in response to applicants' petition, filed October 1, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(a) as a continuation of PCT/GB00/00586, filed February 21, 2000, which claims priority to U.K. application 99.03841.6, filed February 20, 1999. The application, as filed with preliminary amendments, contained claims 1-38. In a first Office action mailed April 22, 2003 the examiner set forth a restriction requirement under 35 U.S.C. 121 dividing the claims into 10 groups.

In the response filed May 22, 2003, applicants elected Group I, claims 1-9, 15 and 16, drawn to a method of determining susceptibility to prostate cancer using nucleic acids. Applicant traversed the restriction on essentially the same grounds presented in the instant petition. On July 1, 2003 the examiner mailed a first Office action on the merits, wherein the restriction requirement was made final. Applicants have since filed a response to the outstanding Office action on October 31, 2003.

DISCUSSION

MPEP 1893.03(d) states, in part:

> [U]nity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a), even if the application filed under 35 U.S.C. 111(a) claims priority to an earlier

international application or to an earlier U.S. national stage application submitted under 35 U.S.C. 371.

In their initial response and in the petition, applicants argue that the various inventions identified by the examiner have unity of invention. This argument is not persuasive because the unity of invention standard does not apply to applications filed under 35 U.S.C. 111(a).

Applicants argue, "It is well established that the same claims cannot be divided into separate inventions" (petition, p. 3). This argument is unsupported by statute, regulation or case law, and is therefore unpersuasive. Applicants are referred to MPEP 809.03 for a discussion of linking claims. Furthermore, applicants are reminded that elected claims 1-4, 15 and 16 were designated as linking claims in the restriction requirement, and these claims will be examined in their entirety should the elected invention be found allowable.

DECISION

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

The application will be forwarded to the examiner for consideration of the response filed October 31, 2003.

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.

John Doll
Director, Technology Center 1600

#13

Mark Martens
3258 Peace Valley Lane
Falls Church
VA 22044
Sunday, April 11, 2004

RECEIVED
APR 1 4 2004
OFFICE OF PETITIONS

Mail Stop PETITION
Application No: 09/933,576

I apologize for including the incorrect fee with my previously submitted request to revive the above-identified application. I am enclosing a copy of your letter for your reference.

Please accept the enclosed check for the balance of the required fee ($15) and reconsider the petition filed under 37 CFR 1.137(b) on February 26, 2004.

Thanks and Regards,

Mark Martens
Inventor

04/15/2004 AKELLEY 00000035 09933576
01 FC:1999 15.00 OP

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

Mark Martens
3258 Peace Valley Lane
Falls Church, VA 22044

COPY MAILED

MAR 1 8 2004

OFFICE OF PETITIONS

In re Application of :
Marc MARTENS :
Application No. 09/933,576 :
Filed: August 21, 2001 :
Attorney Docket No. none (pro se) :

DECISION
ON PETITION
CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed February 26, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

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

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

The instant petition lacks item (2): the proper petition fee to revive unintentionally abandoned application as per 37 CFR 1.17(m). The Small Entity Fee is $665.00, however Applicant remitted by check only $650.00.

A proper response to this communication would consist of remitting the balance payment of $15.00, together with a written request to reconsider the petition filed under 37CFR 1.137(b) on February 26, 2004.

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

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

By hand: Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

Central Fax: (703) 746-3258
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Ehud Gartenberg at (703) 305-4066 or, in his absence, to the undersigned at (703) 308-3865.

BethAnne Dayoan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES 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

Mark Martens
3258 Peace Valley Lane
Falls Church, VA 22044

COPY MAILED

JUN 07 2004

OFFICE OF PETITIONS

In re Application of :
Marc MARTENS :
Application No. 09/933,576 :
Filed: August 21, 2001 :
Attorney Docket No. N/A :

DECISION
ON PETITION
CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed February 26, 2004, to revive the above-identified application.

The petition is **GRANTED**.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3).

Petitioner has met the requirements for filing a grantable petition under 37 CFR 1.137(b).

The application file is forwarded to Technology Center 3700, for consideration of the amendment filed with the instant petition.

Any questions concerning this matter may be directed to Ehud Gartenberg at (703) 305-4066, or in his absence to the undersigned at (703) 308-3865.

BethAnne Dayoan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

COPY MAILED

APR 1 0 2002

OFFICE OF PETITIONS

In re Application of :
Alderucci et al :
Application No. 09/933,588 : DECISION REFUSING STATUS
Filed: August 21, 2001 : UNDER 37 CFR 1.47(a)
For: METHOD AND APPARATUS FOR :
PROVIDING A SUPPLEMENTARY PRODUCT :
SALE AT A POINT-OF-SALE TERMINAL :

This is in response to the "Petition Under 37 CFR 1.47(a)," filed by facsimile transmission on November 26, 2001.

The petition is DISMISSED as moot.

The petition is dismissed as moot since no Rule 1.47(a) matter exists in the above identified application.

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

The application is being forwarded to Technology Center Art Unit 2161 for examination in due course.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WALKER DIGITAL MANAGEMENT, LLC
2 HIGH RIDGE PARK
STAMFORD, CT 06905

COPY MAILED

JUN 05 2008

OFFICE OF PETITIONS

In re Application of :
Dean P. Alderucci, et. al. :
Application No. 09/933,588 : DECISION ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 01-023 :

This is a decision on the petition under 37 CFR 1.137(b), filed on July 6, 2007, to revive the above-identified application.

The application became abandoned for failure to timely reply to the non-final Office action mailed on January 3, 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 and terminal disclaimer under 37 CFR 1.321 with the $130 fee; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3622 for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/19/09

TO SPE OF : ART UNIT ~~3743~~ 3744

SUBJECT : Request for Certificate of Correction for Appl. No.: 09933589 Patent No.: 6564860 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: _____

_____

_____

_____

_____

Cheryl Juhasz 3744

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City
Garden City, NY 11530

COPY MAILED

MAY 05 2004

OFFICE OF PETITIONS

In re Application of :
Kevin J. Reardon :
Application No. 09/933,602 :
Filed: August 21, 2001 : ON PETITION
Attorney Docket No. :
FIS920010165US1 (14775) :

This is a decision on the petition under 37 CFR 1.137(a), filed April 23, 2004, to revive the above-identified application. The petition is properly treated under 37 CFR 1.181.

The petition is **granted.**

The above-identified application became abandoned for failure to timely reply to the Notice to File Missing Parts of Nonprovisional Application, mailed September 24, 2001. The Notice set a two (2) month period for reply. No reply having been received, the above-identified application became abandoned November 25, 2001. A Notice of Abandonment was mailed on December 17, 2003.

Applicant's Assertion

Applicant asserts that a timely reply to the Notice, in the form of a Declaration and late filing fee oath or declaration surcharge, were timely filed and received in the Office. In support of this assertion, Applicant provides a copy of the Declaration and copies of two return-receipt postcards acknowledging receipt by this Office of a Declaration, a Response to notice of missing parts, which included an authorization to charge deposit account 09-0458 any fees required, a late filing fee oath or declaration surcharge, and Assignment and a Certificate of Mailing on February 5, 2002.

Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self-addressed postcard properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post

card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the postcard in the outgoing mail. "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.

In view of the above, the abandonment and holding of abandonment of the above-identified application are hereby withdrawn. The petition fee, $110.00, has been applied towards the fee for a three (3) month extension, $950.00, required to reply to the Notice to File Missing Parts of Nonprovisional Application. The remaining balance, $840.00, has been charged to deposit account 09-0458 as authorized in the Response to notice of missing parts, filed February 5, 2002.

A copy of the Assignment documents have been forwarded to the Assignment Brance.

The application is being returned to the Office of Initial Patent Examination for continued processing in due course.

Telephone inquiries 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

Paper No. 6

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City
Garden City, NY 11530

COPY MAILED

AUG 1 6 2004

OFFICE OF PETITIONS

In re Application of	:	
Kevin J. Reardon	:	
Application No. 09/933,602	:	CORRECTED DECISION
Filed: August 21, 2001	:	ON PETITION
Attorney Docket No.	:	
FIS920010165US1 (14775)	:	

This is a corrected decision on the petition under 37 CFR 1.137(a), filed April 23, 2004, to revive the above-identified application. The petition is properly treated under 37 CFR 1.181.

The petition is **granted.**

The above-identified application became abandoned for failure to timely reply to the Notice to File Missing Parts of Nonprovisional Application, mailed September 24, 2001. The Notice set a two (2) month period for reply. No reply having been received, the above-identified application became abandoned November 25, 2001. A Notice of Abandonment was mailed on December 17, 2003.

Applicant's Assertion

Applicant asserts that a timely reply to the Notice, in the form of a Declaration and late filing fee oath or declaration surcharge, were timely filed and received in the Office on November 7, 2001. In support of this assertion, Applicant provides, *inter alia,* a copy of the Response to Notice to File Missing Parts of Application and a Declaration, which contain a properly executed Certificate of Mailing dated November 7, 2001 and copies of a return-receipt postcards dated November 7, 2001, and acknowledging receipt by this Office of a Declaration and a Response to notice of missing parts on February 5, 2002.

Under 37 CFR 1.8

"[c]orrespondence required to be filed in the Patent and Trademark Office within a set period of time will be considered timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to the expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

In view of the foregoing, the holding of abandonment is hereby withdrawn.

A refund of the extension-of-time fees, $950.00, has been credited to deposit account 09-0458 as authorized in the petition filed April 23, 2004.

A copy of the Assignment documents have been forwarded to the Assignment Branch.

The application is being returned to the Office of Initial Patent Examination for continued processing in due course.

Telephone inquiries 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

FRANCIS I. GRAY, 50-LAW
TEKTRONIX, INC.
BEAVERTON, OR 97077

COPY MAILED
APR 2 0 2006
OFFICE OF PETITIONS

In re Application of :
Xiaofen Chen :
Application No. 09/933,605 : DECISION ON PETITION
Filed: August 20, 2001 : UNDER 37 CFR 1.313(c)(3)
Attorney Docket No. 7222 US :

This is a decision on the petition, filed April 18, 2006, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioner requests that the above-identified application be withdrawn from issue for express abandonment in favor of a continuing application filed on April 7, 2006 (Application No. 11/399,740).

The petition complies with the provisions of 37 CFR 1.313(c)(3). Accordingly, this application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Apr9\933605.wpd

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

AGILENT TECHNOLOGIES
LEGAL DEPARTMENT, 51U-PD
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 58043
SANTA CLARA, CA 95052-8043

COPY MAILED

JUN 05 2002

OFFICE OF PETITIONS

In re Application of:
Mark Timothy Sullivan, Carol J. Courville, Paul Zorabedian, Kery D. Bagwell and David H. Kittell
Application No. 09/933,606
Filed: August 20, 2001
Attorney Dckt No. 10010323-1

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the Petition under 37 CFR 1.47(a), filed February 27, 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 **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 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).

The above-identified application was filed on August 20, 2001, without a fully executed oath or declaration. A Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") was mailed on October 15, 2001, noting the above deficiency.

In response, Petitioner files the instant Petition. It is noted that the declaration has been altered such that the name, residence, post office address and citizenship of named inventors have been lined-through.

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 to item (2), the oath or declaration has been altered, however, the alterations have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or

declaration which complies with 37 CFR 1.67(a) is required. See, MPEP 605.04(a).

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

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

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

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202-3513

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. 5

AGILENT TECHNOLOGIES
LEGAL DEPARTMENT, 51U-PD
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 58043
SANTA CLARA, CA 95052-8043

COPY MAILED

AUG 2 7 2002

OFFICE OF PETITIONS

In re Application of:
Mark Timothy Sullivan, Carol J. Courville, Paul Zorabedian, Kery D. Bagwell and David H. Kittell
Application No. 09/933,606
Filed: August 20, 2001
Attorney Dckt No. 10010323-1

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 August 12, 2002 (Certificate of Mailing dated August 5, 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, Paul Zorabedian, refuses to sign the declaration in the above-identified application. assignment documents.

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.

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

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paul Zorabedian
2441 Benjamin Drive
Mountain View, CA 94043

In re Application of:
Mark Timothy Sullivan, Carol J. Courville, Paul Zorabedian, Kery D. Bagwell and David H. Kittell
Application No. 09/933,606
Filed: August 20, 2001
Attorney Dckt No. 10010323-1

COPY MAILED

AUG 2 7 2002

OFFICE OF PETITIONS

LETTER

Dear Mr. Zorabedia:

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).

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: AGILENT TECHNOLOGIES
LEGAL DEPARTMENT, 51U-PD
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 58043
SANTA CLARA, CA 95052-8043

UNITED STATES PATENT AND TRADEMARK OFFICE

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

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

COPY MAILED

FEB 0 2 2007

OFFICE OF PETITIONS

In re Application of	:	
Hsu, Raymond T.	:	
Application No. 09/933,639	:	ON PETITION
Filed: August 20, 2001	:	
Attorney Docket No. 010498	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 17, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

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 $1020.00 extension of time fee submitted with the petition on November 17, 2006, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

This matter is being referred to Technology Center 2600 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES 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

BROWN, MARTIN, HALLER & MCCLAIN LLP
1660 UNION STREET
SAN DIEGO CA 92101-2926

COPY MAILED

MAR 25 2004

OFFICE OF PETITIONS

In re Application of
Eliezer Masliah et al
Application No. 09/933,640
Filed: August 20, 2001
Attorney Docket No. 6627-PA1071

: 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 June 24, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §120 and 365(c) for the benefit of prior-filed international Application No. PCT/US01/05569, filed February 20, 2001.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant application was filed on August 20, 2001, and was pending at the time of filing of the instant petition.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The reference to the prior-filed 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).

The instant petition does not comply with item (1)

In view of the above, a renewed petition under 37 CFR 1.78(a)(3), along with an amendment to the first line of the specification (or an Application Data Sheet in accordance with 37 CFR 1.76(b)(5)) to include the 35 U.S.C. §§ 120 and 365(c) benefits to the instant application is required.

For the above-noted reason, the petition under 37 CFR 1.78(a)(3) cannot be granted.

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

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

By hand: Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

Any questions concerning this matter may be directed to 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. 12

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

COPY MAILED

NOV 10 2004

OFFICE OF PETITIONS

In re Application of
Eliezer Masliah et al
Application No. 09/933,640
Filed: August 20, 2001
Attorney Docket No. 6627-PA1071

: 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 August 13, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 365(c) for the benefit of the prior-filed PCT application set forth in the concurrently filed Application Data Sheet.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(I) of the prior-filed application, unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

Petitioner claims benefit under 35 U.S.C. § 120 for the prior-filed PCT Application No. PCT/US01/05569, filed February 20, 2001. However the PCT application data is listed under **foreign** priority information on the application data sheet filed with the instant petition.

Accordingly, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute application data sheet or an amendment to correct the above matter 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 Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

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

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

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

COPY MAILED

JUN 0 8 2005

OFFICE OF PETITIONS

In re Application of	:
Eliezer Masliah et al	: DECISION ON PETITION
Application No. 09/933,640	: UNDER 37 CFR 1.78(a)(3)
Filed: August 20, 2001	:
Attorney Docket No. 6627-PA1071	:

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed December 22, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 365(c)) for the benefit of the prior-filed PCT application set forth in the concurrently filed Application Data Sheet (ADS).

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of

the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application. The ADS filed December 22, 2004 fails to state the relationship of PCT Application No. PCT/US01/05569, filed February 20, 2001, to the above application.

Accordingly, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute amendment (complying with 37 CFR 1.121) stating the relationship of the prior-filed PCT application to the above application 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

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

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 23 2006

OFFICE OF PETITIONS

In re Application of
Eliezer Masliah et al
Application No. 09/933,640
Filed: August 20, 2001
Attorney Docket No. 6627-PA1071

: DECISION ON PETITIONS
: UNDER 37 CFR 1.78(a)(3) AND
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the renewed petition filed July 11, 2005, which is being treated under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **Granted**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional 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 applications is submitted after expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6).

The instant nonprovisional application was pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Additionally, intermediate PCT Application No. PCT/US01/05569 was filed within twelve months of the filing date of the prior-filed provisional application, Application No. 60/183,571, which was filed on February 18, 2000, for which priority is claimed.

The petition complies with the requirements for a grantable petition under 37 CFR §§1.78(a)(3) and 1.78(a)(6) in that (1) a reference to the above-noted, prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR §§ 1.78(a)(2)(iii) and 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. §§ 120 and 119(e) to the above-noted, prior-filed applications satisfies the conditions of 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) should <u>not</u> be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§120 and 365(c) and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should <u>not</u> 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 applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1632 for appropriate action on the amendment submitted July 11, 2005, including consideration by the examiner of the claim under 35 U.S.C. § §120 and 365(c) and 37 CFR 1.78(a)(2) for the benefit of the prior-filed application, and for consideration of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional application.

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

ATTACHMENT : Corrected Filing Receipt

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)
6423943	2002-07-23	09933664	2001-08-22	ID 004307

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

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
◉	3 ½ year	(1551)
○	7 ½ year	(1552)
○	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/DJCushing/	Date (YYYY-MM-DD)	2007-02-06
Name	David J. Cushing	Registration Number	28703

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES 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. 6423943
Issue Date: July 23,2002
Application No. 09933664
Filed: August 22,2001
Attorney Docket No. 209750US

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

This is a decision on the electronic petition, filed February 6,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 6,2007 . 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

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

AUG - 6 2003

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

In re Application of :
Thomas Piccariello et al :
Serial No.: 09/933,708 : PETITION DECISION
Filed: August 22, 2001 :
Attorney Docket No.: 54719.000028 :

This is a response to the renewed petition under 37 CFR 1.59(b), filed July 10, 2003, to expunge information from the above identified application.

Petitioner requests that specific items filed as part of an Information Disclosure Statement (IDS), filed March 25, 2003, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) was previously been paid.

In response to the previous petition which denied return of the entire IDS on the basis that it contained publicly available documents, such as patents, applicants have submitted a renewed petition listing specifically those items which are considered proprietary and request their return. The items identified are items P55-P86 of the IDS. A review of these items shows that they are primarily presentations to companies or financial institutions made for the purpose of interesting investment in the subject matter of the application. However, no details of how to make or use are contained in the presentation items and as such they can have no bearing on the determination of patentability of the application. Furthermore, most of the items are marked as or indicated as being presented to the receiving parties under a confidential agreement. As such the materials cannot be considered publicly available and are not useable by the examiner.

Three documents submitted, however, are considered to be worthy of further consideration by the examiner and may have an impact on the determination of patentability of the application. There are items P68, P77 and P78. These items appear to present data and/or experimental results which may be relevant to patentability. As such, these items are not being returned at this time. Should the application be allowed or become abandoned, a supplemental petition to expunge these materials may be submitted, no additional fee being required.

In summary, items P55-P67, P69-76, and P78-P86 are returned herewith. Items P68, P77 and P78 are retained subject to a later renewed expungement request.

The petition is **GRANTED-IN-PART** to the extent indicated above. Any renewed petition for return of the additional items does not require a petition fee.

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

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES
PATENT AND
TRADEMARK OFFICE

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

JUN 30 2003

#19

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

In re Application of :
Thomas Piccariello et al :
Serial No.: 09/933,708 : PETITION DECISION
Filed: August 22, 2001 :
Attorney Docket No.: 54719.000028 :

This is a response to the petition under 37 CFR 1.59(b), filed April 11, 2003, to expunge information from the above identified application.

Petitioner requests that an Information Disclosure Statement (IDS), filed March 25, 2003, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been paid.

A review of the file shows that the IDS is present in the file. The IDS consists of citations of US patents and published applications and non-patent literature publications available to the public as well as a number of items relating to presentations, etc. Applicants request return of the entire IDS. However, it would not be appropriate to return information contained in an IDS which is available to the public and may have a bearing on the patentability determination to be made by the examiner. It is noted that information which is considered confidential may be submitted for examiner consideration in accordance with 37 CFR 1.59:

1.59 Expungement of information or copy of papers in application file.
(a) (1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.
(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h)

and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

M.P.E.P. 724.02 sets forth additional guidelines for such submissions:

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials. Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.
Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)
A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.
In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:
ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(h)) to expunge the information, if found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, may also accompany the envelope or container.

724.05 Petition To Expunge Information or Copy of Papers in Application File

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION
A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;
(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
(C) the information has not otherwise been made public;
(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and
(F) the petition fee as set forth in 37 CFR 1.17(h) is included.
A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

As was noted above, the IDS contains both public and apparently confidential information which was inadvertently submitted. Only the information which is confidential may be returnable. However applicants have not specifically identified such items other than to supply a complete copy of the Form 1449 which accompanied the IDS listing all of the items submitted. Such does not appear to fully meet items (B) and (E) above.

The petition is **DISMISSED** subject to resubmission in proper form with identification of materials to be returned. Any renewed petition does not require a petition fee, if promptly submitted.

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

John Doll (for)

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Robert M. Schulman, Esq.
Hunton & Williams
Suite 1200
1900 K Street, N.W.
Washington, DC 20006-1100

COPY MAILED

JUN 23 2005

OFFICE OF PETITIONS

In re Application of
PICCARIELLO et al.
Application No. 09/933,708
Filed: August 22, 2001
Attorney Docket Number:
54719.000028

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.78(a), filed June 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional Application no. 09/642,820, and to accept unintentionally delayed priority claims under 35 U.S.C. § 119(e) to the provisional applications indicated on the accompanying amendment[1].

The petition is **granted**.

RE: CLAIM FOR PRIORITY UNDER 1.78(a)(3)

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 instant amendment corrects the benefit claims submitted in the preliminary amendment filed December 26, 2001 by: 1) removing the reference under 35 U.S.C. 120 to the provisional applications and 2) correcting errors in the application numbers of two of the provisional applications. With respect to the latter correction, correction of the application number from "60/278,672" to "60/248,672" appears to be in error as the preliminary amendment filed December 26, 2001 identified provisional application No. 60/248,672 at page 3, col. 5 thereof.

(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;

(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.

The instant nonprovisional application was filed on August 22, 2001, and was pending at the time of the 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). This amendment was filed with this petition on June 17, 2004. The petition includes payment of the surcharge under § 1.17(t). Petitioner states that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2) and the date the claim was filed was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed application was submitted during the pendency of the instant nonprovisional application. *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.

RE: CLAIM FOR PRIORITY UNDER 1.78(a)(6)

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the 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 accompanied by:

(i) the reference required by 35 U.S.C. § 119(e) and

37 CFR 1.78(a)(5)(i) to the prior-filed provisional application, unless previously submitted;

(ii) the surcharge set forth in § 1.17(t); and

(iii) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on August 22, 2001, within twelve months of the filing date of the prior-filed provisional applications, identified in the amendment filed June 17, 2004, for which priority is claimed. A reference to the prior-filed provisional applications has been included in an amendment to the first sentence of the specification following the title. The petition includes a statement of unintentional delay which is being construed as a statement that "the entire delay in filing the claim for benefit of priority under 35 U.S.C. § 119(e)(and § 120) was unintentional." Petitioner must notify the Office if this is not a correct interpretation of their statement. 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 applications 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(s) under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under 35 U.S.C. §§ 120 and 37 CFR 1.78(a)(1), and (a)(2) and (a)(5) and under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. The examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to Technology Center Art Unit 1654 for consideration by the Examiner of applicant's claim under 35 U.S.C. §§ 120 and 37 CFR 1.78(a)(2) for the benefit of priority to the prior-filed application and for consideration of

the claims under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional applications.

The amendment filed June 17, 2004 will be reviewed by the examiner for compliance with 37 CFR 1.121.

Petitioner is advised that the instant application had reached the maximum capacity of 400 continuity records listed on a filing receipt. Thus, no further entries could be shown on the filing receipt without deleting an entry. An updated filing receipt is enclosed, which includes the applications that were specifically identified as being in error in the instant petition (application Nos. 09/642,820, 60/247,622 and 60/248,672).

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

Charles A. Pearson
Director
Office of Petitions

Enclosure: Updated Filing Receipt (9 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE

19 AUG 2003

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

#10

Herbert I. Cantor
Crowell & Moring, LLP
P.O. Box 14300
Washington, DC 20044-4300

In re Application of :
IMOTO, et al. :
U.S. Application No.: 09/355,117 : DECISION ON PETITION
PCT No.: PCT/JP00/01190 :
Int. Filing Date: 01 March 2000 : UNDER 37 CFR 1.181
Priority Date: 05 March 1999 :
Attorney Docket No.: 1830/50325 :
For: HETEROCYCLIC COMPOUNDS :
HAVING EFFECT OF ACTIVATING :
NICOTINIC ACETYLCHOLINE ALFA4 :
BETA2 RECEPTOR :

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 25 April 2003 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition under 37 CFR 1.181. No petition fee is due. The initial papers filed 22 August 2001 were processed as a filing under 35 U.S.C. 111(a). For the reasons discussed below, the application will be converted to a national stage filing of PCT/JP00/01190.

BACKGROUND

On 01 March 2000, applicant filed international application PCT/JP00/01190 which claimed a priority date of 05 March 1999. A Demand was filed with the International Preliminary Examining Authority prior to the expiration of 19 months from the priority date, and as a result the deadline for payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 05 September 2001.

On 22 August 2001, applicant filed the present application. The application papers filed therewith included a transmittal letter; a specification containing 27 claims, a signed combined declaration and power of attorney; a preliminary amendment; an Information Disclosure Statement and a check in the amount of $1,106.00 as payment of the U.S. Basic National Fee and a check in the amount of $40.00 for the recording of an assignment. In addition, applicant authorized the charging of any additional fees to Deposit Account No.: 05-1323. None of the papers referred to 35 U.S.C. 371 or "national stage." The application was processed as a filing under 35 U.S.C. 111(a).

On 25 April 2003, applicant filed the present petition under 37 CFR 1.182 to have the application converted to a PCT National phase application under 35 U.S.C. 371. Applicant

included payment of the $130.00 petition fee.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.
>
> Alternatively, one of the following indications may be used:
> 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
>
> 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

An examination of the application file finds that in the declaration filed 22 August 2001, the applicant clearly identifies the specification to which it is directed by referring to international application PCT/JP00/01190. This is a clear indication that the papers were filed under 35 U.S.C. 371. The transmittal letter did not contain any instructions in conflict therewith. As such it is proper to grant applicant's petition at this time and process the application under 35 U.S.C. 371 instead of 35 U.S.C. 111.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.181 is **GRANTED**. The application will be converted from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371.

As discussed above, no petition fee is required. As such, $130.00 will be credited to Deposit Account No.: 05-1323.

This application has an international filing date of 01 March 2000 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **22 August 2001**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a Notification of Acceptance of Application (Form PCT/DO/EO/903) and Official Filing Receipt which identifies this application as a national stage application of PCT/JP00/01190.

Thereafter, the application will be forwarded to Art Unit 1624.

Leonard Smith
Legal Examiner
Office of PCT Legal Administration

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 703-305-0130
Fax: 703-308-6459

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. 6

AUG 19 2002

In re Application of
Steven E. Everett
Serial Number: 09/933,725
Filed: August 22, 2001

For: TANGO II SOIL BLOCK PRESS

DECISION ON
PETITION UNDER
M.P.E.P.708.02, VI

This is in response to the petition filed July 30, 2002, requesting that the above-identified application be granted Special Status under Section 708.02 (VI) of the MPEP.

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

Steve E. Everett
Apt # F 234
2819 Foster Lane
Austin, TX 78757-1143

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HUMAN GENOME SCIENCES INC
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

COPY MAILED

DEC 16 2005

OFFICE OF PETITIONS

In re Application of :
Jian Ni et al :
Application No. 09/933,767 : DECISION ON PETITION
Filed: August 22, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. PZ007P2 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed September 20, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed PCT Application No. PCT/US98/11422, filed June 4, 1998, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. 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;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

It is noted in reviewing the chain of provisional applications to which PCT Application No. PCT/US98/11422 claims priority, it appears from Office database computer records that some of

the applications in the chain were not previously referenced or claimed in the PCT application. Petitioner is advised that, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See* Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d). Therefore, the claim for priority to all the provisional applications cannot be accepted.

The petition is further not grantable since Application No. PCT/US98/11422 is claiming priority to two provisional applications which were filed after the filing of the PCT application; namely, the PCT application was filed on June 4, 1998, yet claims benefit of priority to provisional Application Nos. 60/092,921 (filed July 15, 1998) and 60/094,657 (filed July 30, 1998). A claim for priority can only be made to those applications filed prior to the filing date of the later-filed application. Accordingly, the amendment is not acceptable as filed.

Additionally, it is noted that the amendment contains duplicate entries; i.e., item numbers 76, 77, 78 are duplicates of item numbers 73, 74 and 75.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a proper amendment[1] along wit ha 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

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

By fax:
(571) 272-8300

---

[1] *Note* 37 CFR 1.121

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

Frances Hicks
Lead 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

HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE MD 20850

COPY MAILED

DEC 27 2006

OFFICE OF PETITIONS

In re Application of :
Ni et al. :
Application No. 09/933,767 : DECISION ON PETITION
Filed: August 22, 2001 : UNDER 37 CFR 1.78(a)(3), (a)(6)
Attorney Docket No. PZOO7P2 :

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed January 18, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **Granted**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The instant application was filed on and was pending at the time of filing of the instant petition, and further, was itself copending with prior application PCT/US98/11422 which was filed within one year of the date of filing of the recited provisional applications. A reference to the prior-filed non provisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR §§ 1.78(a)(2)(iii) and 1.78(a)(5)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the amended claim for priority herein is submitted after expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). *See* 35 U.S.C. §§ 120 and 365(c) and § 119(e). Accordingly, having found that

the instant petition satisfies the conditions of 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §§ 120 and 365(c) and § 119(e), the petition to accept an unintentionally delayed claim of benefit to the prior-filed applications is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is actually entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §120 and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

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

Any questions concerning this matter may be directed to the undersigned at (571) 272- 3217.

This application is being referenced to the Technology Center.

Brian Hearn
Petitions Examiner

ATTACHMENT : Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY:DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/933,767	08/22/2001	1634	974	PZ007P2	10	23	4

CONFIRMATION NO. 7025

22195
HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

CORRECTED FILING RECEIPT

OC000000021739396

OC000000021739396

Date Mailed: 12/26/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Paul A Moore, Gerantown, MD;
Craig A. Rosen, Laytonsville, MD;
Steven M. Ruben, Olney, MD;
Jing-Shan Hu, Mountain View, CA;

Power of Attorney:

Kenley Hoover--40302
James Davis--40582
Jonathan Klein--41119
Joseph Kenny--43710
Michele Wales--43975
Mark Hyman--46789
Janet Martineau--46903

Domestic Priority data as claimed by applicant

This application is a CIP of PCT/US01/05614 02/21/2001
which claims benefit of 60/184,836 02/24/2000
and claims benefit of 60/193,170 03/29/2000
This application 09/933,767
is a CIP of 09/205,258 12/04/1998 PAT 6,525,174
and is a CIP of PCT/US98/11422 06/04/1998
which claims benefit of 60/048,901 06/06/1997
and claims benefit of 60/048,900 06/06/1997
and claims benefit of 60/048,893 06/06/1997
and claims benefit of 60/048,964 06/06/1997
and claims benefit of 60/048,884 06/06/1997
and claims benefit of 60/048,894 06/06/1997
and claims benefit of 60/048,971 06/06/1997

and claims benefit of 60/048,885 06/06/1997
and claims benefit of 60/049,375 06/06/1997
and claims benefit of 60/048,881 06/06/1997
and claims benefit of 60/048,880 06/06/1997
and claims benefit of 60/048,896 06/06/1997
and claims benefit of 60/049,020 06/06/1997
and claims benefit of 60/048,876 06/06/1997
and claims benefit of 60/048,895 06/06/1997
and claims benefit of 60/057,654 09/05/1997
and claims benefit of 60/048,917 06/06/1997
and claims benefit of 60/049,374 06/06/1997
and claims benefit of 60/048,875 06/06/1997
and claims benefit of 60/049,373 06/06/1997
and claims benefit of 60/048,916 06/06/1997
and claims benefit of 60/048,972 06/06/1997
and claims benefit of 60/049,970 06/13/1997
and claims benefit of 60/049,019 06/06/1997
and claims benefit of 60/048,915 06/06/1997
and claims benefit of 60/048,892 06/06/1997
and claims benefit of 60/048,899 06/06/1997
and claims benefit of 60/048,882 06/06/1997
and claims benefit of 60/048,964 06/06/1997
and claims benefit of 60/048,971 06/06/1997
and claims benefit of 60/048,894 06/06/1997
and claims benefit of 60/048,884 06/06/1997
and claims benefit of 60/057,651 09/05/1997
and claims benefit of 60/057,644 09/05/1997
and claims benefit of 60/057,765 09/05/1997
and claims benefit of 60/057,762 09/05/1997
and claims benefit of 60/057,775 09/05/1997
and claims benefit of 60/057,648 09/05/1997
and claims benefit of 60/057,774 09/05/1997
and claims benefit of 60/057,649 09/05/1997
and claims benefit of 60/057,770 09/05/1997
and claims benefit of 60/057,771 09/05/1997
and claims benefit of 60/057,776 09/05/1997
and claims benefit of 60/057,760 09/05/1997
and claims benefit of 60/057,761 09/05/1997
and said PCT/US98/11422
claims benefit of 60/057,778 09/05/1997
and claims benefit of 60/057,629 09/05/1997
and claims benefit of 60/057,628 09/05/1997
and claims benefit of 60/057,777 09/05/1997
and claims benefit of 60/057,634 09/05/1997
and claims benefit of 60/070,923 12/18/1997
and claims benefit of 60/048,949 06/06/1997
and claims benefit of 60/048,974 06/06/1997
and claims benefit of 60/048,883 06/06/1997
and claims benefit of 60/048,897 06/06/1997
and claims benefit of 60/048,898 06/06/1997
and claims benefit of 60/048,962 06/06/1997
and claims benefit of 60/048,963 06/06/1997
and claims benefit of 60/048,877 06/06/1997
and claims benefit of 60/048,878 06/06/1997
and claims benefit of 60/057,645 09/05/1997
and claims benefit of 60/057,642 09/05/1997
and claims benefit of 60/057,668 09/05/1997
and claims benefit of 60/057,635 09/05/1997
and claims benefit of 60/057,627 09/05/1997
and claims benefit of 60/057,667 09/05/1997

and claims benefit of 60/057,666 09/05/1997
and claims benefit of 60/057,764 09/05/1997
and claims benefit of 60/057,643 09/05/1997
and claims benefit of 60/057,769 09/05/1997
and claims benefit of 60/057,763 09/05/1997
and claims benefit of 60/057,650 09/05/1997
and claims benefit of 60/057,584 09/05/1997
and claims benefit of 60/057,647 09/05/1997
and claims benefit of 60/057,661 09/05/1997
and claims benefit of 60/057,662 09/05/1997
and claims benefit of 60/057,646 09/05/1997

Foreign Applications

If Required, Foreign Filing License Granted: 11/30/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/933,767

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

METHOD OF DIAGNOSING PANCREATIC CANCER

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

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

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

SEP 18 2007

OFFICE OF PETITIONS

In re Application of :
Sam B. Sandbote :
Application No. 09/933,786 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. 2222.4860000 :

This is a decision on the petition under 37 CFR 1.137(b), filed on October 11, 2006, to revive the above-identified application. The delay in responding is sincerely regretted.

This application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision of June 15, 2006 by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated. *See* 37 CFR 1.197(b). As no claim was allowed, the application was held abandoned. *See* MPEP 1214.06.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114 with the $790 filing fee and an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 2111, for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OGILVY RENAULT
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL, QC
H3A2Y3 CANADA

COPY MAILED

JUL 2 6 2004

OFFICE OF PETITIONS

In re Application of :
Denis Faucher :
Application No. 09/933,798 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. 15309-1US CC/MG :

This is a decision on the petition under 37 CFR 1.137(b), filed May 7, 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 July 16, 2003, which set a shortened statutory period for reply of three (3) months. A one-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on November 17, 2003.

The statement claiming small entity status in accordance with 37 CFR 1.17(m) embodied in the petition under 1.137(b) has been made of record and small entity status has been accorded.

Receipt is acknowledged of the Amendment filed May 7, 2004, with the instant petition.

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

The application file is being forwarded to Technology Center 1700, Art Unit 1771 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

BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO IL 60690-1135

COPY MAILED

NOV 30 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Anthony J. Baerlocher et al. :
Application No. 09/933,843 :
Filed: August 20, 2001 :
Attorney Docket No.: 0112300-898 :

This is a decision on the petition filed March 28, 2005 to withdraw the holding of abandonment for the above-identified application. The petition is treated under 37 CFR 1.181.

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

The application was held abandoned on April 23, 2004, for failure to timely submit a timely response to the Office Action mailed March 22, 2005 and which set a thirty (30) day period for reply. The instant petition and this decision precede the mailing of the Notice of Abandonment.

Petitioner asserts that a response was filed and, in support, petitioner has submitted, *inter alia*, a copy of the response in the form of an amendment and a post card receipt date stamped April 12, 2004 by the USPTO.

A search of the application file and the USPTO records does not reveal receipt of the response, but the evidence submitted corroborates a timely response to the non-Final Office Action.

Accordingly, the holding of abandonment is hereby withdrawn. No petition fee is necessary and none has been charged.

This matter will be referred to Technology Center 3713 for appropriate action on the amendment filed April 12, 2004, a copy of which was submitted upon petition.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES 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

JUN 11 2008

OFFICE OF PETITIONS

In re Application of :
ITKONEN, et al. :
Application No. 09/933,892 : DECISION GRANTING PETITION
Filed: August 21, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **100720-00050(HEIN 18.938)** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 8, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 7, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 3721 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Monica A. Graves
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

J PETER FASSE
FISH & RICHARDSON PC
225 FRANKLIN STREET
BOSTON MA 02110-2804

COPY MAILED
MAY 17 2004
OFFICE OF PETITIONS

In re Application of :
Odgren, et al. :
Application No. 09/933,915 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. 07917-120001 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 16, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file a reply to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures, mailed February 4, 2002, which set a shortened statutory period for reply of two months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. No reply having been received, the above-identified application became abandoned on April 5, 2002. A Notice of Abandonment was mailed on December 30, 2002.

Petitioner has met the requirements to revive the above-identified application, pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of a computer readable form of the sequence listing, paid the petition fee, and made the proper statement of unintentional delay.

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCCLEAN, VA 22102

COPY MAILED

JUN 15 2007

OFFICE OF PETITIONS

In re Application of :
Steven PELIOTIS, et al :
Application No. 09/933,928 : DECISION ON PETITION
Filed: August 21, 2001 : TO WITHDRAW
Attorney Docket No. 577172001500 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 14, 2006 and January 17, 2007.

The request is **APPROVED**.

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

The request was signed by Adam Keser, on behalf of all attorneys of record who are associated with Customer No. 43997.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor first copied address below until otherwise properly notified by the applicant.

There are no pending Office actions at the present time.

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

April Wise
Petitions Examiner
Office of Petitions

cc: INTELLOCITY USA, INC.
1400 MARKET STREET
DENVER, CA 80202

cc: MARC KAUFMAN, ESQ.
NIXON PEABODY LLP
401 9TH STREET, N.W. ,
SUITE 900
WASHINGTON, D.C. 20004

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
09/933,928	08/21/2001	Steven Peliotis	577172001500

CONFIRMATION NO. 7742

OC000000023866666

43997
OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCLEAN, VA 22102

Date Mailed: 05/15/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/17/2007.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

Diane Goodwyn

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

AUG 2 9 2006

OFFICE OF PETITIONS

FLIESLER MEYER, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO, CA 94111

In re Application of :
Ramesh R. Sarukkai :
Application No. 09/933,956 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. YAHOO-01007US0 :

This is a decision on the petition filed, May 5, 2006 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 September 27, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on December 28, 2005.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on May 5, 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 $1020 extension of time submitted with the petition on May 5, 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 matters is being referred to Technology Center AU 2626 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Michael S. Garrabrants
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105-2482

UNITED STATES PATENT AND TRADEMARK OFFICE

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

YAHOO C/O MOFO PALO ALTO
755 PAGE MILL ROAD
PALO ALTO, CA 94304

MAILED

MAY 12 2010

OFFICE OF PETITIONS

In re Application of	:	
Ramesh R. Sarukkai	:	DECISION ON PETITION
Application No. 09/933,956	:	TO WITHDRAW
Filed: August 21, 2001	:	FROM RECORD
Attorney Docket No. 085804-720801	:	

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 22, 2010.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that on May 7, 2010 the power of attorney to YAHOO C/O MOFO PALO ALTO 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: YAHOO! INC. C/O GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK NY 10166

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

COPY MAILED

DEC 17 2009

OFFICE OF PETITIONS

In re Application of :
Jeff Jacob Brauer :
Application No. 09/933,957 : DECISION ON PETITION
Filed: August 20, 2001 : TO WITHDRAW
Attorney Docket No. **Q92694** : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR. § 1.36(b), filed September 9, 2009.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to attorneys/agents associated with Customer Number 72875 has been revoked by the assignee of the patent application on May 20, 2009. Accordingly, the request to withdraw under 37 CFR § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Jeff Brauer
5145 Bonnie Acres Dr
Ellicott City MD 21043

UNITED STATES 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

COPY MAILED

FEB 2 4 2005

OFFICE OF PETITIONS

PATENT DOCUMENTATION CENTER
XEROX CORPORATION
XEROX SQUARE 20TH FLOOR
100 CLINTON AVENUE S
ROCHESTER NY 14644

In re Application of :
Christopher L. Chua et al :
Application No. 09/933,960 : DECISION GRANTING PETITION
Filed: August 20, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. D/9700511D :

This is a decision on the petition under 37 CFR 1.137(b), filed February 8, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely file an abstract within the extendible two month period set in the Notice of October 19, 2001. No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is December 20, 2001. A Notice of Abandonment was mailed on October 14, 2003.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an abstract; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of October 19, 2001 is accepted as having been unintentionally delayed.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 06-06

Paper No: __

COPY MAILED

JUN 19 2006

OFFICE OF PETITIONS

QUALCOMM, INC
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

In re Application of :
Leung, et al. : DECISION
Application No.: 09/933,971 :
Filing Date: 20 August, 2001 :
Attorney Docket No. 010439 :

This is a decision on the petition filed on 3 May, 2006, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 5 May, 2005, with reply due absent extension of time on or before5 August, 2005;
- the instant application went abandoned after midnight 5 August, 2005;
- the Office mailed the Notice of Abandonment on 13 March, 2006;
- on 3 May, 2006, Petitioner filed the instant petition, averred timely filing of a Notice of Appeal with fee with request and fee for extension of time on 3 November, 2005 (resubmitted for the information of the Office on 21 April, 2006), and further Petitioner submitted with the petition a request for continued examination with fee and submission under 37 C.F.R. §1.114 and request and fee for extension of time;

- 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.[1]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

STATUTES, REGULATIONS AND ANALYSIS

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

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

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal

---

[2] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

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

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

of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides:

* * *

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card 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

---

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

> timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).
>
> 37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.
>
> * * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

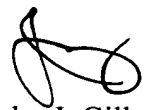
As of this writing Petitioner appears to have satisfied the showing requirements described above.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **granted**.

The application is released to Technology Center 2600 for further processing in due course.

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



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

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

COPY MAILED

FEB 27 2003

OFFICE OF PETITIONS

In re Application of :
Jeffrey Alan Silvernail et al :
Application No. 09/933,987 : NOTICE
Filed: August 21, 2001 :
Attorney Docket No. UDC-22501 :

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 2879.

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

KEVIN L RUSSELL
601 SW 2ND AVE
SUITE 1600
PORTLAND OR 97204

COPY MAILED

JAN 0 6 2005

OFFICE OF PETITIONS

In re Application of :
Li, et al. :
Application No. 09/934,004 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. KLR7146.0122 :

This is a decision on the petition to revive an unintentionally abandoned application under 37 CFR 1.137(b), filed December 22, 2004.

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

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed May 21, 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 22, 2004. A Notice of Abandonment was mailed on December 16, 2004.

Petitioner has submitted the petition fee and an amendment, and made the proper statement of unintentional delay.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $1020 extension of time fee submitted with the petition on December 22, 2004 was subsequent to the maximum period obtainable for reply (November 21, 2004), this fee has been refunded to petitioner's Deposit Account No. 03-1550.

The application file is being forwarded to Group Art Unit 2174 for consideration of the amendment filed December 22, 2004.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thompson E. Fehr
Goldenwest Corporate Center
Suite 300
5025 Adams Avenue
Ogden UT 84403

COPY MAILED

MAR 0 8 2007

OFFICE OF PETITIONS

In re Application of :
Gray :
Application No. 09/934,016 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. PGRACT :
For: MEDICAL PORT FOR AN
EMERGENCY SAFETY RESUSCITATOR

This is a decision on the petition under 37 CFR 1.181, filed December 29, 2006, to withdraw the holding of abandonment in the above-identified application.

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

The Office contended that the above-identified application became abandoned for failure to submit a reply to the April 21, 2006 non-final Office action, which set a three month extendable period for reply. No extensions of time or reply being received, the Office contended that this application became abandoned on July 22, 2006. A Notice of Abandonment was mailed on October 30, 2006.

Petitioner alleges that the April 21, 2006 non-final Office action was not received.

The showing required to establish non-receipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
2. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1]

[1] See notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Petitioner has submitted a copy of the docket record where the requirement would have been entered had the April 21, 2006 non-final Office action been received. In addition, practitioner referenced the docket record in the petition and stated that a search of docket records and the application's file jacket for indication that the April 21, 2006 non-final Office action was received was fruitless.

Petitioner has established non-receipt. The petition is **granted,** the holding of abandonment is withdrawn, and the October 30, 2006 Notice of Abandonment is **vacated**.

After the mailing of this decision, the application will be returned to Technology Center A.U. 3771 for the re-mailing of the April 21, 2006 non-final Office action with a new period set for reply.

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

Shirene Willis Brantley

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

PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK CA 94026

COPY MAILED

JAN 18 2005

OFFICE OF PETITIONS

In re Application of :
Sydney Brenner et al. :
Application No. 09/934,020 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 55525-8055.US00 :

This is a decision on the petition, filed October 8, 2004, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on November 21, 2003, for failure to file a timely response to the Office communication (notification of non-responsive but *bona fide* reply) mailed on October 20, 2003, which set a one (1) month period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed on December 27, 2004.

The application is being forwarded to Technology Center 1639 for consideration of the response filed October 8, 2004 and for further examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[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)).

UNITED STATES 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

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

COPY MAILED

NOV 17 2003

OFFICE OF PETITIONS

In re Application of :
Holger Beckmann et al. :
Application No. 09/934,025 : DECISION ON PETITION
Date Deposited: August 21, 2001 : UNDER 37 C.F.R. §1.10
Attorney Docket No. 018781-001710US :
Title: DETECTION METHOD FOR MONITORING BETA TUBULIN ISOTYPE SPECIFIC MODIFICATION :

This is a decision on the "Request for Corrected Filing Date," which is properly treated as a petition under 37 C.F.R. §1.10, filed October 30, 2003, requesting that application number 09/934,025 be accorded a filing date of August 20, 2001.

The application was deposited on August 21, 2001.

On October 30, 2003, applicant filed the present petition. Petitioner has alleged that the application was deposited on August 20, 2001. Petitioner further states that a postcard receipt and Express Mail label no. EL827150093US were included with the petition, but neither has been located in the file. As such, petitioner's request cannot be granted.

It is further noted that this petition was filed over two years after the filing of the application, and 37 C.F.R. §1.10 requires any petition under this section to be filed promptly.

Accordingly, the petition is **DISMISSED.**

The reply to this letter may be submitted by mail[1], hand-delivery[2], or facsimile[3]. 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 1.10". This is not a final agency action within the meaning of 5 U.S.C 704.

It is suggested that on Renewed Petition, Petitioner provide these missing papers in the filing of this renewed petition.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

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

---

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.
3 (703) 308-6916 or (703) 305-4257, Attn: Office of Petitions.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

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

COPY MAILED

DEC 0 8 2003

OFFICE OF PETITIONS

In re Application of	:	
Holger Beckmann et al.	:	
Application No. 09/934,025	:	DECISION ON RENEWED
Date Deposited: August 21, 2001	:	PETITION UNDER
Attorney Docket No. 018781-001710US	:	37 C.F.R. §1.10
Title: DETECTION METHOD FOR MONITORING BETA TUBULIN ISOTYPE SPECIFIC MODIFICATION	:	

This is a decision on the Renewed Petition under 37 C.F.R. §1.10, filed November 26, 2003, requesting that application number 09/934,025 be accorded a filing date of August 20, 2001.

The application was deposited on August 21, 2001.

On October 30, 2003, applicant filed the original petition, where it was alleged that the application was deposited on August 20, 2001. Petitioner set forth that a postcard receipt and Express Mail label no. EL827150093US were included with the petition, but neither was located in the file. As such, the petition was dismissed via a decision mailed on November 17, 2003. The decision further indicated:

> ... this petition was filed over two years after the filing of the application, and 37 C.F.R. §1.10 requires any petition under this section to be filed promptly.

With the renewed petition, petitioner has included a copy of applicants' postcard receipt acknowledging receipt of the instant application in the United States Patent and Trademark Office

(Office) on August 21, 2001. Petitioner has further included a copy of the Utility Application Transmittal form, which contains the Express Mail number listed above, coupled with a copy of the Express Mail label, which bears the date August 20, 2001.

A check of the United States Postal Service (USPS) website (http://www.usps.com/shipping/trackandconfirm.htm) was inconclusive, as it stated that the information pertaining to this mailing is stored off-line. A check of the Office's USPS Express Mail Finder Database computer program shows that the package was accepted by the USPS on August 20, 2001. Copies of both of these search results are enclosed.

When an applicant mails correspondence to the Office with sufficient postage utilizing the Express Mail Post Office to Addressee, 37 CFR §§1.10(a) and (b) establish that the petitioner is entitled to the date of deposit as the filing date. When a different filing date is accorded to the application, 37 CFR §§1.10(c)-(e) provide a means for petitioning the Office to correct the filing date.

Unfortunately, 37 CFR §§1.10(c)-(e) state that the petition must be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than that which the applicant believes he or she is entitled to. Therefore, time is of the essence.

In the renewed petition, petitioner explains "applicants' attorney became aware that the Patent Office had accorded a filing date other than the USPS deposit date during preparation of a response to the restriction requirement which was not issued until September 26, 2003[1]." Petitioner further indicates that the "error in the date on the Filing Receipt had not been noticed previously[2]."

The Office has no way of determining on what date the postcard receipt was returned to petitioner. In the absence of any information to the contrary, it is reasonable to assume that the postcard was mailed shortly after August 21, 2001.

Additionally, a copy of the filing receipt has not been located in the file. As the Office cannot determine when the filing receipt was sent to the petitioner, it is reasonable to assume that it was mailed shortly after August 21, 2001, and that it granted a filing date of August 21, 2001.

---

1 Petition, page 1.
2 Id.

Roughly two years later, the original petition was filed.

Petitioner has included an express mail label which indicates that the application was deposited on August 20, 2001. The postcard receipt, received roughly two years ago, bears a date stamp "08/21/01." This should have indicated to the petitioner that something was amiss.

Similarly, the filing receipt, received roughly two years ago, placed the applicant on notice of the filing date that had been assigned - August 21, 2001.

However, petitioner has submitted no evidence as to why it took him two years to notice these two discrepancies and submit this petition. As such, it does not appear that petitioner has met the obligation imposed by this portion of the C.F.R.

Accordingly, the petition is **DISMISSED.**

The reply to this letter may be submitted by mail[3], hand-delivery[4], or facsimile[5]. **Please note that the later two have changed, as of December 1, 2003.** Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.10". This is not a final agency action within the meaning of 5 U.S.C 704.

On second renewed petition, petitioner may wish to consider filing a petition under 37 C.F.R. §1.182 to waive the portions of 37 CFR §§1.10(c)-(e) which state that the petition must be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than that which the applicant believes he or she is entitled to.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to

---

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

4 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202

5 (703) 872-9306.

the undersigned at (703) 305-0011.

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

Encl. USPS Tracking Results (paper No. 9)
Express Mail Information Database Result (paper no. 10)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

COPY MAILED

SEP 11 2007

OFFICE OF PETITIONS

In re Application of :
Luca Blessent, et al. :
Application No. 09/934,091 : ON PETITION
Filed: August 20, 2001 :
Attorney Docket No. 990207C1 :

This is a decision on the petition, filed May 18, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 25, 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 December 26, 2006.

Petitioner asserts that the non-final Office action mailed July 11, 2006 and subsequently re-mailed on September 25, 2006 were not received.

A review of the written record indicates no irregularity in the remailing of the Office action on September 25, 2006, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Notice would have been entered and docketed had it been received must be attached to and referenced in the practitioner's statement.

See MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The evidence presented by applicant is insufficient to withdraw the holding of abandonment since the petition has failed to comply with requirement (3) above. While petitioner must submit a copy of the docket record where the non-received Office communication would have been entered and docketed had it been received, the docket record submitted appears to be incomplete. For example, it is noted that while there is no entry for receipt of a non-final Office action mailed on April 5, 2005, there are two separate entries indicating the initial due date of 7/5/05 and the final deadline of 10/5/05 for the required response. It is noted that a response was ultimately filed on October 5, 2005. Therefore, the docket record presented cannot be relied on to show that all USPTO communications were entered and docketed when received.

Absent the required evidence to establish nonreceipt of the Office action of September 25, 2006, the petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1,500 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including 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 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 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

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

COPY MAILED

FEB 28 2008

OFFICE OF PETITIONS

In re Application of :
Luca Blessent, et al. :
Application No. 09/934,091 :
Filed: August 20, 2001 :
Attorney Docket No. 990207C1 :

ON PETITION

This is a decision in response to the petition, filed November 13, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed September 25, 2006. On May 18, 2007 a petition under 37 CFR 1.181 to withdraw the abandonment was filed; however, the petition was dismissed by a decision mailed September 11, 2007. In response, on November 13, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay.

Accordingly, the petition is **GRANTED**.

The application is being referred to Technology Center AU 2616 for appropriate action by the Examiner in the normal course of business on the response received November 13, 2007.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Joseph W. Price
Price and Gess
2100 S.E. Main Street, Suite 250
Irvine, CA 92614

MAILED

MAY 30 2002

OFFICE OF PETITIONS
GROUP

In re Application of:
Kado *et al.*
Application No. 09/934,095
Filed: August 21, 2001
Attorney Docket No. NAK1-BN30a

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102, filed August 21, 2001, to make the above-identified application special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.), Section 708.02, Item VIII: Accelerated Examination.

The petition is **dismissed.**

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P., Section 708.02, Item VIII, must be accompanied by (a) the required petition fee set forth in 37 C.F.R. § 1.17(h), (b) a statement that all claims are directed a single invention or in the event that the United States Patent and Trademark Office determines that all the claims presented are not obviously directed to a single invention, applicant will make an election without traverse as a prerequisite to the grant of special status, (c) a statement that a pre-examination search has been made by the inventor, attorney, agent, professional searcher, etc., and a listing of the field of search by class and subclass, (d) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims, and (e) a detailed description of the submitted references and discussions pointing out how the claimed subject matter is distinguishable over these references.

In this case, the petition does not fully comply with items (c) and (d) above. Specifically, petitioner states that an International Search Report (ISR) and the cited references accompanied the petition. However, an inspection of the application file and the petition papers did not produce copies of the ISR and cited references. While a search by a foreign patent office will generally satisfy the requirement of item (c), a copy of the foreign search report is necessary to support petitioner's statement. In the absence of copies of the ISR and cited references, the petition cannot be accepted to satisfy the requirements of items (c) and (d). Consequently, the

petition is **dismissed**.

Should petitioner desire reconsideration, petitioner should file a renewed petition providing the information required by items (c) and (d) above. No further petition fee is required.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision.

The application is being forwarded to the group Central File and will await action in its regular turn.

Inquires regarding this decision should be directed to Ed Glick at (703) 308-4858.

Edward J. Glick, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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. 10

MAILED

AUG 30 2002

OFFICE OF DIRECTOR
GROUP

Joseph W. Price
Price and Gess
2100 S.E. Main Street, Suite 250
Irvine, CA 92614

In re Application of
Kado et al.
Application No.: 09/934,095
Filing Date: August 21, 2001
Attorney Docket No. NAK1-BN30a

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the request for reconsideration, filed June 17, 2002. The request has been treated as a renewed petition under 37 C.F.R. § 1.102(d) to make the above-identified application special.

Petitioner requests reconsideration of the decision, mailed January 25, 2001, denying the petition to make the application special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.), Section 708.02, Item VIII: Accelerated Examination. To support the renewed petition, a copy of the International Search Report setting forth the field of search and copies of the cited references have been submitted.

The renewed petition is **granted.**

The renewed petition in combination with the petition filed with the application on August 21, 2001 now satisfies the conditions for a grantable petition under M.P.E.P. § 708.02, Item VIII.

The application is being forwarded to the examiner for expedited prosecution.

Edward Westin

Edward P. Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OPTV/MOFO
C/O Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
Mclean, VA 22102

COPY MAILED

MAR 2 8 2008

OFFICE OF PETITIONS

In re Application of	:	
Steven O. Markel et al.	:	
Application No. 09/934,108	:	DECISION ON PETITION
Filed: August 21, 2001	:	TO WITHDRAW
Attorney Docket No. 2050.129US1	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 14, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Morrison & Foerster LLP has been revoked by the assignee of the patent application on January 17, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

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

June 17, 2003

Janet E. Embretson
Schwegman, Lundberg, Woessner & Kluth
P. O. Box 2938
Minneapolis, MN 55402

In re application of:
Clague P. Hodgson DECISION ON PETITION
Serial No.: 09/934,113
Filed: August 21, 2001
For: VECTORS FOR GENE TRANSFER

This is a decision on the petition received on January 21, 2003, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to Comply with Sequence Requirements mailed August 13, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned October 16, 2001. The Notice of Abandonment was mailed on December 2, 2002.

On January 21, 2003, the office received a communication from the attorney of record. Enclosed was an acknowledgement that the attorney responded to the Notice of Missing Parts on November 13, 2001.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice of Missing Parts on November 13, 2001.

The petition is hereby Granted.

The application has been completed for release to Technology Center 1633.

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

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVE., N.W.
WASHINGTON DC 20005

COPY MAILED

JUN 0 4 2004

OFFICE OF PETITIONS

In re Application of :
Byrne et al. :
Application No. 09/934,121 : DECISION GRANTING PETITION
Filed: August 21, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 2222.0320000 :

This is a decision on the petition, filed May 20, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the present nonprovisional application is the subject of an application filed in an eighteen month publication country on August 21, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

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

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The present petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(I) has been rescinded. A Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing, which sets forth the projected publication date of September 16, 2004, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 2645.

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FAEGRE & BENSON LLP
PATENT DOCKETING
2200 WELLS FARGO CENTER
90 SOUTH 7TH STREET
MINNEAPOLIS, MN 55402-3901

COPY MAILED

MAR 0 7 2005

OFFICE OF PETITIONS

In re Application of	:	
Andrew Baird	:	
Application No. 09/934,131	:	NOTICE
Filed: March 17, 2003	:	
Attorney Docket No. 56578-308425	:	

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 (571) 272-3201.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

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

COPY MAILED

MAR 07 2005

OFFICE OF PETITIONS

In re Application of :
Andrew Baird :
Application No. 09/934,131 : ON PETITION
Filed: March 17, 2003 :
Attorney Docket No. 8802-0045 :
:

This is a decision on the petition under 37 CFR 1.137(b), filed August 16, 2004, to revive the above-identified application.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts mailed September 25, 2001, requiring an executed oath or declaration under 37 CFR 1.63 and the surcharge under 37 CFR 1.16(e). A Notice of Abandonment was mailed October 28, 2003. In response, the present petition was filed, as well as an executed declaration and the requisite surcharge.

The petition is **GRANTED**.

The application is being returned to the Office of Initial Patent Examination (OIPE) for further processing using the declaration filed August 16, 2004.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. 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 Commissioner
for Patent Examination Policy

cc: FAEGRE & BENSON LLP
PATENT DOCKETING
2200 WELLS FARGO CENTER
90 SOUTH 7TH STREET
MINNEAPOLIS, MN 55402-3901

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WAYNE A. SIVERTSON
NAWROCKI ROONEY & SIVERTSON P.A.
SUITE 401 BROADWAY PLACE EAST
3433 BROADWAY STREET NORTHEAST
MINNEAPOLIS, MN 55413

COPY MAILED

MAY 18 2004

OFFICE OF PETITIONS

In re Application of :
James T. Casey et al :
Application No. 09/934,167 : NOTICE
Filed: August 20, 2001 :
Attorney Docket No. 55771/102/101 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

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

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

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Publishing Division.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

COPY MAILED

JAN 10 2008

OFFICE OF PETITIONS

In re Application of :
Matsumoto, Shigeki :
Application No. 09/934,192 : DECISION ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 450100-03419 :

This is a decision on the petition, filed November 9, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the non-final Office action mailed April 23, 2007, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 1, 2007.

Petitioner asserts that the Office action dated April 23, 2007 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the non-received Office action would have been entered had it been received must be attached to and referenced in the practitioner's statement.

See MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 2157 for re-mailing the Office action of April 23, 2007. The period for reply will run from the mailing date of the Office action.

Liana Walsh
Petitions Examiner
Office of Petitions

RECEIVED
CENTRAL FAX CENTER
NOV 18 2004

Attorney's Docket No.: 13970-004001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Che-Kuang Wu Art Unit : 1756
Serial No.: 09/934,218 Examiner : Christopher G. Young
Filed : August 21, 2001
Title : GRAY SCALE ALL-GLASS PHOTOMASKS

5/2/05
Approved
Jacqueline M. Stone, Director
Technology Center 1700

Attention: Group Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PERMISSION TO WITHDRAW AS ATTORNEY OF RECORD

The undersigned attorney, on behalf of himself and the other attorneys of record, who are members or associates in the firm of FISH & RICHARDSON P.C., or who were so listed at the time of their appointment, and on behalf of any associate attorneys appointed by any of the attorneys on whose behalf this petition is filed, including the following:

Scott C. Harris, Reg. No. 32,030, requests the approval of the Commissioner to withdraw as attorney of record.

The present mailing address of the attorney of record is:

Fish & Richardson P.C. (Southern California)
12390 El Camino Real
San Diego, California 92130

CERTIFICATE OF TRANSMISSION BY FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

November 18, 2004
Date of Transmission

Signature

Carroll Allman
Typed or Printed Name of Person Signing Certificate

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 3

APR 0 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

CARR & FERRELL LLP
2225 East Bayshore Road, Suite 200
Palo Alto, CA 94303

In re Application of: James Randall Turner)
Application No. 09/934,305)
Filed: August 20, 2001) **DECISION ON REQUEST FOR**
For: SYSTEM AND METHOD FOR) **WITHDRAWAL AS ATTORNEY**
AUTOMATIC PRIVATE IP)
ADDRESS SELECTION)

This is a decision on the Request To Withdraw from Representation filed March 17, 2003.

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

The request is **GRANTED**.

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

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

cc: Jim H. Salter
Blakely, Sokoloff, Taylor and Zafman LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085

UNITED STATES 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 20 2007

OFFICE OF PETITIONS

BENTON F. BAUGH
14626 OAK BENG
HOUSTON TX 77079

In re Application of
Benton F. Baugh
Application No. 09/934,345
Filed: August 22, 2001
For: THRUSTER FLOOD CONTROL METHOD

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed October 27, 2006, requesting revival of 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 (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely reply to the Notice To File Missing Parts Of Nonprovisional Application (Notice) of October 1, 2001, which set a period for reply of TWO (2) months from the mailing date of the Notice. This application became abandoned on December 2, 2001. A Notice of Abandonment was mailed on October 23, 2003.

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

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), (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 Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here in view of the inordinate delay (over 4 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on December 2, 2001. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office notice 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 USC 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 clear that any protracted delay (here, over 4 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

It is noted that the Office had no address available on record to forward the Notice of October 1, 2001 and the Notice of Abandonment of October 23, 2003. However, the fact remains that applicant failed to provide the Office with any address and failed to check on the status over four years. Therefore, it is appropriate to ask for additional information. Statements are required from any and all persons responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

Applicant should be aware that while an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent. ***See also MPEP 401¶ 4.10.***

Further, applicant failed to supply the abstract as required under 37 CFR 1.72(b), in the Notice mailed October 1, 2001. Any renewed petition may be addressed as follows:

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

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

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

Inquiries related to this decision may be made to the undersigned at (571) 272-3208.

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

BENTON F. BAUGH
14626 OAK BENG
HOUSTON TX 77079

COPY MAILED

APR 27 2007

OFFICE OF PETITIONS

In re Application of :
Benton F. Baugh :
Application No. 09/934,345 : ON PETITION
Filed: August 22, 2001 :
For: THRUSTER FLOOD CONTROL METHOD :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely reply to the Notice To File Missing Parts Of Nonprovisional Application mailed October 1, 2001.

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

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

This matter is being referred to the Office of Initial Patent Examination.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BENTON F. BAUGH
14626 OAK BENG
HOUSTON TX 77079

COPY MAILED

MAY 22 2007

OFFICE OF PETITIONS

In re Application of :
Benton F. Baugh :
Application No. 09/934,345 : ON PETITION
Filed: August 22, 2001 :
For: THRUSTER FLOOD CONTROL METHOD :

This is a decision on the petition under 37 CFR 1.137(b), filed October 27, 2006, to revive the above-identified application.

The petition is **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)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either

---

[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item(s) (1).

An abstract was **not** provided for this application, in reply to the Notice To File Missing Parts Of Nonprovisional Application mailed October 1, 2001.

In view of the above, the Office letter mailed April 27, 2007, granting the petition received March 26, 2007 is hereby **vacated**.

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

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

By hand: Customer Window located at:

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Karen Creasy
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

BENTON F. BAUGH
14626 OAK BENG
HOUSTON TX 77079

COPY MAILED

AUG 0 7 2007

OFFICE OF PETITIONS

In re Application of :
Benton F. Baugh :
Application No. 09/934,345 : DECISION GRANTING PETITION
Filed: August 22, 2001 : UNDER 37 CFR 1.137(b)
For: THRUSTER FLOOD CONTROL METHOD :

This is a decision on the papers submitted August 3, 2007[1], which are being treated as a renewed petition under 37 CFR 1.137(b), 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 Abstract; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply is accepted as having been unintentionally delayed.

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

This matter is being referred to the Office of Initial Patent Examination.

Karen Creasy
Petitions Examiner
Office of Petitions

[1]Certificate of Transmission/Mailing date of May 29, 2007.

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

OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCLEAN VA 22102

COPY MAILED

NOV 2 2 2006

OFFICE OF PETITIONS

In re Application of :

MARKEL :
Application No. 09/934,354 : DECISION ON PETITION
Filed: August 20, 2001 : TO WITHDRAW
Attorney Docket No. INTE.07USU1 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 14, 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, " application is being transferred to another law firm", does not meet any of the conditions set forth in 37 CFR 10.40.

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **MARC KAUFMAN, ESQ.**
NIXON PEABODY LLP
401 9TH STREET NW, SUITE 900
WASHINGTON, DC 20004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCLEAN, VA 22102

COPY MAILED

JUL 31 2007

OFFICE OF PETITIONS

In re Application of :
MARKEL, Steven O. :
Application No. 09/934,354 : DECISION ON PETITION
Filed: August 20, 2001 : TO WITHDRAW
Attorney Docket No. 043978-027000 : FROM RECORD
:

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 17, 2007.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to OPTV/MOFO has been revoked by the assignee of the patent application on December 11, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **NIXON PEABODY, LLP**
401 9TH STREET NW, SUITE 900
WASHINGTON DC 20004-2128

UNITED STATES 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. 4

SCOTT A HEIMERMANN
C/O JOAN HEIMERMANN
WEST 3124 HICKORY HILLS ROAD
CHILTON WI 53014-9767

COPY MAILED

OCT 16 2003

OFFICE OF PETITIONS

In re Application of Scott Heimermann and Stephen Danforth Application No. 09/934,411 Filed: August 21, 2001 Title: FULLY AUTOMATED, REQUISITION-DRIVEN, COMPETING AUTHORIZED SUPPLIERS, WEB SITE-BASED, REAL-TIME, REVERSE-AUCTION, CENTRALIZED E-PROCUREMENT SYSTEM FOR GOVERNMENT, WITH BIFURCATED INTERNAL AND EXTERNAL MODULES, REQUISITION POOLING, ORDER FORMULATION AND MANAGEMENT, CONSOLIDATED IN-BOUND SHIPMENT AND DISTRIBUTED J.I.T. DELIVERY, PROCUREMENT-NEEDS PREDICTION, CENTRALIZED CATALOG MANAGEMENT AND NUMEROUS ADDITIONAL FEATURES	DECISION REFUSING STATUS UNDER § 1.47(a)

This is in response to the "PETITION OF JOINT INVENTOR, STEPHEN DANFORTH, TO FILE APPLICATION ON BEHALF OF JOINT INVENTOR, SCOTT A. HEIMERMANN," filed August 21, 2001, which is being treated as a petition under 37 CFR 1.47(a).

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

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 21, 2001, without a properly executed oath or declaration. Together with the filing of the application, applicant filed the instant petition under 37 CFR 1.47(a), to have joint inventor Stephen Danforth make the application for patent on behalf of joint inventor Scott A. Heimermann. The declaration appeared to have been executed by both Danforth and Heimermann. However, as detailed in the petition, the signature of Heimermann was actually made by his wife, Joan Heimermann.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition does not satisfy requirements (1), (2), (3), or (4).

As to requirement (1), there has been no showing that Scott A. Heimermann was presented with the application papers (specification, claims, drawings, oath or declaration). Regarding this, the Manual of Patent Examining Procedure states:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.
>
> It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 U.S.P.Q. 80 Comm'r Pat. 1956).

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.[1] Petitioner stated that Heimermann wrote a letter in which he directed petitioner to send the application papers to Joan Heimermann. However, petitioner has not presented a copy of the letter on petition. On renewed petition, petitioner will need to present a copy of this letter from Scott A. Heimermann, evidencing his refusal to accept the application papers, or else must forward him a copy of the application papers.

As to requirement (2), petitioner has not submitted a proper 37 CFR 1.63 declaration. Where at least one joint inventor has signed a declaration, the signature block for the nonsigning inventors should be left **blank**. Such a declaration will be treated as having been signed by available joint inventor

---

[1] MPEP 409.03(d).

Danforth on behalf of non-signing inventor Heimermann.[2]

As to requirement (3), petitioner has not submitted the petition fee of $130. On renewed petition, petitioner must submit this fee.

As to requirement (4), petitioner must state the last known address of non-signing inventor Heimermann. This address should be the last known address at which Heimermann customarily receives mail.[3]

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

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

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

cc: Stephen Danforth
970 Pickett Street
North 147636
Bayport, MN 55003-1490

---

[2] See MPEP 409.03(a).

[3] See MPEP 409.03(e).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

SCOTT A HEIMERMANN
C/O JOAN HEIMERMANN
WEST 3124 HICKORY HILLS ROAD
CHILTON WI 53014-9767

COPY MAILED

DEC 0 3 2003

OFFICE OF PETITIONS

In re Application of Scott Heimermann and Stephen Danforth Application No. 09/934,411 Filed: August 21, 2001 Title: FULLY AUTOMATED, REQUISITION-DRIVEN, COMPETING AUTHORIZED SUPPLIERS, WEB SITE-BASED, REAL-TIME, REVERSE-AUCTION, CENTRALIZED E-PROCUREMENT SYSTEM FOR GOVERNMENT, WITH BIFURCATED INTERNAL AND EXTERNAL MODULES, REQUISITION POOLING, ORDER FORMULATION AND MANAGEMENT, CONSOLIDATED IN-BOUND SHIPMENT AND DISTRIBUTED J.I.T. DELIVERY, PROCUREMENT-NEEDS PREDICTION, CENTRALIZED CATALOG MANAGEMENT AND NUMEROUS ADDITIONAL FEATURES	DECISION NOTING JOINDER OF INVENTOR AND PETITION UNDER 37 CFR 1.47(A) MOOT

This is in response to the "Request by Joint Inventors Scott A. Heimermann and Stephen Danforth for Reconsideration of Decision Refusing Status Under §1.47(a)," filed December 1, 2003 (Certificate of Mailing dated November 24, 2003).

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

The above-identified application was filed on August 21, 2001, with a declaration bearing signatures for joint inventors Scott A. Heimermann and Stephen Danforth. Together with the filing of the application, applicant filed a petition to have joint inventor Stephen Danforth make the application for patent on behalf of joint inventor Scott A. Heimermann. Because the petition stated that Heimermann could not sign the declaration and could not be reached, it was concluded that Heimermann himself did not sign the declaration, but rather it was executed

by his wife, Joan Heimermann. The petition was dismissed in a decision mailed on October 16, 2003.

On renewed petition, petitioner states that the application as originally filed was properly executed by both of the joint inventors. In other words, Joan Heimermann did not sign the application on behalf of Scott A. Heimermann. According to petitioner, the petition to have one joint inventor make the application for patent on behalf of the other joint inventor was mistakenly filed with the application papers.

The Office is relying upon applicants' duty of candor and good faith. As set forth in 35 U.S.C. 1001, any willful false statements may jeopardize the validity of this application or any patent issued thereon.

In view of the **joinder** of the inventors, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered to be **moot**. This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this Office for further consideration under 37 CFR 1.47(a).

Applicants are reminded that unless a proper power of attorney or agent is filed, or unless there is an assignee of the entire interest, and such assignee has taken action in the case pursuant to 37 CFR 3.71, all papers submitted to the Office will need to carry the signatures of both inventors.

The application is being forwarded to Technology Center 3600, Group Art Unit 3644, for examination in due course.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

COPY MAILED

JUL 23 2002

OFFICE OF PETITIONS

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

In re Application of
Joseph Landman, Haruna Cofer,
Roberto Gumperis, Dimitri Mikhailov
Application No.09/934,443
Filed: August 20, 2001
Attorney Docket No.499.714US1

DECISION GRANTING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed April 17, 2002.

The petition is GRANTED.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the affidavit of William K. Rue attest a copy of the application was mailed via federal express to the non-signing inventor. Rule 47 applicant received confirmation via e-mail of receipt of the application papers. The non-signing inventor's failure to respond to the application sufficiently establishes that the inventor refuses to execute the application papers. Rule 47 applicant also received a phone call from William F. Kolakowski, attorney for non-signing inventor Landman, indicating inventor Landman would not execute the application papers.

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

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

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

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

Paper No. 9

Joseph I. Landman
2433 Woodmont East
Canton, Michigan 48188

William F. Kolakowski
Dykema Gossett
39577 Woodward Avenue, Suite 300
Bloomfield Hills, Michigan 48304-2820

COPY MAILED

JUL 23 2002

OFFICE OF PETITIONS

In re Application of
Joseph Landman, Haruna Cofer,
Roberto Gumperis, Dimitri Mikhailov
Application No.09/934,443
Filed: August 20, 2001
Attorney Docket No.499.714US1

LETTER

Dear Mr. Landman:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. 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

cc: Joseph P. Mehrle
Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
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
www.uspto.gov

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

COPY MAILED

SEP 27 2005

OFFICE OF PETITIONS

In re Application of :
William L. Stebbings, et al. :
Application No. 09/934,450 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No.: 55959US005 :
:

This is a decision on the petition, filed September 22, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 23, 2004, using a Certificate of Mailing or Transmission under 37 CFR 1.8 dated April 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 3761 for further processing of the request for continued examination under 37 CFR 1.114 filed on September 23, 2005.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MENDEL 2 C/O MOFO SF
425 MARKET STREET
SAN FRANCISCO, CA 94066

COPY MAILED

JUN 09 2006

OFFICE OF PETITIONS

In re Application of :
Adam et al. :
Application No. 09/934,455 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. :
MBI-0025 :

This is a decision on the Petition to Accept Unintentionally Delayed Claim for Benefit Under 37 CFR 1.78(a)(3), filed January 13, 2006, 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 and Supplemental Application Data Sheet (ADS) filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.
>
> The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title and ADS, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon.

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 Derek Woods at (571) 272-3232.

This application is abandoned. Therefore, the Office will take no further action on this case.

Frances Hicks
Lead Paralegal
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/934,455	08/22/2001	1638	2190	MBI-0025		70	8

CONFIRMATION NO. 7159

47334
MENDEL 2 C/O MOFO SF
425 MARKET STREET
SAN FRANCISCO, CA 94066

CORRECTED FILING RECEIPT

OC000000018711417

Date Mailed: 05/08/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Luc Adam, Hayward, CA;
James Keddie, San Mateo, CA;
Robert Creelman, Castro Valley, CA;
Jose Luis Riechmann, Oakland, CA;
Cai-Zhong Jiang, Freemont, CA;
Jaqueline Heard, San Mateo, CA;
Marsha L. Pilgrim, Freemont, CA;
Arnold Dubell, San Leandro, CA;
Oliver Ratcliffe, Oakland, CA;
T. Lynne Reuber, San Mateo, CA;
Guo-Liang Yu, Berkeley, CA;
Omaira Pineda, Vero Beach, FL;

Power of Attorney: The patent practitioners associated with Customer Number **47550**.

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/227,439 08/22/2000
and is a CIP of 09/837,944 04/18/2001 ABN
and is a CIP of 09/713,994 11/16/2000
which claims benefit of 60/166,228 11/17/1999
and claims benefit of 60/197,899 04/17/2000
and claims benefit of 60/227,439 08/22/2000

Foreign Applications **Acceptable Request to Retrieve Priority Application Received?**

If Required, Foreign Filing License Granted: 10/17/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/934,455

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Genes for modifying plant traits IV

Preliminary Class

800

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

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

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

DUANE MORRIS LLP
IP DEPARTMENT (TSMC)
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

COPY MAILED

JUN 0 8 2006

OFFICE OF PETITIONS

In re Application of :
Lin Cheng : DECISION ON PETITION
Application No. 09/934,549 :
Filed: August 23, 2001 :
Attorney Docket No. TS01-285 :

This is a decision on the PETITION UNDER 37 CFR 1.181(a) REQUESTING WITHDRAWAL OF HOLDING OF ABANDONMENT UNDER M.P.E.P. § 711.03 filed May 2, 2006.

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

The above-identified application became abandoned for failure to file a timely and proper reply to the final Office action mailed July 29, 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 timely filed and no extension of time considered obtained, the application became abandoned effective October 30, 2005. A courtesy Notice of Abandonment was mailed on March 8, 2006.

Applicant requests withdrawal of the holding of abandonment on the basis that a proper response, a Notice of Appeal and a Request for Extension of Time were transmitted by facsimile to the Office on December 30, 2005. In support thereof, applicant submits a copy of the Response, including the facsimile confirmation.

37 CFR § 1.8(b) provides that:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The instant petition was promptly filed within the meaning of 1.8(b)(1), included a copy of the response as petitioner maintains it was originally transmitted on November 30, 2005, and includes a statement attesting to that transmission supported with a copy of the auto-facsimile transmission from the USPTO confirming receipt on November 30, 2005 of the 12-page facsimile. (The appeal fee of $500 and the extension fee of $120 required for timely acceptance of the response were previously made of record with indication of receipt on November 30, 2005).

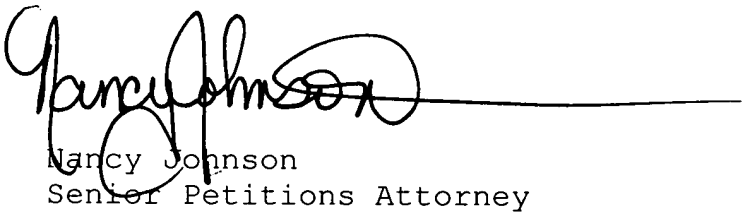
In view thereof, the Notice of Abandonment mailed March 8, 2006 is hereby **vacated**, and the holding of abandonment is **withdrawn**.

No fee is required on petition under § 1.181.

Please be advised that the two-month period for filing an appeal brief (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the mail date of this decision.

Technology Center AU 3637 has been advised of this decision. The application file is, thereby, forwarded to the Technology Center's technical staff to withdraw the holding of abandonment, to process the Notice of Appeal resubmitted on petition filed May 2, 2006, and for the examiner to await filing of applicant's Appeal Brief.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

OK TO ENTER: /J.C./ 01/12/2009

Co/C

OIPE IAP97 OCT 24 2008 PATENT & TRADEMARK OFFICE

Attorney Docket No. 782.1115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Doreen JIANG, et al.

Application No.: 09/934,582

Confirmation No.: 7884

Filed: August 23, 2001

U.S. Patent No.: 7,424,494

Issued: September 9, 2008

ATTENTION

CERTIFICATE OF CORRECTION

BRANCH

For: SYSTEM FOR SYNCHRONIZING VOICE MESSAGING SUBSCRIBER INFORMATION

REQUEST FOR CERTIFICATE OF CORRECTION

Certificate OCT 28 2008 of Correction

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request that a Certificate of Correction be issued in the subject patent, pursuant to 35 U.S.C. §254 and 37 C.F.R. §1.322, to correct the mistakes shown on the attached Form PTO-1050.

Since the mistakes are Patent Office mistakes, it is believed that no fee is required.

Respectfully submitted,

STAAS & HALSEY LLP

Date: October 24, 2008

By: David Pitcher

David M. Pitcher
Registration No. 25,908

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

OCT 28 2008

OK TO ENTER: /J.C./ 01/12/2009

PTO/SB/ 44 (08-00)
Approved for use through 09/30/2000. 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 : 7,424,494

DATED : September 9, 2008

INVENTOR(S) : Doreen JIANG, et al.

First Page, Column 1 (Inventors), Line 7, after "Westford" change "(CA);" to --(MA);--.

Column 15, Lines 23-24, change "messaging," to --messages,--.

Column 16, Line 57, change "telephone" to --telephony--.

Column 17, Line 9, change "telephone" to --telephony--.

Column 18, Lines 5-6, change "first-in-first-out" to --first-in first-out--.

MAILING ADDRESS OF SENDER:
STAAS & HALSEY LLP
1201 New York Ave., N.W.
7th Floor
Washington, DC 20005

PATENT NO. 7,424,494

No. of add'l copies
@ 50¢ per page

⇒

OCT 2 8 2008

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/18/08

TO SPE OF : ART UNIT 2162

SUBJECT : Request for Certificate of Correction for Appl. No.: 09934582 Patent No.: 7424494 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

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

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

X ❑	Approved	All changes apply.
❑	Approved in Part	Specify below which changes do not apply.
❑	Denied	State the reasons for denial below.

Comments: The information provided therein has been considered as to the merits.

Jean M. Corrielus

Art Unit 2162

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE Art Unit

OK TO ENTER: /J.C./ 01/12/2009

Co/C

OIPE IAP97 OCT 24 2008 PATENT & TRADEMARK OFFICE

Attorney Docket No. 782.1115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Doreen JIANG, et al.

Application No.: 09/934,582

Confirmation No.: 7884

Filed: August 23, 2001

U.S. Patent No.: 7,424,494

Issued: September 9, 2008

ATTENTION

CERTIFICATE OF CORRECTION

BRANCH

For: SYSTEM FOR SYNCHRONIZING VOICE MESSAGING SUBSCRIBER INFORMATION

REQUEST FOR CERTIFICATE OF CORRECTION

Certificate OCT 28 2008 of Correction

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request that a Certificate of Correction be issued in the subject patent, pursuant to 35 U.S.C. §254 and 37 C.F.R. §1.322, to correct the mistakes shown on the attached Form PTO-1050.

Since the mistakes are Patent Office mistakes, it is believed that no fee is required.

Respectfully submitted,

STAAS & HALSEY LLP

Date: October 24, 2008

By: David Pitcher

David M. Pitcher
Registration No. 25,908

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

OCT 28 2008

OK TO ENTER: /J.C./ 01/12/2009

PTO/SB/ 44 (08-00)
Approved for use through 09/30/2000. 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 : 7,424,494

DATED : September 9, 2008

INVENTOR(S) : Doreen JIANG, et al.

First Page, Column 1 (Inventors), Line 7, after "Westford" change "(CA);" to --(MA);--.

Column 15, Lines 23-24, change "messaging," to --messages,--.

Column 16, Line 57, change "telephone" to --telephony--.

Column 17, Line 9, change "telephone" to --telephony--.

Column 18, Lines 5-6, change "first-in-first-out" to --first-in first-out--.

MAILING ADDRESS OF SENDER:
STAAS & HALSEY LLP
1201 New York Ave., N.W.
7th Floor
Washington, DC 20005

PATENT NO. 7,424,494

No. of add'l copies
@ 50¢ per page

⇒

OCT 2 8 2008

OK TO ENTER: /J.C./ 01/12/2009

Co/C

OIPE IAP97 OCT 24 2008 PATENT & TRADEMARK OFFICE

Attorney Docket No. 782.1115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Doreen JIANG, et al.

Application No.: 09/934,582

Confirmation No.: 7884

Filed: August 23, 2001

U.S. Patent No.: 7,424,494

Issued: September 9, 2008

ATTENTION

CERTIFICATE OF CORRECTION

BRANCH

For: SYSTEM FOR SYNCHRONIZING VOICE MESSAGING SUBSCRIBER INFORMATION

REQUEST FOR CERTIFICATE OF CORRECTION

Certificate OCT 28 2008 of Correction

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request that a Certificate of Correction be issued in the subject patent, pursuant to 35 U.S.C. §254 and 37 C.F.R. §1.322, to correct the mistakes shown on the attached Form PTO-1050.

Since the mistakes are Patent Office mistakes, it is believed that no fee is required.

Respectfully submitted,

STAAS & HALSEY LLP

Date: October 24, 2008

By: David Pitcher

David M. Pitcher
Registration No. 25,908

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

OCT 28 2008

OK TO ENTER: /J.C./ 01/12/2009

PTO/SB/ 44 (08-00)
Approved for use through 09/30/2000. 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 : 7,424,494

DATED : September 9, 2008

INVENTOR(S) : Doreen JIANG, et al.

First Page, Column 1 (Inventors), Line 7, after "Westford" change "(CA);" to --(MA);--.

Column 15, Lines 23-24, change "messaging," to --messages,--.

Column 16, Line 57, change "telephone" to --telephony--.

Column 17, Line 9, change "telephone" to --telephony--.

Column 18, Lines 5-6, change "first-in-first-out" to --first-in first-out--.

MAILING ADDRESS OF SENDER:
STAAS & HALSEY LLP
1201 New York Ave., N.W.
7th Floor
Washington, DC 20005

PATENT NO. 7,424,494

No. of add'l copies
@ 50¢ per page

⇒

OCT 2 8 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 04 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Belasco, Jacobs & Townsley, LLP
Howard Hughes Center
Los Angeles, CA 90045

Paper No. 5

In re application of
Martin A. Kapp
Application No. 09/934,629
Filed: August 21, 2001
For: INCOME TAX PREPARATION SYSTEM FOR TRAVELING TAXPAYERS

DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)

This is in response to the petition filed on November 21, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/mjz 1/29/04

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

UNITED STATES SURGICAL,
A DIVISION OF TYCO HEALTHCARE GROUP LP
150 GLOVER AVENUE
NORWALK CT 06856

COPY MAILED

SEP 2 1 2005

OFFICE OF PETITIONS

In re Application of	:
Bennett et al.	:
Application No. 09/934,639	: DECISION ON PETITION
Filed: August 22, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 1583 CIP 2 CON 2	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 1, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **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;
(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.

Further, as stated in 37 CFR 1.78(a)(2)(ii), the reference must be submitted during the pendency of the later-filed application. The instant application became abandoned for failure to timely reply to the Office action mailed June 10, 2003. A one-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on August 11, 2003. A Notice of Abandonment was mailed December 24, 2003.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a petition to revive the instant application, along with a renewed petition under 37 CFR 1.78(a)(3), is required. A copy of the outstanding Office action and Notice of Abandonment are enclosed for petitioner's convenience.

The address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

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

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

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

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

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

cc: CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 BROAD HOLLOW ROAD
SUITE 225
MELVILLE, NY 11704

Enclosure: Notice of Non-Responsive Amendment (mailed June 10, 2003)
Notice of Abandonment (mailed December 24, 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

UNITED STATES SURGICAL,
A DIVISION OF TYCO HEALTHCARE GROUP LP
150 GLOVER AVENUE
NORWALK CT 06856

COPY MAILED

OCT 2 6 2005

OFFICE OF PETITIONS

In re Application of	:	
Bennett et al.	:	
Application No. 09/934,639	:	DECISION GRANTING PETITION
Filed: August 22, 2001	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 1583 CIP 2 CON 2	:	

CORRECTED DECISION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 1, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after expiration of the period specified by 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority

under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

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

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

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

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

cc: CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 BROAD HOLLOW ROAD
SUITE 225
MELVILLE, NY 11747

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. 7

Supervisor, Patent Prosecution Services
Piper, Marbury, Rudnick and Wolfe LLP
1200 Nineteenth Street, N. W.
Washington, DC 20036-2412

COPY MAILED

JUN 0 7 2002

OFFICE OF PETITIONS

In re Application of :
Duncan W. McBranch, et al. :
Application No. 09/934,680 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. 8971-017-27 :

This is in response to the petition under 37 CFR 1.47(a), filed March 28, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 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 (1) set forth above.

Petitioner alleges that Michael Egholm refuses to sign the declaration that was twice sent to him. Petitioner has supplied a copy of an e-mail message from Mr. Egholm to David Whitten, the second named inventor, acknowledging receipt of the declaration and assignment. In the e-mail message, Mr. Egholm states he wants to contact Mr. Andy Karnikis, an attorney for Tropix, Inc., to determine if he is able to sign the declaration. According to statements presented in the instant petition, Petitioner contacted Mr. Karnakis who did recall the situation concerning the

declaration and assignment for Mr. Egholm but "could not recall his instructions to Mr. Egholm regarding the same."

Although it is obvious that Mr. Egholm received the declaration and assignment, it is unclear whether Mr. Egholm received a copy of the application papers. MPEP 409.03(d) in pertinent part states:

> "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or if the non-signing inventor is represented by counsel, to the address of record of the non-signing inventor's attorney."

Petitioner must supply a copy of the application papers to Mr. Egholm as required. Upon the filing of a Request for Reconsideration, petitioner must demonstrate that a *bona fide* attempt was made to present the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor. If there is an express written refusal to sign the declaration, a copy of the document evidencing that refusal should be submitted to the USPTO. If the non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration and any documentary evidence to support facts alleged in the affidavit or declaration should be submitted with the reconsideration request.

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

By MAIL:
Assistant Commissioner for Patents
P. O. Box 2327, Mail Stop DAC
Arlington, VA 22202

or

Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

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

By HAND:
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to Marianne Morgan at (703) 306-3475.

Frances Hicks

Frances M. 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. 10

Piper Rudnick, LLP
1200 19th Street, N. W.
Washington, DC 20036-2412

COPY MAILED

AUG 1 2002

OFFICE OF PETITIONS

In re Application of	:	
Duncan W. McBranch	:	DECISION NOTING JOINDER OF
Application No. 09/934,680	:	INVENTOR AND PETITION
Filed: August 23, 2001	:	UNDER 37 CFR 1.47(a) MOOT
Attorney Docket No. 8971-017-27	:	

Papers filed on July 19, 2002 in response to a "Decision Refusing Status Under 37 CFR 1.47(a)" mailed June 7, 2002 included a Declaration signed by a previously non-signing inventor, Michael Egholm, in compliance with 37 CFR 1.63.

The petition is dismissed as moot.

In view of the joinder of the inventor, further consideration under § 1.47(a) is not necessary. This application does not have any Rule 1.47 status and no such status should appear on the file wrappr. This application need not be returned to this Office for any further consideration under 37 CFR 1.47(a).

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

Telephone inquiries should be directed to Marianne Morgan at (703) 306-3475.

Frances Hicks

Frances M. 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

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

COPY MAILED

MAR 20 2006

OFFICE OF PETITIONS

In re Patent No. 6,962,637 :
Issued: November 8, 2005 : LETTER REGARDING PTA AND
Application No. 09/934,694 : NOTICE OF INTENT TO ISSUE
Filed: August 23, 2001 : CERTIFICATE OF CORRECTION
Atty. Dkt. No.: 862.1329 DII :

This letter is in response to the "COMMENTS ON DETERMINATION OF PATENT TERM ADJUSTMENT," filed January 9, 2006. The Office thanks patentees for their good faith and candor in bringing this to our attention.

The above-identified application matured into U.S. Pat. No. 6,962,637 on November 8, 2005. The patent issued with a PTA of 187 days. Patentees, however, request review of the PTA determined for the instant patent and state that there appears to be an incorrect number of days determined for USPTO delay and/or for applicants' delay.

A review of the application history for the instant patent reveals that an adjustment of 299 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1).

The patent was previously accorded an adjustment of 11 days under 37 CFR 1.702(a)(4) and 1.703(a)(6). However, review of the application history reveals that the patent timely issued within four months of the date of receipt of the issue fee payment. The issue fee payment was received July 28, 2005 and the patent timely issued within four months on November 8, 2005. Accordingly, the adjustment of 11 days has been withdrawn.

Thus, adjustment of 299 days is properly reduced a total of 123 days for applicants' failure to engage in reasonable efforts to conclude prosecution.

In view thereof, at the time of issuance, the application was entitled to 176 days of PTA.

As applicants are advising us of a potential error in providing too much patent term adjustment in this application, no fee is due in connection to this matter.

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 176 days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	6,962,637 B2
DATED	:	November 8, 2005
INVENTOR(S)	:	Takeuchi, 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 187 days

Delete the phrase "by 187 days" and insert – by 176 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.

FITZPATRICK CELLA HARPER &
SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

COPY MAILED
NOV 29 2006
OFFICE OF PETITIONS

In re Patent No. 7,106,452 :
Ouchi :
Issue Date: September 12, 2006: LETTER REGARDING
Application No. 09/934,713 : PATENT TERM ADJUSTMENT
Filed: August 23, 2001 :
Atty Docket No. 35.G2873 :

This is in response to the "COMMENTS ON DETERMINATION OF PATENT TERM ADJUSTMENT," filed November 1, 2006. Patentee requests review of the Patent Term Adjustment (PTA) determined for the above-identified patent.

The request is **DISMISSED**.

Patentee is given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136(a).

Patentee is advised that § 1.705(d) provides the avenue before the Office for requesting reconsideration of the revised patent term adjustment indicated in the patent. See § 1.702-1.705. Moreover, pursuant to § 1.705(b), this section requires payment of:

(1) The fee set forth in § 1.18(e) ...

The instant paper was timely filed within two months of the issuance of the patent. However, neither the fee under § 1.18(e) nor a general authorization to charge any required fees, accompanied the request. Rather, petitioner states that "Should it be deemed that Patentee is entitled to the PTA that is greater than that noted on the cover page of the patent, if permitted under 37 C.F.R. § 1.705(d), the Commissioner is authorized to charge the fee required for increasing the PTA to

Deposit Account No. 06-1205." As payment of the fee is a prerequisite to consideration of the request for reconsideration of patent term adjustment, this authorization is insufficient. It does not freely authorize payment prior to consideration. Accordingly, the request is dismissed for failure to comply with the requirement of paragraph (b)(1) to submit the fee under § 1.18(e).

It is further noted that the request for review does not include a statement of the facts involved. (Nor does patentee indicate that the instant paper is being filed pursuant to their duty of candor and good faith to the Office).

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

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

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

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

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
09/934,756	08/23/2001	Kazunari Sakata	33082M098	8726

7590 06/03/2005

Smith, Gambrell & Russell, LLP
Beveridge, DeGrandi, Weilacher & Young
Intellectual Property Group
1850 M Street, N.W., Suite 800
Washington, DC 20036

EXAMINER	
LU, JIPING	

ART UNIT	PAPER NUMBER
3749	

DATE MAILED: 06/03/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 05192005

In re Application of SAKATA ET AL.
Appl No.: 09/934,756
Filed: August 23, 2001
For: VERTICAL HEAT TREATMENT SYSTEM, METHOD FOR CONTROLLING VERTICAL HEAT TREATMENT SYSTEM AND METHOD FOR TRANSFERRING OBJECT TO BE TEATED

DECISION GRANTING PETITION
37 CFR 1.48(b)

This is a decision on the petition filed 9/7/2004 to correct inventorship under 37 CFR 1.48(b).

The petition is granted.

The inventorship in this application has been corrected to delete KAZUNARI SAKATA and SHINYA MOCHIZUKI and MOTOKI AKIMOTO and HIROSHI MOTONO.

Jiping Lu
Primary Examiner,
Art Unit 3749
Technology Center 3700

SMITH, GAMBRELL & RUSSELL, LLP
1850 M STREET, N.W., SUITE 800
WASHINGTON, D.C. 20036

UNITED STATES
PATENT AND
TRADEMARK OFFICE

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

APR 16 2002

MANDEL & ADRIANO
35 NORTH ARROYO PARKWAY
SUITE 60
PASADENA CA 91103

#10

In re Application of	:
Robert E. Reiter et al	:
Serial No.: 09/934,773	: PETITION TO MAKE SPECIAL
Filed: August 21, 2001	:
Attorney Docket No.: 30435.54USD3	:

This is in response to applicants' petition filed February 13, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, X. Therefor the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

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

UNITED STATES 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 22 2006

Technology Center 2100

M. ROBERT KESTENBAUM
11011 BERMUDA DUNES NE
ALBUQUERQUE, NM 87111

In re Application of: Wagner, et al.
Application No. 09/934,817
Attorney Docket No. (Z) 98003 P US
Filed: March 21, 2001
For: OPTICAL ARRANGEMENT AND PROJECTION EXPOSURE SYSTEM FOR MICROLITHOGRAPHY WITH PASSIVE THERMAL COMPENSATION

SUA SPONTE
WITHDRAWAL OF HOLDING OF ABANDONMENT

A review of the application reveals that a Notice of Abandonment was mailed to the applicant on May 23, 2006. The notice incorrectly indicated that the instant application was being held abandoned for failure to respond to the Non-Final Office communication (mailed on November 14, 2005). A timely filed amendment with a three-month extension of time (37 CFR § 1.136(a)) was filed on May 15, 2006 bearing a certificate of facsimile transmission of May 15, 2006 (May 14, 2006 being a Sunday). Accordingly, the amendment/response was timely filed. The amendment, response and extension of time are currently located in the application file. The Office regrets any inconvenience this may have caused.

In view of these facts, the abandonment of the application was clearly in error and is hereby **VACATED**.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to **WITHDRAW** the holding of abandonment, restore the instant application to pending status and to process the amendment filed May 15, 2006. The application will then be forwarded to the Examiner of record for prompt action on the merits.

Inquiries to this decision may be directed to Special Programs Examiner Brian Johnson at (571) 272-3595.

Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

JAN 21 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Application of :
Hideo ANDO, et al. :
Application No. 09/934,827 :
Filed: August 23, 2001 :
For: **INFORMATION RECORDING MEDIUM, INFORMATION RECORDING METHOD AND APPARATUS, AND INFORMATION PLAYBACK METHOD AND APPARATUS** :

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition filed November 15, 2004 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 petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being 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
DIW Aug-06

HOGAN & HARTSON LLP
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES CA 90071-2611

COPY MAILED

AUG 0 7 2006

OFFICE OF PETITIONS

In re Application of :
Makishima et al. :
Application No. 09/934,870 :
Filed: 21 August, 2001 :
Atty Docket No. 83357.0001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed on 20 June, 2006, to change the order of the names of the inventors.

The petition is **granted**.

The order of the names of the inventors will be changed as follows:

1. Yoji Makishima

2. Masaki Tatemori

A corrected filing receipt reflecting the correct order of the names of the inventors is attached.

This application is being referred to Technology Center 2614 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

Encl: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/934,870	08/21/2001	2614	595	83357.0001	15	9	4

CONFIRMATION NO. 9269

CORRECTED FILING RECEIPT

OC000000019914647

26021
HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

Date Mailed: 08/07/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Yoji Makishima, Tokyo, JAPAN;
Masaki Tatemori, Tokyo, JAPAN;

Assignment For Published Patent Application

Yoji MAKISHIMA

Power of Attorney: The patent practitioners associated with Customer Number **26021**.

Domestic Priority data as claimed by applicant

Foreign Applications

JAPAN 2000-251864 08/23/2000
JAPAN 2001-157471 05/25/2001
If Required, Foreign Filing License Granted: 09/24/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/934,870

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

ALL-FREQUENCY-BAND SSB RADIO COMMUNICATION SYSTEM AND RADIO APPARATUS

Preliminary Class

455

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

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

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

NOT GRANTED

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/27/09

TO SPE OF : ART UNIT 2455

SUBJECT : Request for Certificate of Correction for Appl. No.: 09934884 Patent No.: 7490161 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: The changes on Page 3 of 3 apply to Column 14, Claim 45 and not Column 13, Claim 45.

Therefore, please change "in Column 13, Claim 45" to "In Column 14, Claim 45".

All other changes are acceptable.

Thank you,

Shawki Ismail

AU 2455

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/saleh najjar/ SPE

SPE

2455

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

MICHAEL BEST & FRIEDRICH LLP
3773 CORPORATE PARKWAY
SUITE 360
CENTER VALLEY PA 18034-8217

MAILED

OCT 17 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re Application of
Joseph F. Kenney Jr.
Application No. 09/934,906
Filed: August 22, 2001
For: THRUST BEARING ASSEMBLY WITH PRELOAD SPRING

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

This is in reply to applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on July 15, 2003..

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely respond to the Office action dated November 8, 2002.

Any petition to withdraw the holding of abandonment based upon a Certificate of Transmission must include the following requirements:
(1) A copy of a response bearing a signed Certificate of Transmission which includes the date of signing; and
(2) A statement attesting to the personal knowledge of transmitting the response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

In response to a Notice of Abandonment dated June 16, 2003, the applicant submitted the instant petition. Applicant's petition indicates that on February 10, 2003 applicant faxed a response to the Office and provides a copy of the submission showing a Certificate of Transmission dated February 10, 2003.

However, a statement attesting to the personal knowledge of transmitting the response on the date indicated on the certificate, by the person who signed the certificate, in this case Mary A. Azzolina, is required.

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."

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Ken Dorner at (703) 308-0866

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/ekn 10/9/03

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

MAILED

MICHAEL BEST & FRIEDRICH LLP
3773 CORPORATE PARKWAY
SUITE 360
CENTER VALLEY, PA 18034-8217

FEB 18 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re Application of
Joseph F. Kenney Jr.
Application No. 09/934,906
Filed: August 22, 2001
For: THRUST BEARING ASSEMBLY
WITH PRELOAD SPRING

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to applicant's renewed petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on December 18, 2003..

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

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on February 10, 2003. and supported by a statement under 37 C.F.R. 1.8(b)(3).

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

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

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

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

cps/2/14/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

GIDEON GIMLAN
FLIESLER DUBB MEYER & LOVEJOY LLP
FOUR EMBARCADERO CENTER, SUITE 400
SAN FRANCISCO, CA 94111-4156

COPY MAILED

MAR 1 1 2002

OFFICE OF PETITIONS

In re Application of
David Grawrock et al.
Application No. 09/934,926
Filed: August 21, 2001
For: UNIFIED PERMISSIONS CONTROL FOR REMOTELY AND LOCALLY STORED FILES WHOSE INFORMATIONAL CONTENT MAY BE PROTECTED BY SMART-LOCKING AND/OR BUBBLE-PROTECTION

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

This is in response to the petition under 37 CFR 1.47(a), filed December 27, 2001.

The petition is granted.

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

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

Office records have been corrected to reflect the correction of the second inventor's name. A corrected filing receipt accompanies this decision.

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

This application is being forwarded to Technology Center 2100.

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

Attachment: corrected filing receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PAUL R. SPEAR
P.O. BOX 55
YAMHILL, OREGON 97148

COPY MAILED

MAR 1 1 2002

OFFICE OF PETITIONS

In re Application of
David Grawrock; Cameron W. Cotrill; Paul R. Spear; Paul Puttonen
Application No. 09/934,926
Filed: August 21, 2001
For: UNIFIED PERMISSIONS CONTROL FOR REMOTELY AND LOCALLY STORED FILES WHOSE INFORMATIONAL CONTENT MAY BE PROTECTED BY SMART-LOCKING AND/OR BUBBLE-PROTECTION

Dear Mr. Spear:

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 Irvin Dingle at (703) 306-5684. 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
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Gideon Gimlan
Fliesler, Dubb, Meyer & Lovejoy LLP
Four Embarcadero Center, Suite 400
San Francisco, CA 94111-4156

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DINSMORE & SHOHL LLP
ONE DAYTON CENTRE
ONE SOUTH MAIN STREET SUITE 500
DAYTON, OH 45402-2023

COPY MAILED

OCT 29 2004

OFFICE OF PETITIONS

In re Application of :
Asher, Richard E. :
Application No. 09/934,936 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. RED 0001 PE/31805.1 :

This is a decision on the petition under 37 C.F.R. § 1.182, filed September 16, 2004, to change the name of an inventor.

The petition is **GRANTED.**

The name will be changed from Richard Ernest **MILHEM** to Richard Ernest **ASHER**.

Telephone inquiries regarding this decision should be directed to Paralegal Liana Chase at (571) 272-3282.

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

MARSHALL & MELHORN
FOUR SEAGATE, EIGHTH FLOOR
TOLEDO, OH 43604

COPY MAILED

NOV 2 2 2005

OFFICE OF PETITIONS

In re Patent No. 6,786,562 :
Issue Date: September 7, 2004 :
Application No. 09/934,943 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket Number: 1-15090 :

This is a decision regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 22, 2005.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. 154 F.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted and the petition is **GRANTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

This file is being forwarded to the Files Repository.

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

Paper No. 10

MORGAN & FINNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK NY 10154

COPY MAILED

JUN 12 2003

OFFICE OF PETITIONS

In re Application of :
Takeuchi & Unno :
Application No. 09/934,947 : DECISION ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. 1232-4756 :
For: OPTICAL ELEMENT AND
MANUFACTURING METHOD THEREOF

This is a decision on the petition under 37 CFR 1.182 filed June 5, 2003 (certificate of mailing date June 2, 2003), to change the order of inventorship.

The petition is GRANTED.

The first named inventor is now Seiji Takeuchi. A replacement filing receipt is enclosed.

After the mailing of this decision, the application file will be forwarded to Technology Center 1700.

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

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

enclosure: replacement 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

LAW OFFICES OF JOHN E. WAGNER
3541 OCEAN VIEW BLVD
GLENDALE CA 91208

COPY MAILED

SEP 2 8 2005

OFFICE OF PETITIONS

In re	:	
Charles A. Finn	:	
Application No. 09/934,967	:	DECISION ON APPLICATION
Filed: August 22, 2001	:	FOR PATENT TERM ADJUSTMENT
Patent No. 6,899,636	:	
Issued: May 31, 2005	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b)", filed July 29, 2005, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The application for patent term adjustment is **DISMISSED**.

Patentee is given **two (2) months** to respond to this decision. No extensions of time will be granted under 37 C.F.R. § 1.136(a).

On May 31, 2005, the above-identified application matured into U.S. Patent No. 6,899,636. The patent issued with a PTA of twenty-five (25) days.

It appears that Patentee asserts entitlement to a PTA of six hundred thirty-nine (639) days. Patentee states that a "reasonable period for prosecution of this application would be no more than 24 months so that a proper and equitable term extension should be 21 months, 9 days."

Patentee states that the patent is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of twenty-five (25) days based on an adjustment for PTO delay of two hundred eighty-two (282) days pursuant to 35 U.S.C. 154(b)(1)(B) and 37 C.F.R. § 1.703(b), reduced by Applicants' delays of three (3), thirty-six (36), sixty-three (63), and eighty-three (83) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and seventy-two (72) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. 1.704(c)(8).

Patentee argues he should not have been assessed applicant delay for the untimely filing of amendments after two separate final Office actions, because the Examiner withdrew both final rejections. Patentee's argument is untimely raised, as this argument should have been made with an application for patent term adjustment pursuant to 37 C.F.R. § 1.705(b), submitted after the mailing of the Notice of Allowance and prior to payment of the issue fee.

With respect to the seventy-two (72) days of applicant delay assessed pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(c)(8), the adjustment has been reviewed and found to be correct. The Notice of Allowance was mailed on January 11, 2005. Applicant filed a supplemental declaration on March 21, 2005. By Official Gazette Notice dated June 26, 2001, the Director has advised applicants and patentees that the filing of certain papers after the mailing of a Notice of Allowance will be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will result in reduction of a patent term adjustment pursuant to 37 C.F.R. § 1.704(c)(10).[1] An oath or declaration is listed as an example of a paper that is considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application.

Receipt of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. Patentee's request for a refund of the fee is denied.[2]

---

[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, 1247 OG 111 (June 26, 2001).

[2] See Comment 1 in Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000) (stating that the fee set forth in 37 C.F.R. 1.18(e) is charged to allow the Office to recover the estimated average cost of treating applications for patent term adjustment, and is not refundable even in the event of Office error).

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH VA 22042-2924

COPY MAILED

NOV 23 2005

OFFICE OF PETITIONS

In re Application of :
Jose L. Boyer, et al. :
Application No. 09/934,970 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No.: 03678.0064.CPUS01 :
:

This is a decision on the petition, filed June 1, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 12, 2005, in the above-identified application, cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 1623 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

MAIL

DEC 04 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY CA 94704-0778

In re Application of:
Guy Cote et al
Application No.: 09/934,975
Filed: August 21, 2001
For: **RATE CONTROL METHOD FOR VIDEO TRANSCODING**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed November 5, 2002.

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

The signer of the petition, William J. Plut, is not appointed as an attorney or agent of record since the petitioner's limited recognition under 37 CFR 10.9(b) expired June 10, 2002.
For the above stated reasons, the request is **DISMISSED AS MOOT**.

All future communications from the Office will continue to be directed to the above-listed address unless the Office receives proper notification of a change in Power of Attorney and/or correspondence address.

Kusta Zele
Special Program Examiner
Technology Center 2600
Communications & Information Processing
(703) 305-4701

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALCATEL USA
INTELLECTUAL PROPERTY
DEPARTMENT
3400 W. PLANO PARKWAY, MS LEGL2
PLANO, TX 75075

MAIL

MAY 1 1 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re application of:
Naim et al.
Application No. 09/934,987
Filed: August 22, 2001
For: SYSTEM AND METHOD FOR PROVIDING HYBRID VOICE AND PACKET DATA SERVICES TO A MOBILE TELECOMMUNICATIONS DEVICE

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 January 14, 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.

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

All attorneys/agents listed in the withdrawal have been withdrawn.

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

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

cc: Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY CA 94704-0778

MAIL

FEB 1 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Lowell Winger
Application No.: 09/934,992
Filed: August 21, 2001
For: **SYSTEM AND METHOD FOR REDUCED CODEBOOK VECTOR QUANTIZATION**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed November 5, 2002.

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

The signer of the petition, William J. Plut, is not appointed as an attorney or agent of record since the petitioner's limited recognition under 37 CFR 10.9(b) expired June 10, 2002.
For the above stated reasons, the request is **DISMISSED AS MOOT**.

All future communications from the Office will continue to be directed to the above-listed address unless the Office receives proper notification of a change in Power of Attorney and/or correspondence address.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS MN 55440-1022

COPY MAILED

JUL 20 2005

OFFICE OF PETITIONS

In re Patent No. 6,879,327	:	DECISION ON
Mathur, et al.	:	PATENT TERM ADJUSTMENT
Issue Date: April 12, 2005	:	AND
Application No. 09/935,006	:	NOTICE OF INTENT
Filed: August 21, 2001	:	TO ISSUE
Attorney Docket No. 07844-486001	:	CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed May 23, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from one hundred ninety-two (192) days to two hundred sixty-six (266) days.

The petition 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 **two hundred fifty-six (256)** days.

On April 12, 2005, the above-identified application matured into U.S. Patent No. 6,879,327. The instant request for reconsideration filed May 23, 2005 was timely filed within two months of the date the patent issued. See § 1.705(d). The Patent issued with a Patent Term Adjustment of one hundred ninety-two (192) days. Patentee states that the determination of patent term adjustment days should not have been assessed applicant delay of seventy-four (74) days for the submission of a "COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE", filed on January 10, 2005.

The adjustment of seventy-four (74) days for the filing of a "COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE" has been found to be incorrect.[1] Accordingly, applicant delay with respect to this filing should have been zero (0) days.

However, applicant was improperly assessed delay of nineteen (19) days for the filing of a Rule 312 Amendment, also filed on January 10, 2005. Pursuant to 37 C.F.R. § 1.704(c)(10)(i), the number of days of delay assessed should be the number of days "beginning on the date the amendment under 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under 1.312 or such other paper." Here, a Supplemental Notice of Allowability and Response to Rule 312 Communication were mailed on February 7, 2005. Accordingly, applicant delay of twenty-nine (29) days should have been assessed for the filing of the Rule 312 Amendment, not nineteen (19) days.

In view thereof, the correct determination of PTA at the time of issuance is two hundred fifty-six (256) days (347 days of PTO delay, reduced by 91 (29+29+33) 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 **two hundred fifty-six (256)** 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO CA 94303

COPY MAILED

MAR 2 2 2006

OFFICE OF PETITIONS

In re Application of :
Lichtenstein et al. :
Application No. 09/935,016 :
Filed: August 21, 2001 :
Attorney Docket No. PA1686US :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed April 19, 2005, to change the order of the names of the inventors.

The petition is **granted**.

The Office of Petitions has changed the order of the names of the inventors in the USPTO computer records and printed a new bibliographic data sheet, which will be scanned into the Image File Wrapper.

A corrected filing receipt, reflecting the requested change, accompanies this decision.

Petitioners authorized the Office to charge the Deposit Account for a $130.00 petition fee, as well as any necessary fees. The current fee for filing a petition under 37 CFR 1.182 is $400.00. Thus, the Office will charge petitioners' Deposit Account in the amount of $400.00, as authorized.

This matter is being referred to the Office of Patent Publication.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

ARLEN L. OLSEN
SCHMEISER, OLSEN & WATTS
3 LEAR JET LANE
SUITE 201
LATHAM, NY 12110

COPY MAILED

FEB 17 2006

OFFICE OF PETITIONS

In re Application of :
Berry, et al. :
Application No. 09/935,077 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. END920010035US1 :

This is a decision on the petition under 37 CFR 1.181, filed October 13, 2005, to withdraw the holding of abandonment. The petition was recently forwarded to this office for review.

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the non-final Office action mailed March 24, 2004. Accordingly, this application became abandoned on June 25, 2004. A Notice of Abandonment was mailed on March 24, 2005.

Petitioner asserts the Office action was never received and that the Office mailed the action to the wrong address. A review of the application file indicates that the Office action was mailed to an incorrect address. The Office sincerely apologizes for this error.

Accordingly, the petition is granted and the holding of abandonment is withdrawn.

This application is being forwarded to Technology Center 2100, for review of the amendment filed October 13, 2005, *in due course*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW May-07

CHRISTOPHER C. WINSLADE
MCANDREWS HELD & MALLOY
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

COPY MAILED

MAY 22 2007

OFFICE OF PETITIONS

In re Application of	:	
Jyothis Indirabhai	:	DECISION ON PETITION TO
Application No. 09/935,082	:	WITHDRAW HOLDING OF
Filed: 08/21/2001	:	ABANDONMENT
Attorney Docket No. WIDC-026/00US	:	

This is a decision on the petition filed on 16 March, 2007, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the final Office action mailed on 27 December, 2005, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on 17 January, 2007.

Petitioner asserts that the Notice mailed on 27 December, 2005, was not received because it was returned to the USPTO as undeliverable. In particular, petitioner notes that the envelope containing the Office action was stamped "INSUFFICIENT ADDRESS" by the USPS.

In the absence of any irregularity in the mailing of the final Office action, there is a strong presumption that the final Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that

the final Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the final Office action may have been lost after receipt rather than a conclusion that the final Office action was lost in the mail.

A review of the official file reveals that on 13 September, 2004, a revocation and new power of attorney and change of correspondence address was filed, listing the correspondence address as "Christopher C. Winslade, McAndrews, Held & Malloy, 500 W. Madison Street, Suite 3400, Chicago, IL 60661." However, the final Office action mailed on 27 December, 2005, listed the address as "Christopher C Winslade, McAndrews, Hel & Malloy, Suite 3400, Chicago, IL 60661". Furthermore, the Office communication mailed on 27 December, 2005, was returned to the USPTO as undeliverable on 17 January, 2006. As such, the showing of record is that there was an irregularity in the mailing of the Office action mailed on 27 December, 2005, in that said final Office action was not mailed to the proper address.

The Office apologizes for any inconvenience to petitioner.

Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Counsel's address has been corrected in Office records.

The petitioner has made a sufficient showing of nonreceipt of the Office action. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

As such, the holding of abandonment is **withdrawn**. The application is restored to pending status.

The petition is **GRANTED.**

The application file is being referred to Technology Center 2600 technical support staff for remailing of the Office action mailed on 27 December, 2005. The period for reply will be reset from the mailing date thereof.

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

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

CHRISTOPHER C. WINSLADE
MCANDREWS HELD & MALLOY
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

Mail Date: 05/05/2010

Applicant	: Jyothis Indirabhai	: DECISION ON REQUEST FOR
Patent Number	: 7650158	: RECALCULATION of PATENT
Issue Date	: 01/19/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 09/935,082	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/21/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2079** 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

HANLEY, FLIGHT & ZIMMERMAN, LLC
150 S. WACKER DRIVE
SUITE 2100
CHICAGO IL 60606

COPY MAILED
SEP 19 2008

In re Application of	:	
Harry Tang	:	
Application No. 09/935,092	:	ON PETITION
Filed: August 22, 2001	:	
Attorney Docket No. BELL-0099/00164 CIP	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 12, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely to submit corrected formal drawings on or before April 24, 2007, as required by the Notice to File Corrected Application Papers, mailed February 23, 2007, which set a statutory period for reply of sixty (60) days. Accordingly, the application became abandoned on April 25, 2007. The Notice of Abandonment was mailed April 25, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) corrected formal drawings, (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay.

A power of attorney has been submitted on September 11, 2008 changing the address of record. The address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

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

Chris Bottorff
Petitions Examiner
Office of Petitions

cc: **LEE & HAYES, PLLC**
421 W. RIVERSIDE AVE.
SUITE 500
SPOKANE WA 99201

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

AUG 0 8 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Law 4 IP
Noreen O'Hara Welch
94 Eldrid Drive
Silver Spring, MD 20904-2912

Paper No. 4

In re application of : **DECISION ON PETITION**
Todd Robert Colas et al. : **TO MAKE SPECIAL**
Application No. 09/935,120 : **(ACCELERATED**
Filed: August 22, 2001 : **EXAMINATION)**
For: ELECTRONIC ADVERTISEMENT SYSTEM AND METHOD :

This is in response to the petition filed on July 1, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

The petition filed July 1, 2002 fails to adequately meet requirement (C) above. A specific listing of the field of search used in the pre-examination search is required.

For the above stated reasons, the petition is DISMISSED.

Petitioner is given one more opportunity to perfect the petition. 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 respond in writing to the earlier telephonic requests of the examiner to make an election without traverse.

SUMMARY: Petition to Make Special **DISMISSED**.

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.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

snm/snm: 8/4/02

MAILED

SEP 1 2 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

Law 4 IP
Noreen O'Hara Welch
94 Eldrid Drive
Silver Spring, MD 20904-2912

Paper No. 6

In re application of
Todd Robert Colas et al
Application No. 09/935,120
Filed: August 22, 2001
For: ELECTRONIC ADVERTISEMENT SYSTEM AND METHOD

: **DECISION ON RENEWED**
: **PETITION TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on August 12, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

A petition to make special was filed on July 1, 2002. That petition was dismissed in a decision mailed August 8, 2002 wherein it was held that the petition lacked a listing of the field of search performed. The renewed petition supplies the field of search.

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**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

kjd: 9/5/02

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
FROM DIRECTORS OFFICE
FEB 03 2005
TECHNOLOGY CENTER 3600

Noreen O'Hara Welch
Stevens, Davis, Miller & Mosher LLP
1615 L Street, NW
Suite 850
Washington, DC 20036

In re Application of :
Todd Robert Colos et al. :
Application No. 09/935,120 :
Filed: August 28, 2001 :
For: ELECTRONIC ADVERTISEMENT SYSTEM AND METHOD :

DECISION ON PETITION UNDER 37 C.F.R. 1.181 TO REMOVE FINAL STATUS

This is in response to applicant's Petition filed on October 27, 2004, requesting withdrawal of the finality of the Office action mailed October 12, 2004 as being premature.

The petition is **DISMISSED AS MOOT.**

Petitioner alleges that the final rejection dated October 12, 2004 was premature since this Office action contained a new grounds of rejection not necessitated by applicant's amendment to the claims.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97 (c) with the fee set forth in 37 C.F.R. 1.17(p).

A review of the record indicates that in response to applicants after final submission dated December 13, 2004, the examiner has already withdrawn finality of the Office action and issued a new, non-final rejection on January 11, 2005.

Summary: ***Petition Dismissed as Moot***

John J. Love, Director
Patent Technology Center 3600
(703) 308-1020
Facsimile No.: (703) 306-4597
EWS 1/24/05

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

Kevin J. Zilka
Silicon Valley IP Group
P.O. Box 721120
San Jose, California 95172-1120

MAIL

NOV 0 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Limor SCHWEITZER, et al.
Application No. 09/935,129
Filed: August 21, 2001
For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR REPORTING IN A NETWORK-BASED FILTERING AND AGGREGATING PLATFORM

DECISION ON PETITION TO MAKE SPECIAL UNDER M.P.E.P. §708.02(II): INFRINGEMENT

This is a decision on the petition, filed September 24, 2001, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. §1.102(d), and M.P.E.P. §708.02, Section II, must be accompanied by payment of the fee under 37 C.F.R.§1.117(i) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a ***rigid comparison*** of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are **unquestionably infringed**: and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. Applicant must provide one copy of each of the ***references deemed most closely related*** to the subject matter encompassed by the claims.

Applicant's submission meets all the criteria set out above. Accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for expedited examination.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 54

Kevin J. Zilka
Silicon Valley Intellectual Property Group
P.O. Box 721120
San Jose, California 95172-1120

MAIL

MAY 15 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Limor Schweitzer et al.
Application No. 09/935,130
Filed: August 21, 2001
For: DATABASE MANAGEMENT AND RECOVERY IN A NETWORK-BASED FILTERING AND AGGREGATING PLATFORM

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(II)

This is a decision on the petition, filed September 24, 2001 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

M.P.E.P. §708.02, Section II which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

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

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

Paper No. 5

Kevin J. Zilka
Silicon Valley Intellectual Property Group
P.O. Box 721120
San Jose, California 95172-1120

MAIL

FEB 1 9 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Limor Schweitzer et al.)
Application No. 09/935,131)
Filed: August 21, 2001)
For: SYSTEM, METHOD AND)
COMPUTER PROGRAM PRODUCT)
FOR POLICY-BASED BILLING IN A)
NETWORK ARCHITECTURE)

DECISION ON PETITION UNDER M.P.E.P. §708.02(II): INFRINGEMENT

This is a decision on the petition, filed September 21, 2001, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

A grantable petition under 37 C.F.R. §1.102(c), and M.P.E.P. §708.02, Section II, must be accompanied by payment of the fee under 37 C.F.R.§1.117(I) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed: and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. A fee under 37 C.F.R. for such a petition is required .

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**. The application file is being forwarded to the Examiner of Record for expedited examination.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

Baker & McKenzie
805 Third Avenue
New York, NY 10022

COPY MAILED

JAN 28 2004

OFFICE OF PETITIONS

In re Application of :
Anthony C. Shurman :
Application No. 09/935,142 : ON PETITION
Filed: August 21, 2001 :
Attorney Docket No. 56150319-2 :

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

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed March 18, 2003, which set a shortened statutory period for reply of three months from the mail date of the Notice. A two-month extension of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on August 19, 2003.

The application file is being forwarded to Technology Center AU 3728 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

COPY MAILED

JUN 22 2009

OFFICE OF PETITIONS

In re Application :
Larsen, et al. :
Application No. 09/935,144 : PATENT TERM ADJUSTMENT
Filed: August 21, 2001 :
Dkt. No.: GFM-5213CP6CN :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT," filed May 20, 2008. This matter is being properly treated as a timely filed application for patent term adjustment pursuant to 37 CFR 1.705(b).

The application for patent term adjustment (PTA) under 37 CFR 1.705(b) is **HELD IN ABEYANCE IN PART AND DIMISSED IN PART**.

The Determination of Patent Term Adjustment under 35 USC 154(b), mailed March 5, 2008, indicated a patent term adjustment (PTA) to date of 292 days. The instant application for PTA was timely filed May 20, 2008, prior to issue fee payment. Applicants argue that the adjustment of 292 days should be increased to 680 days.

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 of the application. A decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term for Office failure to issue the patent within three years. *See*, 37 CFR 1.703(b).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Applicants are reminded that if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A).

Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. *See*, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR § 1.703(f). *See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

As uncontested by applicants, the application is entitled to an adjustment of 330 days in accordance with 37 CFR 1.702(a)(1).

The reduction of two days in accordance with 37 CFR 1.704(b) in connection with the response filed May 20, 2004 is not in dispute.

The reduction of 58 days in accordance with 37 CR 1.704(b) in connection with the response filed January 7, 2005 is not in dispute.

The reduction of 85 days in accordance with 37 CFR 1.704(b) in connection with the reply filed March 30, 2007 is not in dispute.

The reduction of 90 days in accordance with 37 CFR 1.704(b) in connection with the request for continued examination filed December 28, 2007 is not in dispute.

Applicants contest the adjustment insofar as it relates to the Office's failure to assess a reduction of 91 days in connection with the Notice of Appeal filed February 28, 2006.

As argued by applicants, the adjustment is properly reduced 91 days in accordance with 37 CFR 1.704(b) in connection with the Notice of Appeal filed February 28, 2006. The reduction commenced November 30, 2005 and ended February 28, 2006.

Applicants further contest the adjustment as it relates to the mailing of the non-final Office action on October 4, 2006. Applicants assert that the correct adjustment in this regard is 218 days.

However, the application is not entitled to any adjustment in connection with the mailing of non-final Office action on October 4, 2006. The amendment after final rejection filed November 21, 2005 did not comply with the provisions of 37 CFR 1.113(c). Thus, the provisions of 37 CFR 1.703(a)(3) do not apply. Applicants' proper reply to the final rejection was the Notice of Appeal filed February 28, 2006. Applicants did not file an appeal brief, thus, the provisions of 37 CFR 1.703(a)(4) do not apply. An amendment after final rejection was filed July 14, 2006. The non-final Office action was timely mailed October 4, 2006 within the meaning of 37 CFR 1.702(a)(2) in response to the amendment filed July 14, 2006.

In view thereof, as of the time of allowance, the application is entitled to an adjustment of 330 days less reductions totaling 326 days, or, a net adjustment of four days.

Receipt is hereby acknowledged of the required PTA application fee of $200.00.

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

This application is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Adjusted PAIR Calculation

Day : Saturday
Date: 6/20/2009

PALM INTRANET

Time: 08:18:59

PTA Calculations for Application: 09/935144			
Application Filing Date:	08/21/2001	PTO Delay (PTO):	527
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	235
Post-Issue Petitions:	0	Total PTA (days):	4
PTO Delay Adjustment:	-288		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
100	06/20/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		91	
99	06/20/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		197	
91	03/05/2008	MAIL NOTICE OF ALLOWANCE			
90	02/29/2008	ISSUE REVISION COMPLETED			
89	02/29/2008	DOCUMENT VERIFICATION			
88	02/27/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
87	02/27/2008	CASE DOCKETED TO EXAMINER IN GAU			
86	02/27/2008	NOTICE OF ALLOWABILITY			
85	01/18/2008	DATE FORWARDED TO EXAMINER			
84	12/28/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
83	01/18/2008	DATE FORWARDED TO EXAMINER			
82	12/28/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		90	69
81	01/18/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
80	12/28/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
79	12/28/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
78	11/15/2007	MAIL ADVISORY ACTION (PTOL - 303)			
77	11/13/2007	ADVISORY ACTION (PTOL-303)			
75	09/14/2007	DATE FORWARDED TO EXAMINER			
74	09/11/2007	AMENDMENT AFTER FINAL REJECTION			
73	08/07/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
72	03/08/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			

71	07/27/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
70	03/08/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
69	06/29/2007	MAIL FINAL REJECTION (PTOL - 326)			
68	06/25/2007	FINAL REJECTION			
67	06/27/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
66	06/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
65	04/11/2007	DATE FORWARDED TO EXAMINER			
64	03/30/2007	RESPONSE AFTER NON-FINAL ACTION		85	62
63	03/30/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
62	10/04/2006	MAIL NON-FINAL REJECTION	197		42
61	09/29/2006	NON-FINAL REJECTION			
60	08/29/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
59	08/24/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
58	07/21/2006	DATE FORWARDED TO EXAMINER			
57	07/14/2006	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
56	07/14/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
55	04/12/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
54	04/10/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
53	03/28/2006	MAIL APPEALS CONF. PROCEED TO BPAI			
52	03/28/2006	PRE-APPEALS CONFERENCE DECISION - PROCEED TO BPAI			
51	03/22/2006	MAIL ADVISORY ACTION (PTOL - 303)			
50	03/20/2006	ADVISORY ACTION (PTOL-303)			
49	03/08/2006	CASE DOCKETED TO EXAMINER IN GAU			
48	02/28/2006	REQUEST FOR PRE-APPEAL CONFERENCE FILED			
47	02/28/2006	NOTICE OF APPEAL FILED			
46	02/28/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	02/17/2006	CASE DOCKETED TO EXAMINER IN GAU			

43	12/13/2005	DATE FORWARDED TO EXAMINER			
42	11/21/2005	AMENDMENT AFTER FINAL REJECTION			
41	08/29/2005	MAIL FINAL REJECTION (PTOL - 326)			
40	08/22/2005	FINAL REJECTION			
39	08/05/2005	CASE DOCKETED TO EXAMINER IN GAU			
38	08/04/2005	CASE DOCKETED TO EXAMINER IN GAU			
37	07/15/2005	CASE DOCKETED TO EXAMINER IN GAU			
36	07/11/2005	DATE FORWARDED TO EXAMINER			
35	06/30/2005	RESPONSE AFTER NON-FINAL ACTION			
34	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
33	04/08/2005	CORRESPONDENCE ADDRESS CHANGE			
32	04/05/2005	MAIL NON-FINAL REJECTION			
31	04/04/2005	NON-FINAL REJECTION			
30	01/26/2005	DATE FORWARDED TO EXAMINER			
29	01/07/2005	RESPONSE AFTER NON-FINAL ACTION		58	25
28	01/07/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	01/24/2005	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
26	01/07/2005	WORKFLOW INCOMING AMENDMENT IFW			
25	08/10/2004	MAIL NON-FINAL REJECTION			
24	08/09/2004	NON-FINAL REJECTION			
23	05/26/2004	DATE FORWARDED TO EXAMINER			
22	05/20/2004	RESPONSE TO ELECTION / RESTRICTION FILED		2	19
21	05/20/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
20	05/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
19	02/18/2004	MAIL SUPPLEMENTAL RESTRICTION / ELECTION REQUIREMENT			
18	02/18/2004	CORRESPONDENCE ADDRESS CHANGE			
17	02/18/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
16	02/18/2004	SUPPLEMENTAL RESTRICTION			
15	10/03/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	09/16/2003	MAIL RESTRICTION REQUIREMENT	330		-1
13	09/16/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
12	09/15/2003	CASE DOCKETED TO EXAMINER IN GAU			
11	03/17/2003	CASE DOCKETED TO EXAMINER IN GAU			

10.7	10/22/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	10/22/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	08/21/2001	PRELIMINARY AMENDMENT			
8	01/29/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	01/23/2002	APPLICATION DISPATCHED FROM OIPE			
6	01/22/2002	APPLICATION IS NOW COMPLETE			
4	01/16/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	08/21/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
2	08/29/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/21/2001	INITIAL EXAM TEAM NN			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED
JUN 15 2010
OFFICE OF PETITIONS

In re Patent No. 7,563,760 : DECISION ON APPLICATION FOR
Issued: July 21, 2009 : PATENT TERM ADJUSTMENT and
Application No. 09/935,144 : NOTICE OF INTENT TO ISSUE
Filed: August 21, 2001 : CERTIFICATE OF CORRECTION
Dkt. No.: GFN-5213CP6CN :

This is a decision on the petition filed on September 3, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by 1,160 days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.**

The correct period of adjustment under 37 CFR 1.702(a) is 620 days, not 600 days as set forth by patentees (330 days pursuant to 37 CFR 1.702(a)(1) + 290 days pursuant to 37 CFR 1.702(a)(4)).

The correction period of adjustment under 37 CFR 1.702(b) is 1,223 days, not 1,224 days as set forth by patentees. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on August 22, 2001 and ends on December 27, 2007, the day before the RCE was filed, and not December 28, 2007, the day of filing of the RCE, as calculated by patentees. See, 35 U.S.C. 154(b)(1)(B)(i). Thus, the over 3 year period is 1,223 days, not 1,224 days.

The overall adjustment under 37 CFR 1.703 is properly reduced 446 days for applicant delays under 37 CFR 1.704, as acknowledged by patentees.

However, the "B" delay under 37 CFR 1.702(b) may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151,

whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences. See, 37 CFR 1.703(b)(4).

Accordingly, as a Notice of Appeal was filed February 28, 2006 and a non-final Office action was mailed in response thereto on October 4, 2006, the adjustment is properly reduced an additional 219 days. The period commenced February 28, 2006, the date that the Notice of Appeal was filed, and ended October 4, 2006, the date that the non-final Office action was mailed.

In view thereof, the patent is entitled to an overall adjustment of 1,178 days (620 days under 37 CFR 1.702(a) + 1,223 days under 37 CFR 1.702(b) – zero overlapping days – 219 days pursuant to 37 CFR 1.703(b)(4) – 446 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

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

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 1,178 days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,563,760

DATED : **July 21, 2009** **DRAFT**

INVENTOR(S) : Larsen, 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 991 days

Delete the phrase "by 991 days" and insert – by 1,178 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. 6

COPY MAILED

JAN 0 8 2004

OFFICE OF PETITIONS

MARGER JOHNSON & MCCOLLOM PC
1030 SW MORRISON STREET
PORTLAND OR 97205

In re Application of :
Bill Zimmerman, et al. :
Application No. 09/935,147 : DECISION GRANTING PETITION
Filed: August 21, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 9604-2 :

This is a decision on the petition, filed July 28, 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 August 19, 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 April 15, 2004 accompanies this decision on petition.

There is no indication that a reply to the non-final Office action of June 27, 2003 has been filed. Accordingly, a shortened statutory period of three (3) months for reply to the non-final Office action of June 27, 2003 is restarted with the mailing date of this decision. Extensions of time pursuant to the provisions of 37 CFR 1.136(a) are permitted. Failure to timely reply within the period restarted by this decision will result in the abandonment of this application.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being returned to Technology Center Art Unit 1761 to await a reply to the non-final Office action mailed June 27, 2003, the period of which is restarted to run from the mailing date of this decision on petition as noted above.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIXON PEABODY
401 9th STREET, N.W.
SUITE 900
WASHINGTON, DC 20004

COPY MAILED

JAN 27 2005

OFFICE OF PETITIONS

In re Patent No. 6,807,041 :
Issue Date: October 19, 2004 :
Application No. 09/935,161 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. 740124-150 :

This is a decision on the petition under 37 CFR 1.182, filed December 28, 2004, 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, Crystal Park 3-910 (FAX 746-4642)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GRAYBEAL, JACKSON, HALEY LLP
155-108TH AVENUE NE
SUITE 350
BELLEVUE, WA 98004-5901

MAILED

FEB 15 2006

TECHNOLOGY CENTER 2100

In re Application of: JIAN ZHANG
Application No. 09/935,166
Filed: August 21, 2001
For: EVEN-LOAD SOFTWARE REED-SOLOMON DECODER

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed December 12, 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 is the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 10.40(a) 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 U.S. Patent and Trademark Office (Office) will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Office of any change in correspondence address to ensure receipt of all communications from the Office.

Dale Hall for

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: GRACIELA COWGER
MARGER JOHNSON & McCOLLOM PC
210 SW MORRISION STREET
SUITE 400
PORTLAND, OR 97204

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

MARGER JOHNSON & MCCOLLOM, P.C.
210 SW MORRISON STREET, SUITE 400
PORTLAND OR 97204

COPY MAILED
SEP 22 2006
OFFICE OF PETITIONS

In re Application of :
Jian Zhang. :
Application No. 09/935,166 :
Patent No. 7,028,245 :
Filed: August 21, 2001 :
Issue Date: April 11, 2006 :
Attorney Docket No.: 1552-14 :
Title: EVEN-LOAD SOFTWARE REED-SOLOMON DECODER :

DECISION ON PETITION
UNDER 37 C.F.R. §1.28(c)

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. The petition is **GRANTED** accordingly.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[1]. All other inquiries

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

concerning examination procedures or status of the application should be directed to the Technology Center.

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

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

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

Mail Date: 07/30/2010

Applicant	: Ishita Sharan	: DECISION ON REQUEST FOR
Patent Number	: 7656877	: RECALCULATION of PATENT
Issue Date	: 02/02/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 09/935,238	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/21/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1084** 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

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

COPY MAILED

FEB 27 2004

OFFICE OF PETITIONS

In re Application of
Kessler et al.
Application No. 09/935,264
Filed: August 22, 2001
Title: ACOUSTIC MICRO IMAGING METHOD PROVIDING IMPROVED INFORMATION DERIVATION AND VISUALIZATION

: DECISION ON PETITION

This is a decision on the Petition to Withdraw Holding of Abandonment or in the Alternative to Revive Patent Application, filed February 17, 2004. Accompanying the petition was persuasive evidence that the petition was originally filed on December 31, 2003.

The above-identified application became abandoned for failure to file a timely and proper reply to the Notice to File Missing Parts of Nonprovisional Application mailed October 3, 2001. This Notice set a two (2) month time limit for reply, with extensions of time obtainable under § 1.136(a). No extensions of time having been obtained and no reply received, the above-identified application became abandoned on December 4, 2001. A Notice of Abandonment was not mailed until December 17, 2003.

The instant petition was promptly filed in response. The petition included persuasive evidence that the response to the Notice was timely submitted by virtue of its Deposit in the Express Mail service of the United States Postal Service on December 3, 2001. See 37 CFR 1.10.

In view thereof, the petition to withdraw the holding of abandonment is **GRANTED**. The Notice of Abandonment mailed December 17, 2003, is hereby **VACATED**.

Since consideration of the petition under § 1.137 is unnecessary, although authorized, no petition fees will be charged.

The application file is being forwarded to the Office of Initial Patent Examination for processing of paper Nos. 5 and 6, the responses to the Notice originally filed December 23, 2001.

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

Nancy Johnson
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

LISA A. HAILE, Ph.D.
DLA PIPER RUDNICK GRAY CARY US LLP
4365 EXECUTIVE DRIVE, SUITE 1100
SAN DIEGO, CA 92121-2133

COPY MAILED

JUN 0 6 2005

OFFICE OF PETITIONS

In re Application	:	
Chesnut et al.	:	
Application No. 09/935,280	:	DECISION ON APPLICATION
Filed: August 21, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. INVIT1300-1	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)," filed February 7, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred sixty-four (164) days to one hundred seventy-two (172) 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 was one hundred seventy-two **(172)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 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 164 days. On February 7, 2005, applicants timely[1] submitted an application for patent term adjustment. Applicants request reinstatement of 8 days due to the delay of the response mailed November 27, 2001 to reach OIPE resulting from the consequences of events of September 11, 2001 on domestic first class mail delivery at the U.S. Postal Service.

[1] PALM records show that the Issue Fee payment was also received in the Office on February 7, 2005.

It appears that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants' arguments are well-taken. The Notice dated January 15, 2002, provided that:

> If a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), and the applicant is otherwise entitled to patent term adjustment (or additional patent term adjustment) but for the fact that there was a reduction of such patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) due to the receipt of such reply by the Office more than three business days after the date indicated on the certificate of mailing, the Office will consider the USPS mail situation discussed in this notice to constitute a sufficient showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice. In this situation, the Office will, subject to the conditions set forth below, reinstate a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of three months.

The relevant reply was mailed on November 27, 2001, as shown by the certificate of mailing under § 1.8 thereon. However, the patent term adjustment was reduced by 8 days because the reply was not received in the Office until January 10, 2002.

Thus, it is concluded that the Notice dated January 15, 2002 is applicable to this situation; in spite of all due care, the applicants were unable to reply to the Notice to File Missing Parts within three months of the date of mailing of the notice, October 2, 2001. It is further concluded that applicants have met the other conditions set forth in the Notice for reinstatement of patent term. In this instance, the period of reinstatement is from December 4, 2001, the day that is four business days after November 27, 2001, to January 10, 2002, the date of receipt of the reply. This period constitutes more than 8 days, and thus, applicants are entitled to reinstatement of the entire period of reduction of 8 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one hundred seventy-two (172) days.

It is further noted that applicants have met the requirements set forth in the Notice for waiver of the fee for consideration under 37 CFR § 1.705. Accordingly, the $200 fee submitted is being refunded to Deposit Account No. 07-1896, as authorized.

The Office will forward the file to the Office of Patent Publication so that the patent can be issued.

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

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

Attachment: Copy of Revised PAIR Screen

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02/21/06

TO SPE OF : ART UNIT **1762**

SUBJECT : Request for Certificate of Correction on Patent No.: 09/935332 6936300

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

Angela Green
Certificates of Correction Branch
Tel. No. 703-305-9380 ext. 123

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

1762
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

SEP 25 2002

#10

Sheridan Neimark
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
Suite 300
Washington, DC 20001-5303

In re Application of
Hiroyuki MUKAI et al
Serial No.: 09/935,338
Filed: August 23, 2001
Attorney Docket: MUKAI=1

PETITION DECISION

This is in response to applicants' petition filed July 15, 2002, requesting accelerated examination under Part VIII of MPEP 708.02.

Applicants' petition has been carefully reviewed. All the requirements under MPEP 708.02, VIII have been met. Accordingly, the petition is granted. Prosecution of the application will proceed according to the procedure set forth under MPEP 708.02, VIII, there is no provision for "withdrawal" from this special status.

Applicants' petition is **GRANTED.**

Should there be any questions regarding this decision, please contact Cecilia Tsang by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-0254 or by facsimile transmission at (703) 305-7230.

Cecilia Tsang
Special Program Examiner, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OCT 22 2004

CONNOLLY BOVE LODGE & HUTZ LLP
SUITE 800
1990 M STREET NW
WASHINGTON DC 20036-3425

In re Application of:
Jira et al.
Serial No.: 09/935,344
Filed: August 23, 2001
Attorney Docket No.: 22220-00003-US

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicants' petition under 37 CFR § 1.181(a) filed on August 25, 2004, requesting withdrawal of the holding of abandonment based on the timely filing of a response to the Office action mailed December 17, 2003.

A review of the file history shows that the examiner mailed an Office action (restriction requirement) to applicants on July 2, 2003, setting a one-month statutory time period for reply. On December 17, 2003, the examiner mailed a non-final Office action to applicants, setting a three-month statutory time period for reply. On August 10, 2004, the examiner mailed a notice of abandonment for failure to respond to the outstanding Office action.

Applicants state that a response to the Office action was timely filed on March 16, 2004, as evidenced by a copy of the Auto-Reply fax confirmation page showing receipt of the response by the USPTO on March 16, 2004 at 3:16:29 PM. The confirmation page also shows receipt of an Amendment Transmittal, Amendment, Revocation of Power of Attorney and Change of Correspondence Address, and Certificate of Transmission under 37 CFR 1.8. Applicants also provide a copy of the response to the Office action with the petition. In view of this evidence, applicants are considered to have submitted a timely reply.

Applicants' petition is **GRANTED**. The application is restored to pending status with the mailing date of this decision and will be forwarded to the examiner for consideration of the elected invention on the merits.

Should there be any questions about this decision, please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile at 703-872-9306.

/Marianne C. Seidel/for

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

BARBARA RAE-VENTER, PH.D.
RAE-VENTER LAW GROUP, P.C.
PO BOX 1898
MONTEREY CA 93942-1898

COPY MAILED

FEB 0 2 2004

OFFICE OF PETITIONS

In re Application of :
Wigler et al. :
Application No. 09/935,367 : DECISION ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. TUIN.002.05US :

This is a decision on the petition filed December 3, 2001, requesting pursuant to 37 CFR 1.183 waiver of 37 CFR 1.53(b) such that the above-identified application papers are accorded a filing date of August 21, 2001, instead of the currently accorded filing date of August 22, 2001.

The petition considered under 37 CFR 1.183 is DISMISSED. This decision is not a final agency action. While the delay in treating the petition is sincererly regretted, it is noted that the petition was only recently brought to the attention of this office.

Petitioners seek the earlier filing date of the basis that copendency with the immediate parent case can thereby be obtained, as (1) that parent application (09/261,079) issued as U.S. patent No. 6,277,606 on August 21, 2001, and (2) petitioners were diligent, but unsuccessful over an extended period in trying to have the USPTO correct the correspondence address in the parent case, and likewise were diligent in trying to ascertain the issue date of the patent case.

STATUTE AND REGULATION

35 U.S.C. § 111(a) states:

> (1) WRITTEN APPLICATION.-An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.
>
> (2) CONTENTS.-Such application shall include-
>
> > (A) a specification as prescribed by section 112 of this title;
> >
> > (B) a drawing as prescribed by section 113 of this title; and
> >
> > (C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.-The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.-Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. **The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office** (emphasis added).

35 U.S.C. § 120 provides, in part:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application, shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application, and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

§ 1.183 *Suspension of rules.*

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

OPINION

Since the earliest date that the instant application papers (i.e., a specification containing at least one claim) were received by the USPTO is admittedly August 22, 2001, that is the earliest filing date that can properly be accorded these papers, as the filing date of an application is governed by statute. See 35 U.S.C. § 111(b)(4) ("[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office."

It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). As such the earliest filing date permitted by § 111(b)(4) is the date of receipt of the instant correspondence at the USPTO: August 22, 2001.

As to consideration of the petition under 37 CFR 1.183, that regulation, by its terms, may not be invoked to waive any requirement of the rules that is also a requirement of the patent statute. Since the requirement of 37 CFR 1.53(b) that is here sought to be waived is likewise a requirement of the applicable statute, 37 CFR 1.183 simply cannot be invoked--or properly applied-- to override that requirement of law as such is beyond the authority, much less the discretion, of the USPTO. Since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute. See A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977). That is, the USPTO simply lacks the authority or the discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A.F. Stoddard v. Dann, Id. Accordingly, the petition considered under 37 CFR 1.183 is dismissed.

It is is unfortunate that petitioners waited for receipt of the Issue Notification instead of filing the continuing application at the same time the issue fee was paid in the parent application. Petitioners should note that MPEP §1306.03 has long contained the following caveat: "[b]ecause the Issue Notification may be mailed less than two weeks before the application is expected to issue as a patent, applicants are advised to file any continuing application ***before*** receiving the Issue Notification to avoid loss of copendency" (emphasis added).

This section of the MPEP merely reflects the prior notices that members of the public and registered practitioners were given at "Patents to Issue More Quickly After Issue Fee Payment", 1220 *Off. Gaz. Pat. Office* 42 (March 9, 1999) which states, in pertinent part "[a]s part of the Patent and Trademark Office's changes in business practices to streamline its processing of patent applications, and thereby maximize patent term of patents, the PTO has established an objective to issue patents within four weeks of payment of the issue fee by July 1999 instead of the current average

of three months;" and at "Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee", 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999) which states, in pertinent part:

> "Filing continuing applications: Since a continuing application (a continuation, divisional, or continuation-in-part) may be filed anytime before an application is patented or abandoned, applicants will often wait for the Issue Notification before filing such a continuing application. *Therefore, the PTO strongly advises applicants not to wait for receipt of an Issue Notification before filing any desired continuing application* [emphasis added].
>
> This is because applicants will now receive the Issue Notification just shortly before the application will issue as a patent (when it may be too late to prepare and file a continuing application). Applicants are reminded that: (1) the requirement that there be copendency for an application to obtain any benefit of the filing date of the prior application is a statutory requirement (35 U.S.C. 120) which the PTO cannot waive; and (2) the patent statute contains no provisions for restoring a patented application (unlike an abandoned application) to pending status.
>
> The PTO specifically advises practitioners to be prepared to file any desired application preferably no later than the date the issue fee is paid, to avoid issuance of the application before the continuing application is filed."

This application is being returned to the Office of Inital Patent Examination (OIPE) for further processing. Any questions related to OIPE processing should be directed to OIPE's Customer Service hotline at (703) 305-1820.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn

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

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

HAVERSTOCK & OWENS LLP
162 N WOLFE ROAD
SUNNYVALE, CA 94086

Mail Date: 04/21/2010

Applicant	: Koji Kashima	: DECISION ON REQUEST FOR
Patent Number	: 7647619	: RECALCULATION of PATENT
Issue Date	: 01/12/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/935,419	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/22/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1975** 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

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

COPY MAILED
AUG 23 2006
OFFICE OF PETITIONS

In re Application of	:	
Sinclair et al.	:	
Application No. 09/935,424	:	
Filed: August 23, 2001	:	DECISION ON
Attorney Docket Number: 10610-003	:	PETITION

This is a decision in response to the Petition under 37 C.F.R. § 1.181(a) to Withdraw Holding of Abandonment, filed August 8, 2005. 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 respond to the Notice of Non-Compliant Amendment ("Notice"), mailed December 7, 2004. The Notice set a one (1) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). No response having been received, the application became abandoned on January 8, 2005. A Notice of Abandonment was mailed June 23, 2005.

With the instant petition, Petitioner has demonstrated non-receipt of the Notice by a preponderance of the evidence.

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 application will be referred to Technology Center Art Unit 3737 for re-mailing of the Notice.

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

COPY MAILED

JUL 30 2008

HOFFMAN WARNICK LLC
75 STATE STREET
14TH FLOOR
ALBANY NY 12207

In re Application of :

SINCLAIR, Stephen H. et al. :
Application No. 09/935,424 : DECISION ON PETITION
Filed: August 23, 2001 : TO WITHDRAW
Attorney Docket No. VIME-0001-US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 17, 2008.

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 Stephen Swinton, Jr. on behalf of all attorneys of record who are associated with customer No. 23550. All attorneys/agents associated with the Customer Number 23550 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **STEPHEN H. SINCLAIR**
1208 HENRY LANE
GLADWYNE PA 19035

cc: **VIMETRICS LLC**
1101 GREEN VALLEY ROAD
BRYN MAWR PA 19010

UNITED STATES 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

Paper No. 6

MAR 0 5 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of
LOCKET et al.
Application No. 09/935,426
Filed: August 22, 2001
For:
MULTIMEDIA SIGNAL PROCESSING SYSTEM

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as agent of record filed on January 13, 2004.

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

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

Attorneys/agents listed in the Request to withdraw are withdrawn.

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

The file is being returned to TC 2600 Technical Support Staff to update the correspondence address and then will be forwarded to the files repository.

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

Cc:
Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, CA 95125-5106

UNITED STATES 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, SUITE L
MENLO PARK CA 94025

MAILED

MAR 0 3 2010

OFFICE OF PETITIONS

In re Application of :
Jim Roskind et al. :
Application No. 09/935,439 :
Filed: August 22, 2001 :
Attorney Docket No. NETS0064 :

DECISION ON PETITION

This is a decision on the petition, filed July 31, 2007, which is being treated as a petition requesting that the requirement of 37 CFR 41.33(d)(2) be waived or suspended pursuant to 37 CFR 1.183.

The petition is **dismissed**.

37 CFR 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner.

The petition requests entry of Follow-Up Response Under 37 CFR 1.116 and 41.33 (Response) which was filed February 16, 2007. The Response was filed two days after the Appeal Brief filed February 14, 2007. The examiner responded with an Advisory Action After the Filing of an Appeal Brief on May 31, 2007 concurrent with the Examiner's Answer. The Advisory Action indicated that the Response would not be entered since it was not timely filed before the filing of an appeal brief (37 CFR 41.33(d)(2)).

Petitioner states that prior to filing the appeal brief on February 14, 2007 he had engaged in telephonic and e-mail interviews with the examiner concerning the disqualification of a reference used by the examiner. Petitioner indicates that the information formally submitted in the non-entered Response had previously been presented to the examiner in the e-mail for discussion purposes. The application file record has no evidence of any telephonic or e-mail communication between applicant and examiner. Petitioner argues that the contents of the Response were already in the record due to the e-mail to the examiner and thus the contents of the Response did not present any surprise to the Patent Office. As indicated, the application file record has no evidence of the e-mail or any interview summary and therefore the application record is silent as to the contents of the Response. Whether or not the information presented in the Response was a surprise to the Patent Office is not controlling in consideration to waive the requirements of 37 CFR 41.33(d)(2).

The Office has procedures for filing materials relevant to disputing a rejection of claims set forth by the examiner in a timely manner. As noted above, petitioner indicates he had been discussing with the examiner disqualification of a reference and in fact had e-mailed evidence to the examiner prior to the filing of his appeal brief (this e-mail containing allegedly the same information in the Response). Therefore, there was no reason petitioner could not have timely formally filed this information before filing of the appeal brief. The circumstances presented in the petition are not extraordinary circumstances where the interests of justice requires the granting of relief.

For this reason, the petition is dismissed.

It is noted that in the Advisory Action mailed May 31, 2007, the examiner did comment on the information submitted in the Response but also indicated it would not be entered.

This application is being forwarded to Technology Center Art Unit 2452 for such action as may be appropriate.

Telephone inquiries regarding this communication should be directed to Carl Friedman at (571) 272-6842.

David Bucci
Petitions Examiner
Office of Petitions

OIPE JC40
SEP 20 2004
PATENT & TRADEMARK OFFICE

Pet. Dec.

PTO/SB/83 (09-03)
Approved for use through 11/30/2005. OMB 0651-0035
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.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	09/935,455
Filing Date	August 22, 2001
First Named Inventor	Matthew O'KEEFE
Art Unit	1744
Examiner Name	W. H. Beisner
Attorney Docket Number	286002023020

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

Approved
/JMStone/
Jacqueline M. Stone, Director
Technology Center 1700
11/26/04

Please withdraw me as attorney or agent for the above identified patent application, and

[x] all the attorneys/agents of record.

[ ] the attorneys/agents (with registration numbers) listed on the attached paper(s), or

[ ] the attorneys/agents associated with Customer Number [ ]

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are:
This request is being made at the request of Board of Trustees of the Leland Stanford Junior University

CORRESPONDENCE ADDRESS

1. [ ] The correspondence address is NOT affected by this withdrawal.
2. [x] Change the correspondence address and direct all future correspondence to:

[ ] Customer Number: [ ]

OR

[x] Firm or Individual Name	Alexander Smolenski (Bromberg and Sunstein, LLP)				
Address	125 Summer Street				
City	Boston	State	Massachusetts	Zip	02110-1618
Country					
Telephone	(617) 443-9292		Fax	(617) 443-0004	
Name	Gladys H. Monroy				
Signature	Gladys Monroy		Registration No.	32,430	
Date	September 13, 2004		Telephone No.	(650) 813-5711	

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: September 15, 2004 Signature: _____ (Thao T. Pham)

pa-918560

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK, CO 80108

COPY MAILED

SEP 19 2005

OFFICE OF PETITIONS

In re Application of :
Angel A. Gargiulo :
Application No. 09/935,491 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. W-3908

This is in response to the petition under 37 CFR 1.137(b) filed August 11, 2005.

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

The above-identified application became abandoned for failure to reply to the Notice to File Missing Parts of Non-provisional Application mailed September 25, 2001, which set a period for reply of two (2) months from its mailing date. Extensions of time for reply pursuant to 37 CFR 1.136(a) was available. A proper response was not received within the allowed period, and the application became abandoned on November 26, 2001. A Notice of Abandonment was mailed on December 5, 2003.

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

The declaration filed August 11, 2005, is noted and made of record.

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

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090618

DATE : June 18, 2009

TO SPE OF : ART UNIT 2825

SUBJECT : Request for Certificate of Correction on Patent No.: 6,613,662 B2

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

Certificate of Correction filed 10/12/07 has been entered and approved.

SPE: /Jack Chiang/ **Art Unit** 2825

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

Benjamin L. Volk, Jr.
Howell & Haferkamp, L.C.
7733 Forsyth Boulevard
Suite 1400
St. Louis, Missouri 63105

MAIL

FEB 1 9 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Goldstein
Application No.: 09/935,510
Filed: August 23, 2001
For: HEARING AIDS BASED ON MODELS OF COCHLEAR COMPRESSION USING ADAPTIVE COMPRESSION THRESHOLDS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102 (c), filed December 10, 2001 to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in M.P.E.P. § 708.02, Section IV: Applicant's Age.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, IV must include a showing, as by a birth certificate or the applicant's statement that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a birth certificate, Julius L. Goldstein, showing that applicant is sixty five (65) years of age or more.

Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

The application file will be forwarded to the examiner for expedited prosecution.

Krista Zele
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

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

NOV 2 4 2008

OFFICE OF PETITIONS

In re Patent No. 6,732,992 :
Issue Date: May 11, 2004 :
Application No. 09/935,549 : ON PETITION
Filed: August 24, 2001 :
Patentee(s) Saburo Wakita et al :

This is a decision on the petition under 37 CFR 1.378(c), filed August 22, 2008, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. **Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f).** No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified patent issued on May 11, 2004. Therefore, the grace period in 35 U.S.C. § 41(b) for paying the 3½ maintenance fee expired on May 11, 2008.

35 U.S.C. § 41(c)(1) authorizes the Commissioner to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Commissioner to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (1) above.

The petition to accept an unintentionally delayed payment is signed by Ken Yanai. In order for an assignee to take action in a case before the Office, compliance with 37 CFR 3.73(b) must be satisfied. More specifically, 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.,* copy of an executed assignment submitted for recording) or by specifying (*e.g.,* reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. A blank 37 CFR 3.73(b) accompanies this decision.

The petition for reconsideration must include the lacking item(s) noted above.

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

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

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

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

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Ken Yanai
1-297 Kitabukuro-Cho
Omiya-Ku, Saitama-Shi
Saitama 330-8508, Japan

Attachment: blank 37 CFR 3.73(b)

PTO/SB/96 (10-08)
Approved for use through 11/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

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

Entitled:

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

states that it is:

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

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

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

OR

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

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

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

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

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

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

_____ _____
Signature Date

_____ _____
Printed or Typed Name Telephone Number

_____
Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA

COPY MAILED

FEB 10 2009

OFFICE OF PETITIONS

In re Patent No. 6,732,992 :
Issue Date: May 11, 2004 :
Application No. 09/935,549 : ON PETITION
Filed: August 24, 2001 :
Patentee(s) Saburo Wakita et al :

This is a decision on the petition for reconsideration filed January 21, 2009 under 37 CFR 1.378(e), to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Petitioner will not receive future correspondence related to maintenance fees for the above-identified patent unless a fee address@ (see PTO/SB/47) is submitted for the above-identified patent.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

COPY MAILED

SEP 0 3 2004

OFFICE OF PETITIONS

MARY ROGDE
46-285 IKIIKI ST.
KANEOHE HI 96744

In re Application of
Mary Rogde
Application No. 09/935,562
Filed: August 21, 2001
Title: SOLAR DESALINATION PLANT

DECSION ON PETITION UNDER
37 C.F.R. §§1.137(A)

This is a decision on the petition filed September 2, 2003, pursuant to 37 C.F.R. §1.137(a)[1] to revive the above-identified application.

The Office regrets the delay in issuing this decision.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed October 10, 2002, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 11, 2003. A Notice of Abandonment was mailed June 4, 2003.

With the instant petition, Petitioner has supplied the fee associated with the filing of a petition under 37 C.F.R. §1.137(a), an amendment, and a statement of facts.

Petitioner has met requirements (1) - (2) above. Requirement (4) does not apply.

---

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

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

(2) the petition fee;

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

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

Regarding the third requirement above, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard

35 USC §133 states, "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." (emphasis added)

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference."[2]

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[3]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business[4]?"

Nonawareness of a PTO rule will not constitute unavoidable delay[5].

---

2 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."

3 Id.

4 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

5 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

The burden of showing the cause of the delay is on the person seeking to revive the application[6].

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[7].

The law, regulations and portion of the MPEP relevant to the abandonment of this application

35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

§ 1.111 Reply by applicant or patent owner to a non-final Office action.
(a)
(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.
(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:
(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and
(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.
(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.
(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

---

6 Id.

7 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

37 C.F.R. 1.135: Abandonment for failure to reply within time period.
(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

711.03(c) of the MPEP sets forth, in part:

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:
(A) an argument or an amendment under 37 CFR 1.111;
(B) the filing of a continuing application under 37 CFR 1.53(b) (or a continued prosecution application (CPA) under 37 CFR 1.53(d) if the application is a utility or plant application filed before May 29, 2000, or a design application).
The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

...

The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 CFR 1.137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 CFR 1.137(a) indicates otherwise). In such an instance, a petition under 37 CFR 1.137(b) may be filed accompanied by the fee set forth in 37 CFR 1.17(m), the required reply, 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 any terminal disclaimer required by 37 CFR 1.137(c).

Application of the standard to the current facts and circumstances

Unfortunately, petitions filed under 37 C.F.R. §1.137(a) (where the cause of the abandonment is characterized as "unavoidable") have a very stringent standard associated with them.

With the instant petition, Petitioner has alleged that preparing her response was a rather involved affair, and the timeframe which was provided to her proved to be insufficient.

Petitioner's argument has been considered, and it has been deemed to be unpersuasive. Unfortunately, 35 U.S.C. §133 sets a statutory requirement which mandates the furtherance of the prosecution of an application prior to the expiration of the period for response, unless it can be shown that the delay was unavoidable.

Petitioner has asserted that due to the large number of mistakes which needed to be corrected, coupled with the fact that a colleague in India needed to be consulted, it simply was not possible to submit the required reply in under eleven months. It does not seem likely that in the age of e-mail, video-conferencing, and faxes, a reasonable and prudent person acting in relation to her most important business would require close to a year to correct her submission.

Therefore, it is determined that delay was perhaps unintentional, but certainly not unavoidable.

As such, the petition must be **DISMISSED**.

Alternate venue

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR §1.137(b). Petitioner should note that the standard associated with the filing of an unintentional petition is significantly lower than that associated with the characterization of an abandonment as unavoidable. A grantable petition pursuant to 37 CFR §1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (currently $665 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR §1.137(b) was unintentional. A copy of a blank petition form may be found at http://www.uspto.gov/web/forms/sb0064.pdf.

The filing of a petition under 37 CFR §1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR §1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR §1.137(b).

Response

Any reply 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 reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.137(a) *and/or §1.137(b), if applicable.*" This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner.

To help assure prompt and proper attention to your response, please see the enclosed Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail[8], hand-delivery[9], or facsimile[10].

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.

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

Encl. Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004)

8 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
9 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.
10 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ANDREWS KURTH
1701 PENNSYLVANIA AVENUE NW
SUITE 300
WASHINGTON, DC 20006

COPY MAILED

JUL 11 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Joseph De Bellis :
Application No. 09/935,565 :
Filed: August 24, 2001 :
Attorney Docket No. 5607 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 3, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed August 24, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 25, 2004.

The Change of Correspondence Address filed June 3, 2005 has been entered and made of record.

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

This matter is being referred to Technology Center AU 2167.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MAIL

MAY 1 9 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS CO 80527-2400

In re Application of :
Chiarabini et al. :
Application No. 09/935,579 :
Filed: August 24, 2001 :
For: SYSTEM AND METHOD FOR DOWNLOADING AND FOR PRINTING DATA FROM AN EXTERNAL CONTENT SOURCE :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on March 26, 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 not met items (2) and (4) above. The undersigned, John W. Ryan, is not of record. Furthermore, the Patent Office does not recognize withdrawal of a firm.

Accordingly, the request is **DENIED**.

Future communications from the Office will continue to be directed to the above-listed address unless a change of correspondence is specifically requested. A courtesy copy is being sent to the address listed below.

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

cc: CAROL CLAYTON
WILMER, CUTLER, & PICKERING
2445 M STREET, N.W.
WASHINGTON, D.C. 20037-1420

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS CO 80527-2400

MAIL

MAY 3 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Vinas et al. :
Application No. 09/935,580 :
Filed: August 24, 2001 :
For: METHOD AND APPARATUS FOR :
PRINTING A TEST PATTERN :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on March 26, 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 not met items (2) and (4) above. The undersigned, John W. Ryan, is not of record. Furthermore, the Patent Office does not recognize withdrawal of a firm.

Accordingly, the request is **DISMISSED AS MOOT**.

Future communications from the Office will continue to be directed to the above-listed address unless a change of correspondence is specifically requested. A courtesy copy is being sent to the address listed below.

Richard J. Ernst
For Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: CAROL CLAYTON
WILMER, CUTLER, & PICKERING
2445 M STREET, N.W.
WASHINGTON, D.C. 20037-1420

UNITED STATES 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 & NEUSTADT PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

AUG 12 2004

OFFICE OF PETITIONS

In re Application of :
Haruo Shindo et al :
Application No. 09/935,585 : DECISION GRANTING PETITION
Filed: August 24, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 213217US2X :

This is a decision on the petition, filed August 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 July 6, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2829 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

COPY MAILED

AUG 09 2006

OFFICE OF PETITIONS

In re Application of :
Mahito Shinohara :
Application No. 09/935,589 :
Filed: August 24, 2001 :
Attorney Docket Number: :
35.C15697 : ON PETITION

This is a decision on the Petition to Revive Unavoidably Abandoned Application Pursuant to 37 CFR § 1.137(a) and Payment of issue Fee, filed May 15, 2006.

The Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed November 17, 2005. The Notice set a non-extendable three (3) month period for reply. No response having been received, the application became abandoned on February 18, 2006. A Notice of Abandonment was mailed April 14, 2006.

With the instant petition, Petitioner has demonstrated by a preponderance of the evidence that the Notice was not received. The issue fee has been submitted with the instant petition.

In view of the above, the petition under 37 CFR 1.137(a) is granted.

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

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

Derek L. Woods
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

OIPE IAP96
AUG 22 2006
PATENT & TRADEMARK OFFICE

FW DAC

FITZPATRICK, CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

COPY MAILED
AUG 09 2006
OFFICE OF PETITIONS

In re Application of :
Mahito Shinohara :
Application No. 09/935,589 :
Filed: August 24, 2001 :
Attorney Docket Number: :
35.C15697 : ON PETITION

This is a decision on the Petition to Revive Unavoidably Abandoned Application Pursuant to 37 CFR § 1.137(a) and Payment of issue Fee, filed May 15, 2006.

The Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed November 17, 2005. The Notice set a non-extendable three (3) month period for reply. No response having been received, the application became abandoned on February 18, 2006. A Notice of Abandonment was mailed April 14, 2006.

With the instant petition, Petitioner has demonstrated by a preponderance of the evidence that the Notice was not received. The issue fee has been submitted with the instant petition.

In view of the above, the petition under 37 CFR 1.137(a) is granted.

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

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

Derek L. Woods
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

Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, New York 10012-3801

COPY MAILED

FEB 0 2 2007

OFFICE OF PETITIONS

In re Application of
Shinohara
Application No. 09/935,589
Patent No.: 7,116,367 B2
Filed: August 24, 2001

: DECISION REGARDING PTA

This decision is in response to applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)" filed on December 4, 2006 requesting that the USPTO adjust the patent term adjustment determination at the time of issuance of the application from a determination of 490 days to a determination of 577 days.

Patentees' application for Patent Term Adjustment is **GRANTED**. The Office will *adjust the PAIR calculation* at the time of the issuance of the patent to reflect a determination of **577** days. The Office will adjust the PTA calculation reflected in PAIR and also *sua sponte* issue a certificate of correction reflecting this decision.

Patentees assert that they failed to engage in reasonable efforts to conclude prosecution after the mailing of the notice of allowance by a period of 173 days. Patentees do not dispute the reduction of PTA for a period 173 days pursuant to 37 CFR 1.704)(c)(3) but dispute the additional 87 days under 37 CFR 1.704(b) because the periods of reduction completely overlap.

Patentees' arguments are persuasive. The Office agrees that the reduction periods are overlapping. The period of reduction for the violation of 37 CFR 1.74(c)(3) is the period beginning on February 18, 2006 and ending on August 9, 2006, a one hundred and seventy-three (173) day delay. See 37 CFR 1.704(c)(3). The reduction under 37 CFR 1.704(b) began on February 18, 2006 and ended on May 15, 2006. Since all of days are overlapping, the Office reduction should have only been 173 days and not (173 +87). Accordingly, the proper determination at the time of the issuance of the patent is 754 days of USPTO delay and 177 days of applicant delay. Thus, the proper amount of PTA at the time of the issuance of the patent is 577 (754-177=577) days.

After the mailing of this decision, the Office will forward the file to the Certificate of Correction branch for a prompt issuance of a certificate of correction.

The applicants have submitted the $200.00 fee pursuant to 37 CFR 1.18(e). No additional fees are necessary in deciding this petition.

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

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

cc: Adjusted Pair Calculation
DRAFT certificate of correction

Day : Thursday

PALM INTRANET

Date: 2/1/2007
Time: 11:18:32

PTA Calculations for Application: 09/935589			
Application Filing Date:	08/24/2001	PTO Delay (PTO):	754
Issue Date of Patent:	10/03/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	264
Post-Issue Petitions:	0	Total PTA (days):	577
PTO Delay Adjustment:	87		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
49	02/01/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	87		
45.5	09/13/2006	PTA 36 MONTHS			
45	10/03/2006	PATENT ISSUE DATE USED IN PTA CALCULATION	18		41
44	08/25/2006	EXPORT TO FINAL DATA CAPTURE			
43	08/24/2006	DISPATCH TO FDC			
42	08/23/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
41	05/15/2006	ISSUE FEE PAYMENT VERIFIED		87	31
40	08/09/2006	RECORD PETITION DECISION OF GRANTED TO ACCEPT DELAYED PAYMENT OF ISSUE FEE		173	31
39	05/15/2006	PETITION ENTERED			
37	05/15/2006	ISSUE FEE PAYMENT RECEIVED			
36	04/14/2006	MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
35	04/14/2006	ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
34	03/27/2006	FINISHED INITIAL DATA CAPTURE			
33	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
32	11/22/2005	EXPORT TO INITIAL DATA CAPTURE			
31	11/17/2005	MAIL NOTICE OF ALLOWANCE			
30	11/14/2005	ISSUE REVISION COMPLETED			
29	11/14/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
28	11/14/2005	NOTICE OF ALLOWABILITY			
27	09/12/2005	DATE FORWARDED TO EXAMINER			
26	09/02/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			

25	09/12/2005	DATE FORWARDED TO EXAMINER			
24	09/02/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
23	09/12/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
22	09/02/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
21	06/02/2005	MAIL FINAL REJECTION (PTOL - 326)	50		16
20	05/31/2005	FINAL REJECTION			
19	03/16/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
18	12/13/2004	NEW OR ADDITIONAL DRAWING FILED			
17	03/16/2005	DATE FORWARDED TO EXAMINER			
16	12/13/2004	RESPONSE AFTER NON-FINAL ACTION		4	13
15	12/13/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	11/13/2001	REFERENCE CAPTURE ON IDS			
13	09/09/2004	MAIL NON-FINAL REJECTION	686		-1
12	09/07/2004	NON-FINAL REJECTION			
11	08/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
10	11/13/2001	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
9	11/13/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	06/14/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	11/26/2001	APPLICATION DISPATCHED FROM OIPE			
6	11/20/2001	APPLICATION IS NOW COMPLETE			
5	09/27/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	09/24/2001	CORRESPONDENCE ADDRESS CHANGE			
2	08/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/24/2001	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

Paper No. 14

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
41 ST FL.
NEW YORK NY 10036-2714

COPY MAILED

AUG 0 8 2003

OFFICE OF PETITIONS

In re Application of
Mudd
Application No. 09/935,617
Filed: August 23, 2001
Attorney Docket No. F.11181
For: METHOD AND APPARATUS FOR FABRICATION OF A SELF-SUPPORTING BANDED COIL

: DECISION GRANTING
: PETITION

This is a decision on the petition filed July 14, 2003, requesting, in effect, withdrawal of the Notice of Incomplete Nonprovisional Application, mailed September 25, 2001.

The application was filed on August 23, 2001. However, on September 25, 2001 the Office of Initial Patent Examination mailed a Notice stating that the application had not been accorded a filing date because the application was deposited without drawings.

Petitioner requests that the above-identified application be accorded a filing date of August 23, 2001 on the basis that 3 sheets of drawing figures were received in the Patent and Trademark Office (PTO) on August 23, 2001. In support, the petition is accompanied by a copy of applicant's itemized postcard receipt showing an Office of Initial Patent Examination generated barcode citing August 23, 2001 as the date of receipt. The postcard lists, *inter alia*, that the filing included 3 sheets of drawings.

The return postcard constitutes *prima facie* evidence that 3 sheets of drawing figures were filed on August 23, 2001. MPEP 503. Accordingly, the request is granted.

No fee has been or will be charged in connection with this matter.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of **August 23, 2001**, using the copy of the 3 sheets of drawings submitted on October 5, 2001. Office records will be corrected to show that 3 sheets of drawings were present on filing.

Any inquiries pertaining to this matter may 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

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

LIEBERMAN & NOWAK LLP
350 FIFTH AVE.
SUITE 7412
NEW YORK NY 10118

COPY MAILED

MAY 2 8 2002

OFFICE OF PETITIONS

In re Application of
Mudd
Application No. 09/935,617
Filed: August 23, 2001
Attorney Docket No. F.11181

DECISION GRANTING
PETITION

This is a decision on the petition filed December 31, 2001, requesting, in effect, withdrawal of the Notice of Incomplete Nonprovisional Application, mailed September 25, 2001.

The application was filed on August 23, 2001. However, on September 25, 2001 the Office of Initial Patent Examination mailed a Notice stating that the application had not been accorded a filing date because the application was deposited without drawings.

In response, petitioner filed three sheets of drawings, a newly executed declaration, and the present petition on October 5, 2001.

As stated in MPEP 601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC 113 (first sentence.)

MPEP 601.01(f) also states that:

> A non provisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figures in the specification, but filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g), so long as the application contains something that can be construed as a written description.

This application contains method claims. Therefore, the application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g).

MPEP 601.01(g) states that if an application is filed without all of the drawing figures referred to in the specification, a "Notice of Omitted Items" is mailed indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

In view of the above, the "Notice" mailed September 25, 2001 was mailed in error and is hereby withdrawn.

The application is entitled to a filing date of August 23, 2001. The petition is granted.

Applicant is expected to resubmit the proposed drawings of Figures 1-3 by way of a preliminary amendment for consideration by the examiner for sufficiency of illustration and new matter. See MPEP 608.02.

No petition fee has been or will be charged.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 23, 2001, and for indication in USPTO records that "0" sheets of drawings were present on filing.

Telephone inquiries specific to this matter 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

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

Zilka-Kotab, PC
P.O. BOX 721120
SAN JOSE, CA 95172-1120

Mail Date: 06/18/2010

Applicant	: Jeffrey Green	: DECISION ON REQUEST FOR
Patent Number	: 7640361	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 09/935,634	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1923** 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

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400

COPY MAILED

APR 15 2008

OFFICE OF PETITIONS

In re Application of	:	
Boris Liberman	:	
Application No. 09/935687	:	DECISION ON PETITION
Filed: August 24, 2001	:	
Attorney Docket No. 200600450-1	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 9, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of July 26, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is October 27, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272 - 4914.

This application is being referred to Technology Center AU2853 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Ramesh Krishnamurthy
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

HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

COPY MAILED

MAR 29 2006

OFFICE OF PETITIONS

In re Application of	:	
Jing-Shan Hu et al	:	
Application No. 09/935,726	:	DECISION GRANTING PETITION
Filed: August 24, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. PF112P3D1C1	:	

This is a decision on the petition, filed March 22, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

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

There is no indication that Ms. Helene C. Carlson was ever given a power of attorney in this case. However, in accordance with 37 CFR 1.34, the signature of Ms. Carlson appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party in whose behalf she acts. If Ms. Carlson desires to receive correspondence regarding this file, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to Ms. Carlson, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

---

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

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

This matter is being referred to Technology Center AU 1647 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Helene C. Carlson
Sterne Kessler Goldstein & Fox PLLC
1100 New York Avenue, NW
Washington, DC 20005-3934

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HUMAN GENOME SCIENCES INC
INTELLECTUAL PROPERTY DEPT
14200 SHADY GROVE ROAD
ROCKVILLE MD 20850

COPY MAILED

SEP 12 2007

OFFICE OF PETITIONS

In re Application :
Gentz, et al. :
Application No. 09/935,727 : DECISION ON PATENT TERM
Filed: August 24, 2001 : ADJUSTMENT
Attorney Docket No. PF454P2 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed December 11, 2006, requesting correction of the initial determination of patent term adjustment (PTA) from one hundred seventy-six (176) days to three hundred twenty-seven (327) 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 twenty-seven (327) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 15, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred seventy-six (176) days. On December 11, 2006, Applicants timely[1] submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is three hundred twenty-seven (327) days.

Applicants assert entitlement to a patent term adjustment of three hundred twenty-seven (327) days on the basis that the PTO improperly assessed Applicants a delay of one hundred fifty-one (151) days for filing an Information Disclosure Statement (IDS) on May 16, 2003, after Applicants had filed a response on December 16, 2002.

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 one hundred seventy-six (176) days based on an adjustment for PTO delay of twelve (12) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), one hundred four (104), two hundred eighty-seven (287), and twelve (12) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by Applicants' delays of one hundred fifty-one (151) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8) and eighty-eight (88) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). The adjustment of 151 days is at issue.

A review of the application file reveals that the IDS filed on May 16, 2003, contained a transmittal letter, stating that it was being filed in response to a request from the Examiner. The record shows that the IDS is a copy of the IDS previously filed on December 16, 2002. In particular, applicants have included a copy of a postcard receipt, containing a USPTO date-stamp of December 16, 2002, and itemizing an IDS.

In view of the above, it is concluded that no applicant delay should have been assessed.

---

[1] Applicants filed the application for patent term adjustment together with the payment of the issue fee.

Accordingly, the correct determination of PTA at the time of mailing of the Notice of Allowance is **three hundred twenty-seven (327) days** (415 days of PTO delay and 88 days of applicant delay).

Receipt of the $200 fee 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 (571)272-3207.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enc: updated PAIR screen (2 pages)

UNITED STATES 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

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED

MAY 16 2005

OFFICE OF PETITIONS

In re Application of :
Ronald Gary Godsey et al :
Application No. 09/935,774 : ON PETITION
Filed: August 22, 2001 :
Attorney Docket No. 8231 :

This is a decision on the petition under 37 CFR 1.173(b), filed April 14, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 5, 2003, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 6, 2003.

Pursuant to petitioner's authorization, Deposit Account No. 16-2480 was charged $1,500.00 for the petition to revive an unintentionally abandoned application.

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

This file is being forwarded to Technology Center AU 3627.

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. 6

MAIL

FEB 04 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

COVINGTON & BURLING
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

In re Application of:
Rong C. Fang, et al
Application No.: 09/935,780
Filed: August 24, 2001
For: UNIFIED DATA PACKET FOR ENCAPSULATING DATA PACKETS HAVING DIVERSE FORMATS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed January 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 expiration 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 will not the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

The following attorney(s) are withdrawn from the record: Clarence E. Polk, Jr.

Future communications will continue to be directed to the address above.

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

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

COVINGTON & BURLING
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

MAIL

MAY 03 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
David John Tozer, et al
Application No.: 09/935,780
Filed: August 24, 2001
For: UNIFIED DATA PACKET FOR ENCAPSULATING DATA PACKETS HAVING DIVERSE FORMATS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request For Withdrawal As Attorney Or Agent filed March 8, 2002.

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

The request is **GRANTED**.

The following attorney(s) have been withdrawn from the record: Thomas W. Krause

Future communications from the Office will continue to be directed to the address above.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

MAIL

FEB 0 6 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

COVINGTON & BURLING
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

In re Application of:
Rong C. Fang
Application No.: 09/935,781
Filed: August 24, 2001
For: APPARATUS AND METHOD FOR FACILITATING DATA PACKET TRANSPORTATION

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

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

The request is **GRANTED**.

The following attorney(s) are withdrawn from the record: Clarence E. Polk, Jr.

Future communications will continue to be directed to the address above.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL Paper No. 8

COVINGTON & BURLING
1201 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004-2401

APR 15 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Rong C. Fang
Application No.: 09/935,781
Filed: August 24, 2001
For: APPARATUS AND METHOD FOR FACILITATING DATA PACKET TRANSPORTATION

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney of record filed March 8, 2002.

The request is **GRANTED.** Thomas W. Kraus, the requesting attorney, is withdrawn from record.

The correspondence address has not been changed.

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

Paper No. 8

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

COPY MAILED

MAY 0 6 2002

OFFICE OF PETITIONS

In re Application of :
Jaswinder Pal Singh et al :
Application No. 09/935,782 : NOTICE
Filed: August 22, 2001 :
Attorney Docket No. 25961-708 :

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 2177.

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

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

REED SMITH HAZEL & THOMAS LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042

MAILED

DEC 12 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 6

In re application of : **DECISION ON PETITION**
Victor Sopko, III et al. : **TO MAKE SPECIAL**
Application No. 09/935,843 : **(ACCELERATED**
Filed: August 24, 2001 : **EXAMINATION)**
For: METHOD AND SYSTEM FOR PROVIDING MAINTENANCE SERVICE FOR LONG-TERM CAPITAL EQUIPMENT OR FIXTURES BY PROVIDING A WARRANTY

This is in response to the renewed petition filed on October 15, 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 petition is **DISMISSED**.

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).

The petition filed October 15, 2003 fails to adequately meet requirement (E) above since the detailed discussion does not include a discussion of the "Literature Documents", listed on page 3, under the heading of "List of Relevant References".

For the above stated reasons, the petition is dismissed.

Petitioner is given one more opportunity to perfect the petition. 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. 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

RAR/cps: 12/11/03

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

REED SMITH HAZEL & THOMAS LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042

MAILED

FEB 11 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 8

In re application of : **DECISION ON PETITION**
Victor Sopko, III et al. : **TO MAKE SPECIAL**
Application No. 09/935,843 : **(ACCELERATED**
Filed: August 24, 2001 : **EXAMINATION)**
For: METHOD AND SYSTEM FOR PROVIDING MAINTENANCE SERVICE FOR LONG-TERM CAPITAL EQUIPMENT OR FIXTURES BY PROVIDING A WARRANTY

This is in response to the renewed petition filed on January 23, 2004 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/cps: 1/9/04

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

NOV 2 8 2006

OFFICE OF PETITIONS

OPTV/MOFO
c/o Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
Mclean, VA 22102

In re Application of :

Thomas Lemmons :

Application No. 09/935,873 : DECISION ON PETITION
Filed: August 23, 2001 : TO WITHDRAW
Attorney Docket No. 577172000700 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 14, 2006.

The request is **APPROVED**.

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

The request was signed by Adam Keser on behalf of all attorneys of record who are associated with Customer No. 43997.

All attorneys/agents associated with the Customer No. 43997 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action at this time.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Thomas Lemmons**
7784 S. Swaps Trail
Evergreen, CO 80439

cc: **Marc Kaufman, Esq.**
Nixon Peabody LLP
401 9th Street, N.W.
Suite 900
Washington D.C. 20004

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
09/935,873	08/23/2001	Thomas Lemmons	577172000700

CONFIRMATION NO. 9453

OC0000000021371508

OC0000000021371508

43997
OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCLEAN, VA 22102

Date Mailed: 11/27/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/14/2006.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OPTV/MOFO
C/o Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
Mclean, VA 22102

COPY MAILED

AUG 0 1 2007

OFFICE OF PETITIONS

In re Application of :
Thomas Lemmons :
Application No. 09/935,873 : DECISION ON PETITION
Filed: August 23, 2001 : TO WITHDRAW
Attorney Docket No. 043978-010000 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 17, 2007.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Morrison & Foerster LLP has been revoked by the assignee of the patent application on June 26, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams
Terri Williams
Petitions Examiner
Office of Petitions

cc: **Nixon Peabody, LLP**
401 9th Street, NW
Suite 900
Washington, DC 20004-2128

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No : _____

DATE : 1/29/09

TO SPE OF : ART UNIT 2623 (2600)

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/935,885 Patent No.: 7,386,870
Attn: Hunter Lonsberry

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

*ATTN: Ok to enter change depend. Of clm 7,8,9 & 23 as requested in COCIN?

Ernest B. Wilson, LIE
Certificates of Correction Branch
703-308-9390 ext.122

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: _____

_____

_____

_____

VLL 2/2/09
Hunter B Lonsberry **SPE** **Art Unit**

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

Primary Examiner, AU 2621

UNITED STATES 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

RYAN KROMHOLZ & MANION, S.C.
POST OFFICE BOX 26618
MILWAUKEE, WI 53226

COPY MAILED

SEP 1 2 2004

OFFICE OF PETITIONS

In re Application of :
Juan C. Parodi :
Application No. 09/935,893 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. 203-2375 CON II :

This is a decision on the petition under 37 CFR 1.137(b), filed August 16, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 19, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 20, 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, the $475 extension of time submitted with the petition on August 16, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account number 06-2360.

The statement claiming small entity status in accordance with 37 CFR 1.17(m) embodied in the petition under 1.137(b) has been made of record and small entity status has been accorded.

The application file is being forwarded to Technology Center 3700, Art Unit 3731 for further processing.

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

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RYAN KROMHOLZ & MANION, S.C.
POST OFFICE BOX 26618
MILWAUKEE WI 53226

COPY MAILED

MAY 17 2006

OFFICE OF PETITIONS

In re Application of :
Parodi :
Application No. 09/935,893 : DECISION ON PETITION
Filed: August 23, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 203-2375 CON II :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 15, 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 with the petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

All the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the

benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

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

Any inquiries concerning this decision may be directed to Shirene Willis Brantley at (571) 272-3230. 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 3734 for appropriate action on the amendment filed November 15, 2004, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application.

/Frances Hicks/

Frances Hicks
Lead Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 1

DATE : October 30, 2009

TO SPE OF : ART UNIT 3773 - Uyen (Jackie) T. Ho

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/935,893 Patent No.: 7,591,842 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

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

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

Comments: _____

11.23.09

UNITED STATES 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 19 2003

Paper No. 9

In re Application of :
Howard S. Ducotey, Jr. *et al* : DECISION ON PETITION
Application No. 09/935,896 :
Filed: August 23, 2001 :
Attorney Docket No. EH-10485

This is a decision on the petition filed by facsimile transmission on November 5, 2003 by which petitioners request withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office action dated February 11, 2003. The petition is considered pursuant to 37 CFR 1.8(b) and 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioners allege that the application is not abandoned because a timely and proper reply to the Office letter in question was in fact filed. In support of this allegation, petitioners have furnished a copy of the reply. The reply has affixed thereto a 37 CFR 1.8(a) certificate of transmission dated February 20, 2003, a date within the period of time for filing a reply as set in the Office action dated February 11, 2003. In accordance with 37 CFR 1.8(b), the reply bearing the 37 CFR 1.8(a) certificate establishes that a timely response to the outstanding Office action was in fact filed. Therefore, it is clear that this application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the examiner for action on the reply filed on February 20, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Linda A. P. Cunha
Prattt & Whitney
Patent Department -MS 132-13
400 Main Street
East Hartford, CT 06108

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

JUN - 1 2004

In re Application of	:	
William C. Schuh	:	
Serial Number : 09/935,904	:	WITHDRAWAL
Filed : August 23, 2001	:	FROM
For : SYSTEM AND METHOD OF	:	ISSUE
LEAVENING WITH CARBON DIOXIDE	:	
MONITORING	:	

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

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

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

The application is being forwarded to the examiner for action.

JMStone

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

RENNER, OTTO, BOISELLE & SKLAR, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, OH 44115

cc:Allowed Files, Pk3-915

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUN - 1 2004

In re Application of	:	
William C. Schuh	:	
Serial Number : 09/935,904	:	WITHDRAWAL
Filed : August 23, 2001	:	FROM
For : SYSTEM AND METHOD OF	:	ISSUE
LEAVENING WITH CARBON DIOXIDE	:	
MONITORING	:	

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

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

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

The application is being forwarded to the examiner for action.

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

RENNER, OTTO, BOISELLE & SKLAR, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, OH 44115

cc:Allowed Files, Pk3-915

RECEIVED
JUN 18 2004
OIPE/JC#S

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KAREN A HARDING
EASTMAN CHEMICAL COMPANY
PO BOX 511
KINGSPORT TN 37662-5075

COPY MAILED

DEC 2 0 2004

OFFICE OF PETITIONS

In re Application of :
Clauberg, et al. :
Application No. 09/935,924 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. 71348 :

This is a decision on the petition to revive under 37 CFR 1.137(a), or in the alternative under 37 CFR 1.137(b), filed July 19, 2004.

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

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

The above-identified application became abandoned for failure to timely file a reply in response to the final Office action mailed November 3, 2003. This Notice set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on February 4, 2004. A Notice of Abandonment was mailed on May 11, 2004.

Petition Under 37 CFR 1.137(a):

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

With regards to item (3), petitioner states that he did not receive the November 11, 2003 final Office action. To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[3] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[4] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing **all** replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[5]

Here, the docket report submitted only contains those papers docketed in the instant application. There is no showing of record that precludes the possibility that the November 11, 2003 final Office action was erroneously docketed in another application. Petitioner has not provided a showing of the training of the legal assistant assigned to the above-identified application.

The petition fee of $110 has been charged to petitioner's deposit account, as authorized.

---

[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 711.03(c)(II).

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

[5] Id (emphasis added).

Petition Under 37 CFR 1.137(b):

With the instant petition, petitioner made a proper statement of unintentional delay, paid the petition fee, and submitted the required reply in the form of a Notice of Appeal (and fee).

The petition fee of $1,330 has been charged to petitioner's deposit account, as authorized.

Please be advised that the two month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)) runs from the date of this decision.

The application file is being returned to Group Art Unit 2851 to await for applicant's submission of the appeal brief in triplicate.

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

Cliff Congo
Petitions Attorney
Office of Petitions

12/20/2004 CKHLOK 00000012 050221 09935924

01 FC:1453 1330.00 DA

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Lanxess Corporation
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, PA 15275-1112

COPY MAILED

JUN 27 2005

OFFICE OF PETITIONS

In re Application of	:	
Hermann Sicius, et. al.	:	
Application No. 09/935,988	:	ON PETITION
Filed: August 23, 2001	:	
Attorney Docket No. MO-6569/LEA 34,822	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 3, 2005, to revive the above-identified application.

In response to the Notice of Allowance mailed December 15, 2004, petitioner hereby submits $1,210 for the petition to revive fee, $1,400 for payment of the issue fee, $300 for the publication fee, and the statement of unintentional delay as required by 37 CFR 1.137(b). However, effective December 8, 2004, the large entity unintentional petition fee is listed as $1,500. Therefore, as authorized, the above fees totaling $3,200 have been charged to petitioner's deposit account.

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

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

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

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

NOV 3 0 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard M. Mescher
Porter, Wright, Morris, & Arthur, LLP
41 South High Street
Columbus, OH 43215

In re Application of ALLEN et al Application No.: 09/936,001 PCT No.: PCT/IB00/00205 Int. Filing Date: 08 February 2000 Priority Date: 08 February 1999 Attorney's Docket No.: NA For: APPARATUS FOR DETERMINING WHEN A PATIENT IS SUSCEPTIBLE TO DEFIBRILLATION	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is in response to the "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) " filed on 11 October 2000.

BACKGROUND

On 08 February 2000, this international application was filed, claiming an earliest priority date of 08 February 1999.

A Demand was filed on 24 August 2000 within 19 months from the priority date 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 08 August 2001. This international application became abandoned with respect to the United States at midnight on 08 August 2001 for failure pay the basic national fee.

On 06 September 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, and an executed declaration.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); 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. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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 under 35 U.S.C. 371 and for issuing a PCT/EO/DO/ form 905(Notification of missing requirements) to inform applicant that an executed Declaration or Oath is missing.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

DEC 1 2 2001

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Y. Rocky Tsao
Fish & Richardson
225 Franklin Street
Boston, MA 02110--280

In re Application of	
HANG-GOO KIM et al.	
Serial No.: 09/936,023	
PCT No.: PCT/KR00/01417	DECISION ON PETITION
Int. Filing Date: 07 December 2000	
Priority Date: 07 December 1999	UNDER 37 CFR 1.137(b)
Attorney's Docket No.: 13330-003001	
For: A DEVICE FOR PREVENTING BACK MIXTURE IN FLUIDIZED BED REACTOR	

The petition to revive under 37 CFR 1.137(b) filed 07 September 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire period of delay is 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 basic national fee of $1000 and the required petition fee of $1240 have been paid and thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

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 and the $130 surcharge for filing the oath or declaration after the twenty month period is required.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone: (703) 306-5467

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

Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105-2482

MAILED

SEP 23 2003

Technology Center 2100

In re Application of: Michael NICOLAIDIS)
Application No. 09/936,032)
Filed: March 11, 2002) **DECISION ON REQUEST FOR**
For: LOGIC CIRCUIT PROTECTED) **WITHDRAWAL AS ATTORNEY**
AGAINST TRANSITORY)
PERTURBATIONS)

This is a decision on the Request To Withdraw from Representation filed August 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 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: Basinski & Associates
113 San Nicolas Avenue
Santa Barbara, CA 93109

UNITED STATES 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

APR 2 8 2006

OFFICE OF PETITIONS

SILICON VALLEY PATENT GROUP LLP
2350 MISSION COLLEGE BOULEVARD
SUITE 360
SANTA CLARA, CA 95054

In re Application of :
NCOLAIDIS :
Application No. 09/936,032 : DECISION ON PETITION
Filed: March 11, 2002 : TO WITHDRAW
Attorney Docket No. 514842000100 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 4, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Omkar K. Suryadevara and those practitioners associated with Customer Number 34036 has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

Additionally, the request for withdrawal filed June 15, 2005 by Erwin J. Basinski is rendered moot by his recent appointment, acknowledged in a Notice of Acceptance mailed on March 16, 2006.

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

There is an outstanding office action mailed March 27, 2006 that requires a reply from the applicants.

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

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Erwin J Basinski Esq
BASINSKI & ASSOCIATES
113 San Nicolas Avenue
Santa Barbara CA 93109

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

FRANK J. NAWALANIC
1422 EUCLID AVENUE
720 HANNA BUILDING
CLEVELAND, OH 44115

COPY MAILED

SEP 1 2 2002

OFFICE OF PETITIONS

In re Application	:	
Georg Michael lckinger	:	
Application No. 09/936,039	:	LETTER
Filed: September 8, 2001	:	
Attorney Docket No. X-1139	:	

This is in response to the paper filed September 5, 2002 under 37 CFR 1.28(b) requesting that status as a Small Entity be removed.

In accordance with the September 5, 2002 request, status as a Small Entity has been removed.

This file is being forwarded to Technology Center 1700.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(703) 305-9285

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

td

JUL 1 1 2005

Mailed:

In re application of	:	
Bruno Colin et al.	:	DECISION ON
Serial No. 09/936,077	:	PETITION
Filed: December 3, 2001	:	

For: APPARATUS ENABLING LIQUID TRANSFER BY CAPILLARY ACTION THEREIN

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, MAILED May 17, 2005.

On December 1, 2004, a non-final office action was mailed to applicants. The office action contained a rejection under 35 USC 102 (b) over Nilsson et al.

A reply to the office action was filed on February 28, 2005. In the reply, applicants amended independent claim 9. The amendment overcame the 35 USC 102(b) rejection.

On May 17, 2005 a final office action was mailed. The previous rejection was withdrawn and a new ground of rejection was added. All of the claims were now rejected under 35 USC 102(e) over newly cited art to Kellogg. The examiner stated in the office action that the new ground of rejection was necessitated by Applicant's amendments to the claims and the office action was made final. On June 2, 2005, the instant petition was timely filed.

Petitioner has argued that the finality of the last office action is improper. Petitioner argues that the new ground of rejection was not necessitated by Applicant's amendment.

DECISION

Section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The non-final office action contained a proper rejection under 35 USC 102(b) over all of the pending claims in view of Nilsson et al. Applicants amended the independent claim to add the limitation that each shallow groove is adjacent to the deep grove along the entire length of said deep grove. This limitation overcame the Nilsson et al. reference. It is argued that because applicants overcame the previous rejection and were unaware of the newly cited reference, it would not be proper to make the present action final. It is also argued that because the independent claim was narrowed by the previous amendment, the new ground of rejection was not necessitated by amendment because the newly cited reference was also applicable to the previous broader version of the claim.

This argument is not persuasive. In the instant case, when applicants amended the claim to overcome the prior art, a new ground of rejection was required. The new rejection was required due to applicant's amendment to the claim. The fact that the newly cited reference was also applicable against the broader, previous version of the claim, does not change the fact that applicant's amendment clearly caused it to be cited. Under petitioner's scenario, if a newly cited rejection could not be made final if it was applicable against a previously presented broad claim, then one would be given unlimited attempts to overcome references by amendment until an allowable claim was presented. The only solution would be for the examiner to made multiple, cumulative rejections covering every possible amendment that applicant could make. This contradicts the present final rejection practice and compact prosecution. In the instant case, the examiner had no way of knowing that applicants would choose to amend the claims in the manner they did so as to necessitate a new reference containing the newly presented limitation. As a final point, it is noted that the previous ground of rejection was made under 35 USC 102(b) whereas the new rejection was made under 35 USC 102(e). Generally speaking, a 102(b) rejection is a stronger rejection than a 102(e) so therefore, the examiner made the strongest rejection available in the non-final office action.

Petitioner also urges that the newly cited reference was not cited by applicants and was first cited in the final office action. This has no bearing on whether the new ground of rejection was necessitated by applicant's amendment.

Accordingly, the examiner properly made the May 17, 2005 office action final. The petition is **DENIED**

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

JAMES C. LYDON
100 DAINGERFIELD ROAD
SUITE 100
ALEXANDRIA VA 22314

27 JUN 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

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

William L. Androlia
Koda & Androlia
2029 Century Park East, Suite 3850
Los Angeles, California 90067-3024

In re Application of	:	
DETTMANN, et al.	:	DECISION ON REQUEST
Application No.: 09/936,087	:	
PCT No.: PCT/EP99/01859	:	UNDER 37 CFR 1.497(d)
Int. Filing Date: 03 March 2000	:	
Priority Date: 06 March 1999	:	
Attorney Docket No.: 785A 3140 PCT	:	
For: SYSTEM FOR WRITING MAGNETIC SCALES	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.497(d)" filed 24 April 2002.

BACKGROUND

On 25 February 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.497(d) to add Carsten MOLLER and Torsten SCHONBACH as inventors for the above-identified application. Applicant was afforded two months in which to file a request for reconsideration.

On 24 April 2002, applicant filed the present renewed petition under 37 CFR 1.497(d).

DISCUSSION

As discussed in the decision mailed 25 February 2002, a request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

(1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;

(2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;

(3) the fee set forth in 37 CFR 1.17(i); and

(4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicant previously satisfied Item (3) above.

As to Item (1), applicant has now provided statements from Carsten MOLLER and Torsten SCHONBACH declaring that the error occurred without any deceptive intention on his or her part.

Regarding Item (2), applicant has presently filed a compliant declaration executed by joint inventors Fritz DETTMANN, Uwe LOREIT, Carsten MOLLER and Torsten SCHONBACH.

As to Item (4), applicant has now provided the written consent of the assignee in compliance with 37 CFR 3.73(b).

Therefore, applicant has satisfied all four items above and it is proper to **GRANT** the request under 37 CFR 1.497(d) at this time.

CONCLUSION

For the reasons discussed above, the request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicant has now completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 03 March 2000 and a date of **24 April 2002** under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

FEB 25 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William L. Androlia
Koda & Androlia
2029 Century Park East, Suite 3850
Los Angeles, California 90067-3024

In re Application of	:	
DETTMANN, et al.	:	DECISION ON REQUEST
Application No.: 09/936,087	:	
PCT No.: PCT/EP99/01859	:	UNDER 37 CFR 1.497(d)
Int. Filing Date: 03 March 2000	:	
Priority Date: 06 March 1999	:	
Attorney Docket No.: 785A 3140 PCT	:	
For: SYSTEM FOR WRITING MAGNETIC SCALES	:	

This decision is in response to applicant's "Petition For Correcting Inventorship" filed 21 November 2001. The papers are being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 03 March 2000, applicant filed international application PCT/EP99/01859, which claimed priority of an earlier application filed 06 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 September 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 06 September 2001.

On 06 September 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); a translation of the International Application into English; an International Search Report; an International Preliminary Examination Report and a translation of the annexes to International Preliminary Examination Report.

On 29 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. Applicant was also notified of the need to pay the $65.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 21 November 2001, applicant responded with the present "Petition For Correcting Inventorship"; a combined declaration and power of attorney executed by Fritz DETTMANN, Uwe LOREIT, Carsten MOLLER and Torsten SCHONBACH; an assignment document for recording executed by Fritz DETTMANN, Uwe LOREIT, Carsten MOLLER and Torsten SCHONBACH; a copy of the bibliographic information for the German priority document; a check in the amount of $65.00 as payment of the surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date; a check in the amount of $130.00 as payment of the petition fee and a check in the amount of $40.00 as payment of the assignment recordation fee.

DISCUSSION

Regarding applicant's reference in the present petition to 37 CFR 1.48(f), it is noted that 37 CFR 1.48 applies only to applications filed under 37 CFR 1.53(b). As detailed further in 37 CFR 1.48(f), 37 CFR 1.497(d) controls in cases concerning the submission of an oath or declaration to enter the national stage under 35 U.S.C. 371.

A request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

(1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;

(2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;

(3) the fee set forth in 37 CFR 1.17(i); and

(4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

As Item (3), applicant has provided a check in the amount of $130.00 as payment of the petition fee. Applicant therefore has satisfied Item (3).

Regarding Item (1), applicant has not provided statements from Carsten MOLLER and Torsten SCHONBACH declaring that the error occurred without any deceptive intention on their part.

As to Item (2), the filed declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that no citizenship has been provided for Carsten MOLLER and Torsten SCHONBACH.

Regarding Item (4), applicant has not provided the written consent of the assignee in compliance with 37 CFR 3.73(b).

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons discussed above, the request under 37 CFR 1.497(d) is **DISMISSED**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

02 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard Berg
Ladas & Parry
5670 Wilshire Blvd., Suite 2100
Los Angeles, California 90036

In re Application of :
CHEN et al. :
Application No.: 09/936,132 : DECISION ON PETITION
PCT No.: PCT/GB00/00751 :
Int. Filing Date: 03 March 2000 :
Priority Date: 05 March 1999 :
Attorney Docket No.: B-4294PCT 619054-4 :
For: COMPUTING APPARATUS AND METHODS USING SECURE AUTHENTICATION ARRANGEMENTS

This is a decision on applicants' "Request for Corrected (Filing) Receipt" which is being treated as a petition under 37 CFR 1.10(c) filed in the Patent and Trademark Office on 22 July 2002.

BACKGROUND

On 04 September 2001, applicants timely filed a request to enter into the national stage under 35 U.S.C. 371 along with the appropriate basic national filing fee, a copy of the international application, an executed declaration and power of attorney, and a preliminary amendment.

On 16 October 2001, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 06 September 2001. Subsequently, an Official Filing Receipt was issued indicating a "FILING DATE" of 06 September 2001.

On 22 July 2002, applicants filed the present request to correct the filing date to 04 September 2002. The request to correct the filing date included a copy of the Customer Receipt of the United States Postal Service "Express Mail" mailing label #EL653176548US.

DISCUSSION

On 22 July 2002, applicants filed the petition requesting that the filing date on the Notification of Acceptance and Official Filing Receipt be corrected to indicate the correct date on which the transmittal letter for entry into the national stage in the United States and accompanying papers were filed and on which the requirements under 35 U.S.C. 371 (c) were completed, 04 September 2001.

A copy of the Customer Copy of the "Express Mail" label No.#EL653176548US filed with the petition bears a "Date In" date of 04 September 2001, and further information

obtained from the United States Postal Service (USPS) Express Mail database shows that "#EL653176548US" was accepted by the USPS on 04 September 2001. The same "Express Mail" label number was placed on the transmittal letter for entry into the national stage in the United States and accompanying papers located in the application file, but was date stamped as received in the PTO on 06 September 2001.

Pursuant to 37 CFR 1.10 (c), the promptly presented evidence is convincing that transmittal letter for entry into the national stage in the United States and accompanying papers were filed on 04 September 2001. Thus, the application met the requirements of 35 U.S.C. 371(c) and thus entered the national stage in the United States on 04 September 2001, and therefore the indication of a filing date of 06 September 2001, on the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 and the Official Filing Receipt are incorrect.

CONCLUSION

Applicants' request for issuance of a corrected filing receipt under 37 CFR 1.10(c) is **GRANTED**.

Applicants' request for the correction of the title of invention to "Computing apparatus and methods using secure authentication arrangements" is **GRANTED**.

Applicants' request to issue a corrected filing receipt listing the Foreign Application as "United Kingdom 9905056.9 filed 03/05/1999" 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) and Official Filing Receipt are hereby **VACATED**.

The application has an international filing date of **14 December 1999** under 35 U.S.C. 363 and a date of **04 September 2001** under 35 U.S.C. 371(c).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) which identifies a date of **04 September 2001** U.S.C. 371(c) and preparation and mailing of a corrected Filing Receipt in accordance with this decision, that is a filing receipt that identifies a filing date of **04 September 2001**.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: (703)308-6314
Fax: (703)308-6459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

14 SEP 2004

#10

UNITED STATES PATENT and TRADEMARK OFFICE

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

Philip S. Johnson
Johnson & Johnson
One Johnson & Johnson Plaza
Room 3637
New Brunswick NJ 08933-0002

In re Application of	:	
FUJII et al	:	DECISION ON
Application No.: 09/936,151	:	
PCT No.: PCT/JP00/01681	:	
Int. Filing Date: 17 March 2000	:	PETITION UNDER
Priority Date: 17 March 1999	:	
Attorney Docket No.: JJM-472	:	
For: STERILIZING AGENT CAPSULE CONTAINER AND STERILIZER USING THE SAME	:	37 CFR 1.181

This decision is in response to the "PETITION FOR WITHDRAWAL OF ABANDONMENT" received 21 April 2003, which is being treated as a petition under 37 CFR 1.181 requesting acceptance of a copy of the Declaration submitted as filed in the USPTO on 15 April 2002. The decision is also in response to the supplemental response received on 27 June 2002 indicating a change of the inventor's name. Applicants have submitted, inter alia, a copy of the 15 April 2002 PTO stamped itemized postcard receipt. The itemized postcard lists, inter alia, the following item: Declaration. The five (5) months fee, $2,010.00, extension of time has been charged to applicants' Deposit Account No.: 10-0750/JJM472/ACF

BACKGROUND

On 07 September 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), a copy of the international application. Applicants, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because no executed Declaration or Oath was provided with the transmittal letter.

On 01 November 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 1.47(a) and (b), in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68, and $130.00 surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date (37 CFR 1.492(e)) is required. The notice also indicated that the items above must be submitted within two (2) months from the date of this

notice or by 22 or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 09 May 2002, the DO/EO/US mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) which indicated that the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: 2nd inventor name "Takeshi Orii" is not the same on Request form or Publish application.

On 10 December 2002, the DO/EO/US erroneously mailed a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) which indicated that applicant had failed to respond to the "NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905), mailed 11/01/2001 within the time period set therein. Accordingly the application was abandoned.

In response to the "NOTIFICATION OF ABANDONMENT" mailed on 10 December 2002, petitioner submitted on 21 April 2003 the instant petition requesting withdrawal of the Notice of Abandonment. In support of the request, petitioner has provided a copy of the returned/stamped receipt card acknowledging a receipt date of 15 April 2002.

DISCUSSION

I. 37 CFR 1.181:

A review of the file reveals that applicant's originally filed papers(executed declaration) was received in the USPTO on 15 April 2002 and placed in US application 09/936,151.

Consequently, since the original declaration filed on 15 April 2002 was placed in the application file, the petition filed on 21 April 2003 is **MOOT**.

II. TRANSLATION ERROR OF THE NAME OF SECOND INVENTOR:

On 15 April 2002, applicants filed an executed declaration. In the given name of the of the second inventor, the name "Takeshi" appears; this first given name did not appeared in the international application.

As indicated in the 27 June 2002 supplemental response, the correct name of the second inventor is "Takeshi Orii" and not "Ken Orii" as published in PCT application WO00/55070, which was the result of a translation error as explained in the supplemental response filed on 27 June 2002. It indicated that the name "Ken" comes from an incorrect translation in the PCT application. The discrepancy occurred because the name "Ken" and the name "Takeshi" are both derived from one Chinese character in Japanese.

Applicants' response is accepted as a sufficient response to the Notification of Defective Response (FORM PCT/DO/EO/916) mailed on 09 May 2002. The correct name "Takeshi Orii" will be reflected in the US national stage processing. See MPEP 605.04(b).

DECISION

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

Applicants' request to withdraw the "NOTIFICATION OF ABANDONMENT" is **GRANTED** since the reply filed on April 15, 2002 to the Notification of Missing Requirements mailed on 01 November 2001 was timely. The NOTIFICATION OF ABANDONMENT, mailed 10 December 2002 has been **VACATED**.

Further, the filing receipt will reflect the correct name of the second inventor as "Takeshi Orii." The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision, that is, for issuance of a Notification of Acceptance of Application (Form PCT/DO/EO/903) identifying a 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of **15 April 2002**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No: 5

Joseph W. Price
Price & Gess
Suite 250
2100 SE Main Street
Irvine, California 92614

MAILED

MAY 2 9 2002

Technology Center 2100

In re Application of: Osamu Shibata et al.)
Application No. 09/936,157)
Filed: September 6, 2001) **DECISION ON PETITION FOR**
For: AUTHENTICATION) **ACCELERATED EXAMINATION**
COMMUNICATION APPARATUS) **UNDER M.P.E.P. §708.02(VIII)**
AND AUTHENTICATION)
COMMUNICATION SYSTEM)

This is a decision on the petition, filed March 15, 2002 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);

(b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

(c) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FULBRIGHT & JAWORSKI
600 Congress Avenue
Suite 1900
Austin, TX 78701

COPY MAILED

FEB 0 9 2006

OFFICE OF PETITIONS

In re Application of	:	
Richard A. Dixon, et. al.	:	
Application No. 09/936,190	:	ON PETITION
Filed: December 9, 2001	:	
Attorney Docket No. NBLE:026US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on August 3, 2005, 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 on May 2, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of $700 for payment of the issue fee; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

The Office acknowledges receipt of $9 for three (3) advance soft copies and an authorization to charge $750 for the petition fee. As authorized, the petition fee has been charged to petitioner's deposit account.

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

FEB 2 5 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John N. Coulby
Collier Shannon Scott PLLC
3050 K Street, N.W., Suite 400
Washington, D.C. 20007

In re Application of :
TROUT et al. :
Application No.: 09/936,202 : DECISION ON PETITION
PCT No.: PCT/US00/03871 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 04 February 2000 :
Priority Date: 05 February 1999 :
Attorney Docket No.: 23660-00623 :
For: SURGICAL GUIDE LINE AND SEPARATOR FOR USE DURING A SURGICAL PROCEDURE

The petition to revive under 37 CFR 1.137(b) filed 10 September 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 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 applicants have submitted the basic national fee of $345 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.

However, the declaration filed on 10 September 2001 is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes a duplicate sheet of page 2 of 2. It is unclear if the inventors were presented with only page 2, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 10 September 2001, which is improper. (See MPEP 201.03.)

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

Technology Center 1700

Mailed: 11/5/04

rvk
Paper Number: ____

In re application of :
Claude Maurice Dreulie et al : DECISION ON
Serial No. 09/936,231 : PETITION
Filed: September 12, 2001 :
For: BOX FOR SET OF ELECTRIC STORAGE BATTERIES :

This is a response to the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE HOLDING OF ABANDONMENT, filed September 08, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of August 26, 2004, for failure to timely file a proper response to the Office letter dated October 15, 2003 be withdrawn. The petitioner asserts that the Office letter of October 15, 2003 was not received by applicants.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action. See MPEP 711.03(c)(II).

The evidence presented is sufficient to establish that the Office letter of October 15, 2003 was not received by petitioner. The evidence provided includes a statement by the petitioner that the Office letter of October 15, 2003 was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Office letter of October 15, 2003 was not received. Also provided are: (1) a copy of the attorney's manual docket record where the Office letter of October 15, 2003 would have been posted had it been received and docketed for a due date of January 15, 2004 (Exhibit A); (2) a copy of the attorney's computer docket record where the non-received Office letter would have been posted had it been received and docketed for a due date of January 15, 2004 (Exhibit B); and (3) a copy of the attorney's file jacket of the instant

application, which reveals that no additional entry has been made thereon following the filing of the amendment dated August 05, 2003(Exhibit C).

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the examiner for prompt remailing of the above noted Office letter to the correspondence address and restarting of the statutory period of response from the remail date thereof.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON, VA 22202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CLEMENTS WALKER
1901 ROXBOROUGH ROAD
SUITE 300
CHARLOTTE, NC 28211

COPY MAILED

DEC 20 2006

OFFICE OF PETITIONS

In re Patent No. 6,973,121 :
Issue Date: December 6, 2005 :
Application No. 09/936,250 : ON PETITION
Filed: October 9, 2001 :
Attorney Docket No. 3222 :

This is a decision on the petition under 37 CFR 1.182, filed July 26, 2006, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The Publishing Division is directed to issue duplicate Letter Patent.

Any questions concerning this matter may be directed to Irvin Dingle at (571) 272-3210. Any questions concerning issuance of the duplicate Letters Patent should be directed to either Krystal Paige at (703) 308-9250 ext. 139.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Krystal Paige, South Tower 8th Floor, C-32 Fax (571) 270-9937.

UNITED STATES 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

BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510

COPY MAILED

NOV 0 2 2006

OFFICE OF PETITIONS

In re Application of	:	
Bernard Vallee	:	
Application No. 09/936,251	:	ON PETITION
Filed: September 7, 2001	:	
Attorney Docket No. 05-804	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 30, 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 September 25, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 26, 2003.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This application is being forwarded to Technology Center AU 3636 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

HOWSON AND HOWSON
ONE SPRING HOUSE CORPORATION CENTER
BOX 457
321 NORRISTOWN ROAD
SPRING HOUSE, PA 19477

COPY MAILED

OCT 2 6 2005

OFFICE OF PETITIONS

In re Application of :
George M. Yousef et al :
Application No. 09/936,271 : DECISION GRANTING PETITION
Filed: September 10, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. MTS3USA :

This is a decision on the petition, filed October 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 October 14, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1636 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b) (along with any balance due or the amount due at the time of payment), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form* **must** *be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).*

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8/14/08

TO SPE OF : ART UNIT 1636 C. Qian

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/936271 Patent No.: 7032497

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

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:

Please note that there are two (2) IMIS documents and only one (1) COCIN document. The entry of the corrections is approved.

/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1636

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Bromberg & Sunstein LLP
125 Summer Street
Boston, MA 02110-1618

In re Application of :
GILES, Richard Courthope, et al. :
Application No.: 09/936,280 : DECISION ON
PCT No.: PCT/AU00/00171 :
Int. Filing Date: 10 March 2000 : PETITION
Priority Date: 10 March 1999 :
Attorney Docket No.: 2373/103 : UNDER 37 CFR 1.181
For: TREE HARVESTING APPARATUS :

This decision is in response to "Petition to Reset Period For Response Due to Non-Receipt of Action," filed with the United States Patent and Trademark Office on 05 November 2002. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 10 March 2000, applicants filed international application PCT/AU00/00171. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 14 September 2000. On 28 September 2000, applicant filed a Demand for international preliminary examination, 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 on 10 September 2001.

On 10 September 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 30 October 2001, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905), indicating that a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 13 August 2002, applicants submitted "Completion of Filing Requirements," indicating that applicants had not received a Notification of Missing Requirements accompanied by an executed declaration.

On 05 November 2002, applicants submitted the instant petition under 37 CFR 1.181, accompanied by a copy of the executed declaration.

On 13 March 2003, the Office mailed Notice of Acceptance (Form PCT/DO/EO/903) indicating that the application's 35 USC 371 dates were 13 August 2002.

DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing 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 record must also be referenced in practitioner's statement).

Item (1) has been satisfied.

Items (2) and (3) have not been satisfied.

The declaration incorrectly identifies the filing date of the international application. Though declaration complies with 37 CFR 1.497(a)-(b), it does not comply with 37 CFR 1.63. Additionally, the declaration appears complete, but it is numbered page 1 of 9 through page 4 of 9. A new declaration in compliance with 37 CFR 1.497(a)-(b) and 37 CFR 1.63 is required.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The Notification of Acceptance mailed 13 March 2003 is **VACATED**.

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."

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

12 FEB 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

Bromberg & Sunstein LLP
125 Summer Street
Boston, MA 02110-1618

In re Application of	:	
GILES, Richard Courthope, et al.	:	
Application No.: 09/936,280	:	DECISION ON
PCT No.: PCT/AU00/00171	:	
Int. Filing Date: 10 March 2000	:	PETITION
Priority Date: 10 March 1999	:	
Attorney Docket No.: 2373/103	:	UNDER 37 CFR 1.181
For: TREE HARVESTING APPARATUS	:	

This decision is in response to "Renewed Petition Under 37 CFR 1.181," filed with the United States Patent and Trademark Office on 05 November 2003.

BACKGROUND

On 10 March 2000, applicants filed international application PCT/AU00/00171. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 14 September 2000. On 28 September 2000, applicant filed a Demand for international preliminary examination, 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 on 10 September 2001.

On 10 September 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 30 October 2001, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905), indicating that a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 13 August 2002, applicants submitted "Completion of Filing Requirements," indicating that applicants had not received a Notification of Missing Requirements accompanied by an executed declaration.

On 05 November 2002, applicants submitted a petition under 37 CFR 1.181, accompanied by a copy of the executed declaration.

On 13 March 2003, the Office mailed Notice of Acceptance (Form PCT/DO/EO/903) indicating that the application's 35 USC 371 dates were 13 August 2002.

On 05 September 2003, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicants' petition without prejudice and vacating the Notice of Acceptance mailed 13 March 2003.

On 05 November 2003, applicants filed the instant renewed petition.

DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing 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 record must also be referenced in practitioner's statement).

Item (1) was previously satisfied.

Items (2) and (3) have now been satisfied.

The supplementary declaration satisfies 37 CFR 1.497(a)-(b) and 37 CFR 1.63. The declaration submitted on 05 November 2002 was accompanied by a statement indicating it had been previously submitted on 13 August 2002, signed by someone registered to practice before the Office and a date stamped postcard receipt for 13 August 2002, identifying the application and listing a declaration. For the above reasons, the 05 November 2002 declaration is accepted as having been received on 13 August 2002.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt. The date under date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 13 August 2002.

Erin M. Pender

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

EXXONMOBIL RESEARCH AND ENGINEERING COMPANY
P.O. BOX 900
1545 ROUTE 22 EAST
ANNANDALE, NJ 08801-0900

COPY MAILED

AUG 2 4 2005

OFFICE OF PETITIONS

In re Application of :
Bons, et al. :
Application No. 09/936,312 : ON PETITION
Filed: February 12, 2002 :
Attorney Docket No. 99M006 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 5, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee and publication fee, if applicable, on or before May 18, 2004. Accordingly, this application became abandoned on May 19, 2004. A Notice of Abandonment was mailed on July 27, 2004.

This application is being forwarded to Publishing Division for processing into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions/Patent
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 20 2005

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

In re Application of :
Matthias Witschel et al :
Serial No.: 09/936,356 : PETITION DECISION
Filed: September 11, 2001 :
Attorney Docket No.: 49828 :

This is in response to the petition under 37 CFR 1.144, filed June 10, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on September 11, 2001, and, as amended, contained claims 1-21. In a first Office action, mailed January 17, 2003, the examiner set forth a Lack of Unity requirement dividing the claims into at least 13 groups, as follows:

Group I – claims 1-7 and 14-17, drawn to products of formula I, where X=O and Y forms a pyridine;

Group II – claims 1-6, 8 and 12-17, drawn to products of formula I, where X=C and Y forms a pyrazole;

Group III - claims 1-6, 9 and 14-17, drawn to products of formula I, where X=S and Y forms an oxazole;

Group IV - claims 1-6, 10 and 14-17, drawn to products of formula I, where X= a bond and Y forms a thiazole;

Group V - claims 1-6, 11 and 14-17, drawn to products of formula I, where X=O and Y forms a pyrazine;

Group VI - claim 18, drawn to products of formula VI, where X=S and Y forms a pyridine;

Group VII - claim 18, drawn to products of formula VI, where X=O and Y forms a pyrazole;

Group VIII - claim 19, drawn to products of formula IX, where X=O and Y forms an oxazole;

Group IX - claim 19, drawn to products of formula VI, where X=S and Y forms a thiazole;

Group X - claim 20, drawn to products of formula XV, where X= C and Y forms a pyrazine;

Group XI - claim 20, drawn to products of formula XV, where X= a bond and Y forms a pyridine;

Group XII - claim 21, drawn to products of formula XVI, where X=O and Y forms a pyridine;

Group XIII - claim 21, drawn to products of formula XVI, where X=S and Y forms a pyrazole;

The examiner required applicants to elect a single invention as set forth in the enumerated groups or to identify another specific embodiment to which the claims would be restricted. The examiner stated that the groups lack a common special technical feature since the base tricyclic compounds vary in structure and ring atoms (i.e. Y forms one of the tricycle, rings as does X)

On February 10, 2003, applicants replied by amending the claims, canceling claim 17 and adding claims 22-23 and then elected the compounds identified in claim 22 and a species therewithin. The elected compounds did not fall within any of the above enumerated groups. Applicants traversed the holding on the basis that the special technical feature is not required to define over the prior art.

The examiner mailed a new Office action to applicants on December 31, 2003, maintaining the Lack of Unity requirement and replying to applicants' traversal by maintaining that the common special technical features argued by applicants are to significantly different compounds. The requirement was made Final. The examiner also rejected claims 1-6, 8, 12, 14-16 and 22-23 under 35 U.S.C. 103(a) as unpatentable over Tseng et al.

Applicants replied on June 30, 2004, canceling claims 2-4 and 22 and amending claims 1, 5, 11 and 23, again traversing the Lack of Unity requirement and arguing the rejection of record.

The examiner mailed a Final Office action to applicants on February 16, 2005, noting that applicants have amended the claims to include only the elected group, but continued the traversal with respect to intermediate compound claims 18-21. The examiner replied and maintained the finality of the holding. The examiner then rejected claims 1-6, 8, 12, 14-16 and 22-23 (sic 1, 5-6, 8, 12, 14-16 and 23) under 35 U.S.C. 103(a) as unpatentable over Tseng et al, as before., and made the action Final.

Applicants filed this petition and a reply to the Office action on June 10, 2005. A Notice of Appeal was filed on June 16, 2005.

DISCUSSION

Applicants first argue that the initial Lack of Unity holding is in error because the PCT Rules and guidelines do not require that the special technical feature define a contribution over the art and that the reference relied on by the examiner fails to show the special technical feature which applicants rely on. Applicants state that the claims relate to compounds and intermediates for their preparation and rely on the tricyclic structure of a benzene ring fused to a five member

unsaturated ring which is fused to a variable sized ring which may be heterocyclic and saturated or unsaturated. Applicants also argue that the structures of formulas XVI, XV, IX and VI are intermediates to the final product, but all contain the tricyclic structure. Applicants request that the claims as presently pending be considered to have Unity and that withdrawn claims 18-21, drawn to intermediates be rejoined for examination purposes.

As applicants request review with respect to only presently pending claims which have been amended to a limited structure, review with respect to the original requirement as pertaining to other Groups, the claims to which have been canceled, will not be made.

A review of the pending claims shows that claims 1, 5 and 6 are directed to a benzopyrazole structure of formula I where X is a bond and Y forms an oxazole ring. Claims 7-13 are to various processes of preparing the compound of claim 1 using various precursors reacted with a tricyclic benzoic acid. Claim 14 is to the composition as a herbicide and claim 15 to the herbicide preparation and claim 16 to controlling unwanted vegetation with the herbicide. Withdrawn claims 18-21 are to tricyclic benzoic acid or benzene or cyano or aniline precursors all of which contain the tricyclic structure of claim 1 on which Unity for all other claims is based. These structures lack only R^9 which is the pyrazole bonded to the basic tricyclic structure in the place of the acid, cyano or amino function. As the examiner based the original Lack of Unity requirement on the tricyclic structure and not on variable R^9, the intermediate compounds are found to contain all of the requirements set forth by the examiner for the special technical feature on which Unity was based. These claims, under PCT Rules and guidelines, are to be examined with the product claims since the intermediate contains all of the special technical features of the final product.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of all claims pending including withdrawn claims 18-21.

In view of the above decision, the Finality of the last Office action is withdrawn as the Office action is incomplete. Therefor, applicants' Notice of Appeal is premature and is held in abeyance until a proper Final Office action ensues and applicants choose to pursue a proper Appeal. A new Notice of Appeal will not require a fee unless applicants, in view of the above decision, request refund of the Appeal Fee paid.

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, 571-273-8300

George C. Elliott

George C. Elliott
Director, Technology Center 1600

29 JAN 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

Robert M. Barrett
Bell, Boyd & Lloyd, LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

In re Application of :
AFFOLTER, et al. : DECISION ON PETITIONS
U.S. Application No.: 09/936,367 :
PCT No.: PCT/EP00/01796 : UNDER 37 CFR 1.181
Int. Filing Date: 02 March 2000 :
Priority Date: 11 March 1999 : AND 1.137(b)
Attorney Docket No.: 112843-029 :
For: EXPRESSION OF PROTEOLYTIC :
ENZYMES IN KOJI MOLD IN THE :
PRESENCE OF CARBON SOURCES :

This decision is in response to applicant's correspondence filed 31 July 2003 which is being treated as a petition under 37 CFR 1.181 and "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 22 January 2004. No petition fee is due for the petition under 37 CFR 1.181. Applicant included authorization to charge the $1330.00 petition to revive fee to Deposit Account No. 02-1818.

BACKGROUND

On 02 March 2000, applicant filed international application PCT/EP00/01796, which claimed priority of an earlier application filed 11 March 1999. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 September 2001.

On 11 September 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); an unexecuted declaration; a copy of the international search report and a First preliminary amendment.

On 30 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 executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also informed of the need to provide a nucleotide and/or amino acid sequence disclosure in compliance with 37 CFR 1.821-1.825. Applicant was afforded two months to file the response.

01/30/2004 EHAJARI0 00000150 021818 09936367

On 23 January 2002, applicant responded with an executed combined declaration and power of attorney.

On 30 May 2002, the present application became abandoned as to the United States for failure to fully respond to the Form PCT/DO/EO/905 mailed 30 October 2001.

On 31 July 2003, applicant filed copies of papers purportedly filed 28 March 2003 including a paper sequence listing and diskette for the present application.

On 22 January 2004, applicant filed the present petition to revive pursuant to 37 CFR 1.137(b).

DISCUSSION

I. Petition Under 37 CFR 1.181

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Applicant's 31 July 2003 filing includes a copy of a date-stamped postcard receipt. The postcard identifies the application by applicant, application number and docket number. Among the items listed on the receipt are: "6. Sequence Listing Statement (1 page); 7. Sequence Listing Document (3 pages); and 8. Diskette Containing Computer Readable Form of Sequence Listing (1 diskette)" The receipt is stamped "DT13 Rec'd PCT/PTO 28 MAR 2003." Thus, it is clear that applicant filed a these items on 28 March 2003. As such, it is proper to accept the papers filed on 31 July 2003 as having been filed 28 March 2003. Thus, it is proper to grant applicant's petition under 37 CFR 1.181.

II. Petition Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition 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 (2), applicant included authorization to charge the $1330.00 petition fee to Deposit Account No.: 02-1818.

As to Item (3), applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies Item (3).

With regard to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Thus, applicant has satisfied Items (2) - (4) above.

However, with regard to Item (1), the proper response was the required sequence listing pursuant to 37 CFR 1.821-1.825. The computer readable form filed 31 July 2003 (held to have been filed 28 March 2003 per the above) was found to be non-compliant and a corrected diskette is needed. (See attached copy of CRF Problem Report.) Accordingly, the proper reply has not been furnished.

For the reasons stated above, the petition for revival cannot be granted at this time and the application remains abandoned.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

Applicant's petition under 37 CFR 1.137(b) is **DISMISSED**.

This application remains abandoned as to the United States of America.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the 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.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

#7

CRF Errors Edited by the STIC Systems Branch

Serial Number: 09/936,367

CRF Edit Date: 12/11/03
Edited by: KZ

ENTERED

___ Realigned nucleic acid/amino acid numbers/text in cases where the sequence text "wrapped" to the next line

___ Corrected the SEQ ID NO. Sequence numbers edited were:

_____

___ Inserted or corrected a nucleic number at the end of a nucleic line. SEQ ID NO's edited:

_____

J J Deleted: J invalid beginning/end-of-file text ; ___ page numbers

___ Inserted mandatory headings/numeric identifiers, specifically:

_____

___ Moved responses to same line as heading/numeric identifier, specifically:

_____

___ Other:

_____

_____

_____

PCT

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: **US/09/936,367** TIME: 11:17:12

Input Set : **A:\PTO.AMC.txt**
Output Set: **N:\CRF4\12082003\I936367.raw**

```
      3 <110> APPLICANT: Societe des Produits Nestle
      5 <120> TITLE OF INVENTION: creA-gene
      7 <130> FILE REFERENCE: 80050
C-->  9 <140> CURRENT APPLICATION NUMBER: US/09/936,367
C--> 10 <141> CURRENT FILING DATE: 2001-09-11
     12 <150> PRIOR APPLICATION NUMBER: 99 104 923.0
     13 <151> PRIOR FILING DATE: 1999-03-11
     15 <160> NUMBER OF SEQ ID NOS: 2
     17 <170> SOFTWARE: PatentIn Ver. 2.1
     19 <210> SEQ ID NO: 1
     20 <211> LENGTH: 4238
     21 <212> TYPE: DNA
     22 <213> ORGANISM: Aspergillus oryzae
     24 <400> SEQUENCE: 1
     25 ctgcagttcc agtttctacc ccgtaaatcc ctatcaactt agtccgcccc acattctttt 60
     26 tttttttcc ttttttttc gctcccggtc agagtgatag tgggatttat tacacaccgt 120
     27 gcgtggtcga agaacgacac ggaagaagcc ccggaagacg ccttctctag gcaacaaatg 180
     28 attgtactct tatgatactc aatacggtag aaaatagaga attgagatac gaaagctgac 240
     29 tcatcagaac agaataaggg gaatttttga ttagcaaata acaataataa ttatacaaaa 300
     30 aaacaaataa aaaaatttag gggactcccc acccgctgta atcctgggtg tatctcaaag 360
     31 caaagcaggc gatctggggg gagcacgttc ttttttttc ttttctcttt tttctatttt 420
     32 ttttttttt tttattttag gtctatgcct ttttttttct tttcctttt ttttttttt 480
     33 tttgcccccc gataattctc cccacacata ggacatactt ttttttttt tccttccact 540
     34 cccttcaagg tctccgattc cgataacccc ctctaccagt tcgccctgcc tttttctctc 600
     35 ccctcccccg aagctccatt tctctcttct tcccctccat tcctcattct tcctcttccg 660
     36 tatttccttt atatgctcct atccccagac catttctcca gatttctctc tctttccccc 720
     37 ctctcccttt cgacaaattg ttgcttgact acatccatct cgggttacct acttacagta 780
     38 ccaattccgg atatactcta tcccacccat caccacattc cataacagcg ccctttcatt 840
     39 gggaaagtca ctcttccttg aaattggtta catcgcggac catcgtacct tctttaatcg 900
     40 caaggcttgt gatactcttg cggtgctcgt tcatcaacta gtactttgcc aagagcaagt 960
     41 ctccgtcttg tcgggtggtg atcgactctc cccgatttac ctacccctgt tgcgacgaat 1020
     42 cctgattcgc ctcggctcgt cagcccttcc gagcttccct taagtacagg cttcgtcccc 1080
     43 tctttagctg cactcctcgg tgctaggtta ggacgagtca catgccacca ccggcttctt 1140
     44 cagtggattt caccaatctg ctgaaccctc agaataacga gactggttct gcaccttcca 1200
     45 cgccagtgga tagctccaag gctccctcta ccccgtccag tactcagtcc aactctacca 1260
     46 tggcctcgtc tgttagctta ctaccgcccc tcatgaaggg tgctcgtccc gcaacggaag 1320
     47 aagcgcgcca ggatcttccc cgtccataca agtgtcccct gtgtgatcgc gccttccatc 1380
     48 gtttggagca ccagaccaga catattcgca cacatacggg tgaaaagcca cacgcttgcc 1440
     49 agttcccggg ctgcacaaaa cgctttagtc gctctgacga gctgacacgc cactcaagaa 1500
     50 ttcacaacaa ccccaactcc aggcggagta acaaggcaca tctggccgct gccgctgccg 1560
     51 ctgccgctgc cggacaagag aatgcaatgg taaatgtgac caacgcgggc tcgttgatgc 1620
     52 ccccgcccac aaagcctatg acccgctctg cgcctgtctc tcaggttgga tctccggatg 1680
     53 tctcccctcc gcactccttc tcgaactatg ccggtcacat gcgttccaat ctgggaccat 1740
```

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:17:12

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

54 atgctcgcaa caccgagcgg gcgtcctcgg gaatggatat caatctactt gccaccgctg 1800
55 catctcaggt tgagcgtgat gaacaacatt ttgggttcca cgctggtcca cgtaatcacc 1860
56 atttgttcgc ctcgcgtcac cacaccggtc gtggcctgcc ttccctttca gcgtacgcca 1920
57 tctcgcacag catgagccgt tctcactttc acgaggacga ggatggttac actcatcgcg 1980
58 tcaagcgctc aaggcctaac tcaccaaact cgaccgctcc gtcctcaccg actttctctc 2040
59 acgactctct ttccccaacg ccagaccaca ctccgttggc aacccctgct cattcgccac 2100
60 gcttgaggtc attgggatct agcgaactcc accttccttc gattcgccat ctgtccctcc 2160
61 atcacacccc tgcccttgct ccaatggagc cccagccgga aggccccaac tattacagtc 2220
62 ccagccagtc tcatggtccc acaatcagcg atatcatgtc cagacccgac ggaacacagc 2280
63 gtaaactgcc cgttccacag gttcccaagg tcgcggtgca agatatgctg aaccccagcg 2340
64 ctgggttttc gtcggtttcc tcatcgacga ataactctgt cgcaggaaat gatttggcag 2400
65 aacgtttcta gcctggtgcg gctgcgaaac cctttcaatg tataaagttt tgggctcaaa 2460
66 aaaaattctt gactgtcata cgcgctacga aacgaataga ctttgtgcat ttacagtgcg 2520
67 tggttcatgg gcatccttgg tgtcggctgg ctttctttgc ttactttgtt cgagtatact 2580
68 tttgcgaggc gtccatagtg atagacgggt gggatattct tgtggctttt tccgtgcttg 2640
69 ttcgattctc ccctttcgct ctccttgaaa aataccttte ttatcctata accatttgtt 2700
70 tcattatccc aatgggaatt ggctctacag ctcttattca ttttgtctac tcctctcctg 2760
71 aggcccagtc ccctgataat tccgggctct accatataca tttcatttcg actatgtcag 2820
72 tttccgcttc gatttagacc tcgagcagga cgagagggtt ccgaaagaaa atacaaacaa 2880
73 aaattatagt aatctgcgtt tactttggca taatacagta gtcattagtt gaggtaggca 2940
74 taatctggat gtctaaccat cacttgccct aacctcctac catctgctgc tagtatttgt 3000
75 cttacccgaa acccaattca acgagataga tggattgacg aataacaatt tgttgtccag 3060
76 cgacatgcat gatacatgcg tacgtacata cactaatagt agtcacagac cagttcatca 3120
77 catcctggtc tcgggtattc agatacggaa atgcgtaaga ttggaagggt ctaagaaaaa 3180
78 gcaaagaaaa aggaaaagtt aacactggct ggcgctctct ttccatctct gatcaatgtt 3240
79 attgttcgtc actcagctgt ggacgtggct ccagtcaagt tgtgaattat gatagggtat 3300
80 tgttgacttg acaagttgat cttgatggaa tcaaatcttc tccccgccag attctgacgc 3360
81 ttgaggctct cggatcgaat gaacaacttt tcgcaccaca tcaaccggtt gccgcgtgat 3420
82 gctggagaca aaccgaccca aacgtcacgg tcacacggag gatacgtttg ctagagccag 3480
83 ctgatacccc aagagacaag aaggtaaagg tcgcaaaaat cttttcaata agatggcatc 3540
84 ttccccccac caacccttaa ccattctcct ttcaagctgt gttgccccgc tttggtgcat 3600
85 gggcttgggt agtgcggtcg caaaactact aatttaatga ccgactgctg ctgctttttc 3660
86 actcgccgct cacggactaa gcatgtggga acaggatcgc cccgtcacta tttcagatcg 3720
87 tgtcgtatca aggtgttcgc ccggtgctgc tggcacgaac gccggccatc caagatcatt 3780
88 gttctcattc aaaccgggcg gcttacgtct agccgcggac gtaagcacga agagtgtgtg 3840
89 tagtggtggg agtgaagccg ttgccgaaac catgccgtcc tccacggccg tcccgtcgtt 3900
90 atcaagcgac gctgcctccg cttcatcctc atcagcgggt gtatctctgg agacaagatg 3960
91 ggcggaaggt ctcaccggcc aggagatatt agaagacgat ggaacgggcg cgctcgtcgt 4020
92 cccgccgtcc cgccctgctc ggcaatatca tcaccatacc tatatctgtc tgttctatat 4080
93 cttagattgt caccacacct tcgacgatgt cgagcaatgg aagactcacg ttctgagcca 4140
94 cttccgaacc cacgaaccac cgcgaacagc ccgatgccct ctatgtccgg gtgagcggtt 4200
95 cagcgacacc cccgaacaga aaggatggga tcgcatgc 4238
98 <210> SEQ ID NO: 2
99 <211> LENGTH: 431
100 <212> TYPE: PRT
101 <213> ORGANISM: Aspergillus oryzae
103 <400> SEQUENCE: 2
104 Met Pro Pro Pro Ala Ser Ser Val Asp Phe Thr Asn Leu Leu Asn Pro
105 1 5 10 15

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:17:12

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

```
107 Gln Asn Asn Glu Thr Gly Ser Ala Pro Ser Thr Pro Val Asp Ser Ser
108              20                  25                  30
110 Lys Ala Pro Ser Thr Pro Ser Ser Thr Gln Ser Asn Ser Thr Met Ala
111          35                  40                  45
113 Ser Ser Val Ser Leu Leu Pro Pro Leu Met Lys Gly Ala Arg Pro Ala
114      50                  55                  60
116 Thr Glu Glu Ala Arg Gln Asp Leu Pro Arg Pro Tyr Lys Cys Pro Leu
117  65                  70                  75                  80
119 Cys Asp Arg Ala Phe His Arg Leu Glu His Gln Thr Arg His Ile Arg
120                  85                  90                  95
122 Thr His Thr Gly Glu Lys Pro His Ala Cys Gln Phe Pro Gly Cys Thr
123             100                 105                 110
125 Lys Arg Phe Ser Arg Ser Asp Glu Leu Thr Arg His Ser Arg Ile His
126         115                 120                 125
128 Asn Asn Pro Asn Ser Arg Arg Ser Asn Lys Ala His Leu Ala Ala Ala
129     130                 135                 140
131 Ala Ala Ala Ala Ala Ala Gly Gln Gly Gln Glu Asn Ala Met Val Asn
132 145                 150                 155                 160
134 Val Thr Asn Ala Gly Ser Leu Met Pro Pro Pro Thr Lys Pro Met Thr
135                 165                 170                 175
137 Arg Ser Ala Pro Val Ser Gln Val Gly Ser Pro Asp Val Ser Pro Pro
138             180                 185                 190
140 His Ser Phe Ser Asn Tyr Ala Gly His Met Arg Ser Asn Leu Gly Pro
141         195                 200                 205
143 Tyr Ala Arg Asn Thr Glu Arg Ala Ser Ser Gly Met Asp Ile Asn Leu
144     210                 215                 220
146 Leu Ala Thr Ala Ala Ser Gln Val Glu Arg Asp Glu Gln His Phe Gly
147 225                 230                 235                 240
149 Phe His Ala Gly Pro Arg Asn His His Leu Phe Ala Ser Arg His His
150                 245                 250                 255
152 Thr Gly Arg Gly Leu Pro Ser Leu Ser Ala Tyr Ala Ile Ser His Ser
153             260                 265                 270
155 Met Ser Arg Ser His Phe His Glu Asp Glu Asp Gly Tyr Thr His Arg
156         275                 280                 285
158 Val Lys Arg Ser Arg Pro Asn Ser Pro Asn Ser Thr Ala Pro Ser Ser
159     290                 295                 300
161 Pro Thr Phe Ser His Asp Ser Leu Ser Pro Thr Pro Asp His Thr Pro
162 305                 310                 315                 320
164 Leu Ala Thr Pro Ala His Ser Pro Arg Leu Arg Ser Leu Gly Ser Ser
165                 325                 330                 335
167 Glu Leu His Leu Pro Ser Ile Arg His Leu Ser Leu His His Thr Pro
168             340                 345                 350
170 Ala Leu Ala Pro Met Glu Pro Gln Pro Glu Gly Pro Asn Tyr Tyr Ser
171         355                 360                 365
173 Pro Ser Gln Ser His Gly Pro Thr Ile Ser Asp Ile Met Ser Arg Pro
174     370                 375                 380
176 Asp Gly Thr Gln Arg Lys Leu Pro Val Pro Gln Val Pro Lys Val Ala
177 385                 390                 395                 400
179 Val Gln Asp Met Leu Asn Pro Ser Ala Gly Phe Ser Ser Val Ser Ser
```

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:17:12

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

```
180                 405                 410                 415
182 Ser Thr Asn Asn Ser Val Ala Gly Asn Asp Leu Ala Glu Arg Phe
183             420                 425                 430
```

VERIFICATION SUMMARY DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:17:13

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

L:9 M:270 C: Current Application Number differs, Replaced Application Number
L:10 M:271 C: Current Filing Date differs, Replaced Current Filing Date

PCT

RAW SEQUENCE LISTING
PATENT APPLICATION: US/09/936,367

DATE: 12/11/2003
TIME: 11:13:11

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

W--> 1 SEQUENZPROTOKOLL
3 <110> APPLICANT: Societe des Produits Nestle
5 <120> TITLE OF INVENTION: creA-gene
7 <130> FILE REFERENCE: 80050
C--> 9 **<140> CURRENT APPLICATION NUMBER: US/09/936,367**
C--> 10 **<141> CURRENT FILING DATE: 2001-09-11**
12 <150> PRIOR APPLICATION NUMBER: 99 104 923.0
13 <151> PRIOR FILING DATE: 1999-03-11
15 <160> NUMBER OF SEQ ID NOS: 2
17 <170> SOFTWARE: PatentIn Ver. 2.1
19 <210> SEQ ID NO: 1
20 <211> LENGTH: 4238
21 <212> TYPE: DNA
22 <213> ORGANISM: Aspergillus oryzae
24 <400> SEQUENCE: 1

Does Not Comply
Corrected Diskette Needed

25 ctgcagttcc agtttctacc ccgtaaatcc ctatcaactt agtccgcccc acattctttt 60
26 ttttttttcc ttttttttc gctcccggtc agagtgatag tgggatttat tacacaccgt 120
27 gcgtggtcga agaacgacac ggaagaagcc ccggaagacg ccttctctag gcaacaaatg 180
28 attgtactct tatgatactc aatacggtag aaaatagaga attgagatac gaaagctgac 240
29 tcatcagaac agaataaggg gaatttttga ttagcaaata acaataataa ttatacaaaa 300
30 aaacaaataa aaaaatttag gggactcccc acccgctgta atcctgggtg tatctcaaag 360
31 caaagcaggc gatctggggg gagcacgttc ttttttttc ttttctcttt tttctatttt 420
32 ttttttttt tttatttag gtctatgcct ttttttttct tttcctttt ttttttttt 480
33 tttgcccccc gataattctc cccacacata ggacatactt ttttttttt tccttccact 540
34 cccttcaagg tctccgattc cgataacccc ctctaccagt tcgccctgcc ttttttctctc 600
35 ccctcccccg aagctccatt tctctcttct tcccctccat tcctcattct tcctcttccg 660
36 tatttccttt atatgctcct atccccagac catttctcca gatttctctc tctttccccc 720
37 ctctcccttt cgacaaattg ttgcttgact acatccatct cgggttacct acttacagta 780
38 ccaattccgg atatactcta tcccacccat caccacattc cataacagcg ccctttcatt 840
39 gggaaagtca ctcttccttg aaattggtta catcgcggac catcgtacct tctttaatcg 900
40 caaggcttgt gatactcttg cggtgctcgt tcatcaacta gtactttgcc aagagcaagt 960
41 ctccgtcttg tcgggtggtg atcgactctc cccgatttac ctacccctgt tgcgacgaat 1020
42 cctgattcgc ctcggctcgt cagcccttcc gagcttccct taagtacagg cttcgtcccc 1080
43 tctttagctg cactcctcgg tgctaggtta ggacgagtca catgccacca ccggcttctt 1140
44 cagtggattt caccaatctg ctgaaccctc agaataacga gactggttct gcaccttcca 1200
45 cgccagtgga tagctccaag gctccctcta ccccgtccag tactcagtcc aactctacca 1260
46 tggcctcgtc tgttagctta ctaccgcccc tcatgaaggg tgctcgtccc gcaacggaag 1320
47 aagcgcgcca ggatcttccc cgtccataca agtgtcccct gtgtgatcgc gccttccatc 1380
48 gtttggagca ccagaccaga catattcgca cacatacggg tgaaaagcca cacgcttgcc 1440
49 agttcccggg ctgcacaaaa cgctttagtc gctctgacga gctgacacgc cactcaagaa 1500
50 ttcacaacaa ccccaactcc aggcggagta acaaggcaca tctggccgct gccgctgccg 1560
51 ctgccgctgc cggacaagag aatgcaatgg taaatgtgac caacgcgggc tcgttgatgc 1620
52 ccccgcccac aaagcctatg acccgctctg cgcctgtctc tcaggttgga tctccggatg 1680

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:13:11

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

53 tctcccctcc gcactccttc tcgaactatg ccggtcacat gcgttccaat ctgggaccat 1740
54 atgctcgcaa caccgagcgg gcgtcctcgg gaatggatat caatctactt gccaccgctg 1800
55 catctcaggt tgagcgtgat gaacaacatt ttgggttcca cgctggtcca cgtaatcacc 1860
56 atttgttcgc ctcgcgtcac cacaccggtc gtggcctgcc ttccctttca gcgtacgcca 1920
57 tctcgcacag catgagccgt tctcactttc acgaggacga ggatggttac actcatcgcg 1980
58 tcaagcgctc aaggcctaac tcaccaaact cgaccgctcc gtcctcaccg actttctctc 2040
59 acgactctct ttccccaacg ccagaccaca ctccgttggc aacccctgct cattcgccac 2100
60 gcttgaggtc attgggatct agcgaactcc accttccttc gattcgccat ctgtccctcc 2160
61 atcacacccc tgcccttgct ccaatggagc cccagccgga aggccccaac tattacagtc 2220
62 ccagccagtc tcatggtccc acaatcagcg atatcatgtc cagacccgac ggaacacagc 2280
63 gtaaactgcc cgttccacag gttcccaagg tcgcggtgca agatatgctg aaccccagcg 2340
64 ctgggttttc gtcggtttcc tcatcgacga ataactctgt cgcaggaaat gatttggcag 2400
65 aacgtttcta gcctggtgcg gctgcgaaac cctttcaatg tataaagttt tgggctcaaa 2460
66 aaaaattctt gactgtcata cgcgctacga aacgaataga ctttgtgcat ttacagtgcg 2520
67 tggttcatgg gcatccttgg tgtcggctgg ctttctttgc ttactttgtt cgagtatact 2580
68 tttgcgaggc gtccatagtg atagacgggt gggatattct tgtggctttt tccgtgcttg 2640
69 ttcgattctc ccctttcgct ctccttgaaa aataccttte ttatcctata accatttgtt 2700
70 tcattatccc aatgggaatt ggctctacag ctcttattca ttttgtctac tcctctcctg 2760
71 aggcccagtc ccctgataat tccgggctct accatataca tttcatttcg actatgtcag 2820
72 tttccgcttc gatttagacc tcgagcagga cgagagggtt ccgaaagaaa atacaaacaa 2880
73 aaattatagt aatctgcgtt tactttggca taatacagta gtcattagtt gaggtaggca 2940
74 taatctggat gtctaaccat cacttgccct aacctcctac catctgctgc tagtatttgt 3000
75 cttacccgaa acccaattca acgagataga tggattgacg aataacaatt tgttgtccag 3060
76 cgacatgcat gatacatgcg tacgtacata cactaatagt agtcacagac cagttcatca 3120
77 catcctggtc tcgggtattc agatacggaa atgcgtaaga ttggaagggt ctaagaaaaa 3180
78 gcaaagaaaa aggaaaagtt aacactggct ggcgctctct ttccatctct gatcaatgtt 3240
79 attgttcgtc actcagctgt ggacgtggct ccagtcaagt tgtgaattat gatagggtat 3300
80 tgttgacttg acaagttgat cttgatggaa tcaaatcttc tccccgccag attctgacgc 3360
81 ttgaggctct cggatcgaat gaacaacttt tcgcaccaca tcaaccggtt gccgcgtgat 3420
82 gctggagaca aaccgaccca aacgtcacgg tcacacggag gatacgtttg ctagagccag 3480
83 ctgatacccc aagagacaag aaggtaaagg tcgcaaaaat cttttcaata agatggcatc 3540
84 ttccccccac caacccttaa ccattctcct ttcaagctgt gttgccccgc tttggtgcat 3600
85 gggcttgggt agtgcggtcg caaaactact aatttaatga ccgactgctg ctgctttttc 3660
86 actcgccgct cacggactaa gcatgtggga acaggatcgc cccgtcacta tttcagatcg 3720
87 tgtcgtatca aggtgttcgc ccggtgctgc tggcacgaac gccggccatc caagatcatt 3780
88 gttctcattc aaaccgggcg gcttacgtct agccgcggac gtaagcacga agagtgtgtg 3840
89 tagtggtggg agtgaagccg ttgccgaaac catgccgtcc tccacggccg tcccgtcgtt 3900
90 atcaagcgac gctgcctccg cttcatcctc atcagcgggt gtatctctgg agacaagatg 3960
91 ggcggaaggt ctcaccggcc aggagatatt agaagacgat ggaacgggcg cgctcgtcgt 4020
92 cccgccgtcc cgccctgctc ggcaatatca tcaccatacc tatatctgtc tgttctatat 4080
93 cttagattgt caccacacct tcgacgatgt cgagcaatgg aagactcacg ttctgagcca 4140
94 cttccgaacc cacgaaccac cgcgaacagc ccgatgccct ctatgtccgg gtgagcggtt 4200
95 cagcgacacc cccgaacaga aaggatggga tcgcatgc 4238
98 <210> SEQ ID NO: 2
99 <211> LENGTH: 431
100 <212> TYPE: PRT
101 <213> ORGANISM: Aspergillus oryzae
103 <400> SEQUENCE: 2
104 Met Pro Pro Pro Ala Ser Ser Val Asp Phe Thr Asn Leu Leu Asn Pro

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:13:11

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

```
105  1               5                  10                  15
107 Gln Asn Asn Glu Thr Gly Ser Ala Pro Ser Thr Pro Val Asp Ser Ser
108              20                  25                  30
110 Lys Ala Pro Ser Thr Pro Ser Ser Thr Gln Ser Asn Ser Thr Met Ala
111          35                  40                  45
113 Ser Ser Val Ser Leu Leu Pro Pro Leu Met Lys Gly Ala Arg Pro Ala
114      50                  55                  60
116 Thr Glu Glu Ala Arg Gln Asp Leu Pro Arg Pro Tyr Lys Cys Pro Leu
117  65                  70                  75                  80
119 Cys Asp Arg Ala Phe His Arg Leu Glu His Gln Thr Arg His Ile Arg
120                  85                  90                  95
122 Thr His Thr Gly Glu Lys Pro His Ala Cys Gln Phe Pro Gly Cys Thr
123             100                 105                 110
125 Lys Arg Phe Ser Arg Ser Asp Glu Leu Thr Arg His Ser Arg Ile His
126         115                 120                 125
128 Asn Asn Pro Asn Ser Arg Arg Ser Asn Lys Ala His Leu Ala Ala Ala
129     130                 135                 140
131 Ala Ala Ala Ala Ala Ala Gly Gln Gly Gln Glu Asn Ala Met Val Asn
132 145                 150                 155                 160
134 Val Thr Asn Ala Gly Ser Leu Met Pro Pro Pro Thr Lys Pro Met Thr
135                 165                 170                 175
137 Arg Ser Ala Pro Val Ser Gln Val Gly Ser Pro Asp Val Ser Pro Pro
138             180                 185                 190
140 His Ser Phe Ser Asn Tyr Ala Gly His Met Arg Ser Asn Leu Gly Pro
141         195                 200                 205
143 Tyr Ala Arg Asn Thr Glu Arg Ala Ser Ser Gly Met Asp Ile Asn Leu
144     210                 215                 220
146 Leu Ala Thr Ala Ala Ser Gln Val Glu Arg Asp Glu Gln His Phe Gly
147 225                 230                 235                 240
149 Phe His Ala Gly Pro Arg Asn His His Leu Phe Ala Ser Arg His His
150                 245                 250                 255
152 Thr Gly Arg Gly Leu Pro Ser Leu Ser Ala Tyr Ala Ile Ser His Ser
153             260                 265                 270
155 Met Ser Arg Ser His Phe His Glu Asp Glu Asp Gly Tyr Thr His Arg
156         275                 280                 285
158 Val Lys Arg Ser Arg Pro Asn Ser Pro Asn Ser Thr Ala Pro Ser Ser
159     290                 295                 300
161 Pro Thr Phe Ser His Asp Ser Leu Ser Pro Thr Pro Asp His Thr Pro
162 305                 310                 315                 320
164 Leu Ala Thr Pro Ala His Ser Pro Arg Leu Arg Ser Leu Gly Ser Ser
165                 325                 330                 335
167 Glu Leu His Leu Pro Ser Ile Arg His Leu Ser Leu His His Thr Pro
168             340                 345                 350
170 Ala Leu Ala Pro Met Glu Pro Gln Pro Glu Gly Pro Asn Tyr Tyr Ser
171         355                 360                 365
173 Pro Ser Gln Ser His Gly Pro Thr Ile Ser Asp Ile Met Ser Arg Pro
174     370                 375                 380
176 Asp Gly Thr Gln Arg Lys Leu Pro Val Pro Gln Val Pro Lys Val Ala
177 385                 390                 395                 400
```

RAW SEQUENCE LISTING DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:13:11

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

```
179 Val Gln Asp Met Leu Asn Pro Ser Ala Gly Phe Ser Ser Val Ser Ser
180                 405                 410                 415
182 Ser Thr Asn Asn Ser Val Ala Gly Asn Asp Leu Ala Glu Arg Phe
183             420                 425                 430
```

VERIFICATION SUMMARY DATE: 12/11/2003
PATENT APPLICATION: US/09/936,367 TIME: 11:13:12

Input Set : A:\PTO.AMC.txt
Output Set: N:\CRF4\12082003\I936367.raw

L:1 M:259 W: Allowed number of lines exceeded, (1) GENERAL INFORMATION:
L:9 M:270 C: Current Application Number differs, Replaced Application Number
L:10 M:271 C: Current Filing Date differs, Replaced Current Filing Date

21 JUN 2004

#11

UNITED STATES 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 M. Barrett
Bell, Boyd & Lloyd, LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

In re Application of
AFFOLTER, et al.
U.S. Application No.: 09/936,367
PCT No.: PCT/EP00/01796
Int. Filing Date: 02 March 2000
Priority Date: 11 March 1999
Attorney Docket No.: 112843-029
For: EXPRESSION OF PROTEOLYTIC ENZYMES IN KOJI MOLD IN THE PRESENCE OF CARBON SOURCES

DECISION ON RENEWED PETITION UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1.137(b)" filed 01 April 2004.

BACKGROUND

On 29 January 2004, applicant was mailed a decision dismissing applicant's petition to revive the present national stage application. Applicant was afforded two months to file any request for reconsideration.

On 01 April 2004, applicant filed the present renewed petition. Applicant has certified that the present papers were deposited for mailing on 29 March 2004 and are thererfore considered timely filed.

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). Applicant previously satisfied items (2) - (4) above.

A review of the application file reveals that applicant has currently satisfied item (1) in providing a compliant Sequence Listing for the present application. As such, 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

Applicant's renewed petition under 37 CFR 1.137(b) is **GRANTED**.

The application has an international filing date of 02 March 2000 under 35 U.S.C. 363 and will be given a date of **23 January 2002** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

Freeform Search

Database: US Pre-Grant Publication Full-Text Database
US Patents Full-Text Database
US Patents OCR Backfile
EPO Abstracts Database
JPO Abstracts Database
Derwent World Patents Index
IBM Technical Disclosure Bulletin Database

Term: L8 and (antigen)

Display: 40 Documents in Display Format: - Starting with Number 1

Generate: Hit List Hit Count Side by Side Image

Search Clear Interrupt

Search History

DATE: Monday, October 13, 2008 Purge Queries Printable Copy Create Case

Set Name side by side	Query	Hit Count	Set Name result set
DB=PGPB,USPT,USOC,EPAB,JPAB,DWPI; PLUR=YES; OP=ADJ			
L9	L8 and (antigen)	251	L9
L8	L7 and (carrier or coupled)	265	L8
L7	L6 and (recombinant)	268	L7
L6	L5 and (adjuvant)	350	L6
L5	L2 and (composition)	475	L5
L4	L2 and (immuno$composition)	0	L4
L3	L2 and (immuno4 composition)	0	L3
L2	L1.clm.	520	L2
L1	neisseria meningitidis	4612	L1

END OF SEARCH HISTORY

30 JAN 2004

#13

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

PROSKAUER ROSE LLP
Patent Dept.
1585 Broadway
New York, NY 10036

In re Application of :
KAWALLA, Rudolf *et al* :
U.S. Application No.: 09/936,381 :
PCT No.: PCT/EP00/01517 :
Int. Filing Date: 24 February 2000 :
Priority Date: 13 March 1999 :
Attorney's Docket No.: 20496-303 :
For: METHOD FOR PRODUCING HOT STRIP :

DECISION ON PETITION UNDER 37 CFR 1.182

This decision is in response to applicants' "Second Petition under 37 C.F.R. 1.182" ("Pet.") filed via facsimile on 11 August 2003 and again on 09 September 2003. The $130.00 petition fee has been paid.

BACKGROUND

On 10 September 2001, applicants filed for entry into the national stage in the United States under 35 U.S.C. 371. Applicants listed the international application number as PCT/EP00/01575 on the transmittal letter (Form PTO-1390).

On 25 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 a declaration in compliance with 37 CFR 1.497(a) and (b) must be provided.

On 21 December 2001, applicants filed an executed declaration listing the international application as PCT/EP00/01517.

On 29 January 2002, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) advising applicants that the 35 U.S.C. 371 requirements were satisfied for the national stage of PCT/EP00/01575 on 21 December 2001.

On 14 February 2002, applicants purportedly filed a request to change the PCT reference. The request is not located in the file and there is no indication that this request was acted upon.

On 11 August 2003, applicants filed the instant petition under 37 CFR 1.182 via

facsimile.

On 09 September 2003, applicants resubmitted the petition filed 11 August 2003.

DISCUSSION

Applicants maintain that "when claiming priority of the PCT International Application on the transmittal letter, a typographical error was made, thereby resulting in reference to the wrong PCT International Application." Pet. at ¶ 2. Accordingly, applicants request to "correct the error which was made unintentionally and without deceptive intent." Id. at ¶ 1. Applicants also request that "the claim of priority for the above-identified non-provisional application be changed to PCT International Application PCT/EP00/01517." Id. at ¶ 3. Applicants also seek a corrected filing receipt changing the title to "Method of Producing a Hot-Rolled Strip."

A review of the above-captioned application file revealed that the wrong international application number, *i.e.*, PCT/EP00/01575, was designated on the transmittal letter filed with the national stage papers on 10 September 2001. However, applicants did provide a copy of international application PCT/EP00/01517 as published, a preliminary amendment referencing PCT/EP00/01517 and Information Disclosure Statement referencing PCT/EP00/01517 on 10 September 2001. Applicants then submitted a declaration referencing PCT/EP00/01517 on 21 December 2001.

Nevertheless, the DO/EO/US mailed a Form PCT/DO/EO/903 and filing receipt on 29 January 2002 indicating an international application number of PCT/EP00/01575.

A check of PCT/EP00/01517 shows that it has the same title, inventors, priority date and description as was submitted on 10 September 2001. Therefore, it is clear that a typographical error was made on the transmittal letter. Applicants submitted authorization to charge the required petition fee of $130.00 to Deposit Account No. 16-2500 with the instant petition.

Applicants have met all the requirements of a grantable petition.

CONCLUSION

For the reasons listed above, applicants' petition under 37 CFR 1.182 to correct the PCT application number is **GRANTED**.

The Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 29 January 2002 recorded the wrong international application number and priority date for the international application. Therefore, it is hereby **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected Notification of Acceptance of Application Under 35 U.S.C. 371indicating the correct international application number and a priority date of 13 March 1999, and then mailing a corrected filing receipt. The application will then be forwarded to Technology Center 1700 for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/936,381	12/21/2001	1742	990	20496-303	2	14	1

CONFIRMATION NO. 2936

Proskauer Rose
1585 Broadway
New York, NY 10036

CORRECTED FILING RECEIPT

OC000000011798809

Date Mailed: 01/30/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Rudolf Kawalla, Bobritzsch, GERMANY;
Hans Pircher, Mulheim, GERMANY;
Thomas Heller, Duisburg, GERMANY;
Bernhard Engl, Dortmund, GERMANY;
Pino Tese, Oberhausen, GERMANY;

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/EP00/01517 02/24/2000

Foreign Applications

GERMANY 19911287.8 03/13/1999

If Required, Foreign Filing License Granted: 01/30/2004

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

METHOD FOR PRODUCING HOT STRIP

Preliminary Class

148

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE WI 53202

MAILED

MAY 05 2009

OFFICE OF PETITIONS

In re Application of	:	
Joar Vaage	:	
Application No. 09/936,390	:	DECISION ON PETITION
Filed: September 10, 2001	:	
Attorney Docket No. 1935-00232	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 6, 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 Office action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), mailed December 11, 2007, which set a shortened statutory period for reply of two (2) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 12, 2008. The Notice of Abandonment was mailed September 10, 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 $810, 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 $865 extension of time fee submitted with the petition on March 6, 2009 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Terri Williams at (571) 272-2991.

This application is being referred to Technology Center AU 2872 for appropriate action by the Examiner in the normal course of business on the reply received

Terri Williams for
Chris Bottorff
Petitions Examiner
Office of Petitions

PTO/SB/64 (12-08)
Approved for use through 01/31/2009. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional): 1935-00232

First named inventor: Joar Vaage

Application No.: 09/936,390 — Art Unit: 2872

Filed: September 10, 2001 — Examiner: Audrey Y. Chang

Title: A Method and an Apparatus for Stereoprojection of Pictures

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☑ Small entity-fee $ 810.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of an Amendment (Identify type of reply):

☐ has been filed previously on _____.
☑ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Adjustment date: 05/05/2009 CKHLOK
03/06/2009 INTEFSW 00009376 012000 09936390
02 FC:2254 865.00 CK

3. Terminal disclaimer with disclaimer fee

☑ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature — Date: 7/1-09

Joar Vaage
Typed or printed name — Registration Number, if applicable

Vestre Svanholmen 6, 4313 Sandnes — 51635580
Address — Telephone Number

Address

Enclosures:
☑ Fee Payment
☑ Reply
☐ Terminal Disclaimer Form
☐ Additional sheets containing statements establishing unintentional delay
☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)] ELECTRONIC

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☒ Transmitted by ~~facsimile~~ electronic on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

3-6-09
Date

JoAnn Kuczynski
Signature

JoAnn Kuczynski
Typed or printed name of person signing certificate

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND

1 Date of Request:	04/29/09	2 Serial/Patent #	09/936,390

	3 Please refund the following fee(s):	4 PAPER NUMBER	5 DATE FILED	6 AMOUNT
	Filing			$
	Amendment			$
X	Extension of Time		03/06/09	$ 865.00
	Notice of Appeal/Appeal			$
	Petition			$
	Issue			$
	Cert of Correction/Terminal Disc.			$
	Maintenance			$
	Assignment			$
	Other			$

7 TOTAL AMOUNT OF REFUND: $ 865.00

8 TO BE REFUNDED BY:

	Treasury Check
X	Credit Deposit A/C #:

9: 0 1 -- 2 0 0 0

10 REASON:

	Overpayment
	Duplicate Payment
X	No Fee Due (Explanation):

Extension of time unnecessary.

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Terri Williams TITLE: Paralegal Specialist

SIGNATURE: Terri S. Williams PHONE: (571) 272-2991

OFFICE: Office of Petitions

****

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: CKhok DATE: 5/5/09

Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:

Office of Finance
Refund Branch
Crystal Park One, Room 802B

FORM PTO 1577
(01/90)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE WI 53202

MAILED

MAR 18 2010

OFFICE OF PETITIONS

In re Application of	:	
Joar Vaage	:	
Application No. 09/936,390	:	DECISION ON PETITION
Filed: September 10, 2001	:	
Attorney Docket No. 1935-00232	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 13, 2010, 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 December 28, 2009, as required by the Notice of Allowance and Fee(s) Due mailed September 28, 2009. Accordingly, the date of abandonment of this application is December 29, 2009. A Notice of Abandonment was mailed January 12, 2010.

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 $755.00; (2) the petition fee of $810.00; and (3) a proper statement of unintentional delay.

The address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This application is being referred to the Office of Data Management for processing into a patent.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Joar Vaage
Karlsminnegt. 24
N-4014 Stavanger, Norway

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

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

COPY MAILED

AUG 2 7 2002

OFFICE OF PETITIONS

In re Application of
Nilgun E. Tumer et al
Application No. 09/936,454
Filed: September 13, 2001
Attorney Docket No. OCIRS-073

:DECISION DISMISSING PETITIONS
:UNDER 37 CFR 1.78(a)(3) AND
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petitions under 37 CFR 1.78(a)(3), and 37 CFR 1.78(a)(6) filed by facsimile transmission on July 30, 2002, which are being treated as petitions to accept an unintentionally delayed claim under 35 U.S.C. § 365(c) for the benefit of a prior-filed international application designating the United States of America (Application No. PCT/US00/07330, filed March 20, 2000) and under 35 U.S.C. 119(e) for the benefit of two prior-filed provisional applications (Application Nos. 60/125,654, filed March 22, 1999 and 60/124,961 filed March 18, 1999).

The petitions are **dismissed** as moot for the reasons stated below.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) are only applicable to those applications filed on or after November 29, 2000.

37 CFR 1.78(a)(2)(ii)[1] indicates that the time periods set forth therein do not apply if the later-filed application is: (1) an application for a design patent; (2) an application filed under 35 U.S.C. § 111(a) before November 29, 2000; and (3) **a nonprovisional application which entered the national stage after compliance with 35 U.S.C. § 371 from an international application filed under 35 U.S.C. § 363 before November 29, 2000.**

---

[1] 37 CFR 1.78(a)(2) was amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(2)(iv) for clarity. *See* **Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications**, 66 FR 67087 (December 28, 2001); 1254 Off. Gaz. Pat. Office, 121 (January 22, 2002) (final rule).

Since the instant nonprovisional application is the national stage entry of an international application filed prior to November 29, 2000, the provisions of 37 CFR 1.78(a)(3) for acceptance of a late claim for priority do not apply to the subject nonprovisional application. Accordingly, the petition is dismissed as involving a moot issue.

According to MPEP 1893.03(c), page 1800-149, a national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. *See also* MPEP 1893.03(b). Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. § 371.

In view of the dismissal of the instant petition as moot, the $130 fee is unnecessary. Accordingly, as authorized, this fee will be refunded to Deposit Account No. 12-1095 in due course.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being returned to Technology Center Art Unit 1638 for examination in due course.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

30 SEP 03

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Stephan P. Gribok
Duane, Morris & Heckscher LP
One Liberty Place
Philadelphia, PA 19103

In re Application of :
Nowak et al. :
US Application No.: 09/936,469 :
PCT Application No.: PCT/DE00/00722 :
International Filing Date: 11 March 2000 : DECISION ON PETITION
Priority Date: 12 March 1999 : UNDER 37 CFR 1.181
Attorney's Docket No.: 3212-24 :
For: FIBER TRANSMISSION ELEMENT :
FOR GENERATING A CHROMATIC :
DISPERSION :

This decision concerns the "Request for Withdrawal of Notification of Defective Response" filed on 08 August 2003, which is being properly treated as a petition under 37 CFR 1.181 for acceptance into the national stage in the United States.

BACKGROUND

On 11 March 2000, Applicants filed international application PCT/DE00/00722, which claimed priority of an earlier application filed on 12 March 1999. A copy of the international application, in German, was communicated from the International Bureau to the USPTO on 14 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 2000, the end of the 19-month period from the 12 March 1999 priority date. The period for entering the national stage is thus 30 months and ended at midnight on 12 September 2001.

On 12 September 2001, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), along with, *inter alia*, the $860 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(5), an English translation of the international application, and an unexecuted declaration.

On 30 October 2001, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, requiring submission of an oath or declaration, in compliance with 37 CFR 1497(a) and (b), within the later of 2 months from the mailing date of the notification, or, 32 months from the priority date.

On 04 January 2002, Applicants filed a preliminary amendment, which was mis-construed by the USPTO Office of PCT Operations as a response to the 30 October 2001 notification. Accordingly, on 29 April 2003, a "Notification of Defective Response" (Form PCT/DO/EO/916)

was mailed, setting forth an un-extendable 1-month period for submitting a proper oath or declaration. The instant petition then followed, asserting that a declaration was filed on 13 February 2002, and requesting withdrawal of the 29 April 2003 Form PCT/DO/EO/916.

In addition, the petition contains a request to change the correspondence address for this application. A similar request was filed on 21 July 2003 along with an associate power of attorney. The petition and the requests are separately discussed below.

DISCUSSION

Petition under 37 CFR 1.181

The petition is accompanied by a copy of a postcard receipt date-stamped by the USPTO. The postcard indicates that on 13 February 2002, for this application, the USPTO received, *inter alia*, a signed declaration, a request for a 1-month extension of time, and the $130 surcharge for not having filed a proper oath or declaration before commencement of the national stage in the United States.

The petition encloses a copy of the declaration purportedly filed on 13 February 2002, containing a "January 29, 2002" Certificate of Mailing date. In addition, the USPTO record indicates that the $130 surcharge and the $110 extension-of-time fee were posted to this application on 25 February 2002 with a USPTO "mailroom date" of 13 February 2002. The declaration apparently has not been matched with this file.

Power of attorney and requests to change correspondence address

(A) On 21 July 2003, an "Associate Power of Attorney (37 CFR 1.34)" was filed, appointing practitioner Richard T. Laughlin as an associate attorney for prosecuting this application before the USPTO, and requesting changing the correspondence address for this application to Richard T. Laughlin's law firm in Morristown, New Jersey, which is not the address indicated in the executed declaration. This communication is signed by a Fritz Tiede, identified as manager of "Thorlabs GmbH."

However, the USPTO record only shows assignment, in November and December of 2001, by the inventors named in this application of their entire interest in the application to Profile Optische Systems GmbH. There is no evidence that Thorlabs GmbH is the current assignee of the entire interest in the application, or that Fritz Tiede is one of the attorneys-of-record. Therefore, Fritz Tiede is not authorized to appoint any associate attorney, or change the correspondence address for this application. MPEP 402.02 (Appointment of Associate Attorney or Agent); 403.01 (Correspondence Held with Associate Attorney); 601.03 (Change of Correspondence Address) (Rev. 1, Feb. 2003).

Consequently, the 21 July 2003 "Associate Power of Attorney (37 CFR 1.34)" is ineffective and has not been entered.

(B) The instant petition, signed by practitioner Josefino P. De Leon, also requests that future correspondence for this application be mailed to Richard T. Laughlin at the Morristown, New Jersey address.

Josefino P. De Leon is not the practitioner who filed the national stage papers on 12 September 2001; is not named in the 12 September 2001 transmittal letter; and does not appear to have been appointed by Applicants or the assignee to prosecute this application before the USPTO. Moreover, as delineated above, a signed declaration was filed on 13 February 2002, prior to the instant request. Therefore, Josefino P. De Leon, likewise, is not authorized to change the correspondence address for this application. MPEP 601.03; 405 (Attorney Not of Record) (Rev. 1, Feb. 2003).

While a courtesy copy of this decision is being sent to practitioner Josefino P. De Leon, all future correspondence on this application will only be forwarded to the current address-of-record unless the USPTO is properly instructed otherwise.

CONCLUSION

In view of the above, the signed declaration, a copy of which is enclosed with the petition, was timely filed on 13 February 2002. An examination of this declaration reveals that it complies with 37 CFR 1.497(a) and (b). The 29 April 2003 Form PCT/DO/EO/916 was thus mailed in error, and is hereby **VACATED.** The petition is **GRANTED.**

Applicants have met the requirements of 37 CFR 1.495 for acceptance into the national stage under 35 U.S.C. 371(c). The application has an international filing date of 11 March 2000 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 13 February 2002.

The application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for further processing

Richard Cole
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

cc: Josefino P. De Leon, Esq. (Docket F-15/03)
Shlesinger, Arkwright & Garvey LLP
3000 South Eads Street
Arlington, VA 22202

UNITED STATES 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
1300 I STREET, NW
WASHINGTON, DC 20005

COPY MAILED

JAN 0 5 2005

OFFICE OF PETITIONS

In re Application of :
Walter Nowak et al :
Application No. 09/936,469 : ON PETITION
Filed: February 13, 2002 :
Attorney Docket No. 9314-0006 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 8, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 18, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 19, 2004.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2874.

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

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
901 New York Avenue
Washington DC 20001-4413

COPY MAILED

NOV 16 2005

OFFICE OF PETITIONS

In re Application of
Nowak et al.
Application No. 09/936,469
Filed: 371 date 2/13/2002 (IA date 3/11/2000)

: DECISION DISMISSING PTA
:APPLICATION

This decision is in response to applicant's RESPONSE FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) timely[1] filed on May 6, 2005 requesting that the Office adjust the PTA calculation at the time of the mailing of the notice of allowance from a determination of zero (0) days to a determination of one hundred and forty days.

Applicants' application for PTA is **DISMISSED.**

Applicants assert that the Office erred in failing to provide applicants with an Office delay for failing to provide a notice under 35 U.S.C. 132 or 35 U.S.C. 151 within 14 months of the date the requirements of 371 were fulfilled. Applicants assert that the Office missed such period by a period of 340 days . Applicants further acknowledge a delay on their part by a period of 200 days for the abandonment of the application. Accordingly, applicants assert that the correct amount of PTA at the time of the mailing of the notice of allowance is 140 days.

Applicants arguments are not persuasive because the applicants are ineligible for the PTA grounds under 37 CFR 1.702 and 1.703. In order to be eligible for PTA the application must be filed on/after May 29, 2000. In an application filed under 37 CFR 371 the actual filing date of the application is the international filing date. In this particular application the international filing date of the application is March 11, 2000. Accordingly, applicants are ineligible for PTA. Since the application was filed between June 8, 1995 and May 29, 2000 applicants can earn additional extension time if the Office fails to meet the requirements of 37 CFR 1.701. However, the Office did not fail to meet any of the grounds enumerated in 37 CFR 1.701 and accordingly the zero days of PTA is accurate.

After the mailing of this decision, this application will be forwarded to the Office of Patent Publication for a prompt issuance of the patent.

---

[1]Issue fee paid on May 06, 2005

Application No. 09/936,469

The office has assessed the $200.00 fee associated with this application. No additional fees are required by the Office

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

POSZ LAW GROUP, PLC
12040 SOUTH LAKES DR.
SUITE 101
RESTON VA 20191

COPY MAILED

MAR 20 2007

OFFICE OF PETITIONS

In re Application of :
Shuji Arakawa et al :
Application No. 09/936,484 :
Filed: December 6, 2001 :
Attorney Docket No. VX012358PCT :

ON PETITION

This is a decision on the petition, filed March 16, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 20, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2617 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

19365-088180

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

OIPE JC34
MAY 14 2004
PATENT & TRADEMARK OFFICE

MAILED

OCT 10 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Clark Hill
500 Woodward Avenue
Suite 3500
Detroit, MI 48226

In re Application of
Omar D. Tame
Application No. 09/936,497
Filed: January 4, 2002

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 unpatenatability of one or more claims. See 37 CFR 1.313(b)(3).**

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon 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 this application.

Telephone inquiries should be directed to John J. Love, Director, Technology Center 3600 at 703 308-1020.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

John J. Love, Director
Technology Center 3600
703 308-1020

RECEIVED
OCT 2 : 2003
CLARK HILL

UNITED STATES 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.

Genaissance Pharmaceuticals
5 Science Park
New Haven, CT 06511

COPY MAILED

MAY 2 0 2004

OFFICE OF PETITIONS

In re Application of :
Stephen B. Liggett :
Application No. 09/936,499 : ON PETITION
Filed: December 17, 2001 :
Attorney Docket No. MWH-0031US :

This is a decision on the petition under 37 CFR 1.137(b), filed April 16, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to the Publishing Division to be processed into a patent.

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

GLAXOSMITHKLINE
CORPORATE INTELLECTUAL PROPERTY
FIVE MOORE DR., PO BOX 13398
RESEARCH TRIANGLE PARK, NC 27709-3398

COPY MAILED

NOV 16 2005

OFFICE OF PETITIONS

In re Application of :
Jones et al. :
Application No. 09/936,505 : DECISION ON PETITION
Filed: October 16, 2001 :
Attorney Docket No. PG3671USW :

This is a decision on the "Petition for Withdrawal of Holding of Abandonment Based on Failure to Receive Office Action," filed on February 15, 2005. The petition was recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience.

On August 25, 2004, the Office mailed a Notice of Allowance and Fee(s) Due ("Notice of Allowance"), which set a three-month statutory period to reply. In the apparent absence of the timely payment of the issue fee, the application was held abandoned on November 26, 2004. A Notice of Abandonment was mailed on January 31, 2005.

In the present petition, the practitioner requested that the Office withdraw the holding of abandonment due to non-receipt of the Notice of Allowance.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

A review of the record indicates no irregularity in the mailing of the Notice of Allowance, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice of Allowance was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice of Allowance was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1] For example, if a three-month period

[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).

for reply was set in the non-received Office communication, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office communication must be submitted as documentary proof of non-receipt of the Office communication. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail (*e.g.* if the practitioner has a history of not receiving Office communications).

After reviewing the documents submitted on petition, the Office concludes that the showing of record is sufficient to warrant withdrawal of the holding of abandonment. The practitioner submitted a copy of the docket records where the non-received Notice of Allowance would have been entered had it been received and docketed. Additionally, the practitioner attested to the fact that a search of the file jacket and docket records indicated that the Notice of Allowance was not received. As applicant has presented the required showing, the petition to withdraw the holding of abandonment is granted.

In view of the evidence presented in support of the contention that the practitioner did not receive the original Notice of Allowance of August 25, 2004, **Technology Center Art Unit 3754 shall remail the Notice of Allowance and restart the period for response.**

This matter is being referred to Technology Center Art Unit 3754 for further action in accordance with the present 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

NOV 27 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

MISHRIWAW JAIN
NIRMEL & ASSOC.
11620 MASTERS RUN
ELLICOTT CITY, MD 21042

In re Application of
STRAUVEN, Yvan
Application No.: 09/936,531
PCT No.: PCT/EP00/00932
Int. Filing Date: 03 February 2000
Priority Date: 09 February 1999
Attorney's Docket No.: U.MINIERE-03
For: CENTRIFUGALLY ATOMIZED ZINC ALLOY POWDER FOR ALKALINE BATTERIES

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is in response to the "Petition For Revival Of An International Application For Patent Designating The U.S. Abandoned Unintentionally Under 37 CFR 1.137(b) " filed on 11 September 2001.

BACKGROUND

On 03 February 2000, this international application was filed, claiming an earliest priority date of 09 February 1999.

No Demand appears to have been filed within 19 months from the priority date 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 1.494 was 09 October 2000. This international application became abandoned with respect to the United States at midnight on 09 October 2000 for failure pay the basic national fee.

On 11 September 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, and an executed declaration.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); 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. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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 under 35 U.S.C. 371. The 35 USC 371 date of this application is **11 September 2001**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Mailed: 11-3-05

meb
Paper Number: _____

In re application of
Strauven et al.

Serial No. 09/936,531
Filed: September 11, 2001
For: Centrifugally Atomized Zinc Alloy Powder For Alkaline Batteries

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed June 23, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of June 13, 2005 for failure to timely file a proper response to the Final Rejection of October 14, 2004, be withdrawn. The petitioner asserts that an RCE was timely filed on February 14, 2005. However, the Office issued a Notice of Improper RCE on May 10, 2005, which is after the allowable extension of time period had expired from the date of the Final Rejection and that until this time, the applicant was unaware that there was anything deficient with the RCE request. The applicant promptly filed a proper submission for the RCE upon receipt of the Notice of Improper RCE.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee). A review of the evidence provided by the applicant and a review of the USPTO application file establishes that the request cannot be granted. As clearly stated in the Notice of Improper RCE, mailed May 10, 2005, the RCE "request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice." Since the applicant did not file a proper submission within the time period allowed from the mailing date of the final Office action, the instant application is considered abandoned. Furthermore:

37 C.F.R. § 1.113 states:

"37 C.F.R. § 1.113 (a) Final rejection or action.
(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953." (emphasis added)

37 C.F.R. § 1.114 states:

"37 CFR § 1.114 Request for continued examination.
(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:
(1) Payment of the issue fee, unless a petition under § 1.313 is granted;
(2) Abandonment of the application; or
(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.
(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.
(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.
(e) The provisions of this section do not apply to:
(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
(4) An application for a design patent; or
(5) A patent under reexamination"

37 C.F.R. § 1.116 (b) states:

"37 CFR § 1.116 Amendments after final action or appeal.
(b) After a final rejection or other final action (§ 1.113) in an application or *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under §1.135, or the reexamination from termination. No amendment can be made in an *inter partes* reexamination proceeding after the right of appeal notice under §1.953 except as provided for in paragraph (d) of this section." (emphasis added)

Due to the fact that applicants request filed February 14, 2005 was not accompanied by a submission as required by 37 CFR 1.114 and since the application was not under appeal, the time period set forth in the final Office action continued to run from the mailing date of the final rejection of October 14, 2004. Since the time period set forth in the final Office action continued to run from the mailing date of the final rejection of October 14, 2004, the application became abandoned by operation of law on April 14, 2005 because applicant did not file a proper reply to the final Office letter mailed October 14, 2004. Therefore, given the finality of the rejection in the instant application, the only courses of action available to the applicant as the end of the 6-month statutory period approached would have been:

(1) To file an amendment with the proper extension of time fee, under 37 C.F.R. 1.116, which placed the application in condition for allowance, see MPEP 706.07(f);
(2) File a notice of appeal with the proper extension of time fee, see MPEP 1205;

(3) File a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.
(4) File a continued prosecution application (CPA) under 37 CFR 1.53(d), if appropriate. See MPEP § 201.06(d). **CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000.** See MPEP § 706.07(h), paragraphs I and IV.
(5) Abandon the application.

While the Office attempts to promptly respond to an amendment or papers filed after final, there are those instances where delays do occur, as in the instant application. However, it is clear from rule 37 C.F.R. 1.113 and 1.116 that abandonment of an application is risked when an amendment or other filing after a final Office action is proffered by the applicant. The rule clearly indicates that the mere filing of an amendment or other filing does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Therefore, whether or not petitioners request for RCE was received and processed prior to the expiration of the six-month statutory period, the only right petitioner was entitled to was that of appealing the final rejection or filing a proper request for continued examination. This application became abandoned for failure on the part of petitioner to file an appeal or a proper request for continued examination. This application became abandoned by operation of law (35 U.S.C. 133) for applicants' failure to timely file a Notice of Appeal or proper request for continued examination in response to the outstanding final rejection. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964).

The applicants are advised that if a petition under 37 C.F.R. 1.137(a) or (b) is filed, then such a petition should be accompanied by a:

(1) NOTICE OF APPEAL and pay the required notice of appeal fee, which is set by 37 C.F.R. 1.17(e). An appeal brief would be due two (2) months from the date of filing the notice of appeal, but the due date can be extended up to five (5) months with payment of extension of time fees, or a;

(2) Request for continued examination under 37 C.F.R. 1.114 with the appropriate filing fee and submission required by the rule, and a;

(3) Terminal Disclaimer, pursuant to 37 C.F.R. 1.137(c).

Therefore, the Notice of Abandonment is not withdrawn.

The Petition is **DISMISSED**.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Mishrilal Jain, Esq.
11620 Masters Run
Ellicott City, MD 21042

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MISHRILAL JAIN
11620 MASTERS RUN
ELLICOTT CITY, MD 21042

COPY MAILED
MAY 25 2006
OFFICE OF PETITIONS

In re Application of :
Yvan Strauven, et al. :
Application No. 09/936,531 : ON PETITION
Filed: September 11, 2001 :
Attorney Docket No. U.MINIERE-03 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 5, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply to a final Office action mailed October 14, 2004. A Notice of Abandonment was mailed June 13, 2005. In response on December 5, 2005, the present petition was filed, along with a submission required under 37 CFR 1.114.

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 1746 for further processing of the request for continued examination under 37 CFR 1.114 filed February 14, 2005.

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

BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH, VA 22040-0747

COPY MAILED

FEB 2 8 2007

OFFICE OF PETITIONS

In re Application of	:	
Toru Sorimachi et al	:	
Application No. 09/936,570	:	DECISION DISMISSING PETITION
Filed: December 6, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 2565-0236P	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed February 26, 2007, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **DISMISSED AS MOOT**.

Unfortunately, a decision on the petition under 37 CFR 1.313(c)(2) was not reached prior to the February 27, 2007 scheduled issue date of this application. As this case has now issued, the petition to withdraw from issue cannot be granted. The Office sincerely apologizes for any inconvenience this matter may have caused petitioner.

Petitioner's attention is directed to 37 CFR 1.313(d), which states:

> A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue**. (Emphasis added)

The request for continued examination (RCE) filed concurrently with the petition is improper in view of the issuance of this application into a patent and will not be processed. Accordingly, the $790 RCE fee, as well as the $130 petition fee, will be refunded to petitioner's deposit account.

The Information Disclosure Statement has been made of record in the file of the above-identified application without further consideration. *See* 37 CFR 1.97(i).

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

OCT 3 0 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Karl F. Milde, Jr.
Milde, Hoffberg & Macklin, LLP
10 Bank Street
Suite 460
White Plains, NY 10606

In re Application of :
Martin Rahe :
Application No: 09/936,571 :
PCT Application No.: PCT/DE00/00334 : DECISION ON
International Filing Date: 03 February 2000 : PETITION
Priority Date: 04 February 1999 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: HBC 232-KFM :
For: DEVICE FOR RECEIVING AND :
CONTROLLING VOIDED URINE :

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 14 September 01 is **GRANTED**.

BACKGROUND

On 03 February 2000, applicant filed an international application, No. PCT/DE00/00334 which claimed the priority of an earlier German application filed on 03 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 August 2000.

On 04 September 2000, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of the nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 August 2001.

On 14 September 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); an English translation of the international application as required by 35 U.S.C. §371(c)(2), 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 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) by a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant 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 basic national fee of $430 and petition fee of $620 have been submitted. A terminal disclosure is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The $65.00 surcharge for filing the oath or declaration and the $130.00 processing fee for filing the English translation of the international application later than 30 months from the priority date as required by 37 CFR 1.492(e) and (f) will be charged to counsel's Deposit Account No. 50-0427 as authorized in the transmittal letter filed 14 September 2001.

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 03 February 2000 under 35 U.S.C. §363 and a date of **14 September 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

Telephone: (703) 305-8819
Facsimile: (703) 308-6459

Leonard E. 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

7-24-08

Patent No. : 7,377,053
Inventor(s) : Norio Maeda, et. al.
Issued : May 27, 2008
Title : METHOD AND DEVICE FOR DRING SUBSTRATEDK
Docket No. : US035114

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of 37 CFR 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B. After payment of the issue fee, correction of assignment data submitted on the PTOL-85B can only be done by Certificate of Correction under 37 CFR 1.323, with a request under 37 CFR 3.81(b).

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: 571-273-8300
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

In view of the foregoing, your request is hereby denied.

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124 or 125**

Patrick A. Hilsmier
Global IP Counselors, LLP
1233 20th Street. NW, Suite 700
Washington, DC 20036

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

#6

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

19 JUL 2002

Todd A. Bynum
Madan, Mossman & Sriram, PC
2603 Augusta Drive, Suite 700
Houston, TX 77057

In re Application of	:	
Jones, Ben et al.	:	DECISION ON
Application No.: 09/936,630	:	
PCT No.: PCT/US00/40038	:	PETITION UNDER
Int. Filing Date: 16 March 2000	:	
Priority Date: 17 March 1999	:	37 CFR 1.47(a)
Attorney Docket No.: IO-1009US	:	
For: SENSOR	:	

This is a decision on applicants' "Petition In Support of Application Filed Under 37 C.F.R. 1.47(a) and Fees Under 37 C.F.R. §1.17(h)," filed in the United States Patent and Trademark Office (USPTO) on 04 June 2002.

BACKGROUND

On 16 March 2000, applicants filed international application PCT/US00/40038, which claimed a priority date of 17 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 October 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 17 September 2001.

On 12 September 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 04 December 2001, USPTO mailed a Notification of Missing Requirements (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) was required.

On 04 June 2002, applicants submitted the instant petition under 37 CFR 1.47, 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 executed by eight of eleven inventors; copies of certified mail receipts, envelopes and a letter.

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 (3) have been met. Applicants have paid the petition fee and have listed the addresses of the nonsigning inventors in the petition.

Item (2) has not been met. It is not clear whether applicants are claiming that the nonsigning inventors have refused to sign or could not be located after a diligent effort. As to Mr. Broseghini, the package was delivered, but there is no evidence that it was delivered to Mr. Broseghini, as the receipt was unsigned. As to Mr. Devolk, applicants have located two addresses for him, but it is not clear what efforts applicants have made to locate an address where he can be reached, such as internet searches. As to Mr. Johnson, applicants have no proof of delivery. Applicants must detail what efforts were made to locate the inventors, such as internet searches, postal inquiries, etc. Such information should come from someone with first hand knowledge of such efforts.

Item (4) has not been met. The declaration is not complete. Applicants state that a copy of the declaration was sent to each of the inventors. However, the office received only one declaration with the signatures of eight of eleven inventors. Applicants may not piece together pages from different declarations to create a composite declaration. Applicants must supply the complete declarations as executed by the inventors.

Additionally, it is noted that the declaration as submitted would not comply with 37 CFR 1.63, as it fails to list the residence and postal address for the non-signing inventors.

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.

Leonard E. Smith
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
WASHINGTON, D.C. 20231
www.uspto.gov

Todd A. Bynum
Madan, Mossman & Sriram, PC
2603 Augusta Drive, Suite 700
Houston, TX 77057

In re Application of
Jones, Ben et al.
Application No.: 09/936,630
PCT No.: PCT/US00/40038
Int. Filing Date: 16 March 2000
Priority Date: 17 March 1999
Attorney Docket No.: IO-1009US
For: SENSOR

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 19 September 2002.

BACKGROUND

On 16 March 2000, applicants filed international application PCT/US00/40038, which claimed a priority date of 17 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 October 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 17 September 2001.

On 12 September 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 04 December 2001, USPTO mailed a Notification of Missing Requirements (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) was required.

On 04 June 2002, applicants submitted a petition under 37 CFR 1.47, 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 executed by eight of eleven inventors; copies of certified mail receipts, envelopes and a letter.

On 19 July 2002, the Office dismissed the petition without prejudice.

On 19 September 2002, applicants submitted a renewed petition under 37 CFR 1.47(a).

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 (3) were previously met.

Item (2) has not been met.

As to Mr. Broseghini, the package was delivered, but there is no evidence that it was delivered to Mr. Broseghini, as the receipt was unsigned. Applicant argues that since 37 CFR 1.47(a) provides for either applicant's unavailability of an applicant or applicant's refusal, proof of receipt of the paperwork by Mr. Broseghini is unnecessary. As applicant must provide evidence of either the unavailability or refusal of applicant, it is necessary that applicant make clear which is being proved and then prove the relevant facts. Applicant is alleging refusal by conduct. It is unclear how applicant could refuse to sign a paper that applicant did not receive and of which applicant was not aware. See MPEP 409.03(d).

As to Mr. Devolk, it appears that the information in ¶11c is largely second hand from counsel's assistant. Counsel should include a declaration from the assistant with first hand knowledge of the communications.

As to Mr. Johnson, applicants have not provided proof of delivery. Applicant argues that applicant/inventor Johnson had signed the Norwegian patent paperwork. It does not appear that applicant is arguing that the Norwegian patent paperwork was sent in the same package. Applicant states that an assistant spoke with Mrs. Johnson. Applicant does not provide a statement from a person with first hand knowledge of the conversation nor does applicant indicate that the conversation provided evidence of the receipt of the paperwork by applicant/inventor Johnson or that he refused to execute it.

Additionally, applicant cannot establish refusal to execute the declaration by conduct from the packages that included the partial declarations. In paragraph 10a, applicant explains that only a partial declaration was sent to each of the applicant/inventors. Under 37 CFR 1.497(a)(3), a declaration must list all inventors and their respective citizenships. It would appear that Mr. Jones received a declaration that listed him as the sole inventor and each of the other inventors received a declaration that listed them as one of two inventors. Additionally, by adding in pages to create a single declaration, applicant modified the wording of the declaration subsequent to its execution by the inventors. See MPEP §§ 602.01 and 605.04(a).

Item (4) has not been met. The declaration does not comply with 37 CFR 1.497(a)-(b). Applicants were sent declarations that listed either one or two inventors. The declaration failed to list all inventors and their citizenships, as required by 37 CFR 1.497(a)(3).

Additionally, it is noted that the declaration as submitted would not comply with 37 CFR 1.63, as it fails to list the residence and postal address for the non-signing inventors.

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

UNITED STATES 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 A. Bynum
Madan, Mossman & Sriram, PC
2603 Augusta Drive, Suite 700
Houston, TX 77057

In re Application of	:	
Jones, Ben et al.	:	DECISION ON
Application No.: 09/936,630	:	
PCT No.: PCT/US00/40038	:	PETITION UNDER
Int. Filing Date: 16 March 2000	:	
Priority Date: 17 March 1999	:	37 CFR 1.47(a)
Attorney Docket No.: IO-1009US	:	
For: SENSOR	:	

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 09 May 2003.

BACKGROUND

On 16 March 2000, applicants filed international application PCT/US00/40038, which claimed a priority date of 17 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 October 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 17 September 2001.

On 12 September 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 04 December 2001, USPTO mailed a Notification of Missing Requirements (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) was required.

On 04 June 2002, applicants submitted a petition under 37 CFR 1.47, 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 executed by eight of eleven inventors; copies of certified mail receipts, envelopes and a letter.

On 19 July 2002, the Office dismissed the petition without prejudice.

On 19 September 2002, applicants submitted a renewed petition under 37 CFR 1.47(a).

On 18 December 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 09 May 2003, applicants submitted a second "Renewed Petition Under 37 C.F.R. 1.47(a)," accompanied by a petition for a three month extension of time and the fee for a three 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 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 (3) were previously met.

Items (2) and (4) have now been met. Applicants have furnished documentary evidence of receipt of the application papers by Mr. Broseghini, Mr. Johnson, and Mr. Burchfield. Applicants have demonstrated a diligent effort to locate Mr. DeVolk. The declaration now complies with 37 CFR 1.497(a)-(b).

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 date of **09 May 2003**.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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

Jeffrey D. Myers
Peacock, Myers, & Adams, P.C.
Post Office Box 26927
Albuquerque, New Mexico 87125-6927

In re Application of :
GRUITROIJ et al. :
U.S. Application No. 09/936,632 :
PCT No.: PCT/NL00/00163 : DECISION ON REQUEST
Int. Filing Date: 10 March 2000 :
Priority Date: 11 March 1999 :
Attorney Docket No.: 30394-1057 :
For: APPARATUS FOR THE INTERNAL INSPECTION OF PIPES AND TUBES AND THE LIKE

This decision is in response to applicants' "Petition under 37 CFR 1.497(d) to Correct Inventorship" filed 21 February 2002. Applicant's Deposit Account No. 13-4213 has been charged a $130 petition fee under 37 CFR 1.17(h).

BACKGROUND

On 10 March 2000, applicants filed international application No. PCT/NL00/00163 which claimed a priority date of 11 March 1999 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 September 2000. The international application named Leonardus Johannes Gruitroij, Christiaan Willem Schomper, and Jurgen Francois Elbertse as applicants/inventors. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 11 September 2001.

On 12 September 2001, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia:* the requisite basic national fee; a copy of the international application; and an unexecuted declaration.

On 07 November 2001, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 21 February 2002, applicants filed the present petition, an executed declaration and power of attorney, and a petition for a two-month extension of time.

DISCUSSION

In the instant case, the international application named Leonardus Johannes Gruitroij, Christiaan Willem Schomper, and Jurgen Francois Elbertse as applicants/inventors. Applicants request to delete Jurgen Francois Elbertse as an applicant/inventor and add Sieman Roelof van der Heide and Joost Martinus Parent as applicants/inventors. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

(1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;

(2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a);

(3) the fee set forth in 37 CFR 1.17(i); and

(4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied items (1), (2) and (3). Further, in order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship in compliance with 37 CFR 3.73(b), or written confirmation that no assignee exists. Here, the international application indicates A. Hak Industrial Services B.V as an applicant and it is unclear if the invention has been assigned to A. Hak Industrial Services B.V.

Applicant's Deposit Account No. 13-4213 has been charged a $130 petition fee under 37 CFR 1.17(h).

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Attorney-Advisor
PCT Legal Office
Tel: (703) 308-6314
Fax: (703) 308-6459

24 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Jeffrey D. Myers
Peacock, Myers, & Adams, P.C.
Post Office Box 26927
Albuquerque, New Mexico 87125-6927

In re Application of :
GRUITROIJ et al. :
U.S. Application No. 09/936,632 :
PCT No.: PCT/NL00/00163 : DECISION ON REQUEST
Int. Filing Date: 10 March 2000 :
Priority Date: 11 March 1999 :
Attorney Docket No.: 30394-1057 :
For: APPARATUS FOR THE INTERNAL INSPECTION OF PIPES AND TUBES AND THE LIKE

This decision is in response to applicants' "Response to Petition" which is being treated as a Renewed Petition under 37 CFR 1.497(d) filed 05 June 2002.

BACKGROUND

On 10 March 2000, applicants filed international application No. PCT/NL00/00163 which claimed a priority date of 11 March 1999 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 September 2000. The international application named Leonardus Johannes Gruitroij, Christiaan Willem Schomper, and Jurgen Francois Elbertse as applicants/inventors. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 11 September 2001.

On 12 September 2001, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia:* the requisite basic national fee; a copy of the international application; and an unexecuted declaration.

On 07 November 2001, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 21 February 2002, applicants filed "Petition under 37 CFR 1.497(d) to Correct Inventorship;" an executed declaration and power of attorney; and a petition for a two-month extension of time. The petition under 37 CFR 1.497(d) was dismissed in a decision dated 28 March 2002.

On 05 June 2002, applicant filed the present renewed petition.

DISCUSSION

In the instant case, the international application named Leonardus Johannes Gruitroij, Christiaan Willem Schomper, and Jurgen Francois Elbertse as applicants/inventors. Applicants request to delete Jurgen Francois Elbertse as an applicant/inventor and add Sieman Roelof van der Heide and Joost Martinus Parent as applicants/inventors. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires: (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part; (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a); (3) the fee set forth in 37 CFR 1.17(i); and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b). Applicants have satisfied items (1), (2) and (3).

In regards to item (4), applicants have submitted a written consent of assignee to the correction in inventorship in compliance with 37 CFR 3.73(b).

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicants have completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 10 March 2000 and a date of **21 February 2002** under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

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

06 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#4

Todd A. Bynum
MADAN, MOSSMAN & SRIRAM
2603 Augusta Drive, Suite 700
Houston, Texas 77057

In re Application of	:	
RUSHEFSKY, Larry, et al.	:	
U.S. Application No.: 09/936,634	:	DECISION ON PETITION
PCT No.: PCT/US00/07310	:	UNDER 37 CFR 1.47(a)
International Filing Date: 17 March 2000	:	
Priority Date: 17 March 1999	:	
Attorney's Docket No.: IO-1013US	:	
For: INTEGRATED AND MULTI-AXIS SENSOR ASSEMBLY AND PACKAGING	:	

This decision is issued in response to the petition under 37 CFR 1.47(a) filed by applicants on 04 June 2002. Applicants have paid the required petition fee.

BACKGROUND

On 17 March 2000, applicants filed international application PCT/US00/07310 which claimed a priority date of 26 February 1999 and which designated the United States.

On 13 October 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 17 September 2001.

On 12 September 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.

On 05 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The Notification also informed applicants that the failure to submit the declaration within two months of the date of the Notification would result in abandonment of the application.

On 04 June 2002, applicants filed a response to the Notification Of Missing Requirements, with the fee for the required extension of time. The response included declarations executed by 19 of the 20 inventors, and a petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of the remaining inventor, Axel Sigmar.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have failed to satisfy items (2) and (4).

Regarding the petition fee, applicants submitted a payment in the amount of $130 with their petition. Item (1) is therefore satisfied.

As for item (2), nowhere in the petition do applicants expressly state that a last known address for the nonsigning inventor. Accordingly, item (2) is not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed a declaration executed by 19 of the 20 inventors containing an unsigned signature block for the nonsigning inventor. Pursuant to the MPEP, this declaration has been treated as having been signed by the co-inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants' assert that Mr. Sigmar refuses to execute the application. Under such circumstances, MPEP § 409.03(d) requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, the evidence submitted by applicants to demonstrate Mr. Sigmar's refusal to execute the is contained in counsel's statement's in the petition, and the exhibits thereto. The petition provides evidence that the nonsigning inventor has been provided with a copy of the application, a necessary prerequisite to claiming a refusal to sign. However, it is not clear from the present record that the nonsigning inventor has in fact refused to sign the application papers. In fact, it appears that Mr. Sigmar actually agreed to sign the application and that finalizing a consulting fee agreement is all that is required to obtain Mr. Sigmar's signature. Applicants must provide further evidence that Mr. Sigmar has refused to execute the application before item (4) above can be considered satisfied.

Applicants' have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). Accordingly, the petition cannot be granted on the present record.

CONCLUSION

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 reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include a clear statement of the nonsigning inventor's last known address and adequate evidence of the nonsigning inventor's refusal to execute the application, as discussed above and in the form required by MPEP § 409.03(d).

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard Cole
PCT Legal Examiner
PCT Legal Office

RMR/RC:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

23 APR 2003

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#6

Todd A. Bynum
MADAN, MOSSMAN & SRIRAM
2603 Augusta Drive, Suite 700
Houston, Texas 77057

In re Application of	:	
RUSHEFSKY, Larry, et al.	:	
U.S. Application No.: 09/936,634	:	DECISION ON RENEWED
PCT No.: PCT/US00/07310	:	PETITION UNDER
International Filing Date: 17 March 2000	:	37 CFR 1.47(a)
Priority Date: 17 March 1999	:	
Attorney's Docket No.: IO-1013US	:	
For: INTEGRATED AND MULTI-AXIS SENSOR ASSEMBLY AND PACKAGING	:	

This decision is issued in response to the renewed petition under 37 CFR 1.47(a) filed 06 December 2002. No additional petition fee is required.

BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed by this Office on 06 September 2002. In that decision, applicant's original petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). Specifically, the decision held that applicant had failed to demonstrate that the nonsigning inventor had refused to execute the application, and had failed to provide an express statement of the nonsigning inventor's last known address.

On 06 December 2002, applicant filed the renewed petition considered herein.

DISCUSSION

The materials submitted with the renewed petition (relating to additional efforts made by applicants to obtain the signature of the nonsigning inventor after the previous decision), taken in combination with the previous petition, provide adequate evidence that the nonsigning inventor has refused to sign the application papers after being provided with a copy of such application. The renewed petition also contains an express statement of the nonsigning inventor's last known address. Accordingly, item (2) and item (4) of the requirements of a grantable petition under 37 CFR 1.47(a), as set forth in the 06 September 2002 decision, have now been satisfied.

However, upon further review, a defect has been identified in the declaration filed by applicants on 04 June 2002. Specifically, the inventor identified in the published international application as Al LEMKE has executed the declaration under the name Guido LEMKE. The inconsistency in this inventor's name between the declaration and the published international

application renders the declaration filed 04 June 2002 unacceptable. The discrepancy between "Al" and "Guido" is more than a mere typographical error. Accordingly, applicant must provide either a new declaration executed by this inventor in the name which appears on the international application (Al LEMKE) or, in the alternative, a petition under 37 CFR 1.182 requesting that this applicant's name be changed to "Guido LEMKE." Such petition must include an explanation of the discrepancy in the inventor's name, a statement that no deceptive intent was involved, and a $130 petition fee. If Mr. LEMKE has officially changed his name, then the petition must include an affidavit signed by Mr. LEMKE with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order as well as the petition fee. See MPEP 605.04(c). In the alternative, applicant may also provide a showing that the change was effected under PCT Rule 92bis during the international stage.

The petition under 37 CFR 1.47(a) cannot be granted until an acceptable declaration has been submitted, that is, until the discrepancy with respect to Mr. LEMKE's name is properly resolved.

CONCLUSION

The renewed 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 reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)" and should include either a new copy of the declaration executed by inventor Al LEMKE, or a grantable petition under 37 CFR 1.182 correcting Mr. LEMKE's name to Guido LEMKE, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard Cole
PCT Legal Examiner
PCT Legal Office

RMR/RC:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

16 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#8

Todd A. Bynum
MADAN, MOSSMAN & SRIRAM
2603 Augusta Drive, Suite 700
Houston, Texas 77057

In re Application of	:	
RUSHEFSKY, Larry, et al.	:	
U.S. Application No.: 09/936,634	:	DECISION ON PETITIONS
PCT No.: PCT/US00/07310	:	UNDER 37 CFR 1.182 AND
International Filing Date: 17 March 2000	:	37 CFR 1.47(a)
Priority Date: 17 March 1999	:	
Attorney's Docket No.: IO-1013US	:	
For: INTEGRATED AND MULTI-AXIS SENSOR ASSEMBLY AND PACKAGING	:	

This decision is issued in response to the second renewed petition under 37 CFR 1.47(a) and the petition under 37 CFR 1.182, both filed 23 June 2003. Applicant has paid the required petition fee.

BACKGROUND

The decision mailed by this Office on 23 April 2003 indicated that applicant had completed the requirements for a grantable petition under 37 CFR 1.47(a) except for a defect in the filed declaration. Specifically, the inventor identified in the published international application as Al LEMKE has executed the declaration under the name Guido LEMKE.

On 23 June 2003, applicants filed the response considered herein, including a petition under 37 CFR 1.182 seeking to correct the name of the inventor to Guido LEMKE, as set forth in the declaration.

DISCUSSION

In the present petition, counsel provides an explanation of the discrepancy between the inventor's name as listed in the international application and on the declaration. Specifically, counsel states that Mr. LEMKE was identified as "Al in the international application because that is the name by which Mr. Lemke is informally known in the company, i.e., Mr. Lemke's nickname." Counsel states that, while preparing the national stage papers, he learned that the inventor's correct name is Guido Lemke. Accordingly, he listed Mr. Lemke as "Guido (Al) Lemke" on the declaration.

Applicants' explanation for the discrepancy in the inventor's name is accepted. Accordingly, the petition under 37 CFR 1.182 is appropriately granted, and the inventor's name of record for this national stage application is changed to Guido LEMKE. Based on this correction, the previously filed declaration is now acceptable.

As noted in the previous decision, applicants have filed all the requirements for a grantable petition under 37 CFR 1.47(a) for acceptance of the application without the signature of Axel SIGMAR. Now that the declaration filed 04 June 2002 is in an acceptable format, the petition under 37 CFR 1.47(a) is appropriately granted.

CONCLUSION

The petition under 37 CFR 1.182 is **GRANTED**. The name of the inventor identified in the international application as Al LEMKE is corrected to Guido LEMKE, as listed in the declaration filed 04 June 2002.

The second renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The declaration filed on 04 June 2002 is accepted without the signature of inventor Axel SIGMAR.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and a notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision. The 35 U.S.C. 371(c) date is 04 June 2002.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

16 SEP 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Axel SIGMAR
6311 Lowman Ford Rd.
Lago Vista, Texas 78645

In re Application of: RUSHEFSKY, Larry, et al.
U.S. Application No.: 09/936,634
PCT No.: PCT/US00/07310
International Filing Date: 17 March 2000
Priority Date: 17 March 1999
Attorney's Docket No.: IO-1013US
For: INTEGRATED AND MULTI-AXIS SENSOR ASSEMBLY AND PACKAGING

Dear Mr. SIGMAR:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a). 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.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

Counsel of Record:
Todd A. Bynum
MADAN, MOSSMAN & SRIRAM
2603 Augusta Drive, Suite 700
Houston, Texas 77057

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

012006

PAUL S MADAN
MADAN, MOSSMAN & SRIRAM, PC
2603 AUGUSTA, SUITE 700
HOUSTON TX 77057-1130

JAN 26 2006

In re Application of:
Larry Rushesfsky et al.
Serial No.: 09/936,634
Filed: June 4, 2002
For: INTEGRATED AND MULTI-AXIS SENSOR ASSEMBLY AND PACKAGING

DECISION ON PETITION

This is a decision on the petition, filed January 6, 2006, via facsimile transmission, to withdraw the holding of abandonment of the above-identified application.

The petition is GRANTED.

This application was held abandoned for failure to respond in a timely manner to the non-final Office action of June 14, 2005. A Notice of Abandonment was mailed on December 22, 2005.

Petitioner states that a response was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard on which the US Patent and Trademark Office (USPTO) acknowledges receipt of a response along with a petition for a three-month extension of time and requisite fees on December 20, 2005. A copy of the response was submitted along with the postcard receipt.

The response was not of record in the application file record at the time the Notice of Abandonment was mailed but has since been associated with the record. The response was timely filed since it is accompanied by a certificate of mailing under 37 CFR 1.8(b) dated December 14, 2005. The application was not abandoned in fact.

For the above stated reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. Inconvenience to the applicant is regretted.

An Office action will be prepared and issued in due course.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606. Issues relating to examination should be directed to the examiner and/or the Supervisory Patent Examiner in charge.

Arthur Grimley, Acting Group 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.gov

COPY MAILED

JUL 11 2008

BRACHER RAWLINS LLP
Fox Court
14 Gray's Inn Road
London WC1X 8HN

Enclosure: February 13, 2008 letter, requesting registration of a "Freezing Injunction"

For: U.S. Patent Nos. 6,818,033; 6,849,094; 6,936,095; 7,207,197 and 7,300,482; and U.S. Patent Application Publication Nos. 2003/0159412; 2004/0103785; 2004/0083773; 2004/0244438; 2005/0092032; 2005/0194295 and 2006/0162299	:	**DECISION DISMISSING REQUEST**

This is a decision on the letter, dated February 13, 2008, requesting registration of a "Freezing Injunction," issued In The High Court of Justice, Chancery Division, against (a) U.S. Patent Nos. 6,818,033, 6,849,094, 6,936,095, 7,207,197, 7,300,482, any other U.S. patents for which John Herbert North is the applicant, and (b) U.S. Patent Application Publication Nos. 2003/0159412, 2004/0103785, 2004/0083773, 2004/0244438, 2005/0092032, 2005/0194295 and 2006/0162299. The letter is taken as written requests for both (a) a citation of information under 35 U.S.C. § 301 in multiple patents, and (b) a citation of information under 35 U.S.C. § 122(b) in multiple published patent applications.

This request is before the Office of Patent Legal Administration for decision.

The present request for citation of the Freezing Injunction in the above-captioned U.S. patents and patent application publications has been fully considered. The request is **dismissed**, for the reasons set forth below.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.4(c) provides:

> "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must

be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

35 U.S.C. § 122(b) provides:

> (c) PROTEST AND PRE-ISSUANCE OPPOSITION.– The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

The Manual of Patent Examining Procedure (MPEP) § 1134 provides (in part):

> Any submission filed by a third party (e.g., a protest) in an application published under 35 U.S.C. 122(b) (without the express written consent of the applicant) that does not comply with the requirements of 37 CFR 1.99 will be disregarded and not entered into the application file.

35 U.S.C. § 301 provides:

> Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

The Manual of Patent Examining Procedure (MPEP) § 2205 provides (in part):

> The prior art which may be submitted under 35 U.S.C. 301 is limited to "written prior art consisting of patents or printed publications."
>
> If the prior art citation contains any issue not directed to patents and printed publications, it should not be entered into the patent file, despite the fact that it may otherwise contain a complete submission of patents and printed publications with an explanation of the pertinency and applicability. Rather, the prior art citation should be returned to the sender as described in MPEP § 2206.

DISCUSSION

The instant written request for citation of the Freezing Injunction is improper, because 37 CFR 1.4(c) provides that "each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." In

this instance, a third party has provided written requests for both (a) a citation of information under 35 U.S.C. § 301 in a patent, and (b) a citation of information under 35 U.S.C. § 122(b) in a published patent application. Accordingly, the request is improper, and is dismissed.

It is additionally noted as follows:

1. The request for "any other U.S. patents for which John Herbert North is the applicant" is indefinite and does not identify a specific patent to which the request may be applied. Further, 37 CFR 1.4(b) requires that "a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical," and requestor clearly has not provided copies for all the above-captioned patents, published patent applications, and any other patents for which John Herbert North is the applicant.

2. The prior art which may be submitted under 35 U.S.C. § 301 is limited to patents or printed publications. The present information citation (submission) contains an issue not directed to patents and printed publications, as well as comments on the information submitted. Requester has not shown the present information submission to be compliant with 35 U.S.C. § 301 and MPEP 2205.

3. Any submission filed by a third party (e.g., a protest) in an application published under 35 U.S.C. 122(b) (without the express written consent of the applicant) must comply with the requirements of 37 CFR 1.99. Requester has not shown the present information submission to be compliant with 35 U.S.C. § 122(b) and MPEP 1134.

CONCLUSION

Accordingly, the written request under 35 U.S.C. § 301 and 35 U.S.C. § 122(b) for citation of prior art is **dismissed**

The citation (submission) of information will not be entered into any file, and it is returned herewith to the sender.

Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 24, 2008

FEB 2 0 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Steven L. Oberholtzer, Esq.
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

In re Application of LATARNIK et al	:	
U.S. Application No.: 09/936,638	:	
Int. Application No.: PCT/EP00/02347	:	DECISION
Int. Filing Date: 16 March 2000	:	
Priority Date: 17 March 1999	:	
Attorney Docket No.: 10543-032	:	
For: METHOD FOR DETERMINING PARAMETERS	:	

This is in response to the papers filed 18 January 2002, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 16 March 2000, applicant filed international application PCT/EP00/02347, which claimed priority of an earlier Germany application filed 17 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 October 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 17 September 2001.

On 12 September 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 31 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 18 January 2002, applicant filed the present request for status, including a declaration executed by joint inventor Helmut Fennel and by the legal representatives of joint inventor Michael Latarnik, who according to the declaration is deceased.

DISCUSSION

37 CFR 1.42 provides, "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."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

In the present case, the declaration filed 18 January 2002 is not in compliance with 37 CFR 1.497(b)(2). Specifically, the declaration does not state the citizenship, residence, and mailing address of the legal representatives. It is further noted that Michael Latarnik is listed as the second inventor, the third inventor, and the fourth inventor, which is improper.

CONCLUSION

For the reasons above, the request for status 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. Extensions of time may be obtained up to the limit set forth by the Notification of Missing Requirements mailed 31 October 2001. Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42".

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

30 JAN 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Steven L. Oberholtzer, Esq.
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

In re Application of LATARNIK et al	:	
U.S. Application No.: 09/936,638	:	
Int. Application No.: PCT/EP00/02347	:	DECISION
Int. Filing Date: 16 March 2000	:	
Priority Date: 17 March 1999	:	
Attorney Docket No.: 10543-032	:	
For: METHOD FOR DETERMINING PARAMETERS	:	

This is in response to the "Renewed Request for Status Under 37 CFR 1.42 and Enclosures" filed 12 December 2002.

BACKGROUND

On 16 March 2000, applicant filed international application PCT/EP00/02347, which claimed priority of an earlier Germany application filed 17 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 October 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 17 September 2001.

On 12 September 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 31 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 18 January 2002, applicant filed a request for status under 37 CFR 1.42, including a declaration executed by joint inventor Helmut Fennel and by the legal representatives of joint inventor Michael Latarnik, who according to the declaration is deceased.

On 20 February 2002, this Office mailed a decision dismissing the 18 January 2002 request for status on grounds that the declaration did not comply with 37 CFR 1.497(b)(2).

On 29 April 2002, applicant filed a renewed request for status.

On 14 May 2002, this Office mailed a decision dismissing the 29 April 2002 renewed request for status on grounds that the declaration did not comply with 37 CFR 1.497(a)(3).

On 12 December 2002, applicant filed the present renewed request for status along with a newly executed declaration.

DISCUSSION

37 CFR 1.42 provides, "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."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declaration filed 12 December 2002 is in compliance with 37 CFR 1.497.

CONCLUSION

For the reasons above, the papers filed 12 December 2002 are ACCEPTED under 37 CFR 1.42.

The application has an International Filing Date of 16 March 2000 and a date under 35 U.S.C. 371(c) of 12 December 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

JUN 14 2007

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MANDEL & ADRIANO
55 S. LAKE AVENUE, SUITE 710
PASADENA, CA 91101

In re Application of	:
Adam J. Katz et al	:
Serial No.: 09/936,665	: CORRECTION OF INVENTORSHIP
Filed: September 10, 2001	:
Attorney Docket No.: 304488.77USW1	:

This is in reply to the petition under 37 CFR 1.324, filed February 14, 2005, to correct the inventorship in the above identified application which issued as Patent No. 6,777,231 on August 17, 2004. The delay in acting on this petition is regretted.

37 CFR 1.324 allows correction of inventorship in an issued patent by filing of a petition which names the correct inventors and is accompanied by statements from each inventor named and from the assignee that they agree to the correction. Applicants' petition is accompanied by copies of a complaint filed in District Court in California and a response to the complaint seeking court action to grant the change of inventorship. No final court decision has been filed with regard to the complaint. Since the petition does not comply with the requirements noted above and no court decision granting it is of record, the petition cannot be granted.

In view of the above reasons the petition is **DENIED**.

Should there be any questions with respect to this action, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the Office general facsimile number, 571-273-8300.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 13 2007

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MANDEL & ADRIANO
55 S. LAKE AVENUE, SUITE 710
PASADENA, CA 91101

In re Application of	:
Adam J. Katz et al	:
Serial No.: 09/936,665	: CORRECTION OF INVENTORSHIP
Filed: September 10, 2001	:
Attorney Docket No.: 304488.77USW1	:

REVISED DECISION

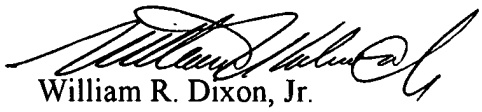
This is in reply to the petition under 37 CFR 1.324, filed February 14, 2005, to correct the inventorship in the above identified application which issued as Patent No. 6,777,231 on August 17, 2004. The delay in acting on this petition is regretted.

Subsequent to a telephone interview with applicants' attorney in July, 2007, a further review of the prosecution of this application was undertaken. In view of that review it has been discovered that a first petition to delete inventors under 37 CFR 1.48(b) was filed on November 24, 2003. This petition was proper, but was never acted on prior to issuance of the patent on August 17, 2004. Subsequent to issuance of the patent, applicants contacted SPE Remy Yucel on August 25, 2004, who advised applicants to file applicants to file a request for Certificate of Correction. Applicants filed a proper request including, *inter alia,* a request to list the correct inventorship. This portion of the request was denied in view of the petition having never been granted. A copy of the original petition was also refiled on February 14, 2005, but was not forwarded for decision until recently and was improperly decided. Thus, the petition decision mailed June 4, 2007, is vacated.

In view of the proper filing of a petition under 37 CFR 1.48(b) which meets all of the requirements of the rule, the inventorship of the above patent is hereby corrected and will be reflected in a Certificate of Correction to be issued in due course. The correct inventorship is Marc H. Hedrick, Prosper Benhaim and Min Zhu.

In view of the above reasons the petition under 37 CFR 1.48(b) is **GRANTED**.

Should there be any questions with respect to this action, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the Office general facsimile number, 571-273-8300.



William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AUG 14 2007

MANDEL & ADRIANO
55 S. LAKE AVENUE, SUITE 710
PASADENA, CA 91101

In re Application of	:
Adam J. Katz et al	:
Serial No.: 09/936,665	: CORRECTION OF INVENTORSHIP
Filed: September 10, 2001	:
Attorney Docket No.: 304488.77USW1	:

SECOND REVISED DECISION

This is in reply to the Petition for Correction of Inventorship under 37 CFR 1.48(b), filed November 24, 2003, to correct the inventorship in the above identified application. The petition was resubmitted to the Office on January 21, 2004 and August 31, 2004. The delay in acting on this petition is regretted.

On August 17, 2004, the above identified application issued as U.S. Patent No. 6,777,231, naming seven inventors. Thus, Applicants' petition under 37 CFR 1.48(b) became a petition under 37 CFR 1.324 after the application issued as a patent since 37 CFR 1.48(b) applies only to applications. See MPEP 1481.02 (explaining that "[w]hile a request under 37 CFR 1.48 is appropriate to correct inventorship in a nonprovisional application, a petition under 37 CFR 1.324 is the appropriate vehicle to correct inventorship in a patent" and further explaining that ". . . if a request under 37 CFR 1.48(A), (B), OR (C) is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under 37 CFR 1.324 . . . .").

On June 4, 2007, the petition was denied on the grounds that the requirements of 37 CFR 1.324 were not satisfied ("Original Decision"). 37 CFR 1.324 allows correction of inventorship in an issued patent via a petition, provided that the petition is accompanied by statements from each named inventor and the assignee that all agree to the correction. The Office explained that petition did not include the requisite statements and therefore failed to comply with the requirements of 37 CFR 1.324.

On July 25, 2007, Applicants' alleged representative engaged in a telephone interview regarding the denial, pointing out errors in the denial, for example, that the petition was not filed on February 14, 2005 as had been stated in the Original Decision. Following that interview, a further review of the prosecution of U.S. Patent No. 6,777,231 was undertaken.

On August 3, 2007, the Office issued a Revised Decision, vacating the Original Decision and granting the petition. The Office indicated that the petition was being considered under 37 CFR

1.48(b) and that all the requirements set forth in that rule were satisfied. Consequently, the Office indicated that a Certification of Correction would issue, listing only three inventors.

The Office sua sponte is reconsidering the Revised Decision of August 3, 2007, in this Second Revised Decision to correct errors in the Revised Decision. The Office notes that the petition under 37 CFR 1.48(b) met all of the requirements of that rule at the time of filing. However, since the petition was never acted on until after issuance of U.S. Patent No. 6,777,231, it could only be considered under 37 CFR 1.324, as explained above. Thus, the Office notes that it was in error to have considered the petition in the Revised Decision of August 3, 2007, under 37 CFR 1.48(b) and that the Office correctly considered the petition in the Original Decision of June 4, 2007, as under 37 CFR 1.324.

As explained in the Original Decision, 37 CFR 1.324 requires consent of all parties to a patent to agree to correction of the inventorship. "All parties" include all inventors and all assignees. It is to be noted that the requirement in 37 CFR 1.324 for statements from each named inventor and all assignees is a requirement of 35 U.S.C. § 256. That statute provides that "[w]henever a person is named in an issued patent as the inventor, ... and such error arose without any deceptive intention on his part, Director may, **on application of all the parties and assignees**, ... issue a certificate correcting such error." 35 U.S.C. § 256 (Emphasis added). Here, "all parties" have not submitted statements, consenting to the correction of inventorship of U.S. Patent No. 6,777,321. In fact, no statements have been submitted on behalf of any named inventor or any assignee.

In view of the unsatisfied requirement that all parties consent to the change of inventorship, the Revised Decision of August 3, 2007, is vacated. The petition under 37 CFR 1.48(b), which is being considered under 37 CFR 1.324, is **DENIED**. The Certificate of Correction noted in the previous decision has been withdrawn.

Should there be any questions with respect to this action, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the Office general facsimile number, 571-273-8300.

Christopher Low
Director, Technology Center 1600 (Acting)

SCANI Please forward case and paper to address shown below.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/20/07

Paper No.: _____

TO SPE OF : ART UNIT 1636 Yucel Irem (Spe) 9/936,665 CW

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/93665 Patent No.: 6777231

Please respond to this request for a certificate of correction within 7 days. 6,777,231

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

☐ Approved	All changes apply.
☐ Approved in Part	Specify below which changes do not apply.
☒ Denied	State the reasons for denial below.

Comments: PLEASE SEE THE PETITION DECISION (PETDEC IN IFW) DATED 8/14/2007 (PETITION DENIED).

SPE Art Unit

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

1/29/08

Patent No. :6777231
Inventor(s) : Adam J. Katz
Issued : 1/23/2007
Title : Adipose-Derived Stem Cells and Lattices
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals that the petition decision is denied by the petition office. Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

Nixon & Vanderhye P.C.
901 North Glebe Road 11th Floor
Arlington, VA 22203

HR/CBN

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 9

WILLIAM P. JENSEN
SHOOK HARDY & BACON
600 TRAVIS SUITE 1600
HOUSTON, TX 77002-2911

MAIL

MAY - 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Acosta et al.
Application No. 09/936,682
Filed: September 17, 2001
For: **SYSTEM AND METHOD FOR ANALYZING AND IMAGING THREE-DIMENSIONAL VOLUME DATA SETS**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition to make special filed on September 17, 2001, under MPEP 708.02 VI: Energy.

A petition to make special under the Manual of Patent Examination Procedure) §708.02 VI must be accompanied by a statement explaining how the invention materially contributes to the discovery or development of energy resources or the more efficient utilization and conservation of energy resources. No fee is required.

The petition meets all the above-listed requirements. After careful consideration, it appears the Applicant's disclosure is sufficiently and substantially directed towards seismic analysis and interpretation, which can be directly used in the efficient discovery of underground oil resources.

Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. After mailing this decision, the application will be forwarded to the examiner for immediate handling.

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

Paper No. 10

R. NEIL SUDOL
COLEMAN SUDOL SAPONE, P.C.
714 COLORADO AVE.
BRIDGEPORT, CONNECTICUT 06605-1601

COPY MAILED

OCT 20 2004

OFFICE OF PETITIONS

In re Application of :
James Riley et al :
Application No. 09/936,753 : ON PETITION
Filed: September 17, 2001 :
Attorney Docket No. A20-029 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 6, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Office action mailed April 2, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 3, 2003.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

The application is being forwarded to Technology Center AU 3723 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 16

WILLIAM H. DIPPERT
REED SMITH LLP
599 LEXINGTON AVENUE
29TH FLOOR
NEW YORK, NY 10022

COPY MAILED

APR 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Amir Loshakove, et al. :
Application No. 09/936,789 : ON PETITION
Filed: September 17, 2001 :
Attorney Docket No. 088/02319 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed on April 29, 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 24, 2003, using a Certificate of Mailing under 37 CFR 1.8 dated March 17, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

The file is being forwarded to Technology Center AU 3731 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

JOAN M. MCGILLYCUDDY
AKZO NOBEL INC.
INTELLECTUAL PROPERTY DEPARTMENT
7 LIVINGSTONE AVENUE
DOBBS FERRY NY 10522-3408

COPY MAILED

FEB 10 2006

OFFICE OF PETITIONS

In re Application of :
Gerard Howard Davies et al :
Application No. 09/936,794 :
Filed: November 13, 2001 :
Attorney Docket No. ACO2694P1US :

ON PETITION

This is a decision on the petition, filed February 3, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 27, 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 1762 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WILLIAM B PATTERSON
MOSER PATTERSON & SHERIDAN
SUITE 1500
3040 POST OAK BOULEVARD
HOUSTON, TX 77056

COPY MAILED

JUL 3 0 2004

OFFICE OF PETITIONS

In re Application of :
Robert Bridges :
Application No. 09/936,795 : ON PETITION
Filed: February 19, 2002 :
Attorney Docket No. BOUL/0007 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 6, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed September 25, 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 May 19, 2004 indicating that the reply filed on March 29, 2004 failed to place the application in condition for allowance. Accordingly, the application became abandoned on March 25, 2004.

Receipt is acknowledged of the Amendment filed July 6, 2004, with the instant petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

The application matter is being forwarded to Technology Center 2800, Art Unit 2859 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

FEB 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

Paul J. White
National Renewable Energy Laboratory
1617 Cole Blvd.
Golden, CO 80418

In re Application of	:	
TANGLER et al.	:	
Application No.: 09/936,802	:	DECISION
PCT No.: PCT/US00/01434	:	
Int. Filing Date: 08 February 2000	:	
Priority Date: 08 February 1999	:	
Attorney Docket No.: NREL 99-17	:	
For: COOLING-TOWER FAN AIRFOILS	:	

The petition to revive under 37 CFR 1.137(b) filed 14 September 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 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 applicants have submitted the basic national fee of $100 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.

Deposit Account No. 14-1460 has been charged a $620.00 petition fee under 37 CFR 1.17(m).

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 along with the $65 surcharge for filing the oath or declaration after the thirty-month period is required.

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

02/26/2002 LLANDGRA 00000053 140460 09936802
02 FC:241 620.00 CH

30 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paul J. White
National Renewable Energy Laboratory
1617 Cole Blvd.
Golden, Co 80401

In re Application of :
TANGLER et al. :
Application No.: ~~10/089,469~~ 09/936,802 : DECISION
Attorney Docket No.: NREL 99-17 :
For: COOLING-TOWER FAN AIRFOILS :

This Decision is in response to applicant's "COMMUNICATION" filed via facsimile transmission on 30 January 2002, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

The petition requests that the Transmittal Letter, petition for revival under 37 CFR 1.137(b), declaration of inventors, and copy of international application accompanying the petition under 37 CFR 1.181 be accepted as having originally been received on 14 September 2001. Applicants have provided sufficient evidence to establish that on 14 September 2001 applicants filed the above-mentioned documents. The proof is in the form of the copy of the receipt for the above-identified application which bears a United States Patent and Trademark Office (USPTO) date stamp of 14 September 2001 and which itemizes the above-mentioned documents and identifies the above-captioned docket number, title and inventors. Petitioner's statements in the petition are construed as meaning that the copies of the documents filed 30 January 2002 are copies of the documents originally filed 14 September 2001. If this interpretation is incorrect, applicant must *immediately* notify the Office of PCT Legal Administration of such fact. Therefore, in view of the date-stamped receipt and practitioner's statement, the documents received on 30 January 2002 may properly be accepted as originally received in the USPTO on 14 September 2001. The petition under 37 CFR 1.181 filed 30 January 2002 is **GRANTED**.

However, applicants must file a petition under 37 CFR 1.182 to clarify the discrepancies in the papers filed 14 September 2001 before these papers can be processed. On 14 September 2001, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission included, *inter alia*, a Transmittal Letter and a declaration of inventors. The first page of the Transmittal Letter indicates the international application number as PCT/US00/01742. However, the title, inventors, and priority date indicated on the Transmittal Letter do not correspond to PCT/US00/01742. Also, the declaration is not in compliance with 37 CFR 1.497(a)-(b) since it fails to identify the specification to which it is directed. The declaration also indicates the international application number as PCT/US00/01742 but the title, inventors,

and priority date listed on the declaration do not correspond to that international application number. A new declaration in compliance with 37 CFR 1.497(a)-(b) will need to be filed since the declaration cannot be corrected by petition.

Applicant is required to file a reply to this communication resolving the above-stated inconsistency. A proper reply would include a petition under 37 CFR 1.182, including the petition fee set forth in 37 CFR 1.17(h), to correct the Transmittal Letter (The petition should set forth the specific circumstances as to how and when the error was made and should set forth that the mistake was an inadvertent error without deceptive intent).

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available. Failure to timely file a proper response will result in abandonment of the application.

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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

10 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

PAUL J WHITE
NATIONAL RENEWABLE ENERGY LABORATORY
1617 COLE BOULEVARD
GOLDEN CO 80401

In re Application of	:	
TANGLER et al.	:	
Application No.: 09/936,802	:	
PCT No.: PCT/US00/01434	:	
Int. Filing Date: 21 January 2000	:	DECISION
Priority Date: 08 February 1999	:	
Attorney Docket No.: NREL 99-17	:	
For: COOLING-TOWER FAN AIRFOILS	:	

This decision is in response to the submission filed on 13 November 2002.

BACKGROUND

On 21 January 2000, applicant filed international application PCT/US00/01434, which claimed a priority date of 08 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 10 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 31 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 August 2001.

On 14 September 2001, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee to Deposit Account No. 14-0460, an unexecuted declaration of inventors, and a petition to revive under 37 CFR 1.137(b). These application papers were identified by applicants with attorney docket number NREL 99/17 and were assigned application number **09/936,802**. The first page of the Transmittal Letter indicates the international application number as PCT/US00/01742. However, the title, inventors, and priority date indicated on the Transmittal Letter do not correspond to PCT/US00/01742. The declaration also indicates the international application number as PCT/US00/01742 but the title, inventors, and priority date listed on the declaration do not correspond to that international application number.

06/11/2003 SNAJARRO 00000006 140460 09936802

01 FC:1460 130.00 CH

On 30 January 2002, applicants filed a submission via facsimile transmission which requested that the copy of the application papers accompanying the submission be accorded a receipt date of 14 September 2001 and be processed as a national stage application, which was treated as a petition under 37 CFR 1.181. The application papers included a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee, an unexecuted declaration of inventors, and a petition to revive under 37 CFR 1.137(b). The application papers were identified by applicants with attorney docket number NREL 99/17 and were assigned application number *10/089,469*.

On 08 February 2002, a decision was mailed in application number **09/936,802** granting applicants' petition to revive under 37 CFR 1.137(b).

On 27 February 2002, the United States Designated/Elected Office (DO/EO/US) mailed in application number **09/936,802** a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 22 March 2002, applicants filed a response in application number **09/936,802** to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 which was accompanied by a declaration of inventors. This declaration identified the specification being executed as serial number 09/936,802 filed on 14 September 2001.

On 12 April 2002, the DO/EO/US mailed in application number **09/936,802** a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 indicating the 35 U.S.C. 371(c) date as 22 March 2002. This Notice indicated the international application number as PCT/US00/01742.

On 30 September 2002, a decision was mailed in *10/089,469* granting applicants' petition under 37 CFR 1.181 filed 30 January 2002. The decision also indicated, however, that applicants must file a petition under 37 CFR 1.182 to clarify the discrepancies in the papers filed 14 September 2001 before these papers could be processed. It was also noted that a new declaration was required.

On 13 November 2002, applicants submitted a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee. The Transmittal Letter indicated that this was a first submission of items concerning a filing under 35 U.S.C. 371 of international application number PCT/US00/01434. Accordingly, the submission was assigned application number *10/276,157*. The submission was accompanied by a "PETITION AND STATEMENT UNDER 37 C.F.R. § 1.182" and a declaration of inventors.

On 04 December 2002, the USPTO mailed in application number **09/936,802** a first Office action on the merits, which indicated, *inter alia*, that the oath or declaration was defective.

On 08 April 2003, applicants submitted in application number **09/936,802**, *inter alia*, a new declaration of inventors.

On 13 May 2003, the USPTO mailed in application number **09/936,802** a NOTICE OF ALLOWABILITY indicating, *inter alia*, that the declaration submitted 08 April 2003 was defective and that a new declaration of inventors was still required.

DISCUSSION

Petition Under 37 CFR 1.181 filed 30 January 2002

As noted above, the original application papers filed 14 September 2001 have been located and assigned application number **09/936,802**. Accordingly, the decision mailed 30 September 2002 in application number *10/089,469* is hereby VACATED. The petition under 37 CFR 1.181 filed 30 January 2002 is DISMISSED as MOOT.

In that only one national stage of a PCT application is permitted, the submission filed 30 January 2002 has been placed in application number **09/936,802**. The decision mailed 30 September 2002 has also been placed in application number **09/936,802**. Assigned serial number *10/089,469* has been cancelled. Applicant should use application number **09/936,802** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/US00/01434.

Petition Under 37 CFR 1.182 filed 13 November 2002

Again, in that only one national stage of a PCT application is permitted, the submission filed 13 November 2002 has also been placed in application number **09/936,802**. Assigned serial number *10/276,157* has been cancelled. Again, applicant should use application number **09/936,802** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/US00/01434.

A review of the application file including counsel's statements in the present petition, as well as a review of the USPTO file for PCT/US00/01742, reveals that the indication of international application PCT/US00/01742 was incorrect, and that the present application should in fact be the national stage application of international application PCT/US00/01434. The NOTICE OF ACCEPTANCE OF APPLICATION mailed 12 April 2002 contained the incorrect international application number. (The international application number was indicated as PCT/US00/01742 rather than as PCT/US00/01434.) Accordingly, the NOTICE OF ACCEPTANCE mailed 12 April 2002 is hereby VACATED.

Declaration of Inventors

The declaration filed 14 September 2001 and the declaration filed 30 January 2002 were not in compliance with 37 CFR 1.497(a)-(b) since each declaration failed to properly identify the specification to which it was directed. The declaration of inventors filed 22 March 2002 is the first declaration which was filed which was in compliance with 37 CFR 1.497(a)-(b). Accordingly, the 35 U.S.C. 371(c) date is 22 March 2002. It is also noted that while the declaration is in compliance with 37 CFR 1.497(a)-(b), it is not necessarily in compliance with 37 CFR 1.63. Accordingly, the requirement for a new declaration set forth in the NOTICE OF ALLOWABILITY mailed 13 May 2003 still stands.

CONCLUSION

For the reasons set forth above, the submissions filed 30 January 2002 and 13 November 2002 have been placed in application number 09/936,802. The decision mailed 30 September 2002 has also been placed in application number 09/936,802.

For the reasons set forth above, the decision mailed 30 September 2002 is hereby **VACATED**.

For the reasons set forth above, the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 mailed 12 April 2002 is hereby **VACATED**.

For the reasons set forth above, the petition under 37 CFR 1.181 filed 30 January 2002 is **DISMISSED** as **MOOT**.

For the reasons set forth above, the petition under 37 CFR 1.182 filed 13 November 2002 is **GRANTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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 (1) mailing of a corrected NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371

(Form PCT/DO/EO/903) indicating the international application number as PCT/US00/01434 and according the application a 35 U.S.C. 371(c) date of **22 March 2002** and (2) issuance of a corrected filing receipt. The application will then be forwarded to the Office of Patent Publication.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

30 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WOLF, BLOCK, SCHORR & SOLIS-COHEN LLP
250 PARK AVENUE
NEW YORK NY 10177

In re Application of	:	
LOSHAKOVE, Moshav-Bazra et al.	:	
U.S. Application No.: 09/936,805	:	DECISION ON
PCT No.: PCT/IB00/00310	:	
International Filing Date: 20 March 2000	:	PETITION
Priority Date: 19 March 1999	:	
Attorney's Docket No.: 088/02389	:	UNDER 37 CFR 1.181
For: LOW PROFILE ANASTOMOSIS CONNECTOR	:	

Applicants filed "Request For Corrected Filing Receipt" on 25 August 2005. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 17 September 2001, applicants submitted a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, the basic national fee and a preliminary amendment setting forth applicant's priority claim.

On 25 August 2005, applicants submitted the instant request for a corrected filing receipt.

DISCUSSION

A corrected filing receipt setting forth the priority claims as listed in the preliminary amendment will be sent under separate cover. The foreign priority claims will be corrected to reflect the PCT applications, as listed in the published PCT and as claimed. However, the claim to the 1998 Israeli application is not proper as it is more than one year prior to the filing of the international application. Additionally, the relationships as listed in the request for the corrected filing receipt do not reflect the relationships as claimed in the preliminary amendment.

CONCLUSION

For the above reasons, the Petition Under 37 CFR 1.181 is **GRANTED** in part, **DISMISSED** in part.

A corrected filing receipt will be mailed separately.

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.

This application is being referred to Paul Bell in the Office of PCT Legal Administration for issuance of a corrected filing receipt.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

UNITED STATES 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

WILLIAM H. DIPPERT
REED SMITH LLP
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

COPY MAILED

JUL 17 2003

OFFICE OF PETITIONS

In re Application of :
Amir Loshakove et al :
Application No. 09/936,806 : NOTICE
Filed: September 17, 2001 :
Attorney Docket No. 088/02376

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 3700.

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

Dykema Gossett PLLC
Suite 300 West
1300 I Street, NW
Washington, DC 20005-3308

In re Application of
JOHNSEN, Lars
Application No.: 09/936,820
PCT No.: PCT/DK00/00121
Int. Filing Date: 17 March 2000
Priority Date: 18 March 1999
Attorney Docket No.: 66386-272-7
For: A LID FOR CLOSING A CONTAINER

DECISION ON

PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's "Submission of Declaration," filed on 18 March 2003. The 18 March 2003 submission and the 28 March 2003 submission have been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 17 March 2000, applicant filed international application PCT/DK00/00121. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 September 2000. A demand for international preliminary examination was filed 17 October 2000, prior to the expiration of nineteen months from the priority date. The deadline for entry into the national stage in the United States was thirty months from the priority date, 18 September 2001.

On 18 September 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 18 March 2003, applicant submitted "Submission of a Declaration," accompanied by a declaration and a postcard receipt.

On 28 March 2003, applicant submitted "Verification," stating that the declaration was a true copy of the original declaration.

DISCUSSION

MPEP at section 503 states, in part:

> 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 23 October 2001 postcard receipt lists, *inter alia*, the declaration. The postcard receipt is date stamped and indicates the applicant and the serial number.

The postcard receipt is adequate evidence the declaration was received on 23 October 2001.

The 28 March 2003 letter states that the declaration is a true copy of the 23 October 2001 submission and the statement is signed by someone registered to practice before the office.

A review of the declaration reveals that it is in compliance with 37 CFR 1.497(a)-(b) and that applicants have satisfied the requirements under 35 U.S.C. §371.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence deposited with the United States Postal Service on or after May 1, 2003 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.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. §371(c) date is 23 October 2001.

Leonard E. Smith
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

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON DC 20004-2128

COPY MAILED
DEC 02 2008

In re Patent No. 7,214,185
Issue Date: May 8, 2007
Application No. 09/936,840
Filed: September 18, 2001
Attorney Docket No. 1890-0018

ON PETITION

This is a decision on the petition filed September 29, 2008 which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The application is being referred to the Certificates of Correction Branch to correct the name of the assignee on the front page of the patent, and for consideration of the remainder of the request for certificate of correction.

Karen Creasy
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Dec. 15 2008

TO SPE OF : ART UNIT 3734
SUBJECT : Request for Certificate of Correction for Appl. No.:/09/936840 /7214185

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 Replacement Drawings be approved?

Magdalene Talley
Certificates of Correction Branch
703-308-9390 ext. 116

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved**	**All** changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments: The Replacement Drawing Sheet Submitted on 9/29/08 is Approved

TODD E. MANAHAN
SUPERVISORY PATENT EXAMINER

12/24/09

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

JUN 25 2003

#9

NIXON PEABODY LLP
8180 GREENSBORO DRIVE
SUITE 800
McLEAN, VA 22102

In re Application of	:	
Martin Caldwell et al	:	
Serial No.: 09/936,841	:	DECISION ON PETITION
Filed: September 18, 2000	:	
For: A Surgical Access Device	:	

This is in response to the petition applicant filed on June 4, 2003 to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, VIII, thus the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, Box Design, Washington, DC 20231, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director
Technology Center 3700/2900

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

Raymond B. Churchill, Jr.
GOTTLIEB, RACKMAN, & REISMAN
270 Madison Avenue
New York, New York 10016-0601

In re Application of :
BERTHON-JONES, Michael :
Application No.: 09/936,854 :
PCT No.: PCT/AU00/00411 : DECISION ON
Int. Filing Date: 05 May 2000 :
Priority Date: 06 May 1999 : 37 CFR 1.42 PAPERS
Attorney Docket no.: 3869-24 :
For: CONTROL OF SUPPLIED PRESSURE :
IN ASSISTED VENTILATION :

This is a decision on the submission under 37 CFR 1.42 filed on 02 January 2002

BACKGROUND

On 17 September 2001, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee.

On 02 November 2001, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration was required.

On 02 January 2002, applicants filed a response to the Notification Of Missing Requirements which included, among other materials, a declaration executed by the surviving co-inventor and on behalf of the deceased co-inventor Peter John Deacon WICKHAM by the executor of his estate.

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."

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.

The declaration submitted on 02 January 2002 identifies the deceased inventor and states his country of citizenship, former residency and mailing address, as required for compliance with 37 CFR 1.497(a)(3). The declaration is signed by the executor of the deceased inventor's estate, states his relationship to the deceased, and provides the executor's country of citizenship and residency. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2).

Based on the above, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**. The declaration filed on 02 January 2002 is accepted as complying with 37 CFR 1.497.

Deposit Account No. 07-1730 has been charged $130 as the surcharge for filing the declaration later than thirty months after the priority date.

The application will be forwarded to the United States Designated/Elected Office (US/DO/EO) for further processing. The 35 U.S.C. 371 date is 02 January 2002.

Boris Milef
PCT Legal Examiner
PCT Legal Office

RMR/BM:rmr

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

APR 13 2006

OFFICE OF PETITIONS

Fish & Richardson
225 Franklin Street
Boston, Massachusetts 02110-2804

In re Application of
Weiss
Application No. 09/936,859
Filed: November 15, 2001
Attorney Docket No. 06275-283US1

: DECISION GRANTING PTA

This decision is in response to applicant's "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" requesting that the Office adjust the PTA determination at the time of the notice of allowance BE ADJSUTED from a determination of NINETY-EIGHT (98) days to a determination of ONE HUNDRED AND THIRTY-THREE (133) days.

Applicant's application is **GRANTED**. The Office will adjust the PAIR calculation to reflect this decision.

Applicant assert that the Office was correct in their determination of ninety-eight (98) days of Office delay for failing to meet the requirements of 37 CFR 1.702(a)(1). Applicants assert that the Office failed to add an additional 36 days pursuant to 37 CFR 1.702(a)(2). Applicants assert that the applicants mailed a response to the non-final rejection dated April 23, 2004 on July 24, 2003. Applicants assert that the Office had four months to respond but did not respond until December 30, 2003, a thirty-six day delay. In addition, applicants concede that they delayed by one day the response filed on July 24, 2003.

Applicants arguments are persuasive. A review of the PTA/PALM history does not reflect the submission of a response on July 24, 2003. However, the Image File Wrapper (IFW) clearly reflects receipt of applicants' amendment that was filed on July 24, 2003. The Office error in not entering the response to the non-final rejection into the PALM created an incorrect PTA determination. Accordingly, the Office did not meet the requirements of 37 CFR 1.702(a)(2) within four months. The delay was thirty-six (36) days. Applicant missed the requirement of 37 CFR 1.704(b) by one day. Accordingly, the overall amount of PTA is one hundred and thirty-three days (98+36-1=133).

After the mailing of this decision, the Office will forward this application to the Office of Patent Publications for a prompt issuance of the patent. Any delays in issuing the patent beyond four months of the payment of the issue fee and other requirements being satisfied under 37 CFR 1.702(a)(4) will be added at the time of the issuance of the patent and will be reflected in the issue notification letter that is mailed to the applicants approximately three weeks prior to the actual issue date.

The Office has charged the $200.00 fee. No additional fees are required.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: adjusted PAIR calculation

Day : Wednesday

PALM INTRANET

Date: 4/12/2006
Time: 14:25:41

PTA Calculations for Application: 09/936859			
Application Filing Date:	11/15/2001	PTO Delay (PTO):	98
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	0
Post-Issue Petitions:	0	Total PTA (days):	133
PTO Delay Adjustment:	35		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
38	04/12/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	35		
17	12/30/2003	MAIL NOTICE OF ALLOWANCE			
16	12/30/2003	MAIL FORMAL DRAWINGS REQUIRED			
15	12/29/2003	FORMAL DRAWINGS REQUIRED			
14	12/29/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
13	12/29/2003	NOTICE OF ALLOWABILITY			
12	04/23/2003	MAIL NON-FINAL REJECTION	98		-1
11	04/17/2003	NON-FINAL REJECTION			
10	12/23/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	08/15/2002	CORRESPONDENCE ADDRESS CHANGE			
8	08/15/2002	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
7	03/26/2002	CASE DOCKETED TO EXAMINER IN GAU			
6	12/07/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
5	12/04/2001	APPLICATION DISPATCHED FROM OIPE			
4	12/04/2001	NOTICE OF DO/EO ACCEPTANCE MAILED			

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

06245 · 253 US1

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JKF
CHL

Janis K Fraser Ph D J D
Fish & Richardson P C
225 Franklin Street
Boston, MA 02110-2804

RECEIVED
SEP 21
JANIS K. FRASER

COPY MAILED

SEP 15 2004

OFFICE OF PETITIONS

In re Application of :
Derek Shaw, et al. :
Application No. 09/936,859 : -ON PETITION-
Filed: November 15, 2001 :
Attorney Docket No. P 0283672 :

This is a decision on the petition, filed September 15, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on April 1, 2004, using a Certificate of Mailing or Transmission under 37 CFR 1.8 dated March 30, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being forwarded to Technology Center AU 3763 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

RECEIVED
SEP 20 2004
FISH & RICHARDSON, P.C.
BOSTON OFFICE

[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).

Reviewed By Practice Systems
Initials: CSL
Reviewed By Billing Secretary

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www. uspto. gov

Janis K Fraser Ph D J D
Fish & Richardson P C
225 Franklin Street
Boston, MA 02110-2804

COPY MAILED

SEP 15 2004

OFFICE OF PETITIONS

In re Application of :
Derek Shaw, et al. :
Application No. 09/936,859 : ON PETITION
Filed: November 15, 2001 :
Attorney Docket No. P 0283672 :

This is a decision on the petition, filed September 15, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on April 1, 2004, using a Certificate of Mailing or Transmission under 37 CFR 1.8 dated March 30, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being forwarded to Technology Center AU 3763 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 062005

DATE : 06/20/2005

TO SPE OF : ART UNIT 1638

SUBJECT : Request for Certificate of Correction on Patent No.: 6,858,776

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

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:

Amendment to column 10, line 35 NOT APPROVED because no basis was pointed out for "GSP4." See approved amendment to line 51 of column 10. Amendment to line 45 of column 10 NOT APPROVED because "MC" does not appear in this line.

SPE

1638
Art Unit

FEB 2 2 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Kenneth Solomon
Howell & Haferkamp, L.C.
7733 Forsyth Blvd.
Suite 1400
St. Louis, MO 63105

In re Application of REES
U.S. Application No.: 09/936,878
Int. Application No.: PCT/GB01/00241
Int. Filing Date: 22 January 2001
Priority Date: 20 January 2000
Attorney Docket No.: 16230-8446
For: PHYSIOLOGICAL MEDIUM FOR PERFUSING, PRESERVING, AND STORING ISOLATED CELL, TISSUE AND ORGAN SAMPLES

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 19 February 2002.

BACKGROUND

On 22 January 2001, applicant filed international application PCT/GB01/00241, which claimed priority of an earlier United Kingdom application filed 20 January 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 26 July 2001. The twenty-month period for paying the basic national fee in the United States expired at midnight on 20 September 2001.

On 17 September 2001, applicant filed purported national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission did not include the basic national fee required under 35 U.S.C. 371.

International application PCT/GB01/00241 became abandoned as to the United States at midnight on 20 September 2001 for failure to pay the basic national fee.

On 19 February 2001, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR

1.17(m), and a statement that "the 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."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be submitted.

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 : 04/05/06

TO SPE OF : ART UNIT 1713

SUBJECT : Request for Certificate of Correction for Appl. No.: **09/936902** Patent No.: **6818714**

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Certificates of Correction Branch

703-308-9390 ext. 123

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

_____

_____

_____

_____

_____ 1713

SPE **Art Unit**

03 SEP 2002

UNITED STATES [redacted] AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

P4578

Reply Due 11/3/02

Eric T. Jones
REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN, AND MCCULLOCH
P.O. Box 4390
Troy, Michigan 48099-4390

In re Application of	:	
ULRICHSEN, Borre, Bengt, et al.	:	
U.S. Application No.: 09/936,924	:	DECISION ON PETITION
PCT No.: PCT/IB00/00301	:	
International Filing Date: 20 March 2000	:	
Priority Date: 19 March 1999	:	
Attorney's Docket No.: 0279.3014.001	:	
For: INSPECTION OF MATTER	:	

This decision is issued in response to the "Request For Acceptance Of Late Response To Notification Of Missing Requirements Under 35 U.S.C. 371 In The United States Designated/ Elected Office (DO/EO/US)" filed 21 June 2002, which has been treated as a petition under 37 CFR 1.181 to confirm the filing of a response to the Notification Of Missing Requirements on 13 December 2001. No petition fee is required.

BACKGROUND

On 20 March 2000, applicants filed international application PCT/IB00/00301 which claimed a priority date of 19 March 1999 and which designated the United States. On 28 September 2000, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 09 October 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 19 September 2001.

On 19 September 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.

On 01 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than thirty months from the priority date were required. The Notification also informed applicants that the failure to submit these materials within two months of the date of the Notification would result in abandonment of the application.

On 21 June 2002, applicants filed the "Request For Acceptance Of Late Response To Notification Of Missing Requirements Under 35 U.S.C. 371 In The United States Designated/ Elected Office (DO/EO/US)" considered as a petition under 37 CFR 1.181 herein. The petition asserts that applicants filed a response to the Notification Of Missing Requirements, including an executed declaration and the required surcharge, on 13 December 2001. Accompanying the petition is a copy of the materials purportedly filed on 13 December 2001.

DISCUSSION

A review of the materials purportedly filed on 13 December 2001 reveals that, unlike other papers filed by applicants in this application, these materials do not contain a certification of mailing under 37 CFR 1.8 or a certification of deposit as "Express Mail" under 37 CFR 1.10, nor have applicants provided any additional evidence of the purported 13 December 2001 filing (i.e., an "Express Mail" receipt, a copy of a mail log entry made at the time of the purported submission, etc). Absent further evidence of the 13 December 2001 filing, it cannot be concluded that the materials attached to the present petition were filed prior to 21 June 2002, the filing date of the present petition.

The deadline for a response to the Notification Of Missing Requirements was 02 January 2002. Extensions under 37 CFR 1.136(a) were available for five months, that is, until 02 June 2002. Because applicant has not submitted adequate evidence that the declaration was filed prior to 21 June 2002, the present application is abandoned for failure to file a timely response to the Notification Of Missing Requirements.

CONCLUSION

Applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

This application is **ABANDONED** for failure to file a timely response to the Notification Of Missing Requirements mailed 01 November 2001.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181" and should include adequate evidence that the materials attached to the present petition were originally filed on 13 December 2001.

Applicants might also consider filing a petition to revive the application under 37 CFR 1.137(b).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

13 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Eric T. Jones
REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN, AND MCCULLOCH
P.O. Box 4390
Troy, Michigan 48099-4390

In re Application of :
ULRICHSEN, Borre, Bengt, et al. :
U.S. Application No.: 09/936,924 : DECISION ON
PCT No.: PCT/IB00/00301 : RENEWED PETITION
International Filing Date: 20 March 2000 :
Priority Date: 19 March 1999 :
Attorney's Docket No.: 0279.3014.001 :
For: INSPECTION OF MATTER :

In a decision mailed on 03 September 2002, this Office dismissed applicants' petition under 37 CFR 1.181 seeking to confirm the 13 December 2001 filing of a response to the Notification Of Missing Requirements mailed 01 November 2001. The decision stated that the evidence presented did not support a conclusion that the materials in question had been filed on 13 December 2001.

On 23 September 2002, applicants filed the "Renewed Petition Under 37 CFR 1.181" considered herein. The submission included a copy of a docket log that purportedly confirms the mailing of the response on 13 December 2001. This new evidence has been carefully considered; however, it is again concluded that the submitted evidence does not support a finding that the attached materials were filed on 13 December 2001. Applicants have not presented any evidence that the 13 December 2001 submission was made pursuant to the certification requirements of 37 CFR 1.8 or pursuant to the "Express Mail" procedures set forth in 37 CFR 1.10. Under these circumstances, the evidence presented is insufficient to support the conclusion that the response to the Notification Of Missing Requirements was properly filed with the USPTO on 13 December 2001.

Applicants' renewed petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

This application remains **ABANDONED** for failure to file a timely response to the Notification Of Missing Requirements mailed 01 November 2001.

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 1.181" and should include adequate evidence that the materials attached to the present petition were originally filed on 13 December 2001.

It is again suggested that applicants consider filing a petition to revive the application under 37 CFR 1.137(b).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard Cole
PCT Legal Examiner
PCT Legal Office

RMR/RC:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

28 MAR 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Eric T. Jones
REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN, AND MCCULLOCH
P.O. Box 4390
Troy, Michigan 48099-4390

In re Application of	:	
ULRICHSEN, Borre, Bengt, et al.	:	
U.S. Application No.: 09/936,924	:	DECISION ON
PCT No.: PCT/IB00/00301	:	PETITION FOR REVIVAL
International Filing Date: 20 March 2000	:	(37 CFR 1.137(b))
Priority Date: 19 March 1999	:	
Attorney's Docket No.: 0279.3014.001	:	
For: INSPECTION OF MATTER	:	

The petition to revive under 37 CFR 1.137(b) filed 19 March 2003 in the above-captioned application is hereby **GRANTED** as follows:

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 of 37 CFR 1.137(b)(3).

Applicants have previously submitted, on 21 June 2002, the required reply (a proper response to the Notification Of Missing Requirements mailed 01 November 2001, that is, a declaration in compliance with 37 CFR 1.497 and an authorization to charge Deposit Account No. 50-0852 the related surcharge), 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.

Pursuant to the previously filed authorization to charge, Deposit Account No. 50-0852 will be charged the required $130 surcharge.

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. The 35 U.S.C. 371 date is **21 June 2002**.

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
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TIMOTHY H. VAN DYKE
VAN DYKE & ASSOCIATES
1630 HILLCREST STREET
ORLANDO, FL 32803

COPY MAILED

SEP 30 2004

OFFICE OF PETITIONS

In re Application of :
Parker Small et al :
Application No. 09/936,954 : ON PETITION
Filed: January 24, 2002 :
Attorney Docket No. UF-1561A-US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 10, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Office action mailed November 28, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 29, 2003.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application is being forwarded to Technology Center AU 1645 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Timothy H. Van Dyke
390 N. Orange Avenue, Suite 2500
Orlando, FL 32801

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MERCHANT & GOULD P.C.
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

COPY MAILED

JUN 13 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Kenji Narumi et al :
Application No. 09/936,968 :
Filed: September 18, 2001 :
Attorney Docket No. 10873.0797USWO

This is a decision on the petition, filed February 23, 2005 under 37 CFR 1.313(c)(2), to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 17, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2653 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

PEPR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
DEC 10 2001
TECH CENTER 1600/2900

In re application of :

Shunichi SHIOZAWA et al. : **Attn: BOX PCT**

Serial No. 09/936,989 : **Docket No. 2001_1298A**

Filed September 19, 2001 :

RHEUMATOID ARTHRITIS GENE AND METHOD FOR DIAGNOSING RHEUMATOID ARTHRITIS
[Corresponding to PCT/JP00/01697
Filed March 21, 2000]

THE COMMISSIONER IS AUTHORIZED TO CHARGE ANY DEFICIENCY IN THE FEE FOR THIS PAPER TO DEPOSIT ACCOUNT NO. 23-0975.

SUBMISSION OF EXECUTED DECLARATION

Assistant Commissioner for Patents,
Washington, DC 20231

Sir:

Enclosed herewith is an executed Declaration for the above-identified application which was originally filed without an executed Declaration.

The Declaration identifies the application by the Title, name of the inventors, and filing date of the application.

Accordingly, it is submitted that the present application now complies with the requirements of 37 CFR 1.53(d). Enclosed herewith is the $130.00 surcharge required by 37 CFR 1.16(e).

Early issuance of a filing receipt is therefore requested.

Respectfully submitted,
Shunichi SHIOZAWA et al.

By _____
Warren M. Cheek, Jr.
Registration No. 33,367
Attorney for Applicants

WMC/dlk
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
October 30, 2001

ATTY DOCKET #: 2001_1298A **Due Date:** n/a

OUR REF: 2001_1298A/WMC/00653
Applicant: Shunichi SHIOZAWA et al.
Serial No.: 09/936,989 **Filing Date:** September 19, 2001
Title: RHEUMATOID ARTHRITIS GENE AND METHOD FOR DIAGNOSING RHEUMATOID ARTHRITIS

Receipt of the following papers is acknowledged:

PTO FEE SHEET, COVER LETTER (TO INCLUDE PTO FEE OF **$130.00**), EXECUTED DECLARATION.

THE COMMISSIONER IS AUTHORIZED TO CHARGE ANY DEFICIENCY IN THE FEE FOR THIS PAPER TO DEPOSIT ACCOUNT NO. 23-0975.

Date: October 30, 2001 **Attorney:** WMC/dlk **[Check No.** 47252 **]**

RECEIVED
DEC 10 2001
TECH CENTER 1600/2900

Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/936,989	Shunichi Shiozawa	2001-1298A

INTERNATIONAL APPLICATION NO.	
PCT/JP00/01697	
I.A. FILING DATE	PRIORITY DATE
03/21/2000	03/20/1999

000513
WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

CONFIRMATION NO. 2860
371 FORMALITIES LETTER

OC000000006985910

Date Mailed: 10/30/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Biochemical Sequence Diskette
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Preliminary Amendments

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- 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 current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

- **$130** Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL

RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is **$130** for a Large Entity:

- **$130** Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

PAULETTE R KIDWELL

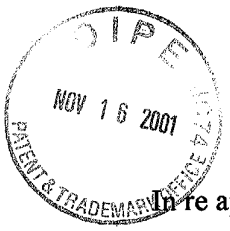
Telephone: (703) 305-3656

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/936,989	PCT/JP00/01697	2001-1298A

03-18-02

JC10 Rec'd PCT/PTO 16 NOV 2001



PCT

RECEIVED
DEC 10 2001
TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :

Shunichi SHIOZAWA et al. : **Attn: BOX PCT**

Serial No. 09/936,989 : **Docket No. 2001_1298A**

Filed September 19, 2001 :

RHEUMATOID ARTHRITIS GENE AND METHOD
FOR DIAGNOSING RHEUMATOID ARTHRITIS
[Corresponding to PCT/JP00/01697
Filed March 21, 2000]

RESPONSE

Assistant Commissioner for Patents,
Washington, DC 20231

Sir:

This is responsive to the Notice to File Missing Parts dated October 30, 2001.

The Notice to File Missing Parts requires the filing of an executed Declaration.

However, an executed Declaration has been previously filed on October 30, 2001. Copies of the executed Declaration and cover letter are enclosed herewith. A copy of the PTO postcard receipt is also enclosed. It is noted that the PTO fee for filing the executed Declaration was also concurrently submitted on October 30, 2001.

Issuance of the Official Filing Receipt is accordingly requested.

Respectfully submitted,
Shunichi SHIOZAWA et al.

By _____
Warren M. Cheek, Jr.
Registration No. 33,367
Attorney for Applicants

WMC/dlk
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
November 16, 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

Nixon & Vanderhye
8th Floor
1100 North Glebe Road
Arlington VA 22201-4714

MAIL

FEB 11 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
BRADY, et al.
Application No. 09/936,998
Filed: February 7, 2002
For: **METHOD AND APPARATUS FOR IMAGE PROCESSING**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition, filed on December 16, 2004 under M.P.E.P. § 708.02(X), inventions relating to HIV/AIDS and Cancer.

The petition is **GRANTED**.

The petition meets the requirements of MPEP § 708.02 (X).

The application file is being forwarded to the Examiner for accelerated examination in accordance with M.P.E.P. § 708.02.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

01 AUG 2003

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Kenyon & Kenyon
One Broadway
New York, NY 10004

In re Application of	
Zimmermann et al.	
US Application No.: 09/937,006	
PCT Application No.: PCT/DE01/00199	DECISION ON PETITION
International Filing Date: 18 January 2001	UNDER 37 CFR 1.181
Priority Date: 21 January 2000	
Attorney's Docket No.: 10191/1957	
For: METHOD FOR PERFORMING A TRACK SLIP AND A PLAYBACK REVICE	

This decision is in response to the "Petition to Withdraw Holding of Abandonment" filed on 19 July 2002, which is being properly treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in this international application as to the United States.

BACKGROUND

On 18 Janaury 2001, Applicants filed international application PCT/DE01/00199, which claimed priority of an earlier application filed on 21 January 2000. Given that there is no evidence of the filing of a Demand for International Preliminary Examination on or before 21 August 2001, when the 19th month from the 21 January 2000 priority date would expire, the period for entering the national stage is thus 20 months and ended on 21 September 2001.

On 19 September 2001, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), accompanied by, *inter alia*, the $860 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(4), and an unexecuted declaration.

On 30 October 2001, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, stating that an oath or declaration as required by 35 U.S.C. 371(c)(4) was missing, and setting forth an extendable 2-month period for submitting an oath or declaration. The required oath or declaration was not filed on or before 30 December 2001, and no extension of time in accordance with 37 CFR 1.136(a) was obtained. The international application was held abandoned as to the United States on 31 December 2001. A Notification of Abandonment (Form PCT/DO/EO/909) was mailed on 8 July 2002.

The instant petition asserts that an executed declaration was filed on 29 May 2002 along with a request for a 5-month extension of time and the requisite extension-of-time fee.

ANALYSIS

Upon review of the application file, the Office located a "Response to Missing Requirements under 35 U.S.C. 371" filed on 29 May 2002, accompanied by an executed "Declaration and Power of Attorney" and an authorization to charge the $1,960 for a 5-month extension of time to Deposit Account No. 11-0600. These papers apparently were not matched with the file until after the mailing of the Form PCT/DO/EO/909.

CONCLUSION

In view of the above, the declaration was timely filed. The petition is thus **GRANTED**. The holding of abandonment in the international application, as to the United States, is hereby withdrawn.

The Form PCT/DO/EO/909 mailed on 8 July 2002 is hereby **VACATED**.

Finally, a review of the declaration reveals that it complies with the requirements of 37 CFR 1.497(a) and (b). Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 18 January 2001 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **29 May 2002**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Boris Milef
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
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

MAIL

AUG 1 0 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

ROBERT M BAUER, ESQ.
LACKENBACH SIEGEL, LLP
1 CHASE ROAD
SCARSDALE NY 10583

In re Application of:
Jani Ekman, et al.
Application No. 09/937,047
Filed: January 8, 2002
For: **HANDOVER IN A MOBILE COMMUNICATION SYSTEM USING CONFERENCE FACILITY**

DECISION
ON PETITION

This is a response to the Petition to Withdraw Holding of Abandonment, filed May 27, 2005.

This application became abandoned for failure to timely submit the issue fee due in response to the Notice of Allowance and Issue Fee Due mailed January 10, 2005. A Notice of Abandonment was mailed on May 16, 2005.

The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the Practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received", 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c), section II. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Petitioner asserts that the Notice of Allowance mailed January 10, 2005 was never received because it was mailed to an improper correspondence address. In support thereof, Petitioner asserts that a communication in regard to a change of correspondence address was filed August 19, 2004. Petitioner states that the Patent and Trademark Office (PTO) failed to timely change the address until after the mailing of the Notice of Allowance and Issue Fee Due as evidenced by copies of the "Notice of Acceptance of Power of Attorney" that was mailed to applicant on January 19, 2005.

A review of the file does find an irregularity in the correspondence address. It is clear that the PTO failed to timely change the correspondence address of record, and therefore applicant's failure to receive the Notice of Allowance and Issue Fee Due was due to inadvertent PTO error. The PTO regrets any inconvenience to Petitioner.

The Notice of Abandonment mailed May 16, 2005 is hereby vacated and the holding of abandonment withdrawn. Also, the Notice of Allowance and Issue Fee Due mailed January 10, 2005 is hereby vacated.

The petition is **GRANTED**.

Since it has been established that the Notice of Allowance was not received, it is presumed that Applicant also failed to receive the Notice of Allowability. The application will be forwarded to the Technology Center's technical support staff for mailing of a new Notice of Allowance and Issue Fee Due, as well as a copy of the Notice of Allowability to the new correspondence

address. The three (3) month non-extendable time period for paying the issue fee will be set to run from the mailing date of the new Notices.

Krista Zele
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

OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT, PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

JUN 03 2005

OFFICE OF PETITIONS

In re Application of :
Antoine F. Carpentier :
Application No. 09/937,057 : DECISION GRANTING PETITION
Filed: February 26, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 249326US0X PCT :

This is a decision on the petition under 37 CFR 1.137(b), filed February 24, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an election/amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the restriction requirement of March 9, 2004 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1635 for appropriate action on the reply received on February 14, 2005.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

23 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Joseph Levi
Clifford Chance Rogers & Wells LLP
200 Park Avenue
New York, NY 10016

In re Application of :
DESURMONT, Guillaume et al. :
Application No.: 09/937,090 : DECISION ON
PCT No.: PCT/FR00/00614 :
Int. Filing Date: 14 March 2000 : PETITION
Priority Date: 24 March 1999 :
Attorney's Docket No.: 6680-010 : UNDER 37 CFR 1.181
For: METHOD OF COPOLYMERIZATION :
AND RESULTING COPOLYMERS :

This decision is in response to applicants' "Response to Notification of Defective Response," filed with the Office on 15 July 2002.

BACKGROUND

On 14 March 2000, applicants filed international application PCT/FR00/00614, which claimed a priority date of 24 March 1999. A copy of the international application was transmitted to the United States Patent and Trademark Office (USPTO) on 28 September 2000. On 19 September 2000, a demand for international preliminary examination was filed, prior to the expiration of nineteen months from the priority date. As such, the deadline for entry into the national stage in the United States was thirty months from the priority date, or 24 September 2001.

On 21 September 2001, applicants filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, the basic national fee.

On 09 November 2001, the Office mailed a Notification of Missing Requirements (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 filing the oath or declaration after thirty months were required. The Notification set a two month extendable period for reply.

On 23 April 2002, applicants filed the petition requesting that the Office reset the time period for reply so that it starts on the date when the correspondence was received by the applicant, instead of on the mail date. The petition included a certificate of first class mailing indicating the correspondence had been deposited with USPS on 12 April 2002.

On 14 June 2002, the Office mailed Notification of Defective Reply.

On 15 July 2002, applicants submitted the instant response.

DISCUSSION

Petition To Reset Time Period For Reply

A petition to reset the time period for reply must be (1) timely filed, (2) demonstrate significant delay, (3) present evidence, (4) state when the communication was received and (5) be signed.

Items (1), (2), (4) and (5) were previously met.

Item (3) has been satisfied. Though applicants have not presented evidence of the receipt date of the Notification of Missing Requirements, applicants have produced the envelope from the Notification of Missing Requirements indicating it was mailed on 11 March 2002.

The time period for response to the Notification of Missing Requirements is reset to begin on 11 March 2002.

The fee for the four month extension of time will not be charged.

Declaration

The declaration submitted on 15 July 2002 complies with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.181 is **GRANTED**.

The application has an international filing date of 14 March 2000 under 35 U.S.C. §363 and a date of 15 July 2002 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 in accordance with this decision.

Leonard E Smith

for 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Mailed: 11-30-05

MEB
Paper Number:

In re application of
Yamaguchi et al.
Serial No. 09/937,129
Filed: September 20, 2001
For: Filter Cartridge

: DECISION ON
: PETITION

This is a response to the PETITION TO WITHDRAW ABANDONMENT, filed May 27, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of April 18, 2005, for failure to timely reply to the Notice of Allowance of October 28, 2004 be withdrawn. The petitioner asserts that the issue fee payment was timely filed by mail with the Office on November 24, 2004, with the appropriate fees. A copy of the stamped post card receipt 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 issue fee payment was submitted by mail, which was received by the Office on November 24, 2004 is sufficient. The application will be forwarded to the issue branch for processing and consideration of the issue fee payment filed November 24, 2004, 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 Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Brian H. Batzli
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

COPY MAILED
JUL 13 2006
OFFICE OF PETITIONS

In re Application of
Terrence R. Burke, Jr., et al.
Application No. 09/937,150
Filed: March 26, 2002
Atty Docket No.: 401371

ON PETITION

This is a decision on the petition, filed July 12, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July21, 2005, in the above-identified application, cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

The application is being referred to Technology Center AU 1653 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: LEYDIG, VOIT & MAYER, LTD.
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

FEB 15 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Lisa B. Kole
BAKER & BOTTS LLP
30 Rockefeller Plaza
New York, N.Y. 10112-4498

In re Application of
FISHER *et al*
U.S. Application No.: 09/937,165
PCT No.: PCT/US00/06862
Int. Filing Date: 15 March 2000
Priority Date: 19 March 1999
Attorney Docket No.: 34585-A-PCT/USA
070050.1667
For: IMPROVED EXPRESSION VECTOR FOR CONSISTENT CELLULAR . . .

DECISION ON
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)

Applicants' "Petition to Revive Application Pursuant to 37 C.F.R. § 1.137(b)" filed with the national stage papers on 21 September 2001 in the above-captioned application is hereby **GRANTED** as follows:

The basic national fee has been paid. The petition fee of $620.00 for a small entity has been submitted. Applicants state that "the entire delay in filing the accompanying application was unintentional" has been interpreted as meaning that the "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). If this is an incorrect interpretation, applicants are requested to notify this office. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

No declaration was included with the national stage papers. 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 the declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge pursuant to 37 CFR 1.492(e) is required.

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

STRIKER STRIKER & STENBY
103 EAST NECK ROAD
HUNTINGTON, NY 11743

COPY MAILED

JUL 25 2007

OFFICE OF PETITIONS

In re Application of :
Helmut KREUZER et al :
Application No. 09/937,167 : DECISION ON PETITION
Filed: January 8, 2002 :
Attorney Docket No. 1764 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 9, 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 reply in a timely manner to the non-final Office action mailed August 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 November 15, 2006. A Notice of Abandonment was mailed on March 26, 2007.

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). The instant petition lacks items (1) and (3) above.

As to items (1) and (3) above, the reply and the petition containing the statement of unintentional delay are not considered to have been signed as the signature appearing on the reply and petition appear to be a "stamped" signature. The rule at 37 CFR 1.4(d)(2) requires "[a]n S-signature * * * inserted between forward slash marks * * *." The person signing the correspondence must insert his or own S-signature with a first single forward slash mark, before, and a second single forward slash mark after the S-signature. The "must insert his or her own signature" requirement is met by the signer directly typing his or her own signature using a keyboard. As the stamped signature appearing on the petition and reply is not in compliance with 37 CFR 1.4(d)(2), these papers are not considered to be properly signed. Further, the registration number must appear on the document as shown on the attached S-signatures examples.

For the above reasons, the petition under 37 CFR 1.137(b) cannot be granted at this time as compliance with 37 CFR 1.4(d)(2) has not been satisfied on either the reply or the petition.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:
Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: S-signatures Examples

I. S-SIGNATURE EXAMPLES, 37 CFR 1.4(d)(2) effective September 21, 2004

A. BY INVENTORS, AFFIANTS (e.g., §§ 1.131 & 1.132), ASSIGNEES AND PRACTITIONERS SIGNING AS INVENTORS

	SIGNATURE TYPE	SIGNATURE	TREATMENT	PREFERRED
1.	S-Signature within forward slashes, name below	/John T. Smith/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	✓
2.	S-Signature with spaces within forward slashes, name below	/ John T. Smith / John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	
3.	S-Signature within forward slashes, name below but no line under the S-Signature	/John T. Smith/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2), as a line is not required, although it is recommended.	
4.	Script font S-Signature within slashes, name below	/John T. Smith/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	
5.	Name above, S-Signature within slashes, below	John T. Smith /John T. Smith/	**Proper Signature** Treat as signed, § 1.4(d)(2).	
6.	S-Signature within slashes, name on right side	/John T. Smith/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	
7.	S-Signature within slashes, name below, both signature and name have typos	/Johon T. Smith/ John T. Smmith	**Proper signature** Signer identifiable, typo should be noted in record.	
8.	S-Signature without slashes, name below	John T. Smith John T. Smith	Improper signature Treat as unsigned due to lack of slashes, § 1.4(d)2(i).	
9.	Script font S-Signature without slashes, name below	John T. Smith John T. Smith	Improper signature Treat as unsigned due to lack of slashes, § 1.4(d)2(i).	
10.	S-Signature within double slashes, name below	//John T. Smith// John T. Smith	Improper signature Treat as unsigned due to extra slashes, § 1.4(d)2(i).	
11.	S-Signature within slashes	/John T. Smith/	Improper signature Treat as unsigned as no name provided, § 1.4(d)(2)(iii).	
12.	Graphic symbol S-Signature within slashes, name below	/☺/ John T. Smith	Improper signature Treat as unsigned due to use of graphic symbol, § 1.4(d)(2)(i).	
13.	Improper punctuation symbols in S-Signature within slashes, name below	/Good?Great!!!/ John T. Smith	Improper signature Treat as unsigned due to use of ? and ! symbols, § 1.4(d)(2)(i).	

NOTE: Signatures by assignees are also required to be by: 1) an appropriate party of the assignee to sign; 2) supported by evidence that the proper assignee is submitting the document. The assignee of the entire interest, or all partial assignees, must sign any correspondence (§§ 3.71(b) & (c)).

I. S-SIGNATURES EXAMPLES (continued)

B. BY PRACTITIONERS OF RECORD OR ACTING IN A REPRESENTATIVE CAPACITY

	SIGNATURE TYPE	SIGNATURE	TREATMENT	PREFERRED
1.	S-Signature & reg no. within slashes, name below	/John T. Smith, Reg.# 999999/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	✓
2.	S-Signature & reg no. within slashes, name below but no line under S-Signature	/John T. Smith, Reg.# 999999/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2), as a line is not required, although it is recommended.	
3.	Script font S-Signature within slashes, name & reg. no. below	/John T. Smith/ John T. Smith, Reg. #999999	**Proper Signature** Treat as signed, § 1.4(d)(2).	
4.	S-Signature within slashes, name below with reg. no.	/Customer Number 555555/ John T. Smith, Reg. No. 999999	**Proper Signature** Treat as signed, § 1.4(d)(2).	
5.	S-Signature within slashes, name below with reg. no.	/John T. Smith/ John T. Smith, Reg. #999999	**Proper Signature** Treat as signed, § 1.4(d)(2).	✓
6.	S-Signature within slashes, and with reg. no. to the right, name below	/John T. Smith/ Reg. #999999 John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	✓
7.	Reg. no. to left of S-Signature within slashes, name below	Reg. #999999 /John T. Smith/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	
8.	Name above, S-Signature and reg. no. within slashes below	John T. Smith /John T. Smith, Reg.# 999999/	**Proper Signature** Treat as signed, § 1.4(d)(2).	
9.	S-Signature and reg. no. within slashes, name on right side	/John T. Smith, Reg.# 999999/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2).	
10.	S-Signature and reg. no. within slashes, name below; John T. Smith signing his signature for Bill Jones (whose name appears first)	Bill Jones by /John T. Smith, Reg.# 999999/ John T. Smith	**Proper Signature** Treat as signed, § 1.4(d)(2). Acceptable because of John T. Smith's signature, for himself.	
11.	S-Signture within double slashes, name and reg. no. below	//John T. Smith// John T. Smith, Reg. #999999	Improper signature Treat as unsigned due to extra slashes, § 1.4(d)(2)(i).	
12.	S-Signature within back slashes, name and reg. no. below	\John T. Smith\ John T. Smith, Reg. #999999	Improper signature Treat as unsigned due to back slashes instead of forward slashes, § 1.4(d)(2)(i).	
13.	S-Signature without slashes, name and reg. no. below	John T. Smith John T. Smith, Reg. #999999	Improper signature Treat as unsigned due to lack of slashes, § 1.4(d)(2)(i).	

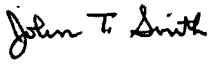
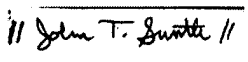
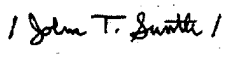
I. EXAMPLES OF S-SIGNATURES (continued)

B. BY PRACTITIONERS OF RECORD OR ACTING IN A REPRESENTATIVE CAPACITY (continued)

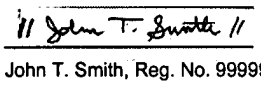
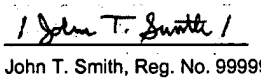
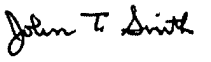
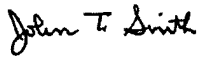
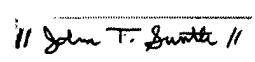
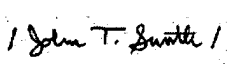
14.	Script font S-Signature without slashes, name and reg. no. below	*John T. Smith* John T. Smith, Reg. #999999	Improper signature Treat as unsigned due to lack of slashes, § 1.4(d)(2(i).
15.	Graphic symbol S-Signature within slashes, name and reg. no. below	/☺face/ John T. Smith, Reg #999999	Improper signature. Treat as unsigned due to usage of graphic symbol, § 1.4(d)(2(i).
16.	Improper punctuation symbols in S-Signature within slashes, name and reg. no. below	/Good?Great!!!/ John T. Smith, Reg #999999	Improper signature. Treat as unsigned due to use of ? and ! symbols, § 1.4(d)(2(i).
17.	S-Signature within slashes and reg. no. to right	/John T. Smith/ Reg #99999	Improper signature. Treat as unsigned as no name provided, § 1.4(d)(2(iii).
18.	S-Signature within slashes and name below	/John T. Smith/ John T. Smith	Improper signature. Treat as unsigned as no registration number provided, § 1.4(d)(2(ii).
19.	S-Signature and reg. no. with only 1 slash, name below. John T. Smith signing his signature for Bill Jones (whose name appears first)	Bill Jones by/ John T. Smith, Reg.# 999999 John T. Smith	Improper signature. Treat as unsigned as no slash mark is after signature, § 1.4(d)(2(i).
20.	S-Signature and reg. no. within slashes, John T. Smith signing his signature for Bill Jones (whose name appears first)	Bill Jones by /John T. Smith, Reg.# 999999/	Improper signature. Treat as unsigned as no signer name provided, § 1.4(d)(2(iii).

II. HANDWRITTEN SIGNATURE EXAMPLES, 37 CFR 1.4(d)(1)

A. BY INVENTORS, AFFIANTS, ASSIGNEES & PRACTITIONERS OF RECORD EXAMPLES

	SIGNATURE TYPE	SIGNATURE	TREATMENT	PREFERRED
1.	Handwritten with name below	John T. Smith	**Proper signature** No change, recommended for non-practitioners to include name.	✓
2.	Handwritten with name and registration number below	John T. Smith, Reg. No. 99999	**Proper signature** No change, recommended for practitioners to include name and reg. no.	✓
3.	Handwritten		**Proper signature** No change, name not required, § 1.4(d)(1).	
4.	Handwritten within multiple slashes		**Proper signature** No change, name not required, slashes not required or prohibited, §1.4(d)(1).	
5.	Handwritten within slashes		**Proper signature** No change, name not required, slashes not required or prohibited, §1.4(d)(1).	

B. BY PRACTITIONERS SIGNING IN A REPRESENTATIVE CAPACITY (37 CFR 1.34) (NOT OF RECORD) EXAMPLES

1.	Handwritten	John T. Smith, Reg. No. 99999	**Proper signature** See § 1.4(d)(1). Name in addition to signature is required by § 1.34, see 1283 OG 148 (June 22, 2004).	✓
2.	Handwritten within multiple slashes	 John T. Smith, Reg. No. 99999	**Proper signature** Slashes not required or prohibited, §1.4(d)(1). Name in addition to signature is required by § 1.34, see 1283 OG 148 (June 22, 2004).	
3.	Handwritten within slashes	 John T. Smith, Reg. No. 99999	**Proper signature** Slashes not required or prohibited, §1.4(d)(1). Name in addition to signature is required by § 1.34, see 1283 OG 148 (June 22, 2004).	
4.	Handwritten with reg. no.	 Reg. No. 99999	Improper signature Treat as unsigned; no name provided as required by § 1.34, see 1283 OG 148 (June 22, 2004).	
5.	Handwritten with name	 John T. Smith	Improper signature Treat as unsigned; no registration number provided as required by § 1.34, see 1283 OG 148 (June 22, 2004).	
6.	Handwritten with slashes		Improper signature Treat as unsigned; no name and registration number provided as required by § 1.34, see 1283 OG 148 (June 22, 2004).	
7.	Handwritten with slashes		Improper signature Treat as unsigned; no name and registration number provided as required by § 1.34, see 1283 OG 148 (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

Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743

COPY MAILED

JAN 1 1 2008

OFFICE OF PETITIONS

In re Application of :
Helmut Kreuzer et al. :
Application No. 09/937,167 : ON PETITION
Filed: January 8, 2002 :
Attorney Docket No. 1764 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 1, 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 above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed August 14, 2006 which set a shortened statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on November 15, 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 Commissioner may require additional information. See MPEP 711.03(c)(II)(C) and (D). The renewed petition lacks item (1).

The Petition Decision mailed July 25, 2007 noted that items (1) and (3) were missing from the petition filed April 9, 2007 due to improper signature. The renewed petition includes a properly signed statement but does not include a properly signed reply to the Office action.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Telephone inquiries concerning this decision should be directed to the Carl Friedman at (571) 272-6842.

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

COPY MAILED

MAY 20 2008

OFFICE OF PETITIONS

Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743

In re Application of :
Helmut Kreuzer et al. :
Application No. 09/937,167 : ON PETITION
Filed: January 8, 2002 :
Attorney Docket No. 1764 :

This is a decision on the second renewed petition under 37 CFR 1.137(b), filed January 21, 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 August 14, 2006 which set a shortened statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on November 15, 2006.

The petition decision mailed January 11, 2008 dismissed the renewed petition filed August 1, 2007 for failure to provide the required reply under 37 CFR 1.137(b)(1) in that no signed amendment was included with the renewed petition.

The instant renewed petition includes a proper amendment.

The renewed petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) the required statement of unintentional delay have been received. Accordingly, the amendment is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the Carl Friedman at (571) 272-6842.

The application is being referred to Technology Center Art Unit 3729 for appropriate action on the merits.

for David Bucci
Petitions Examiner
Office of Petitions

JAN 17 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Edwin E. Voigt
Vidas, Arrett & Steinkraus, P.A.
Suite 2000
6109 Blue Circle Drive
Minnetonka, MN 55343-9185

In re Application of :
ODDSEN. et al. :
Application No.: 09/937,172 : DECISION ON PETITION
PCT No.: PCT/NO00/00093 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 17 March 2000 :
Priority Date: 25 March 1999 :
Attorney Docket No.: H82.2-10148 :
For: A METHOD OF MANUFACTURING FEED PELLETS AND PLANT FOR USE IN THE IMPLEMENTATION OF THE METHOD

The petition to revive under 37 CFR 1.137(b) filed 30 November 2001 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 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.

Deposit Account No. 22-0350 has been charged a $1280.00 petition fee under 37 CFR 1.17(m).

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

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

MAR - 5 2004

BRET E. FIELD
BOZICEVIC, FIELD & FRANCIS, LLP
200 MIDDLEFIELD ROAD, SUITE 200
MENLO PARK, CA 94025

In re Application of	:
Geoffrey Dobson et al	:
Serial No.: 09/937,181	: STATUS LETTER
Filed: January 10, 2002	:
Attorney Docket No.: FREE-001	:

This is in response to applicants' attorneys' request, filed January 29, 2004, to withdraw from representation in the above identified application.

 10.40 Withdrawal from employment.
(b) Mandatory withdrawal . A practitioner representing a client before the Office shall withdraw from employment if:
(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;
(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
(4) The practitioner is discharged by the client.
(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:
(1) The petitioner's client:
(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
(ii) Personally seeks to pursue an illegal course of conduct;
(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.
(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Applicants' attorney has provided no reason for withdrawal, as required.

The request to withdraw is **DISMISSED**.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at Office facsimile number.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES 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

RATNERPRESTIA
P.O. Box 980
Valley Forge, PA 19482-0980

MAR 19 2004

In re Application of:
Shunsuke Ohtsuda et al.
Serial No.: 09/937,185
Filed: September 21, 2001
Attorney Docket No. NSG-202US

DECISION ON PETITION

This is a decision on the petition, filed February 9, 2004, via facsimile transmission, requesting that the Amendment After Final Rejection be entered under 37 C.F.R. § 1.181 or § 1.182. The petition is being treated as a petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment of the above-identified application, to enter the Amendment After Final Action, to reset the statutory period for filing a reply to the final Office action to run from the mail date of any Advisory Action to be issued and to refund the fee for the three-month extension of time filed with the Notice of Appeal on December 17, 2003.

DD The petition to withdraw the holding of abandonment is granted.
The petition to reset the period for reply to the final Office action is denied.
The request to refund the extension of time fee is granted.

This application was held abandoned for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of June 17, 2003. A Notice of Abandonment was mailed on January 27, 2004.

Petitioner asserts that a reply, consisting of an "Amendment After Final Action" was timely filed on August 6, 2003, but has not been considered by the USPTO. As such, petitioner requests that, due to the delay on the part of the USPTO, this amendment should be entered and that, if any Advisory Action is issued in response thereto, the shortened statutory period for reply be reset to run from the mailing date of such Advisory Action. It is further asserted that the delay in considering the Amendment After Final Action has caused the petitioner to have to pay the fee for an extension of time of three months to file the Notice of Appeal on December 22, 2003.

A review of the file record indicates that the above-identified Amendment After Final Action was timely submitted but was not matched with the file for consideration by the examiner. In

the apparent absence of an Office communication regarding the status of the Amendment After Final Action, a Notice of Appeal and a petition for an extension of time of three months were filed via a certificate of mailing under 37 CFR 1.8(a) with a deposit date of December 17, 2003, and were received in the USPTO on December 22, 2003.

STATUTE, REGULATIONS AND PRACTICE

37 C.F.R. § 1.113(a) states in part that:

> (a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116...

37 C.F.R. § 1.116(a) and (b) state that:

> (a) After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or save the application from abandonment under § 1.135.
> (b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

M.P.E.P. § 706.07(f) states in part that:

> All final rejections setting a three (3) month shortened statutory period (SSP) for response should contain one of the Form Paragraphs (7.39; 7.40; 7.41) advising applicant that if the response is filed within two (2) months of the date of the final Office action, the shortened statutory period will expire at three (3) months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable response period will be established. In no event can the statutory period for response expire later than 6 months from the date of the final rejection.
>
> ...
>
> Advisory Actions
>
> (4) Where the final Office action sets a variable response period as set forth in paragraph 1 above, AND applicant files a complete first response to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the
>
> ...

(c) Response does not put the application in condition for allowance - then the advisory action should inform applicant that the SSP for response expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking the appropriate box at the top portion of the Advisory Action form, PTOL – 303.

...

For example, if applicant initially responds within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3 - month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

OPINION

In view of the copies of the postcard receipts evidencing the timely filing of the Amendment After Final Action on August 8, 2003 and of the Notice of Appeal on December 22, 2003, the copies of the Amendment and of the Notice of Appeal are hereby accepted since the USPTO has apparently lost the originally submitted papers.

Refund of the extension of time fee for filing the Notice of Appeal:
Pursuant to the USPTO policy on practice after final action as outlined in M.P.E.P. § 706.07(f), when a reply to a final Office action setting a three-month shortened statutory period for response is filed within two months of the date of the action, a variable response period will be established: the statutory period will expire at three months from the date of the final action or on the date the advisory action is mailed, whichever is later, but no later than six months from the date of the final action. The Amendment After Final Action submitted on August 6, 2003 was filed within two months from the date of the final action. Accordingly, a variable statutory period was established pursuant to M.P.E.P. § 706.07(f). In the instant application, the proposed after final amendment pursuant to 37 C.F.R. § 1.116 does not place the application in condition for allowance as indicated in the attached Advisory Action, the variable statutory period was extended to six months from the date of the final action and expired December 17, 2003. As such, the filing of the Notice of Appeal on December 22, 2003 via a certificate of mailing dated December 17, 2003 did not require an extension of time to be considered timely. The request for refund the fee for three-month extension of time filed December 22, 2003 is granted.

Resetting the statutory period in an Advisory Action:
Under current practice after an Office action is made final, it is incumbent upon an applicant to take appropriate steps to ensure against the abandonment of his/her application. Because the Amendment After Final Action submitted is not deemed to place the application in condition for allowance, the reply required may be a Notice of Appeal and requisite fee. While it is regrettable that the USPTO did not timely consider the After Final Amendment and an Advisory Action not mailed before the expiration of the statutory period, there is no provision in the statute or rule that permits resetting a statutory period in an Advisory Action. Accordingly, the petition to reset the time period for filing a reply to the final Office action cannot be granted.

Withdrawing the holding of Abandonment:
In view of the timely filing of the Notice of Appeal, the holding of abandonment is hereby withdrawn and the Notice of Abandonment vacated. The application is restore to the status of pending and under appeal. The appeal brief is due.

Time for filing an appeal brief:
Because the application was held abandoned while on appeal and because of the special circumstances surrounding this application, the two-month time to file the appeal brief pursuant to 37 C.F.R. § 1.192 is hereby reset to run from the date of this decision. Extensions of this time are governed by 37 C.F.R. § 1.136(a).

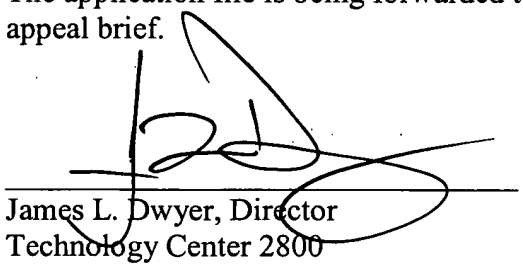
CONCLUSION

The holding of abandonment is withdrawn and the Notice of Abandonment vacated. The extension of time fee of $950.00 will be refunded to Deposit Account No. 18-0350 and the two-month time for filing the appeal brief is reset to run from the date of this decision with extensions of time available under 37 CFR 1.136(a).

A copy of the Advisory Action is enclosed for petitioner's file record.

Questions regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

The application file is being forwarded to the Technology Central Files where it awaits the appeal brief.



James L. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Enclosure: Copy of the Advisory Action in response to the Amendment After Final Action

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Marina Larson & Associates LLC
re: MSK
P. O. BOX 4928
DILLON CO 80435-4928

COPY MAILED

MAY 25 2007

OFFICE OF PETITIONS

In re Application of :
Rosen et al. :
Application No. 09/937,192 : Decision on Petition for
International Filing Date: April 7, 2000 : Patent Term Extension
For: METHODS AND COMPOSITIONS FOR :
DEGRADATION AND/OR INHIBITION OF :
HER-FAMILY TYROSINE KINASES :

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition To The Director Under Rule 1.181," received on January 10, 2007.. 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 1.181 is dismissed.

Petitioner notes that the Notice of Allowance mailed on December 7, 2006, for the above-identified application did not contain an indication of paten term extension under 35 U.S.C. §154(b).

Petitioner contends that the instant application is entitled to 1054 days, 602 days or at the very least 338 days of patent term extension as compensation for the delays due prosecution of the application. Petitioner contends that since the Examiner was reversed on the § 112 first and second paragraph rejections that there was a final decision in favor of applicant.

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 April 7, 2000. Accordingly it 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. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was a successful appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner's argument that patent term extension should be awarded to the above-identified application because there was a final decision in favor of the Applicant is not persuasive. While the examiner was reversed on the § 112 rejections, the Examiner was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all the grounds, there is not a final decision in favor of applicants. As noted on page 8 of the "Decision on Appeal" mailed on August 28, 2006, the Examiner was "Affirmed."

The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

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 a petition under 37 CFR 1.705(b) has been paid. Any request for reconsideration of this decision must be submitted as a petition under either 37 CFR 1.182 or 37 CFR 1.183 with the required fee.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted or mailed by the Office, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Marina Larson & Associates LLC
re: MSK
P. O. BOX 4928
DILLON CO 80435-4928

MAILED

MAR 3 1 2009

OFFICE OF PETITIONS

In re Application of	:
Rosen et al.	:
Application No. 09/937,192	:
International Filing Date: April 7, 2000	: Decision on Petition for
U.S. Patent No. 7,238,682	: Patent Term Extension
For: Methods and Compositions for	:
Degradation and/or Inhibition of HER-Family	:
Tyrosine Kinases	:

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Request for Reconsideration of: Petition to the Director Under 1.181," received on June 12, 2007. The petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701. See 35 U.S.C. § 154(b)[1] and 37 CFR § 1.701.

The petition under 37 CFR 1.182 or 1.183 is denied.

Background

Petitioner filed a petition as a "Petition To the Director Under 37 CFR 1.181" for review of the patent term extension on January 10, 2007, for an extension of the patent term. Petitioner requested a patent term extension of 1,054 days, 602 days or at the very least 338 days due to delays in the Office during which the application was under appeal. On May 25, 2007, the petition was dismissed and the patent term extension was 0 days.

Petitioner contends that the original petition was dismissed in error, as the petition was dismissed because the Legal Advisor could not find a decision of Appellate Review in favor of Applicant, as the Legal Advisor concluded that "while the Examiner was reversed on the 112 rejection, the Examiner

[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.

was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all grounds, there is not a final decision in favor of applicants".

Petitioner asserts that the provisional double patenting rejection was never an issue on appeal, as the only grounds of rejections on appeal in this case were the 35 U.S.C. 112 rejections. Petitioner asserts that the examiner acknowledged this in the Examiner's Answer concluding that the "appellants grounds of rejection to be reviewed on appeal is correct, however then the Examiner repeated the obvious double patenting rejection in the Examiner's Answer.

Petitioner asserts that even if the provisional obvious double patenting rejection were an issue in the appeal, which it was not, that Applicant's can find nowhere where it states that the Examiner has to be reversed "on at least one claim for all grounds" to find a decision in favor of Applicants as asserted in the Decision on Petition.

Petitioner argues that the BPAI reversed all of the Examiner's 112 rejections and the case proceeded straight to allowance and no terminal disclaimer was filed, thus the only determination adverse to patentability was reversed. Petitioner asserts that the provisional rejection and could not mature to an actual basis for rejection.

Petitioner contends that the instant application is entitled to 1054 days, 602 days or at the very least 338 days of patent term extension as compensation for the delays due prosecution of the application. Petitioner contends that since the Examiner was reversed on the § 112 first and second paragraph rejections that there was a final decision in favor of applicant.

Applicable Statutes and Regulation

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)
***

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.
35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these

administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) interference proceedings under 35 U.S.C. 135(a); and/or

(2) the application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3), and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) with respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) the number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) the number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) the number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) the member of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) the number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," 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.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(a)(3) and 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension.

The above-identified application was filed on April 7, 2000. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was a successful appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner's argument that patent term extension should be awarded to the above-identified application, because after the decision by the BPAI, the application was allowed without a terminal disclaimer being filed is not persuasive. While the examiner was reversed on the § 112 rejections, the Examiner was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all the grounds, there is not a final decision in favor of Applicants. As noted on page 8 of the "Decision on Appeal" by the BPAI, which was mailed on August 28, 2006, the Examiner was "**Affirmed,**" there was not a final decision in favor of Applicants.

Petitioner's argument that there is no support for the assertion that the Examiner has to be reversed "on at least one claim for all grounds" to find a decision in favor of Applicants is not persuasive. Both 37 CFR 1.701(a)(3) and 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal

Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension. According to Changes to Implement 20-Year Patent Term and Provisional Applications, 60 FR 20195, 20219, (April 25, 1995) Comment 137 and Response, "[e]xtension of patent term under § 1.701(a) (3) is applicable if all the rejections on any one claim are ultimately reversed."

Petitioner's argument that the obvious double patenting rejection was not an issue, as the Examiner acknowledged that the Appellants grounds of rejection in the Brief was correct, which omitted the obvious double patenting rejection is not persuasive. In the Office Action from which the Appeal was taken, the Examiner made an obvious double patenting rejection and then he repeated the obvious double patenting rejection in the Examiner's Answer. Petitioner did not note or argue the obvious double patenting rejection in Applicants' Reply Brief.

The application was not issued due to an adverse determination of patentability by the BPAI, was not delayed due to an interference proceeding, nor was it subject to a secrecy order, as a result, this application is not eligible for the extension under 35 U.S.C. 154 in effect on June 8, 1995 and 37 CFR 1.701. While a Notice of Appeal and an Appeal Brief were filed in the application, the application was not allowed pursuant to an adverse determination of patentability by the BPAI.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. Since, the application was not issued due to an adverse determination of patentability by the BPAI, the Office is without authority to grant the application patent term extension under 35 U.S.C. 154(b)(2) and 37 CFR 1.701.

The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

Decision

The prior decision which refused to grant a petition under 35 U.S.C. 154(b) and 37 CFR 1.701 for patent term extension for the delayed issuance of the patent for the above-identified patent application has been reconsidered. For the reasons stated herein, and in the previous decision, however, a patent term extension in this case cannot be granted under 35 U.S.C. § 154(b) in effect on June 8, 1995 and 37 CFR §§ 1.182 and 1.701. Therefore, the petition is **denied**.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized, the required $400 fee for the petition has been charged to petitioner's Deposit Account.

This decision may be viewed as a final agency action. See MPEP § MPEP 1002.02(b).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

Robert A. Clarke
Director and Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Joseph S. Tripoli
Thomson Multimedia Licensing
P. O. Box 5312
Princeton, NJ 08543-5312

COPY MAILED

MAR 14 2005

OFFICE OF PETITIONS

In re Application of :
Nacerdine Azzi, et al. :
Application No. 09/937,275 : ON PETITION
Filed: March 4, 2002 :
Attorney Docket No. RCA 89433 (PF990009) :

This is a decision on the petition under 37 CFR 1.137(b), filed January 6, 2005, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 2800 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Joseph J. Laks
Vice President
Thomson Licensing, LLC
P.O. Box 5312
Princeton, NJ 08543-5312

COPY MAILED

JUN 23 2008

OFFICE OF PETITIONS

In re Application of :
Nacerdine Azzi et al. :
Application No. 09/937,275 : DECISION ON PETITION
Filed: March 4, 2002 :
Attorney Docket No. RCA 89433 (PF990009) :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 28, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely submit corrected drawings in a timely manner in reply to the Notice of Allowability mailed on October 17, 2007, which set a period for reply of three (3) months. Accordingly, the application became abandoned on January 18, 2008. A Notice of Abandonment was mailed on February 12, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of corrected drawings, (2) the petition fee of $1540, (3) a proper statement of unintentional delay. Accordingly, the corrected drawings is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, 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 the Office of Data Management for further processing into a patent.

Carl Friedman
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner of Patents

Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, NW
Washington, DC 20036

MAILED

AUG 02 2005

Director's Office
Group 3700

In re Application of :
COON ET AL. :
Serial No. 09/937,282 : Decision on
Filed December 21, 2001 : Petition
For: Wire-Coil Packaging Drum with Improved :
Bottom Assembly :

A Notice of Abandonment for the above-identified application was mailed March 21, 2005. Applicant filed a petition to withdraw the Holding of Abandonment under 37 CFR 1.181 on March 30, 2005. In the petition applicant indicates that a request for RCE was filed June 18, 2004 amendment was timely filed. In the filing of the Request for Continued Examination the application number was incorrectly noted and the RCE was placed in the wrong file. This error has been noted and the RCE is now properly placed in the above indicated application.

In view of the above, the Notice of Abandonment mailed March 21, 2005 is in error. The **Holding of Abandonment is Withdrawn**. This application is being forwarded to the examiner for appropriate action.

Richard A. Bertsch, Director
Technology Center 3700

13 AUG 200

UNITED STATES 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
1300 I Street, N.W.
Washington, D.C. 20005-3315

In re Application of :
FERRARI, Veronique :
U.S. Application No.: 09/937,314 :
PCT No.: PCT/FR01/00229 : DECISION ON PETITION
International Filing Date: 24 January 2001 : UNDER 37 CFR 1.181
Priority Date: 24 January 2000 :
Attorney's Docket No.:05725.0932 :
For: TRANSFER-RESISTANT COMPOSITION :
STRUCTURED IN RIGID FORM BY A :
POLYMER :

This decision is issued in response to the "Petition Under 37 CFR 1.181" filed by applicant on 15 April 2003. No petition fee is required.

BACKGROUND

On 24 January 2001, applicant filed international application PCT/FR01/00229, which claimed priority of an earlier application filed 24 January 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 26 July 2001.

A Demand for international preliminary examination electing the United States was not filed prior to the elapse of 19 months from the priority date. Accordingly, the deadline for submission of the basic national fee in the United States expired twenty months after the priority date, i.e., 24 September 2001.

On 24 September 2001, applicant filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 17 January 2002, the DO/EO/US mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than twenty months after the priority date were required.

On 15 April, 2003, applicant filed the petition considered herein. The petition seeks to confirm the filing of an executed declaration and surcharge payment on 06 December 2001, and the resubmission of the declaration and surcharge payment on 16 April 2002. The petition includes copies of the previous submissions and the related return postcards.

DISCUSSION

A review of the application file confirms the presence of the materials originally filed by applicant on 06 December 2001 (transmittal letter, executed declaration, and Information Disclosure Statement, with references). The transmittal letter bears a USPTO receipt stamp dated 06 December 2001, confirming the asserted filing date. The included declaration satisfies the requirements of 37 CFR 1.497. It appears that the $130 check included with the 06 December 2001 submission was mistakenly applied towards the international application number PCT/FR01/00229.

The application file also contains the materials filed by applicant on 16 April 2002 (Response To Notification Of Missing Requirements, with copies of the materials filed 06 December 2001). These materials bear a USPTO receipt stamp dated 16 April 2002, confirming the asserted filing date. Based on the authorization to charge contained in the 16 April 2002 filing, Deposit Account No. 06-0916 was charged the $130 surcharge.

It is noted that the application file also contains the Preliminary Amendment field by applicants on 14 March 2002.

Applicant's 06 December 2001 filing of a declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than twenty months after the priority date is confirmed. Based on this submission, the Notification Of Missing Requirements mailed 17 January 2002, based as it was on the purported failure of applicant to file a declaration and surcharge, is appropriately vacated.

Based on the above, applicant's petition is moot.

CONCLUSION

The petition under 37 CFR 1.181 is **MOOT**.

The Notification Of Missing Requirements mailed 17 January 2002 is hereby **VACATED**.

The declaration filed 06 December 2001 is accepted in compliance with 37 CFR 1.497.

Deposit Account No 06-0916 will be credited with a $130 refund based on the duplicative charges made for the $130 surcharge.

This application, is being forwarded to the National Stage Processing Division for further processing in accord with this decision. The 35 U.S.C. 371 date is 06 December 2001.

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAR 18 2004

Michelle E. O'Brien
FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, LLP
1300 I Street, NW
Washington, D.C. 20005-3315

In re Application of	:	
Veronique FERRARI	:	
Serial No. 09/937,314	:	DECISION ON PETITION
International Filing Date: September 24, 2001	:	
Attorney Docket No.: 5725.0932-00	:	

This is in response to applicant's "Petition to Make Special under 37 CFR 1.102(d) and MPEP 708.02, (II)" filed February 27, 2004.

A review of the petition shows that requirements of MPEP 708.02 have been met. Accordingly, the petition is granted. There is no provision for "withdrawal" from this special status.

Petition Granted.

Should there be any questions with regard to this letter please contact Cecilia Tsang by letter addressed to the Director, technology center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0562 or by facsimile transmission to the Office general facsimile number.

Cecilia Tsang
Special Program Examiner, TC1600

UNITED STATES 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.

Eric B Meyertons
Conley Rose & Tayon
PO Box 398
Austin, TX 78767-0398

COPY MAILED

AUG 1 3 2004

OFFICE OF PETITIONS

In re Application of
Philippe Magnier
Filing Date: December 17, 2001
Application No. 09/937,362
International Filing Date:
March 17, 2000
Atty Docket No. 5310-03400

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed May 25, 2004. Applicant requests pursuant to 35 U.S.C. 154(b), a determination of patent term adjustment due to examination delay of 165 days.

The petition is **DISMISSED**.

On February 18, 2004, the Office mailed the Determination of Patent Term Extension under 35 U.S.C. 154(b)(application filed after June 7, 1995 but prior to May 29, 2000) in the above-identified application. The Notice stated that the patent term extension to date is 0 days.

The Patent Term Guarantee Act of 1999 amended 35 U.S.C. § 154 to include § 154(b), which provides for adjustment of patent term due to examination delay. The provisions of § 154(b) related to adjustment of patent term due to administrative delays apply only to original applications, other than designs, filed on or after May 29, 2000. The provisions do not apply to international application filed before May 29, 2000 by virtue of the requirements of 35 U.S.C. 371 having been met on or after May 29, 2000. The date on which an international application fulfills the requirements of 35 U.S.C. 371 is not the filing date, or even relevant to the filing date, of the international application. Section 4405 of the American Inventors Protection Act of 1999 provides that the amendments relating to patent term adjustment shall apply to any application filed on or after May 29, 2000, but does not provide that its patent term adjustment provisions apply to international applications filed before May 29, 2000, that complied with the requirements of 35 U.S.C. 371 on or after May 29, 2000. See Comment 6 to *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

Since the international filing date of this application, March 17, 2000, is before May 29, 2000, this application is not eligible for patent term adjustment due to examination delay.

Since this application did not have a successful appeal, interference or secrecy order delay, this application is not eligible for the extension or adjustment under 35 U.S.C. 154. The Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 50-1505, as authorized. No additional fees are required.

The Publishing Division has been advised of this decision. The application is being forwarded for timely issuance of the patent.

Telephone inquiries with regard to this communication should be directed to Senior Petitions Attorney Nancy Johnson at (703) 305-0309.

Kery A Fries for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Jan. 11, 2005

TO SPE OF : ART UNIT 1711

SUBJECT : Request for Certificate of Correction on Patent No.: 6,770,680

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 see the PCT data – should this be changed?

Thank You For Your Assistance

_____
Certificates of Correction Branch

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☑ **Approved**	All changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments:

_____

_____

_____

_____

_____

_____ 1711
SPE **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 24 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 New York Avenue, N.W.
Washington DC 20005-3934

In re Application of
Foster et al.
Serial No. : 09/937,484
Filed : 2 January 2002
Attorney Dkt No. : 1581.0870000/RWE/ALS

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181, filed on 17 August 2004, to withdraw the lack of unity requirement. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the application was filed under 35 USC 371 on January 2, 2002 with 17 claims (claims 30-47) drawn to a conjugate of lectin and a peptide/protein, a nucleic acid encoding said conjugate and peptide and methods of there use and preparation. After an initial lack of unity requirement mailed on October 3, 2003, a second supplemental lack of unity requirement was mailed on January 29, 2004 in which claims 30-47 were divided in to ten groups based on 35 U.S.C. 121 and 372, as follows:

> Group I, claims 30-37, drawn to a conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity), classified in class 530, subclass 300+.
>
> Group II, claim 38 drawn to a nucleic acid sequence encoding a conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity), classified in class 435, subclass 5+.
>
> Group III, claims 39-42, drawn to a method of treating a disease or condition comprising administering an effective amount of a lectin, classified in class 514, subclass 2.

Group IV, claims 39-42, drawn to a method of treating a disease or condition comprising administering an effective amount of a nucleic acid sequence coding a lectin, classified in class 514, subclass 2.
Group V, claims 39-42, drawn to a method of treating a disease or condition comprising administering an effective amount of conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity), classified in class 514, subclass 2.

Group VI, claims 39-42, drawn to a method of treating a disease or condition comprising administering an effective amount of a nucleic acid sequence encoding a conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity), classified in class 514, subclass 2.

Group VII, claims 43-44, drawn to a method of preparing a conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity) comprising coupling the compounds together, classified in class 424, subclass 1.69+.

Group VIII, claims 43-44, drawn to a method of preparing a conjugate of lectin (non-endogenous to humans) and a peptide/protein (substantially free of Clostridial neurotoxin enzyme activity) comprising expressing in a host cell a nucleic acid sequence capable of encoding said conjugate, classified in class 424, subclass 1.69+.

Group IX, claims 45-46, drawn to a lectin AND a peptide or protein (AS OPPOSED TO A CONJUGATE of the two compounds), classified in class 530, subclass 300+.

Group X, claim 47, drawn to a method of treating a disease or condition comprising administering a lectin AND a peptide or protein (AS OPPOSED TO A CONJUGATE of the two compounds), classified in class 514, subclass 2.

Applicants elected with traverse to prosecute the invention of Group III, represented by claims 39-42, drawn to a method of treating a disease or condition comprising administering an effective amount of a lectin and the specific conjugate comprising *Erythrina cristagalli* lectin.

A first action on the merits was mailed on June 21, 2004 in which Examiner rejected claims 39-42 under 35 U.S.C. 112, 2nd paragraph as unclear how an *Erythrina cristagalli* lectin conjugate can both inhibit and stimulate C-fiber activity, in order to treat a disease or condition resulting from an inhibition or stimulation of C-fiber neuron activity, asking the applicant to point out where in the specification support may be found for both types of modulation by an *Erythrina cristagalli* lectin conjugate, or amend the claims to more distinctly claim the invention. Additionally, the Examiner suggested that Applicant amend the claims to distinctly claim only the elected invention.

Claims 39-41 were rejected under 112 second paragraph. Claims 39-42 were also rejected in the same Office action under 35 U.S.C. 112, 1st paragraph as not enabled and not described.

Applicants filed the instant petition on August 17, 2004.

On September 21, 2004 applicants responded to the first action on the merits by canceling claims 30-47 and adding new claims 48-61 drawn to a method of inhibiting C-fiber neuron activity, comprising administering to a patient a first lectin in amount effective to inhibit C-fiber neuron activity, wherein the first lectin is selected from the group consisting of a lectin that binds to a galactosyl residue and a lectin that binds to a glucosyl residue.

DISCUSSION

The petition under 37 C.F.R. 1.144 and 1.181, was filed on 17 August 2004, to withdraw the lack of unity requirement. Specifically applicants petition the lack of unity requirement on the basis that:

A) Federal Regulations and PCT Administrative Instructions Demonstrate that Lack of unity is Improper,

B) Examination of all of the Claims is not burdensome,

C) Federal Courts regard lack of unity of a single claim as improper, and

D) additional comments responsive to the examiner's supplemental lack of unity requirement.

In the analysis of the fact pattern of the prosecution of the instant application, it is noted that applicants have cancelled claims 30-47 which the lack of unity requirement in question was based upon and applicants have substituted those claims with claims 48-61 drawn to a method of inhibiting C-fiber neuron activity, comprising administering to a patient a first lectin in amount effective to inhibit C-fiber neuron activity, wherein the first lectin is selected from the group consisting of a lectin that binds to a galactosyl residue and a lectin that binds to a glucosyl residue. It is noted that all of the newly submitted claims 48-62 would fall within the previously elected group III, however applicants' arguments which are drawn to the propriety of the lack of unity requirement are addressed.

Applicants petition the lack of unity requirement as stated above as it applies to the previous claims 30-47 on the basis that Federal Regulations and PCT Administrative Instructions Demonstrate that Lack of unity is improper on the basis that the instant application has entered the national stage from an international stage application after compliance with 35 U.S.C. 371 and that all of the claims possess unity of invention because they contain the same special technical feature. Applicants submit that the special technical feature of the claims should be construed as medicinal lectins and that this feature is present in independent claims 30 and 45.

Applicants' argument is acknowledged, however, found not persuasive on the basis that the shared special technical feature of each of the groups is not a "medicinal lectin", but rather a lectin, as this is the only technical feature shared between each of the previously identified ten groups. As stated by the examiner, the inventions listed as Groups I through X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I through X share a technical relationship which corresponds to a lectin. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. As previously stated, Mathiowitz (US 6,235,313 B1) teach the use of a lectin from *Erythrina cristagali* in a composition with a peptide for treatment of inflammation. Thus, the shared technical feature of the groups is not a "special technical feature", as it makes no contribution as a whole over the prior art and unity of invention between the groups cannot be based upon known features.

Applicants further petition on the basis that Federal Regulations and PCT Administrative Instructions Demonstrate that Examination of all of the Claims is not burdensome, because the application was considered to have unity of invention during the international phase. This argument is not found persuasive on the basis that decisions regarding unity of invention during the international phase are not binding to the application during the national phase and unity is reconsidered anew at each stage of the prosecution. As stated above, the different groups indicated by the examiner lack unity of invention because they do not share a "special technical feature" as discussed above.

Applicants' argument on the basis that Federal Courts regard lack of unity within a single claim as improper, based on *In re Weber*, 198 U.S.P.Q. 332 (CCPA 1978) and *In re Hass*, 198 U.S.P.Q. 334 (CCPA 1978) is acknowledged, however, not found persuasive on the basis that the applications referred to in these cases which were not filed under 35 USC 371, are not directed to lack of unity practice. Moreover, the determination of unity of invention does not depend upon the inventions being in the same or separate claims. See 37 CFR 1.475(e) below.

> (e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Finally, applicants argue that the examiner has misconstrued the special technical feature and used US 6,235,313, to defeat "lectin". Applicants submit that such action is misplaced as the '313 patent does not describe the use of any lectin as a medicament. This argument is not found persuasive on the basis that the shared technical feature

between all of the groups is not a "medicinal lectin" but rather a "lectin". Moreover, because Mathiowitz (US 6,235,313 B1, see column 10, lines 60-67, claim 2 and Abstract) teach the use of a lectin from *Erythrina cristagali* in a composition with a peptide for treatment of inflammation, a medicinal use, this technical feature is not a special technical feature.

As stated above, applicants have cancelled claims 30-47 which the lack of unity requirement in question was based upon and replaced those claims with claims 48-62 drawn to a method of inhibiting C-fiber neuron activity, comprising administering to a patient a first lectin in an amount effective to inhibit C-fiber neuron activity, wherein the first lectin is selected from the group consisting of a lectin that binds to a galactosyl residue and a lectin that binds to a glucosyl residue. It is noted that all of the newly submitted claims 48-61 would fall within the previously elected Group III and have all been examined.

DECISION

Because the technical feature that links the original inventions is not a contribution over the prior art in view of Mathiowitz, the petition under 37 C.F.R. 1.144 and 1.181, filed on 17 August 2004, to withdraw the lack of unity requirement as to claims 30-47 is **DENIED**.

The application will be forwarded to the examiner for consideration of the amendment filed 21 September 2004.

Because there is no fee for this petition, the petition fee paid of $130.00 will be credited to applicants' Deposit Account No. 19-0036, as directed.

Any request for consideration of this petition decision must be filed within two (2) months of the mailing date of this 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.

Bruce Kisluik
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

FOLEY & LARDNER LLP
SUITE 500
3000 K STREET, N.W., SUITE 500
WASHINGTON, DC 20007-5109

COPY MAILED

APR 0 2 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Bruno Berge :
Application No. 09/937,508 :
Filed: May 22, 2002 :
Attorney Docket No. BERGE-2

This is a decision on the petition, filed April 1, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 6, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Irvin Dingle at (703) 306-5684.

The file will be forwarded to Technology Center AU 2873 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Date : April 2, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of Application No. 09/937,508

Applicant(s) : Bruno Berge
Application No. : 09/937,508
Filed : May 22, 2002

The above-identified application has been assigned Patent No. 6,724,540 and an issue date of April 20, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of : April 20, 2004.

"All reference to Patent No. 6,724,540 to Bruno Berge of France for DROP CENTERING DEVICE appearing in the Official Gazette of April 20, 2004 should be deleted since no patent was granted."

Irvin Dingle
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

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

COPY MAILED

JUL 3 0 2008

OFFICE OF PETITIONS

In re Application of :
Bruno BERGE :
Application No. 09/937,508 : DECISION ON PETITION
Filed: May 22, 2002 : TO WITHDRAW
Attorney Docket No. BERGE-2 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 27, 2008.

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 Rouget F. Henschel on behalf of all attorneys associated with Customer Number 22428.

All attorneys associated with Customer Number 22428 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: BRUNO BERGE
155, ROUTE DU CATEAU
38140 REAUMONT
FRANCE

cc : MR. JONATHAN P. OSHA
OSHA & LIANG LLP
ONE HOUSTON CENTER,
SUITE 2800,
1221 MCKINNEY STREET
HOUSTON, TX 77010

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OSHA LIANG L.L.P.
TWO HOUSTON CENTER
909 FANNIN, SUITE 3500
HOUSTON TX 77010

MAILED

SEP 10 2009

OFFICE OF PETITIONS

In re Patent No. 7,443,596 :
Issued: October 28, 2008 :
Application No. 09/937,508 : ON PETITION
Filed: May 22, 2002 :
Attorney Docket No. 17187/007001 :

This is a decision on the petition under 37 CFR 1.182, filed July 30, 2009, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

The Publishing Division is directed to issue a duplicate Letters Patent.

Any questions concerning this matter may be directed to Joan Olszewski at 571-272-7751. Any questions concerning issuance of the duplicate Letters Patent should be directed to Niomi Farmer at (703) 308-9250, ext. 129.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, P/ODM, South Tower 8C23 (FAX 571-270-9753)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA GA 30309

COPY MAILED

NOV 17 2005

OFFICE OF PETITIONS

In re Application of :
Michael S.G. Bell et al. :
Application No. 09/937,542 : ON PETITION
Filed: September 26, 2001 :
Attorney Docket No. 40198/181160(CAN100) :

This is a decision on the petition filed February 21, 2005, under 37 CFR 1.181, to withdraw the holding of abandonment for the above-identified application.

The petition to withdraw the holding of abandonment is **GRANTED**.

The application was held abandoned on September 25, 2003 for failure to file a timely response to the non-Final Office Action mailed June 24, 2003, 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 January 24, 2005.

Petitioner asserts that a proper response, was filed via facsimile transmission on September 10, 2003. In support, petitioner submits a copy of the reply said to have been filed, but not acknowledged, with the U.S. Patent and Trademark Office, which also includes a certificate of facsimile transmission pursuant to 37 CFR 1.8.

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 3731 for appropriate action on the amendment filed September 10, 2003, a copy of which was submitted upon petition.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JOHN S. PRATT, ESQ.
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA GA 30309

COPY MAILED

JUL 0 1 2008

OFFICE OF PETITIONS

In re Application of	:	
Michael S.G. Bell et al	:	
Application No. 09/937,542	:	DECISION GRANTING PETITION
Filed: September 26, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 40198/324831 (CAN100)	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 11, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE/Notice of Appeal/previously filed amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Final Rejection mailed March 20, 2007, 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 3734 to consider the above.

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

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

MAILED

JUN 07 2010

OFFICE OF PETITIONS

In re Application of :
Michael Bell et al. :
Application No. 09/937,542 :
Filed: September 26, 2001 :
Atty. Docket No. 40198/324831(CAN100) :

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is in response to the "Communication Regarding Patent Term Adjustment (PTA) Indicated in the Notice of Allowance" filed January 19, 2010. Applicants request the initial determination of patent term adjustment be corrected from zero (0) days to one thousand six hundred ninety-one (1,691) days.

The application for patent term adjustment is **dismissed**.

On October 19, 2009, the Office mailed a "Determination of Patent Term Extension under 35 U.S.C. 154(b) (application filed after June 7, 1995 but prior to May 29, 2000)" indicating the patent term extension to date is 0 days.

Applicants contend the Notice of Allowance should have indicated the patent term adjustment is 1,691 days.

Applicants' arguments for patent term adjustment are based on an assumption the provisions of the Patent Term Guarantee Act of 1999, Pub. L. No. 106-113, § 4402, 113 Stat. 1501A-557 (codified at 35 U.S.C. § 154(b)) apply to the instant case. However, the provisions of the act do not apply to international applications filed before May 29, 2000. Even if the application fulfills the requirements of 35 U.S.C. § 371 on or after May 29, 2000, the provisions of the act are inapplicable if the international filing date is before May 29, 2000. *See* Comment 6 to Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term (Final Rule), 65 *Fed. Reg.* 56366 (September 18, 2000).

The international filing date for this application is April 7, 2000, which is before May 29, 2000. Therefore, the provisions of the Patent Term Guarantee Act of 1999 are inapplicable.

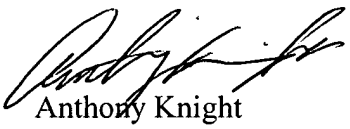
Although the provisions of the Patent Term Guarantee Act of 1999 do not apply in this case, the provisions of former 35 U.S.C. § 1.154(b) and 37 C.F.R. § 1.701 are applicable because the

international filing date for the application is on or after June 8, 1995, and before May 29, 2000. Under the former statute and regulation, the term of a patent can be extended by up to a maximum of five years as a result of delays in the issuance of the patent due to interferences, secrecy orders, and/or successful appeals to the Board of Patent Appeals and Interferences or federal courts. The record fails to indicate any time was consumed by a secrecy order, interference, or successful appeal in this case. Therefore, the Office has no authority to grant an extension of the patent term.

Receipt of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fees are required.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6698161
Issue Date: March 2,2004
Application No. 09937557
Filed: September 25,2001
Attorney Docket No. BUG 2 0146

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 19,2008 ,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 November 19,2008 . 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.

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)
6,698,161	2004-03-02	09/937,557	2001-09-25	03367/0210911-US0

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
◉	3 ½ year	(1551)
○	7 ½ year	(1552)
○	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Jay P. Lessler/	Date (YYYY-MM-DD)	2008-11-19
Name	Jay P. Lessler	Registration Number	41151

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

BRIAN W. HAMEDER
LADAS & PARRY, LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

COPY MAILED
AUG 2 9 2006
OFFICE OF PETITIONS

In re Patent No. 7,013,548 :
Issue Date: March 21, 2006 :
Application No. 09/937,591 : NOTICE
Filed: September 27, 2001 :
Patentee(s): Bard Lotveit :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed by facsimile transmission on July 21, 2006. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

26 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Morris Liss
Connolly Bove Lodge & Hutz LLP
P.O. Box 19088
Washington, DC 20036-3425

In re Application of YOSHIOKA et al	:	
U.S. Application No.: 09/937,628	:	
Int. Application No.: PCT/JP00/00426	:	DECISION
Int. Filing Date: 27 January 2000	:	
Attorney Docket No.: 21900/0039	:	
For: EMERGENCY COMMUNICATION SYSTEM	:	

This is in response to applicant's "Petition" filed 09 May 2002.

BACKGROUND

On 27 January 2000, applicant filed international application PCT/JP00/00426. A copy of the international application was communicated to the USPTO from the International Bureau on 02 August 2001. The twenty-month period for paying the basic national fee in the United States expired at midnight on 27 September 2001.

On 27 September 2001, applicant 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 26 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 20 November 2001, applicant filed an executed declaration.

On 20 March 2002, this Office mailed a communication which identified a discrepancy between the Transmittal Letter and the declaration.

On 09 May 2002, applicant filed the present petition. The $130.00 petition fee will be charged to Deposit Account No. 22-0185 per applicant's authorization.

DISCUSSION

The declaration filed 20 November 2001 identifies international application PCT/JP00/00427 as the specification to which it is directed, while the Transmittal Letter identifies international application PCT/JP00/00426.

The petition states that the declaration for the present application was erroneously included with papers submitted for U.S. Application Number 09/937,621 on 20 November 2001. A review of both the present application file and the 09/937,621 application file reveals that the proper declaration for the present application is contained in the 09/937,621 application file. Applicant's explanation for the error is accepted. The declaration has been placed in the proper application file.

CONCLUSION

For the reasons above, the petition is GRANTED.

The application has an International Filing Date of 27 January 2000 and a date under 35 U.S.C. 371 of 20 November 2001.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 9

William H Drummond
Drummond & Duckworth
5000 BIRCH STREET
SUITE 440, EAST TOWER
Newport Beach, CA 92660

COPY MAILED

APR 3 0 2004

OFFICE OF PETITIONS

In re Application of :
Douglas D. Burkett :
Application No. 09/937,632 : ON PETITION
Filed: January 22, 2002 :
Attorney Docket No. 344-P-26-USA :

This is a decision on the petition, filed April 14, 2004, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

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. Petitioner may request a refund of the $475 extension fee in writing. A copy of this decision should accompany petitioner's request.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9220. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center AU 1626 for consideration of the amendment filed April 14, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

BASF CORPORATION
ANNE GERRY SABOURIN
26701 TELEGRAPH ROAD
SOUTHFIELD, MI 48034-2442

COPY MAILED
AUG 0 9 2005
OFFICE OF PETITIONS

In re Application of	:	
Lettmann et al.	:	DECISION ON APPLICATION
Application No. 09/937,650	:	FOR
Filed: November 8, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. IN-5523	:	

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. §1.705" filed January 14, 2005. In effect, applicants request that the determination of patent term extension of zero (0) days in this application be corrected to a determination of patent term adjustment of three hundred ninety-eight (398) days.

The petition is **DISMISSED**.

On November 18, 2004, the Office mailed the Determination of Patent Term Extension under 35 U.S.C. 154(b)(application filed after June 7, 1995 but prior to May 29, 2000) in the above-identified application. The Notice stated that the patent term extension to date is 0 days. Petitioner asserts entitlement to a period of adjustment of three hundred ninety-eight (398) days for examination delay.

The Patent Term Guarantee Act of 1999 amended 35 U.S.C. § 154 to include § 154(b), which provides for adjustment of patent term due to examination delay. The provisions of § 154(b) related to adjustment of patent term due to administrative delays apply only to original applications, other than designs, filed on or after May 29, 2000. The provisions do not apply to

international application filed before May 29, 2000 by virtue of the requirements of 35 U.S.C. 371 having been met on or after May 29, 2000. The date on which an international application fulfills the requirements of 35 U.S.C. 371 is not the filing date, or even relevant to the filing date, of the international application. Section 4405 of the American Inventors Protection Act of 1999 provides that the amendments relating to patent term adjustment shall apply to any application filed on or after May 29, 2000, but does not provide that its patent term adjustment provisions apply to international applications filed before May 29, 2000, that complied with the requirements of 35 U.S.C. 371 on or after May 29, 2000. See Comment 6 to Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

Since the international filing date of this application, March 27, 2000, is before May 29, 2000, this application is not eligible for patent term adjustment due to examination delay.

Since the above-identified application did not have a successful appeal, interference or secrecy order delay, this application is not eligible for the extension or adjustment under 35 U.S.C. 154. The Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Publishing Division for processing into a patent.

Telephone inquiries on this decision should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272 - 3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

29 JUN 2004

#15

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Phillip S. Johnson
JOHNSON & JOHNSON
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

In re Application of :
KUTCHAN, Toni M. *et al* :
U.S. Application No.: 09/937,665 :
PCT No.: PCT/AU00/00249 :
Int. Filing Date: 24 March 2000 :
Priority Date: 26 March 1999 :
Attorney Docket No.: J&J-1825 :
For: CODEINONE REDUCTASE FROM ALKALOID POPPY :

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with a "Response to Notification of Defective Response" on 20 January 2004 is hereby **GRANTED** as follows:

In their response, applicants filed a computer readable version of the sequence listing that has been processed as good technically and entered into the database by the Scientific and Technical Information Center (STIC). The appropriate petition fee of $1,330.00 has been paid. Applicants state that "[t]he 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" 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.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 24 March 2000, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 20 February 2002.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

NOTICE RE: CERTIFICATES OF CORRECTION

DATE : 08/20/05 Paper No.: _____

TO : Supervisor, Art Unit 1624

SUBJECT : Certificate of Correction Request in Patent No.: 6,818,657 B1

A response to the following question is requested with respect to the accompanying request for a certific 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 th scope or meaning of the claims be changed.

Newsome, L.

PLEASE COMPLETE THIS FORM AND
RETURN WITH FILE, WITHIN 7 DAYS,
TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922
PALM LOCATION 7580 - TEL. N0. 305-8309

THANK YOU FOR YOUR ASSISTANCE!

Note your decision, regarding the changes requested in the Request for Certificate of Correction, l placing a check mark (+) in the box that reflects your decision, which corresponds to the question checke above.

☒ **YES** ☐ **NO** ☐ **Comments below**

☐ **Comments:** _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Supervisor **Art Unit** 1624

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/19/07

Paper No.: _____

TO SPE OF : ART UNIT 2816

SUBJECT : Request for Certificate of Correction on Patent No.: 6867645

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:

OK to enter

OK

SPE

2816

Art Unit

OK TO ENTER: /QT/ (03/10/2008)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Zahid ANSARI et al.	Confirmation No.: 3828
Application No.: 09/937,680	Patent No.: 6,867,645 B1
Filing Date: November 29, 2001	Patent Date: March 15, 2005
For: METHOD AND APPARATUS FOR PROVIDING PULSE WIDTH MODULATION	Attorney Docket No.: 81400-4000

REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.323

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees hereby respectfully request the issuance of a Certificate of Correction in connection with the above-identified patent. The corrections are listed on the attached Form PTO-1050. The corrections requested are as follows:

Drawings:

On the title page and in FIG. 1, in the power supply 102, delete the upper "–" sign and insert -- + --.

On the title page and in FIG. 3, in the power supply 102, delete the upper "–" sign and insert -- + --; and to the left of the "LOAD" box, delete the "–" sign and insert -- + --.

FIG. 9, at the "Vdc" location, delete the upper "–" sign and insert -- + --.

Column 3:

Line 8, after "apparatuses for practicing the invention are" delete "ill ated." and insert -- illustrated. --

Line 61, after "The inverter circuit is preferably an" delete "II-bridge" and insert -- H-bridge --.

12 NOV 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#4

Daniel A. Monaco
Drinker, Biddle & Reath, LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996

In re Application of
O'HARTE, et al.
Application No.: 09/937,687
PCT No.: PCT/GB00/01089
Int. Filing Date: 29 March 2000
Priority Date: 29 March 1999
Attorney Docket No.: 8830-8
For: PEPTIDE

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's petition filed in the United States Patent and Trademark Office (USPTO) on 09 May 2002.

BACKGROUND

On 29 March 2000, applicant filed international application PCT/GB00/01089, which claimed priority of an earlier application filed 29 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 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 29 September 2001.

On 28 September 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); a copy of the International Search Report; a First Preliminary Amendment and an unexecuted combined declaration and power of attorney.

On 13 November 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) informing applicant of the need to provide a signed 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 as well as a sequence listing for the present application.. In addition, applicant was advised of the need to provide payment of the $65.00 surcharge for providing an oath or declaration later than thirty months from the priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and

payment of fees.

On 09 May 2002, in response to information provided by the PCT Help Desk, applicant filed the present petition accompanied by an executed combined declaration and power of attorney, a sequence listing disk, a copy of a transmittal letter dated 08 January 2002 and a return postcard receipt with a 08 January 2002 USPTO date stamp which lists the attorney docket number, title and applicant and identifies the items to be filed as including "Response to Notification of Missing Requirements; Declaration and Power of Attorney; Sequence Listing Disk With Amendment and Statement (37 CFR 1.821 (f)(g)) and Check No. 51161 ($65.00)."

DISCUSSION

A review of the application file reveals that the NOTIFICATION OF MISSING REQUIREMENTS was mailed by the USPTO on 13 November 2001, addressed to the mailing address provided in the international application (no new correspondence address was provided in the transmittal letter for entry into the national stage in the United States submitted 28 September 2001). It is noted that the transmittal letter purportedly filed 08 January 2002 identified the application as "09/937,786." A search of that file did not reveal the filed papers therein. However, the evidence filed with the petition, namely the date stamped postcard receipt and information contained therein is convincing that a response including a combined declaration and power of attorney was filed on 08 January 2002. Thus, it is appropriate to withdraw the holding of abandonment.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED.**

The application has an international filing date of **29 March 2000** under 35 U.S.C. 363 and a date of **08 January 2002** under 35 U.S.C. 371(c).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a filing receipt and a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) which identifies a date of **08 January 2002** under 35 U.S.C. 371(c).

Leonard E. Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

03 MAR 2005

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

John J. Gresens
MERCAHNT & GOULD
P.O. Box 2903
Minneapolis, MN 55402-0903

In re Application of	:	DECISION ON
ZIGMANS et al	:	
Application No.: 09/937,691	:	
PCT No.: PCT/NL00/00198	:	
Int. Filing Date: 24 March 2000	:	
Priority Date: 31 March 1999	:	PETITION UNDER
Attorney's Docket No.: 9424.162USWO	:	
For: DEVICE FOR TREATING A SURFACE,	:	
IN PARTICULAR A LEATHER SURFACE,	:	
SUCH AS THAT OF LEATHER SHOES	:	37 CFR 1.181

This is in response to applicants' "PETITION TO WITHDRAW OF ABANDONMENT BASED ON US PATENT OFFICE ERROR" filed 03 November 2004, which is being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 28 September 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), and a copy of the international application. Applicants, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because no executed Declaration or Oath was provided with the transmittal letter at such time.

On 29 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)" (Form PCT/DO/EO/905) which informed applicants, inter alia, that an "Oath or declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date indicating that the current oath or declaration ... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68" must be submitted within two (2) months from the date of this Notice or 32 months from the priority date of the application. Failure to properly will result in abandoned.

On 15 October 2004, the DO/EO/US mailed a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909), which indicated that applicants have failed to respond to the notification of MISSING REQUIREMENTS, mailed 10/29/2001 since no reply was received.

In response to the "NOTIFICATION OF ABANDONMENT" mailed on 15 October 2004, applicants have submitted the instant petition requesting withdrawal of the Notice of Abandonment. In support of the petition, applicants have provided a copy of the items submitted on 07 February 2002, which includes, inter alia, checks and the "Express Mail" receipt providing proof of mailing on 2/27/2002.

DISCUSSION

The record shows that the checks of $130.00 and $920.00 submitted by applicants were processed on 02/07/02. However, the processing of the checks does not by itself establish that the Declaration was filed timely. For example, the correspondence could have included only the checks and not the Declaration. Nevertheless, in the instant situation, the money was applied to national stage application number 09/937,691. The copy of the checks accompanying the petition does not appear to contain any indication regarding the application number or other means to associate them to the application. Because the USPTO had no way to associate the application number with these check, another document or documents identifying the application number must have been filed with the checks. Applicants have provided, inter alia, a copy of the transmittal sheet, the express mail receipt, copy of the checks, and a copy of the signed Declaration, which were purportedly filed by "Express Mail." Another document must have been received by the Office for the Office to apply the money to the appropriate national stage application 09/937,761. Since Office cannot locate any of the documents purportedly filed by applicants, convincing evidence has been provided that the Office received and misplaced the documents purportedly mailed on 07 February 2002.

The transmittal letter, and Declaration accompanying the petition will be accorded a receipt date of 07 February 2002. The mailroom date for the checks in the RAM database is 07 February 2002. Also, applicants have provided a copy of the Express Mail label "EV036306044US" showing a USPS stamped date of 07 February 2002.

Applicants' evidence is accepted as *prima facie* that a Declaration was timely deposited with the U.S. Patent and Trademark Office on 07 February 2002. Accordingly, the date of receipt for the Declaration is 12 November 2003.

Consequently, the instant application has been improperly abandoned.

CONCLUSION

For the reasons above, the petition under 37 C.F.R. §1.181 is **GRANTED**.

Applicants' request to withdraw the "NOTIFICATION OF ABANDONMENT" is **GRANTED**. The NOTIFICATION OF ABANDONMENT, mailed 15 October 2004 has been **VACATED**.

However, for the reason below, the application may not enter into national stage processing at this time. The declaration filed on 07 February 2002 is defective since it does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3) must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of two sets of declarations, which one set is complete and the other is incomplete since each set must be complete by having the correct number of pages and listing all the inventors. One set is complete because it comprises of the six (6) pages of the declaration and list all the inventors. The second set is incomplete because it only contains a list of three of the four inventors and does not have the other pages of the Declaration to make it whole. Therefore the composite Declaration is defective.

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
Tel: (571) 272-3276
Fax: (571) 273-0459

Boris Milef
PCT Legal Examiner
PCT Legal Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Jan. 10, 2004

TO SPE OF : ART UNIT 1641

SUBJECT : Request for Certificate of Correction on Patent No.: 6,790,625

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 see the claims dependency (clm. 14 & 15)!

Thank You For Your Assistance

_____
Certificates of Correction Branch

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved**	All changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments:

BAO-THUY L. NGUYEN
PRIMARY EXAMINER 8/30/05

_____ 1641
SPE Art Unit

02 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Nickolas E. Westman
Westman, Champlin & Kelly, P.A.
Suite 1600 – International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319

In re Application of	
Zheludev et al.	
Application No.: 09/937,736	DECISION ON
PCT No.: PCT/GB00/01199	
Int. Filing Date: 29 March 2000	PETITION
Priority Date: 29 March 1999	
Attorney's Docket No.: H48.12-0001	UNDER 37 CFR 1.47(b)
For: TRANSMITTING AND RECEIVING APPARATUS	

This is a decision in response to the "Petition To Make Application For Patent On Behalf Of And As Agent For Joint Inventors Who Refuse To Sign (37 CFR 1.47(b))" filed on 06 May 2002 to accept the application without the signature of inventors Nikolay Zheludev and Boris Kokorin.

BACKGROUND

On 29 March 2000, applicant filed international application PCT/GB00/01199 that claimed priority of an earlier British application filed 29 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 27 October 2000 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 29 September 2001.

On 28 September 2001, applicant filed a letter for entry into the national stage in the United States which was accompanied by a copy of the International Application, a preliminary amendment, drawing sheets, an abstract, a copy of the International Search

Report and the basic national fee of $430 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/937,736.

On 06 November 2001, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee. The notification set a two-month time period in which to respond.

On 06 May 2002, applicant filed a "Petition Under 37 CFR 1.47(b) to Accept Application Without Inventor's Signature."

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 06 May 2002, applicants filed the following papers:

1) a Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) including a Petition under 37 CFR 1.47(a);

2) the required petition fee;

3) the $65 surcharge for providing the oath/declaration after 30 months from the earliest priority date;

4) a declaration executed by Richard Wardle (Director of Hex Technology Holdings Limited) on behalf of Nikolay Zheludev and Boris Kokorin; and,

5) various documents intended to show that inventors Nikolay Zheludev and Boris Kokorin have refused to sign the application papers and to establish the proprietary interest of Hex Technology Holdings Limited .

DISCUSSION

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 1.37(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), (4), (5) and (6).

With respect to item (1), applicant has provided the $130 petition fee. With respect to item (3), applicant has provided a statement of the last known address of both Nikolay Zheludev and Boris Kokorin. With respect to item (4), applicant has provided a declaration executed by Richard Wardle (Director of Hex Technology Holdings Limited) on behalf of Nikolay Zheludev and Boris Kokorin. With respect to item (5), applicant has provided a copy of assignment documents from both Nikolay Zheludev and Boris Kokorin for the earlier British application which is identical to the current application. With respect to item (6), Mr. Wardle has provided the required statement.

MPEP §409.03(b) states, in part:

> "Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The 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. Such a petition will be dismissed as inappropriate.
>
> The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions."

With respect to item (2) above, there is no indication in Mr. Wardle's statement that a delivery of the application papers was ever attempted to either Nikolay Zheludev and Boris Kokorin. Although, Mr. Wardle states that he forwarded a copy of the Declaration and Power of Attorney to Mr. Kokorin's attorney, he does not mention the application papers. Further, Mr. Wardle admits that he did not even attempt to deliver the Declaration and Power of Attorney to Mr. Zhedudev since he stated that he would not sign. Further, other than Mr. Wardle's conversation with Mr. Kokorin's attorney, there is absolutely no indication that any attempt has been made to locate Mr. Kokorin in South Africa. Mr. Wardle's statement that "The lawyer confirmed, on 30th April 2002, that this had been forwarded to Mr. Kokorin but that he had not by then signed and that I should not expect him to do so" is a statement based on heresay which is unacceptable.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED**.

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. Extensions of time may be obtained under 37 CFR 1.136(a).

Should status under 37 CFR 1.47(b) not be successfully completed, the international application will be viewed as becoming abandoned with respect to the United State at midnight at the expiration of the time period set in this decision or as extended by any extension see timely paid 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 this letter marked to the attention of the PCT Legal Office.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Richard Cole
PCT Legal Examiner
PCT Legal Office

DSB/RC:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

10 NOV 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

Nickolas E. Westman
Westman, Champlin & Kelly, P.A.
Suite 1600 – International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319

In re Application of	:
Zheludev et al.	:
Application No.: 09/937,736	: DECISION ON
PCT No.: PCT/GB00/01199	:
Int. Filing Date: 29 March 2000	: RENEWED PETITION
Priority Date: 29 March 1999	:
Attorney's Docket No.: H48.12-0001	: UNDER 37 CFR 1.47(a)
For: TRANSMITTING AND RECEIVING APPARATUS	:

This is a decision in response to the "RENEWED PETITION UNDER 37 CFR § 1.47" filed on 30 May 2003 to accept the application without the signature of inventor Boris Kokorin.

BACKGROUND

On 29 March 2000, applicant filed international application PCT/GB00/01199 that claimed priority of an earlier British application filed 29 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 27 October 2000 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 29 September 2001.

On 28 September 2001, applicant filed a letter for entry into the national stage in the United States which was accompanied by a copy of the International Application, a preliminary amendment, drawing sheets, an abstract, a copy of the International Search Report and the basic national fee of $430 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/937,736.

On 06 November 2001, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee. The notification set a two-month time period in which to respond.

On 06 May 2002, applicant filed a "Petition Under 37 CFR 1.47(b) to Accept Application Without Inventor's Signature" requesting that the application be accepted without the signatures of inventors Nikolay Zheludev and Boris Kokorin.

On 02 December 2002, the USPTO mailed a decision indicating that Mr. Wardle's statement was unacceptable insofar as it was not based on first hand knowledge of the facts.

On 30 May 2003, applicant filed the current petition including a declaration signed by Nikolay Zheludev, and a declaration by Mr. Michael Kerns.

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 inventor refuses to execute the application 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(b) applicant on behalf of and as agent for the non-signing inventor. Applicant has satisfied items (1), (3) and (4).

With respect to item (1), applicant has provided the $130 petition fee. With respect to item (3), applicant has provided a statement of the last known address of Boris Kokorin. With respect to item (4), applicant has provided a declaration executed by Richard Wardle (Director of Hex Technology Holdings Limited) on behalf of Boris Kokorin.

With respect to item (2) above, Mr. Kerns states that he hand carried a copy of the entire application papers to inventor Boris Kokorin and that inventor Kokorin refused to execute the declaration.

CONCLUSION

The 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 non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

The application will be given an international filing date of 29 March 2000 under 35 U.S.C. 363, and a date of 30 May 2003 under 35 U.S.C. 371.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

DSB/BM:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

10 NOV 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

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. Boris Kokorin) 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/GB00/01199 and was filed on 29 March 2000 in the names of Nikolay Zheludev and Boris Kokorin for the invention entitled TRANSMITTING AND RECEIVING APPARATUS. The national stage application number is 09/937,736 and has a 35 U.S.C. 371 date of 30 May 2003.

10 NOV 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

Boris I. Kokorin
Old Arabat,
33 Sivtev Vrajek Pereuioko
Apartment10, 4th Floor, Moscow
Russia

In re Application of: Zheludev et al.
Application No.: 09/937,736
PCT No.: PCT/GB00/01199
Int. Filing Date: 29 March 2000
Priority Date: 29 March 1999
Attorney's Docket No.: H48.12-0001
For: TRANSMITTING AND RECEIVING APPARATUS

Dear Mr. Kokorin:

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.

Debra S. Brittingham
PCT Legal Examiner
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

Counsel of Record: Nickolas E. Westman
Westman, Champlin & Kelly, P.A.
Suite 1600 – International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319

17 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Edward D. Grieff
Hale and Dorr, LLP
1455 Pennsylvania Avenue, N.W.
Suite 1000
Washington, D.C. 20004-1008

In re Application of	:	
CUTLER et al.	:	
Application No.: 09/937,762	:	DECISION ON PETITION
PCT No.: PCT/GB00/01062	:	UNDER 37 CFR 1.182
Int. Filing Date: 21 March 2000	:	
Priority Date: 01 April 1999	:	
Attorney Docket No.: 109846.998	:	
For: AGROCHEMICAL COMPOSITION		

This decision is in response to applicants' "Petition under 37 CFR 1.182 in Response to Notice of Defective Response" filed 10 May 2002. The petition was accompanied by a declaration signed by Julia Lynne Ramsey using both her former name and present name. The petition fee of **$130** has been charged to counsel's Deposit Account No. 08-0219.

BACKGROUND

On 01 October 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 and a copy of the international application.

On 08 November 2001, the United States/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indication an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be furnished.

On 29 January 2002, applicants submitted an executed declaration and the surcharge under 37 CFR 1.492(e). In a communication dated 27 March 2002, the PCT Legal Office indicated that the declaration filed 29 January 2002 was not in compliance with 37 CFR 1.497.

On 10 May 2002, applicants filed the present petition accompanied by a declaration by Julia Lynne Ramsey stating that "on 22 July 2000, I changed my name from Julia Lynne Culter to Julia Lynne Ramsey."

DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order. As noted above, the $130 petition fee has been charged to counsel's Deposit Account No.08-0219, and thus item (1) has been satisfied.

The papers have been reviewed and the papers are accepted.

The declaration submitted on 29 January 2002 executed by Julia Lynne Ramsey; Antony George Seville; and Michael John Bean is accepted.

CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Julia Lynne Cutler to Julia Lynne Ramsey is **GRANTED**.

The application has an international filing date of 21 March 2000 under 35 U.S.C. 363 and a date of **29 January 2002** under 35 U.S.C. 371(c).

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Attorney-Advisor
PCT Legal Office
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

Paper No. 13

MORRIS LISS
CONNOLLY BOVE LODGE & HUTZ
P.O. BOX 19088
WASHINGTON, DC 20036-0088

COPY MAILED

DEC 23 2003

OFFICE OF PETITIONS

In re Application of
Buchanan, Nigel
Application No. 09/937,767
Filed: February 21, 2002
Attorney Docket No. 20234/0073

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 12, 2003, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed October 1, 2002. No extensions of time under the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, this application became abandoned on January 2, 2003. A Notice of Abandonment was mailed on October 31, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the authorization to charge the $930.00 extension of time fee submitted with the petition on November 12, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will not be charged 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 request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The file is now being forwarded to Technology Center 3700 for further examination on the merits.

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Morris Liss
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425

UNITED STATES 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 LISS
CONNOLLY BOVE LODGE & HUTZ
PO BOX 19088
WASHINGTON, DC 20036-0088

COPY MAILED

NOV 2 6 2004

OFFICE OF PETITIONS

In re Application of :
Nigel Buchanan :
Application No. 09/937,767 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 20234/0073 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 15, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)), runs from the date of this decision.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed April 30, 2004, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The reply submitted on August 26, 2004 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed November 4, 2004. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed. A one month extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on April 16, 2004.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Pursuant to petitioner's authorization, Deposit Account No. 22-0185 was charged a total of $855.00 -- $685.00 for the petition to revive an unintentionally abandoned application and $170.00 for the Notice of Appeal fee.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

This matter is being referred to Technology Center AU 3723.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: CONNOLLY BOVE LODGE & HUTZ
1990 M STREET, N.W., SUITE 800
WASHINGTON, DC 20036-3425

25 NOV 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Michael G. Gilman
Lowe Hauptman Gilman & Berner LLP
1700 Diagonal Road, Suite 310
Alexandria, VA 22314

In re Application of
BHATTACHARYYA, Debasis et al.
Application No.: 09/937,850
PCT No.: PCT/IN00/00013
Int. Filing Date: 16 February 2000
Priority Date: None
Attorney's Docket No.: 3095-004
For: A MULTI STAGE SELECTIVE CATALYTIC CRACKING PROCESS AND A SYSTEM FOR PRODUCING HIGH YIELDS OF MIDDLE DISTILLATE PRODUCTS FROM HEAVY HYDROCARBON FEEDSTACKS

DECISION

ON PETITION UNDER

37 CFR 1.181

This is a decision on applicant's "Response to Notice to File Missing Parts," filed with the Office on 30 July 2002. This has been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 16 February 2000, applicant filed international application PCT/IN00/00013. A copy of the international application was transmitted to USPTO by the International Bureau on 23 August 2001. The deadline for entry into the national stage in the United States was twenty months from the priority date, or 16 October 2001.

On 28 September 2001, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, the basic national fee.

On 31 January 2002, the Office mailed Notification of Missing Requirements (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) was required.

On 30 July 2002, applicant filed the instant petition and a response to the Notification of Missing Requirements.

DISCUSSION

Applicant asks that the Office waive the extension of time fee because the Notification of Missing Requirements was significantly delayed.

MPEP §710.06 sets forth the requirements for resetting a period for reply due to late receipt of an office action. A petition to reset the time period for reply must be (1) filed within two weeks of receipt of the office action, (2) demonstrate significant delay, (3) present evidence, (4) state when the communication was received and (5) be signed.

Items (2)-(5) have been met. More than half of the time period set for reply had elapsed. Applicant has provided a copy of the original communication with the law office's receipt stamp attached to it and states that the communication was received on that date. Finally, the petition is signed by a practitioner registered to practice before the Office.

Item (1) has not been satisfied. The petition was filed on 30 July 2002, though the Notification of Missing Requirements was received 20 March 2002.

The fee for a four month extension of time will be charged to deposit account no. 07-1337, as authorized by the petition.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The application has an international filing date of 12 November 1998 under 35 U.S.C. §363 and a date of 30 July 2002 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 in accordance with this decision.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

13 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Steven H. Noll
SCHIFF HARDIN & WAITE
Patent Department
6600 Sears Tower
Chicago, IL 60606

In re Application of
MIN, Mart *et al*
U.S. Application No.: 09/937,875
PCT No.: PCT/SE00/00572
Int. Filing Date: 23 March 2000
Priority Date: 31 March 1999
Attorney's Docket No.: P01,0337
For: A RATE ADAPTIVE PACEMAKER

DECISION UNDER 37 CFR 1.181

This decision is in response to the "Response to Notification of Missing Requirements" ("Pet") filed 30 January 2002 which has been treated as a petition under 37 CFR 1.181. No fee is required.

BACKGROUND

On 01 October 2001, applicants submitted 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*, the basic national fee and authorization to charge required fees to Deposit Account No. 50-1519.

On 07 November 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 declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 was required. A two-month time period for response was set.

On 30 January 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, an executed declaration.

DISCUSSION

In the instant petition, applicants claim that a signed declaration was submitted with the present application and that the Notification of Missing Requirements was sent in error.

The Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, long-established, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. Section 503 of the Manual of Patent Examining

BEST AVAILABLE COPY

Procedure (MPEP) lists procedures to ensure receipt of all papers filed in the USPTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants have not provided a copy of the date-stamped filing receipt for the documents submitted with the original application on 01 October 2001 claiming that "[d]ue to processing delays, the stamped return postcard for the application as originally filed has not been received by the undersigned counsel's law firm, as is the case for many applications filed within this time frame." Pet. at ¶ 2. Instead, applicants claim that "the application was accompanied by a cover sheet wherein the box for item 9 was checked, stating that an oath or Declaration was submitted therewith, and the Declaration which is in the file should be a telefaxed copy of the signed Declaration." Id. at ¶ 2.

A review of the above-captioned application reveals that the transmittal letter (Form PTO-1390) did indicate that a declaration was submitted. However, a further review of the subject application shows that the declaration purportedly filed on 01 October 2001 was not located in the file.

The Office file is the official record of what was mailed by "Express Mail" on 01 October 2001. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of overcoming the evidence in the record. The transmittal letter is not checked by anyone to ensure that the item is included in the documents filed. In this case, the transmittal letter is not dispositive, the content of the Office file is.

Since a postcard receipt was not submitted, applicants have not provided *prima facie* evidence that the declaration was included with the papers on 01 October 2001.

CONCLUSION

Applicants' petition under 37 CFR 1.181 is **DISMISSED**.

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. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

BEST AVAILABLE COPY

The executed declaration filed with the instant petition complies with 37 CFR 1.497(a) and (b). The surcharge fee of $130.00 has been charged to Deposit Account No. 50-1519 as authorized.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 23 March 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **30 January 2002**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

BEST AVAILABLE COPY

26 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Steven H. Noll
SCHIFF HARDIN & WAITE
Patent Department
6600 Sears Tower
Chicago, IL 60606

In re Application of	:	
MIN, Mart *et al*	:	
U.S. Application No.: 09/937,875	:	**DECISION**
PCT No.: PCT/SE00/00572	:	**UNDER**
Int. Filing Date: 23 March 2000	:	**37 CFR 1.181**
Priority Date: 31 March 1999	:	
Attorney's Docket No.: P01,0337	:	
For: A RATE ADAPTIVE PACEMAKER	:	

This decision is in response to applicants' "Request for Reconsideration of Decision Dated December 19, 2002" filed 21 January 2003.

BACKGROUND

On 13 December 2002, a decision dismissing applicants' petition under 37 CFR 1.181 was mailed because applicants did not provide a date-stamped postcard receipt for the declaration purportedly filed 01 October 2001.

On 21 January 2003, applicants submitted the instant renewed petition which included a copy of the date-stamped postcard receipt for the documents filed 01 October 2001.

DISCUSSION

MPEP 503 lists procedures for applicants to ensure receipt of any paper filed in the USPTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In the renewed petition, applicants have provided a copy of a postcard filing receipt. The receipt clearly identifies the application and all papers submitted. The filing receipt acknowledges that a "Declaration" was listed in the documents mailed 01 October 2001. The receipt has a date stamp of "533 Rec'd PCT/PTO 01 OCT 2001" across its face.

BEST AVAILABLE COPY

Accordingly, applicants have provided *prima facie* evidence that the declaration was received by the USPTO on 01 October 2001.

DECISION

For the reasons above, applicants' petition under 37 CFR 1.181 is **GRANTED**.

The decision dated 13 December 2002 stated that the instant application has a 35 U.S.C. 371 date of 30 January 2002. Since applicants have submitted a grantable petition under 37 CFR 1.181, this date has changed. The application has an international filing date of 23 March 2000 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **01 October 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

BEST AVAILABLE COPY

31 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Bradley B. Geist
Baker Botts
30 Rockefeller Plaza
New York ,NY 10112-4498

In re Application of PETER SOPP et al. Application No.: 09/937,913 PCT No.: PCT/DE00/00837 Int. Filing Date: 17 March 2000 Priority Date: 01 April 1999 Attorney's Docket No.: A34661-PCT-USA For: GUIDE SYSTEM FOR A ROLLING MILL, ESPECIALLY FOR A MILL TRAIN	DECISION ON PETITION UNDER 37 CFR 1.181

This is in response to applicant's "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action", treated as a petition under 37 CFR 1.181" filed in the United States Patent and Trademark Office (USPTO) on 20 December 2002 alleging that applicant did not receive the Notification of Missing Requirements mailed on 20 November 2001.

BACKGROUND

A review of the application file reveals that the NOTIFICATION OF MISSING REQUIREMENTS was mailed by the USPTO on 20 November 2001. The notification indicated that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and $130 surcharge for filing the oath or declaration after the thirty month period was required. Applicant was given two months to respond to the Notification or until 20 January 2002 with extensions of time (up to 5 months) available under 37 CFR 1.136(a). No response to the Notification of Missing Requirements was received, and thus, the application was held to be **ABANDONED** as of midnight on 22 June 2002 (20 June 2002 was a Saturday and 21 June 2002 was a Sunday).

On 13 November 2002, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant.

DISCUSSION

In order to establish that papers were not received, a petition under 37 CFR 1.181 with a

proper showing is required. As set forth in the Official Gazette at 1156 OG 53, the petition must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). No petition fee is required.

Items (1) and (2) are satisfied by the practitioner's statement that the Office action was not received by the practitioner and his statement attesting that a search of the file jacket and docket records indicated that the Office action was not received.

With regard to Item (3), applicant submitted a copy of the "attorney's docket notices for the two month and six month dates, i.e. 20 January 2002 and 20 May 2002". With a five month extension of time available, the relevant date is 20 June, not 20 May 2002. This docket record does not exclude the possibility that the "Notification of Missing Requirements" was in fact received by counsel's firm, but inadvertently docketed to the wrong attorney/application. The computer docket record relied upon by counsel establishes only that the Notification was not docketed in connection with his docket, not that such Notification was not received. It is for this reason that the Office generally requires, as the appropriate docket record for establishing nonreceipt of an Office communication, a record of all USPTO responses dues on the due date for reply to the communication at issue (i.e., a listing of all replies due in the USPTO on 20 January 2002 for the present case). MPEP 711.03(c), (Rev. 1, Aug 2001) p. 700-140. Counsel does not indicate that the records submitted represent the docket record where the non-received office action would have been entered had it been received.

With regard to Query 2, the law firm's docket record for the month of November 2001 is puzzling as the due dates vary from 2 months to 6 or 7 months for notices mailed in November. Furthermore, although counsel states that the law firm's log reflects every "Missing Requirements" notice received in November 2001, the log itself indicates "Missing Parts". No explanation is provided and a question is raised as to whether this is a query for "Missing Parts" or "Missing Requirements" notices. What is required is as the appropriate docket record for establishing nonreceipt of an Office communication, is a record of all USPTO responses dues on the due date for reply to the communication at issue (i.e., a listing of all replies due in the USPTO on 20 January 2002 for the present case).

Thus, applicant has not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted at this time.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision.

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.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk

Telephone: (703) 306-5467
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

#7

11 AUG 2003

Bradley B. Geist
Baker Botts
30 Rockefeller Plaza
New York ,NY 10112-4498

In re Application of PETER SOPP et al. Application No.: 09/937,913 PCT No.: PCT/DE00/00837 Int. Filing Date: 17 March 2000 Priority Date: 01 April 1999 Attorney's Docket No.: A34661-PCT-USA For: GUIDE SYSTEM FOR A ROLLING MILL, ESPECIALLY FOR A MILL TRAIN	DECISION ON PETITION UNDER 37 CFR 1.181

This is in response to applicant's "Letter Request for Reconsideration" of Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action, treated as a renewed petition under 37 CFR 1.181 filed in the United States Patent and Trademark Office (USPTO) on 21 April 2003 alleging that applicant did not receive the Notification of Missing Requirements mailed on 20 November 2001.

BACKGROUND

A review of the application file reveals that the NOTIFICATION OF MISSING REQUIREMENTS was mailed by the USPTO on 20 November 2001 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and $130 surcharge for filing the oath or declaration after the thirty month period was required. Applicant was given two months to respond to the Notification or until 20 January 2002 with extensions of time (up to 5 months) available under 37 CFR 1.136(a).

No response to the Notification of Missing Requirements was received, and thus, the application was held to be **ABANDONED** as of midnight on 22 June 2002 (20 June 2002 was a Saturday and 21 June 2002 was a Sunday). On 13 November 2002, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant.

On 20 December 2002, applicants filed a petition under 37 CFR 1.181. On 31 March 2003, this office mailed its decision, which dismissed the petition without prejudice on the grounds that applicants had not provided the proper showing in order to establish that papers were not received. The decision indicated that applicants had not provided a copy of the docket record showing all responses docketed for the date a response was due (20 January 2002 in this case) showing that there was no record of a response for the present application being due on that date.

On 21 April 2003, applicants submitted the instant "Letter Request for Reconsideration"

along with a copy of the docket record for 20 January 2002. Applicants submitted a proper reply, that is, a copy of the docket record for the date a response was due (20 January 2002 in this case) showing that there was no record of a response for the present application being due on that date. Counsel also explained the law firm's docket record for the month of November 2001 previously submitted; that the term "Missing Parts" is a short version of "Missing Requirements" and that the "docket record for each file is a 6 month 'Final Deadline' date and a 2-month "Response Due" date. Thus, applicant has now provided the proper showing necessary to withdraw the holding of abandonment and the petition is granted at this time.

CONCLUSION

For the reasons indicated above, the renewed petition is **GRANTED**. The Notification of Abandonment (Form PCT/DO/EO/909) mailed on 13 November 2002 is **VACATED**.

The application will be forwarded to the U.S. Designated/Elected Office for further processing including issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration and the surcharge for filing the oath or declaration after the thirty month period is required.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467
Facsimile: (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : October 02,2007

TO SPE OF : ART UNIT **2154**

SUBJECT : Request for Certificate of Correction for Appl. No.: **09/937,934** Patent No.: **7194548 B1**

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

DO NOT SENT TO ATTORNEY

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

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: _____

NATHAN FLYNN
SUPERVISORY PATENT EXAMINER

SPE 2154 **Art Unit**

23 JAN 2004

#5

UNITED STATES 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 H. Kelly
Scheef & Stone, LLP
5956 Sherry Lane, Suite 1400
Dallas, TX 75225

In re Application of
SEBIRE, et al.
U.S. Application No.: 09/937,949
PCT No.: PCT/EP01/01839
Int. Filing Date: 16 February 2001
Priority Date: 18 February 2000
Atty Docket No.: NOKI14-00009
For: COMMUNICATIONS SYSTEM

DECISION ON PETITIONS

UNDER 37 CFR 1.181 AND

37 CFR 1.8

This decision is in response to applicant's facsimile communication filed 20 November 2003 in the United States Patent and Trademark Office (USPTO). The communication is being treated first as a petition under 37 CFR 1.181 as to the previous filings and as a petition under 37 CFR 1.8 regarding the request to withdraw the holding of abandonment. No petition fees are required.

BACKGROUND

On 16 February 2001, applicant filed international application PCT/EP01/01839, which claimed priority of an earlier application filed 18 February 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 September 1999. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 October 2001.

On 02 October 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia:* the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an information disclosure statement and a First preliminary amendment.

On 09 November 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 executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 17 July 2002, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form

PCT/DO/EO/909) informing applicant that applicant had failed to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 09 November 2001 within the time period set therein and that above-identified application was abandoned as to the United States.

On 20 November 2003, applicant filed the present petition under 37 CFR 1.8 accompanied by copies of the papers purportedly filed on 05 August 2002 and 11 September 2003.

DISCUSSION

I. Petition Under 37 CFR 1.181

Applicant's present filing requests consideration of a request to withdraw holding of abandonment purportedly filed on 05 August 2002 and again on 11 September 2003. The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of a date-stamped postcard receipt for both filings. As applicant has provided a stamped postcard receipt for the 05 August 2002 there is no need to consider the 11 September 2003 filing. The postcard identifies the application by applicant, application number and docket number. Among the items listed on the receipt is "Request to Withdraw Holding of Abandonment" and "Copies of Response to Notification of Missing Requirements, Declaration and Power of Attorney, Certificate of Mailing by First Class Mail, and a check in the amount of $130.00 as submitted on January 9, 2002" The receipt is stamped "DT05 Rec'd PCT/PTO 05 AUG 2002." Thus, it is clear that applicant filed a request to withdraw holding of abandonment accompanied by the appropriate response documents on 05 August 2002. As detailed below, applicant has attested that the copies considered herein are true and complete copies of the originally filed papers.

II. Petition Under 37 CFR 1.8

37 CFR 1.8(b) states:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice the correspondence will be considered timely filed if the party who forwarded the correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
>
> (2) Supplies an additional copy of the previously mailed or

transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

With the present petition, applicant has satisfied items all three items above. Thus, it is proper to grant applicant's petition under 37 CFR 1.8.

Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have now been satisfied. Regarding the assigning of a 35 U.S.C. 371 date, 37 CFR 1.8(a) states that, "[T]he actual date of receipt will be used for all other purposes." In light of the granting of the 37 CFR 1.181 petition, it is proper to accept the copy of the combined declaration and power of attorney filed 20 November 2003 as a substitute for the combined declaration and power of attorney filed 05 August 2002.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

Applicant's petition under 37 CFR 1.8 is **GRANTED**.

As authorized, the $130.00 surcharge will be charged to Deposit Account No.: 50-0208.

The "NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909)" mailed on 17 July 2002 is hereby **VACATED**.

This application will be given an international application filing date of 16 February 2001 and a date of **05 August 2002** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE – 10TH FL.
NEW YORK NY 10151

COPY MAILED

FEB 0 2 2009

OFFICE OF PETITIONS

In re Application of :
Kalisch et al. :
Application No. 09/937,952 : DECISION ON PETITION
Filed: December 5, 2001 :
Attorney Docket No. 592050-2018 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 9, 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 final Office action mailed September 12, 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 December 13, 2006. A Notice of Abandonment was mailed May 7, 2007.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;
(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether

the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (almost two and one-half years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on December 13, 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 Leonard J. Santisi of Dorsey & Whitney LLC was counsel of record at the time of abandonment, he should explain why this application became abandoned while it was under his control and what efforts were made to further reply of itself and with whom this matter was discussed outside of the practice of Dorsey & Whitney LLC. 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), such as Leonard J. Santisi of Dorsey & Whitney LLC and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then at the practice of Dorsey & Whitney LLC, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, almost two and one-half 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 the practice of Dorsey & Whitney LLC 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).

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

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 Joan Olszewski at (571) 272-7751.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

MAILED

APR 02 2009

OFFICE OF PETITIONS

In re Application of	:	
Kalisch et al.	:	
Application No. 09/937,952	:	ON PETITION
Filed: December 5, 2001	:	
Attorney Docket No. 592050-2018	:	

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed March 11, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action mailed September 12, 2006. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 13, 2006. A Notice of Abandonment was mailed May 7, 2007.

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 continues to lack item(s) (3).

The renewed petition does not include a statement and or declaration from William S. Frommer, the attorney prosecuting the application at the time of its abandonment. This information was not included in the renewed petition and therefore it remains unclear what Mr. Frommer knew from the time the application went abandoned on December 13, 2006 until the filing of a petition on January 9, 2009. As stated in the February 2, 2009 petition dismissal letter, "**Statements are required from any and all persons then at the practice of Dorsey & Whitney LLC and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action.**" Therefore, a statement from Mr. William S. Frommer is required in response to this dismissal.

Petitioner may wish to pursue reinstatement of the patent under the unavoidable provisions of 37 CFR 1.137(a). 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 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**; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Window located at:
U.S. Patent and Trademark Office
Customer Service Window Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Joan Olszewski at (571) 272-7751.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE – 10TH FL.
NEW YORK NY 10151

MAILED

JUL 0 2 2009

OFFICE OF PETITIONS

In re Application of	:	
Kalisch et al.	:	
Application No. 09/937,952	:	DECISION ON PETITION
Filed: December 5, 2001	:	
Attorney Docket No. 592050-2018	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed May 29, 2009, 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 September 12, 2006. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on December 13, 2006. A Notice of Abandonment was mailed May 7, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810.00 and the submission required by 37 CFR 1.114 (previously submitted January 9, 2009); (2) the petition fee of $1,620.00 (previously submitted January 9, 2009); and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Joan Olszewski at (571) 272-7751.

The file is now being forwarded to Technology Center 3652 for processing of the Request for Continued Examination under 37 CFR 1.114 filed on January 9, 2009.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 18

HORST M. KASPER
13 FOREST DRIVE
WARREN, NJ 07059

COPY MAILED

JAN 13 2004

OFFICE OF PETITIONS

In re Application of
Fey, Wilhelm
Application No. 09/937,968
Filed: January 30, 2002
Attorney Docket No. MSA246

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 22, 2003, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed March 5, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on June 6, 2003. A Notice of Abandonment was mailed on September 18, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to Technology Center 2800 for further examination on the merits.

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

PEARNE & GORDON LLP
526 Superior Avenue East
Cleveland, Ohio 44114-1485

In re Application of	:	
Hirofumi Yura Et al	:	DECISION ON
Application No.: 09/937,991	:	
PCT No.: PCT/JP00/02012	:	REQUEST
Int. Filing Date: 30 March 2000	:	
Priority Date: 02 April 1999	:	FOR WITHDRAWAL
Attorney's Docket No.: 33944	:	
For: Functionalized Glycosaminoglycan...	:	OF ABANDONMENT
By Using The Same	:	

This Decision is in response to applicants "Petition to Withdraw Notification of Abandonment" filed on 07 August 2002, which argues that the above-identified application was improperly held abandoned.

BACKGROUND

On 28 September 2001, applicant filed a Transmittal letter (Form PTO-1390) for entry into the national stage in the United States, which was accompanied by, a copy of the international application. No executed oath or declaration was filed at such time.

On 31 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 the oath or declaration complying with 37 CFR 1.497(a) and (b), identifying the application by international application number and international filing date must be furnished within the time period set forth. The notification set two months time limit or 32 months from the priority date for the application, whichever is later to respond.

On 02 July 2002, the DO/EO/US mailed a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) which indicated that applicant had failed to respond to the "NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905), mailed 10/31/2001 within the time period set therein; accordingly the application was abandoned.

In response to the "NOTIFICATION OF ABANDONMENT" mailed on 02 July 2002, petitioner has submitted the instant petition requesting withdrawal of the Notice of Abandonment. In support of the request, petitioner has provided a copy of the returned/stamped receipt card acknowledging a receipt date of 23 January 2002.

DISCUSSION

The present petition was accompanied by a copy of the original postcard which was sent to the United States Designated/Elected Office (DO/EO/US). The postcard lists the item submitted on 23 January 2002 and it indicates, *inter alia*, declaration and power of attorney was received on such date. Applicant's representative states that the papers accompanying the present petition are copies of the papers that were received at the Patent Office on 23 January 2002.

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.

Applicant's postcard receipt serves as *prima facie* evidence of receipt of the listed item on 23 January 2002 by the USPTO.

Since the itemized postcard does not list the "letter" in its contents of items received on 23 January 2002, the "letter" can not be considered as being simultaneously filed with the declaration. Accordingly, the certificate of mailing under 37 CFR 1.8 is invalid for the declaration and can not be used as a basis for a timely filing date of 19 December 2001 for the declaration.

This response, however, with a month extension for response (since the 2 month response was due on 31 December 2001) was within the time period stipulated and applicant's representative Docket Account is being charged $110.00 (37 CFR 1.17(a)) as indicated in the "Letter" in response to the Notice to File Missing parts of Application.

In view of the above, applicant's representative response- the Declaration filed on 23 January 2002- is considered timely. Accordingly, the instant application has been improperly abandoned.

CONCLUSION

Applicants' request to withdraw the "NOTIFICATION OF ABANDONMENT" is **GRANTED**.

The NOTIFICATION OF ABANDONMENT, mailed 02 July 2002 has been **VACATED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision, that is, for issuance of a Notification of Acceptance of Application (Form PCT/DO/EO/903) identifying a 35 U.S.C.§ 371 date of **23 January 2002**.

Rafael Bacares
PCT Legal Examiner
Work (703) 308-2260
Fax (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal Affairs

02 DEC 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#6

Nate F. Scarpelli
MARSHALL, GERSTEIN & BORUN
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 60606-6402

In re Application of :
BÄR, Kai K.O. *et al* :
U.S. Application No.: 09/937,995 : **DECISION**
PCT No.: PCT/EP00/02773 : **UNDER**
Int. Filing Date: 29 March 2000 : **37 CFR 1.181**
Priority Date: 01 April 1999 :
Attorney's Docket No.: 27428/37727 :
For: INFRARED IRRADIATION :

This decision is in response to the papers filed 29 August 2002 which has been treated as a petition under 37 CFR 1.181. No fee is required.

BACKGROUND

On 08 November 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 declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 was required. A two-month time period for response was set.

On 20 December 2001, applicants purportedly submitted an executed declaration and surcharge fee.

On 28 August 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Notification of Missing Requirements within the time period set.

On 29 August 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, a copy of the response including an executed declaration purportedly mailed 20 December 2001, and authorization to charge any required fees to Deposit Account No. 13-2855.

DISCUSSION

In the instant response to the Notification of Abandonment mailed 28 August 2002, applicants filed "a copy of correspondence that was mailed to the USPTO (using a certificate of mailing under 37 C.F.R. 1.8) on December 20, 2001." This response also included a copy of a declaration in compliance with 37 CFR 1.497(a) and (b).

However, 37 CFR 1.8 merely allows for correspondence to be considered as timely filed if the correspondence is mailed or transmitted prior to expiration of the time period given in certain cases. 37 CFR 1.8 does not prove receipt of papers filed in the USPTO.

Section 503 of the MPEP lists procedures to ensure receipt of all papers filed in the USPTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants have not provided a copy of the date-stamped filing receipt for the documents purportedly submitted 20 December 2001. Accordingly, applicants have not provided *prima facie* evidence that the declaration and surcharge fee were filed 20 December 2001. Moreover, a review of USPTO financial records for the above-captioned application does not show that the surcharge fee was received on 20 December 2001.

CONCLUSION

For the reason discussed above, the petition under 37 CFR 1.181 is **DISMISSED**. The application remains **ABANDONED**.

Applicants may wish to consider filing a petition under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any such petition to revive or request for reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this 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.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

06 FEB 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Nate F. Scarpelli
MARSHALL, GERSTEIN & BORUN
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 60606-6402

In re Application of :
BÄR, Kai K.O. *et al* :
U.S. Application No.: 09/937,995 :
PCT No.: PCT/EP00/02773 : **DECISION**
Int. Filing Date: 29 March 2000 :
Priority Date: 01 April 1999 :
Attorney's Docket No.: 27428/37727 :
For: INFRARED IRRADIATION :

This decision is in response to the papers filed 13 January 2003 which have been treated as a petition under 37 CFR 1.8(b). No fee is required.

BACKGROUND

On 02 December 2002, a decision dismissing applicants' petition under 37 CFR 1.181 was mailed because applicants did not provide *prima facie* evidence that the declaration and surcharge fee were mailed 20 December 2001.

On 13 January 2003, applicants submitted the instant renewed petition which was accompanied by, *inter alia*, Exhibits A - D.

DISCUSSION

The petition filed 29 August 2002 was dismissed pursuant to 37 CFR 1.181 in a decision dated 02 December 2002. Applicants failed to provide *prima facie* evidence in the form of a date-stamped postcard receipt that the declaration and surcharge fee were originally submitted on 20 December 2001.

In the present renewed petition, applicants request withdrawal of the notice of abandonment based on 37 CFR 1.8(b).

37 CFR 1.8(b) states, in part:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned . . . the correspondence will be considered timely if the party who

forwarded such correspondence:
(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. . . .

In the renewed petition, applicants have met all of the requirements listed above for a grantable petition. Applicants have provided the requisite statement, and a copy of the documents purportedly filed 20 December 2001. (A copy of those documents were also filed with the original petition.) The "Statement Pursuant to 37 C.F.R. §1.8(b)(3)" with accompanying documentary evidence including a computerized and written copy of the docket record for 20 December 2001 is sufficient to meet the requirements of 37 CFR 1.8(b)(3).

CONCLUSION

For the reasons above, applicants' petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notification of Abandonment mailed 28 August 2002 is hereby **VACATED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 29 March 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 20 December 2001.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

22 MAR 2

#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

Jodi-Ann McLane
Salter & Michaelson
321 South Main Street
Providence, RI 02903

In re Application of	:	
Luthje et al.	:	DECISION UNDER
Application No.: 09/937,996	:	
Filing Date: 28 September 2001	:	37 CFR 1.78
Attorney Docket No.: 02572	:	
For: Steering Device For Vehicles	:	

This is in response to applicant's "Petition For Acceptance Of Unintentionally Delayed Priority Claim" filed on 30 August 2004, which is being treated under 37 C.F.R. 1.78.

BACKGROUND

On 30 March 2000, applicants filed international application PCT/EP00/02839, which claimed a priority date of 01 April 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 12 October 2000. A Demand electing the United States was filed prior to the elapse of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 01 October 2001.

On 28 September 2001, applicant filed the instant application, in which processing under 35 U.S.C. 111(a) was appropriate, as described in the Communication mailed on 08 October 2003.

DISCUSSION

37 CFR 1.78(a)(2) applies to nonprovisional applications which were filed on or after November 29, 2000. A petition under 37 CFR 1.78(a)(3) is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In the present case, the later filed application under 35 U.S.C. 111(a) was filed on 28 September 2001 and the petition was filed after the time period specified in 37 CFR 1.78(a)(2)(ii).

37 CFR 1.78(a)(3) states:

> 3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121 or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally

> delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:
>
> (I) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
>
> (ii) The surcharge set forth in §§ 1.17(t); and
>
> (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section 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.

Requirement (1) has not been satisfied because the reference to the prior filed application included in the "Second Preliminary Amendment" filed on 09 January 2004 does not explicitly state whether the instant application is a continuation, continuation-in-part, or divisional application of the international application.

Requirements (2) and (3) have been satisfied for the following reasons. The required reference to the prior filed application was included in the "Second Preliminary Amendment" filed on 09 January 2004. The fee has been paid. The petition states that "the entire delay in filing between the date the claim was due and the date the claim was filed was unintentional."

CONCLUSION

For the reasons above, the petition under 37 CFR 1.78(a)(3) is **DISMISSED,** without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

05 [illegible] 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Jodi-Ann McLane
Salter & Michaelson
321 South Main Street
Providence, RI 02903

In re Application of	:	
Luthje et al.	:	DECISION
Application No.: 09/937,996	:	
Filing Date: 28 September 2001	:	UNDER
Attorney Docket No.: 02572	:	
For: Steering Device For Vehicles	:	37 CFR 1.78

This is with regard to counsel's correspondence filed on 31 March 2005, which is in response to the decision under 37 CFR 1.78 mailed on 22 March 2005.

DISCUSSION

The decision under 37 CFR 1.78 mailed on 22 March 2005 dismissed without prejudice the petition under 37 CFR 1.78 filed on 30 August 2004, because

> the reference to the prior filed application included in the "Second Preliminary Amendment" filed on 09 January 2004 does not explicitly state whether the instant application is a continuation, continuation-in-part, or divisional application of the international application.

The instant response is accompanied by a "Supplemental Preliminary Amendment" which amends the specification to include an appropriate reference. Therefore, it would now be appropriate to grant the requested relief under 37 CFR 1.78.

DECISION

For the reasons above, the petition under 37 CFR 1.78(a)(3) is **GRANTED**.

Applicant is advised that 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 inclusion of the prior-filed application on any future Filing Receipt should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. The examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

MAR 1 2 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Noland J. Cheung
Bayer Corporation
100 Bayer Road
Pittsburgh, PA 15205-9741

In re Application of SCHOLL et al
U.S. Application No.: 09/937,998
Int. Application No.: PCT/EP00/02452
Int. Filing Date: 20 March 2000
Priority Date: 01 April 1999
Attorney Docket No.: Mo-6634/LeA 33,620
For: RUBBER COMPOSITIONS CONTAINING HYDROXYL GROUPS

DECISION

This is in response to applicant's letter filed 25 February 2002, which is accompanied by a copy of a declaration purportedly filed on 23 January 2002. The submission is being treated as a petition to accord the copy of the declaration an original filing date of 23 January 2002 and as a request for status under 37 CFR 1.42. No petition fee is due.

BACKGROUND

On 20 March 2000, applicant filed international application PCT/EP00/02452, which claimed priority of an earlier Germany application filed 01 April 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 12 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 05 October 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 01 October 2001.

On 27 September 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 07 November 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371, which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 25 February 2002, applicant filed the present petition. The petition states that it is accompanied by a copy of a return postcard receipt.

DISCUSSION

I. Filing date of declaration.

The evidence of record is sufficient to establish that the declaration was originally filed on 23 January 2002. Specifically, the copy of the return postcard, which includes an "Combined Declaration and Power of Attorney" in its itemized contents and which bears a USPTO date stamp of 23 January 2002, serves as *prima facie* evidence that the declaration was received by the USPTO on 23 January 2002.

II. Request for status under 37 CFR 1.42

The declaration filed 23 January 2002 is executed by inventor Jurgen Trimbach and by an heir of Thomas Scholl, who according to the declaration is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

In the present case, the declaration is signed by one of the heirs, Ulrike Scholl, on behalf of all of the other heirs, Philipp Scholl, Christine Scholl, and Johannes Scholl, who are minor children. The submission of the declaration executed by 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

For the reasons set forth in §I above, the petition is GRANTED.

For the reasons set forth in §II above, the papers filed 23 January 2002 are ACCEPTED under 37 CFR 1.42.

The application has an International Filing Date of 20 March 2000 and a date under 35 U.S.C. 371 of 23 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

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)
6647813	2003-11-18	09938037	2001-08-23	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	◉	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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	/Robert R. Green/	Date (YYYY-MM-DD)	2008-01-17
Name	Robert R. Green		

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. 6647813
Issue Date: November 18,2003
Application No. 09938037
Filed: August 23,2001
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 17,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 17,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

COPY MAILED

JUL 0 9 2004

OFFICE OF PETITIONS

In re Application of
Karl W. Terry, et al.
Application No. 09/938,039
Filed: August 23, 2001
Attorney Docket No. 7124.015

ON PETITION

This is a decision in response to a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee filed July 8, 2004.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid April 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 relating to this decision should be directed to the undersigned at (703) 305-9220.

After the application is received in the Office of Petitions, the file will be forwarded to Technology Center AU 1712 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MAILED

DEC 31 2001

Paper No. 3

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Fulbright & Jaworski, LLP
666 Fifth Avenue
New York, New York 10103-3198

In re Application of: Jonas Ulenas et al.	)	
Application No. 09/938,125	)	
Filed: August 23, 2001	)	**DECISION ON PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(c) AND MPEP § 708.02 (IV): APPLICANT'S AGE**
For: METHOD AND APPARATUS FOR OBTAINING CONSUMER PRODUCT PREFERENCES THROUGH PRODUCT SELECTION AND EVALUATION	)	

This is a decision on the petition, filed 3 October 2001, under 37 C.F.R. §1.102(c) and M.P.E.P. §708.02(IV): Applicant's Age, to make the above-identified application special.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section IV must include a showing, as by a birth certificate or the applicant's statement, that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a copy of Jonas Ulenas' passport establishing that applicant is sixty five (65) years of age or more. Accordingly, the petition is **GRANTED.**

The application is being forwarded to the examiner for expedited prosecution.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6615762
Issue Date: September 9,2003
Application No. 09938129
Filed: August 23,2001
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 18,2008 ,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 November 18,2008 . 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.

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)
6615762	2003-09-09	09938129	2001-08-23	3950-002

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	/Julie Reed/	Date (YYYY-MM-DD)	2008-11-18
Name	Julie Reed	Registration Number	35349

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

MAILED

FEB 07 2007

Technology Center 2100

SHUMAKER & SIEFFERT. P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125

In re Application of:
Robert B. Wood
Application No. 09/938,144
Filed: 23 August 2001
For: INTELLIGENT DATA STORAGE DEVICE

DECISION ON PETITION TO WITHDRAW THE FINALITY OF AN OFFICE ACTION

This paper provides the decision on the petition filed December 11, 2006 under 37 C.F.R. § 1.181 and M.P.E.P. § 706.07 to withdraw the finality of the Office action, mailed September 11, 2006.

The Petition is **DISMISSED.**

RECENT PROSECUTION HISTORY

In the Non-Final Office Action, mailed March 1, 2006, the Examiner rejected claims 1 and 18 as being unpatentable over Hacker [MP3: The Definitive Guide, published March 2000] in view of Bruner et al. [US 6,212,588 BI]

Applicants responded on June 29, 2006 by amending claims 1 and 18.

The amendment to claim 1 changed the claim preamble from being a claim for a "data storage device in a form factor assembly not greater than three and one half inches" to "a device".

Applicants also amended the claim to remove the following elements from the claim:

an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc;
memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU.

Further Applicants amendment also changed :

a printed circuit board (PCB) fastened to the base-plate having a servo controller in operable communication with the actuator arm for moving the actuator arm over the data disc;

to

a printed circuit board (PCB) fastened to the base-plate having a servo controller;

and changed

a central processing unit (CPU) mounted to the PCB generating control signals to the servo controller and running an operating system;

to

a central processing unit (CPU) mounted to the PCB running an operating system;.

The amendment to claim 18 changed the limitation

a data disc mounted within the case, wherein the data disc rotates about a central axis;

to

a data disc mounted within the case,

and removed the limitation

an actuator arm carrying a head to read and write data to the data disc;

On September 11, 2006, the Examiner issued a final action. Examiner applied a new grounds of rejection under 35 U.S.C. 102(e) over Stefanksy [US 6,226,143 B1], and indicated that applicants' amendment necessitated the new grounds of rejection.

Applicants petitioned on November 13, 2006 that the second Office action was made final prematurely. This petition was treated as a Request for Reconsideration, and the examiner issued an advisory action stating that "the claims, as amended, no longer requires the device to be a data storage device with form factor assembly of less than three and one half inch and the actuator arm adjacent to the data disc carrying a transducers and a memory. The amended claims at current directs toward a PCB fastened to a baseplate having servo controller in combination with a CPU mounted to the PCB. As can clearly be seen, the claims filed on 6/29/06 is of different scope than the claims filed on 8/25/06, applicant's argument regarding the combination of Hacker and Bruner is therefore moot and necessitated the search and the new ground of rejection as set forth in the final office action".

REQUIREMENTS

A petition under 3 7 CFR § 1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181 (f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Further, when a petition is taken from an action or

requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR § 1.111) and a repeated action by the Examiner.

The petition filed on November 13, 2006 includes elements (1) and (2) above, as well as a request for reconsideration. The advisory action mailed on November 20, 2006, constitutes a repeated action by the Examiner.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the finality of the September 11, 2006 office action.

OPINION

Petitioner presents the following arguments in support of the position that the Final rejection was premature:

a) The (final) Office action rejection of claims 1 and 18 under 35 U.S.C. 102 (e), as being anticipated by Stefansky [US 6,226,143 B1], is improper as the Examiner applied new grounds of rejection to claims broadened by applicants' amendment. If the rejection under 35 U.S.C. § 103(a) as being obvious over Hacker in view of Brunet et al. of claims 1 and 18 prior to the broadening amendment had properly supported the rejection, the same grounds of rejection would have also supported a rejection of claims I and 18 as broadened after the amendment. For this reason, Applicant's amendment submitted June 29, 2006 could not have necessitated the new grounds of rejection as set forth in the Final Office Action with respect to at least claims 1 and 18.

b) Applicants' petition recites (p.2, last paragraph) "because the amendment submitted June 29, 2006 did not further limit the scope of claims 1 and 18 in any way, that the amendment could not have necessitated the new grounds of rejection of claims 1 and 18 as required for a proper Final Office Action".

ANALYSIS

M.P.E.P. § 706.07(a) provides that "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 [other grounds not pertinent here]" (emphasis added).

In the instant case, applicant's amendment changed the claim scope (as shown in the Recent Prosecution History section above) that it was no longer needed that the reference teach "a data storage device in a form factor assembly not greater than three and one half inches" as recited in claim 1. Claim 18 was also amended to remove "an actuator arm carrying a head to read and write data to the data disc". Hacker was specifically cited "for the actuator arm" and "data storage device". By removing these limitations from the claim, applicant made the claim broad. Thus other references that were not available as prior art for the original claims, became available as prior art for the amended claims. Hence, the new grounds of rejection were necessitated by applicant's amendment. M.P.E.P. § 706.07(a) only requires that the new grounds of rejection be necessitated by Applicants amendment. It does not require that the amendment be "further limiting" as argued by applicant.

With respect to Petitioners' argument that "Applicant finds no support in the MPEP or elsewhere for the proposition that an amendment that only broadens the scope of a claim can necessitate a new ground of rejection", while the undersigned agrees with that statement, the undersigned also would like to point put that there also is no support in the MPEP that the amendments have to be further limiting the scope of a claim to be made final with a new grounds of rejection as argued by the petitioners.

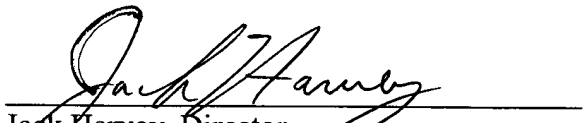
With respect to Petitioners' argument that

> Because Applicant did not add any features in claim 1 or claim 18, it is clear that Applicant's amendments only broadened the subject matter of claims l and 18. If the rejection under 35 U.S.C. § 103(a) as being obvious over Hacker in view of Brunet et al. of claims 1 and 18 prior to the broadening amendment had properly supported the rejection, the same grounds of rejection would have also supported a rejection of claims I and 18 as broadened after the amendment. For this reason, Applicant's amendment submitted June 29, 2006 could not have necessitated the new grounds of rejection in set for the in the Final Office Action with respect to at least claims 1 and 18.

However, it is noted that the claims 1 and 18, in their amended format, did not require some of the essential elements that the Hacker (primary) reference was relied upon to teach. MPEP 706: (2) provides that in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. MPEP 706.02 I. CHOICE OF PRIOR ART; BEST AVAILABLE provides that prior art rejections should ordinarily be confined strictly to the best available art. Hence, examiner applied the new grounds of rejection commensurate with the amended scope of the claims 1 and 18, and commensurate with office practice and procedures.

The petition is **DISMISSED**.

The application remains under final rejection with the time period for response continuing to run from the mailing of the Final Office action, September 11, 2006.



Jack Harvey, Director
Technology Center 2100
Computer Architecture, Software,
and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAIL

APR 2 5 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of
Paul Clinton Coffin, et al.
Application No. 09/938,155
Filed: August 23, 2001
For: **SYSTEMS AND METHODS FOR PROVIDING AUTOMATIC ACCESS TO DATA MEDIA IN A DATA STORAGE SYSTEM**

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the Petition to Withdraw Holding of Abandonment pursuant to MPEP §711.03(c) and 37 CFR §1.181(a), filed November 19, 2004. No fee is required.

This application was held abandoned for failure to timely submit a response to the non-final Office action mailed December 23, 2003. A Notice of Abandonment was mailed September 29, 2004.

Petitioner states that the non-final Office action was not receive. The petition was accompanied by a declaration from a Maria Carroll, Legal Administrator for Hewlett-Packard Corporate Legal Department, and also a copy of a mail log.

Pursuant to MPEP § 711.03(c) *[See also Notice entitled Withdrawing the Holding of Abandonment When Office Actions Are Not received, 1156 O.G. 53 (November 16, 1993)]*, in absence of any irregularity in the mailing of an Office Action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating:

(a) that the Office communication was not received by the practitioner; and

(b) personally attesting to a search of the file jacket and docket records indicates that the Office communication was not received;

In addition, the petition must include a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

It is noted that neither the petitioner David Rodack or Maria Carroll are listed as having power of attorney in the subject application, according to Office records. Therefore, the petition does not comply with the requirements of a successful petition to withdraw the holding of abandonment

due to the lack of a statement from the Practitioner attesting to a personal search of the file jacket and docket records and indicating that the office communication was not received.

Moreover, there is no evidence of record that Petitioner was ever granted power of attorney in the application. Therefore, Petitioner is not the practitioner of record in which to make the requisite statement.

In addition, the correspondence address of the Petitioner is not the correspondence address of record. There is no evidence of record whereby the correspondence address was changed to the Petitioner's address. Therefore, Petitioner also has failed to provide evidence supporting non-receipt of the Office action at the correspondence address of record.

Accordingly, the petition is **DENIED.**

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision, be executed by a practitioner of record and include the information as outlined above. Alternatively, practitioner may file a petition to revive under 37 CFR §1.137.

A courtesy copy of this decision is being mailed to Petitioner's address below. However, all future communications will continue to be mailed to the address set forth above.

The application is being forwarded to the Technology Center's file repository.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

Cc: Thomas, Kayden, Horstemeyer & Risley, L.L.P.
Suite1750, 100 Galleria Parkway
Atlanta, Georgia 30339-5948

UNITED STATES 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

JUL 19 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of
Paul Clinton Coffin, et al.
Application No. 09/938,155
Filed: August 23, 2001
For: **SYSTEMS AND METHODS FOR PROVIDING AUTOMATIC ACCESS TO DATA MEDIA IN A DATA STORAGE SYSTEM**

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the request for reconsideration, filed June 30, 2005. No fee is required.

This application was held as abandoned for failure to timely respond to the non-final Office action mailed on December 23, 2003. A Notice of Abandonment was mailed September 29, 2004.

Petitioner alleges that the non-final Office action was not received.

The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the Practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received", 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Petitioner has satisfied the requirements set forth above. Accordingly, the application file was not abandoned in fact and the holding of abandonment is withdrawn.

The petition is **GRANTED.**

Given the original mailing date of the non-final Office action, the application will be returned to the examiner for updates as appropriate and generation of a new Office action. The time period for response will be restarted from the mail date of the new Office action.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

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

JUN - 2 2004

In re Application of	:	
Frederick A. Meyers	:	NOTICE OF WITHDRAWAL
Serial No. 09/938,205	:	FROM ISSUE
Filed: August 23, 2001	:	UNDER 37 CFR 1.313(b)
For: ANTIMICROBIAL COATED METAL SHEET:		

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 at Roy King (571) 272-1244.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

FROST BROWN TODD LLC
2200 PNC Center
201 E. Fifth Street
Cincinnati, OH 45202-4162

cc: Allowed Files—Pk3-915

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JUN - 2 2004

In re Application of	:	
Frederick A. Meyers	:	NOTICE OF WITHDRAWAL
Serial No. 09/938,205	:	FROM ISSUE
Filed: August 23, 2001	:	UNDER 37 CFR 1.313(b)

For: ANTIMICROBIAL COATED METAL SHEET:

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 at Roy King (571) 272-1244.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

FROST BROWN TODD LLC
2200 PNC Center
201 E. Fifth Street
Cincinnati, OH 45202-4162

cc: Allowed Files—Pk3-915

RECEIVED
JUN 18 2004
OIPE/JCWS

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

COPY MAILED

MAY 0 6 2002

OFFICE OF PETITIONS

In re Application of
Arviv, et al.
Application No. 09/938,216
Filed: August 24, 2001
Attorney Docket No. 1160
Title: ASYMMETRIC ADAPTIVE MODULATION IN A WIRELESS COMMUNICATION SYSTEM

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is in response to the "Statement of Facts in Support of Filing on Behalf on Non-Signing Inventors (37 CFR 1.47)", filed February 12, 2001, which is being treated as a petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. 1.136(a).

The above-identified application was filed on August 24, 2001. On September 28, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a two month extension of time and included a Certificate of Mailing dated January 25, 2002. Accompanying the petition were: (1) a statement of facts by Ruth Stoffel, describing the efforts to obtain signatures from inventors Ofri Arviv and Penny Efraim; and (2) copies of cover letters from Stoffel to Arviv and Efraim, transmitting the application.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last

known address of the non-signing inventor. Rule 47 applicant has not met requirement (1) or (2) above.

As to requirement (1), applicant states that he was notified by Federal Express that the package to non-signing inventor Efraim could not be delivered because of an insufficient address. However, applicant has not submitted a copy of the Federal Express return slip showing that the package was undeliverable. Applicant must submit this evidence on renewed petition.

As to requirement (2), the declaration is not acceptable because it does not comply with 37 CFR 1.63(a)(3). The declaration submitted does not identify the citizenship of Efraim. Also, because the declaration fails to identify the mailing address and residence of Efraim, the declaration does not comply with 37 CFR 1.63(c)(1). On renewed petition, applicant must submit a declaration in compliance with 37 CFR 1.63.

In addition, the declaration is not acceptable because the alteration to the address of David Gazelle, while initialed, was not dated.[1]

Receipt of the substitute drawings, filed with the instant petition, is acknowledged.

As applicant did not submit the required $130 petition fee, that fee has been charged to Deposit Account No. 11-1410, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Assistant Commissioner for Patents Box DAC Washington, D.C. 20231
By FAX:	(703) 308-6916 Attn: Office of Petitions
By hand:	Crystal Plaza Four, Suite 3C23 2201 S. Clark Place Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] "Any interlineation, erasure, cancellation or other alteration of the application papers...should be dated and initialed or signed by the applicant on the same sheet of paper." 37 CFR 1.52(c)(1).

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

KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

COPY MAILED

SEP 16 2002

OFFICE OF PETITIONS

In re Application of
Arviv, et al.
Application No. 09/938,216
Filed: August 24, 2001
Attorney Docket No. 1160
Title: ASYMMETRIC ADAPTIVE MODULATION IN A WIRELESS COMMUNICATION SYSTEM

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is in response to the "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", filed September 4, 2002.

The petition under 37 CFR 1.47(a) is **GRANTED**.

The above-identified application was filed on August 24, 2001. On September 28, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed a petition under 37 CFR 1.47(a) on February 12, 2002 and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a two month extension of time and included a Certificate of Mailing dated January 25, 2002. Accompanying the petition were: (1) a statement of facts by Ruth Stoffel, describing the efforts to obtain signatures from inventors Eli Arviv and Penny Efraim; and (2) copies of cover letters from Stoffel to Arviv and Efraim, transmitting the application.

However, this petition was dismissed in a decision mailed on May 6, 2002. Petitioner failed to prove that non-signing inventor Efraim could not be reached after diligent effort.[1] In addition, petitioner, by not providing the citizenship, mailing address, and residence of Efraim, failed to submit a declaration in compliance with 37 CFR 1.63. Lastly, the declaration was not sufficient because an alteration to the address of inventor

[1] Specifically, petitioner failed to provide a copy of the Federal Express return slip showing that a package containing the application papers sent to Efraim was undeliverable.

Gazelle, while initialed, was not dated.[2]

On renewed petition, petitioner has submitted a declaration executed by Efraim, containing her citizenship, residence, and mailing address. In addition, the alteration to the address of Gazelle on the declaration is initialed and dated.

The declaration filed September 4, 2002 and the petition have been reviewed and found to be in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to non-signing inventor Eli Arviv at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The $400 fee for a two month extension of time has been charged to Deposit Account No. 11-1410, as authorized.

The application file is being forwarded to the Office of Initial Patent Examination for continuation of pre-examination processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

E. Shirene Willis for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[2] See 37 CFR 1.52(c)(1).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK CA 94026

COPY MAILED

SEP 0 4 2007

OFFICE OF PETITIONS

In re Application of :
David L. Morris, Steve A. :
Daniel, and Daniel J. Balbierz :
Application No. 09/938,276 :
Filed: August 22, 2001 : DECISION ON PETITION
Attorney Docket No. 13724 853 :
Title: TISSUE SURFACE TREATMENT :
APPARATUS AND METHOD :

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a)[1], filed June 29, 2007.

On August 22, 2001, the application was filed, identifying David L. Morris, Steve A. Daniel, and Daniel J. Balbierz as joint inventors. The application was deposited without an executed oath or declaration. On April 27, 2007, a Notice of Allowability

---

1A grantable petition under 37 C.F.R. §1.47(a) requires:
(1) the petition fee of $200;
(2) a surcharge of either $65 or $130 if the petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(e);
(3) a statement of the last known address of the non-signing inventors;
(4) either
a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
(5) a declaration which complies with 37 C.F.R. § 1.63.

and Issue Fee Due was mailed, requiring, *inter alia*, a substitute oath or declaration. This Notice set a three-month period for reply.

Along with the present petition, Petitioner has submitted, *inter alia*, the petition fee, a declaration that has been executed by Mr. Balbierz, and a declaration of facts.

Petitioner has met requirements (1) - (4) of Rule § 1.47(a).

Regarding the fifth requirement of Rule § 1.47(a), the last known address differs from the address that appears on the declaration, and as such, it appears that the declaration contains an incorrect zip code for Mr. Morris.

The statement of facts sets forth that the zip code for Mr. Morris is 2217. The declaration lists the zip code for Mr. Morris is 1127. It appears that the zip code that appears in the last known address is correct. See footnote 1 on the second page of the petition.

It follows that the present petition must be **DISMISSED.**

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.47(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

On renewed petition, Petitioner will need to submit a new declaration that contains the correct address for the non-signing joint inventor. Alternatively, Petitioner may submit an Application Data Sheet.

Petitioner will note that an ADS filed with the application is not required to be signed unless the ADS includes a nonpublication request. 37 C.F.R. § 1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. § 1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. § 1.33(b).

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be

submitted by mail[2], hand-delivery[3], or facsimile[4]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[5].

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[6]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. None

PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK CA 94026

COPY MAILED

NOV 14 2007

OFFICE OF PETITIONS

In re Application of :
David L. Morris, Steve A. :
Daniel, and Daniel J. Balbierz :
Application No. 09/938,276 :
Patent No. 7,278,991 : DECISION ON RENEWED
Filed: August 22, 2001 : PETITION
Issue Date: October 9, 2007 :
Attorney Docket No. 13724 853 :
Title: TISSUE SURFACE TREATMENT :
APPARATUS AND METHOD :

This is in response to the renewed petition pursuant to 37 C.F.R. § 1.47(a)[1], filed October 9, 2007.

1A grantable petition under 37 C.F.R. §1.47(a) requires:
(1) the petition fee of $200;
(2) a surcharge of either $65 or $130 if the petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(e);
(3) a statement of the last known address of the non-signing inventors;
(4) either
a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
(5) a declaration which complies with 37 C.F.R. § 1.63.

On August 22, 2001, the application was filed, identifying David L. Morris, Steve A. Daniel, and Daniel J. Balbierz as joint inventors. The application was deposited without an executed oath or declaration. On April 27, 2007, a Notice of Allowability and Issue Fee Due was mailed, requiring, *inter alia*, a substitute oath or declaration. This Notice set a three-month period for reply.

An original petition was filed on June 29, 2007, and was dismissed via the mailing of a decision on September 4, 2007.

With this fifth renewed petition, Petitioner has submitted a declaration that contains the correct information for non-signing joint inventor Morris. Consequently, Petitioner has met each of the five requirements of Rule § 1.47(a), and has submitted all required fees. Therefore, this fifth renewed petition pursuant to Rule § 1.47(a) is **GRANTED** and this application is hereby accorded Rule § 1.47 status.

This Office will forward notice of this application's filing to the non-signing inventors at the addresses given on the declaration. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225[2].

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Steve A. Daniel
40874 Calido Place
Fremont, CA 94539

COPY MAILED

NOV 14 2007

OFFICE OF PETITIONS

In re Application of	:	
David L. Morris, Steve A.	:	
Daniel, and Daniel J. Balbierz	:	
Application No. 09/938,276	:	
Patent No. 7,278,991	:	LETTER
Filed: August 22, 2001	:	
Issue Date: October 9, 2007	:	
Attorney Docket No. 13724 853	:	
Title: TISSUE SURFACE TREATMENT	:	
APPARATUS AND METHOD	:	

Dear Mr. Daniel:

You are named a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. § 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application, you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, the attorney of record below would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries **regarding this communication** should be directed to the undersigned at (571) 272-3225. Requests for

information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

cc: PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK CA 94026

UNITED STATES 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 M. Kriegsman
KRIEGSMAN & KRIEGSMAN
665 Franklin Street
Framingham, MA 01702

COPY MAILED

MAR 2 1 2006

OFFICE OF PETITIONS

In re Application of:
SHIHALE, Thomas, et al.
Application No.: 09/938,283
Filing Date: August 23, 2001
Attorney's Docket No.: 81715CIP
For: CONTINUOUSLY CONNECTED FASTENER STOCK AND METHOD OF MANUFACTURING THE SAME

DECISION ON PETITION FOR REVIVAL OF ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-entitled application, filed January 09, 2006.

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the final Office action mailed June 14, 2005, which set a shortened statutory period of reply of three (3) months. A response was not filed and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application was abandoned as of midnight on September 14, 2005.

On January 09, 2006, applicants filed the petition for revival under 37 CFR 1.137(b) considered herein. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of a Request For Continued Examination (RCE) accompanied by the necessary fee and submission (the "Amendment" included with the RCE satisfies the submission requirement of 37 CFR 1.114). Accordingly, the reply to the final Office action of June 14, 2005 (in the form of the RCE and submission) is accepted as having been unintentionally delayed.

The application file is being referred to Technology Center AU 3728.

Telephone inquiries concerning this decision should be directed to the undersigned.

Richard M. Ross
Attorney Advisor
(571) 272-3296

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ENRIQUE ESTEVEZ
Allen Dyer Doppelt Milbrath and Gilchrist, PA
255 S. Orange Ave, Suite 1401
Orlando, FL 32801

COPY MAILED

APR 13 2006

OFFICE OF PETITIONS

In re Application of
GERALD A. PIERSON, et al
Application No. 09/938,288
Filed: August 23, 2001
Attorney Docket No. 18554F

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed August 18, 2005.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Enrique G. Estavez (# 37,823), on behalf of himself, Christopher F. Regan (#34,906), Herbert L. Allen (#25,322), Carl M. Napolltano (#37,405), and Jacqueine E. Hartt (#37,845).

The aforementioned attorneys have been withdrawn; all other attorneys remain of record.

The correspondence address change submitted along with the withdrawal has been replaced by a subsequent new change of correspondence address filed on October 3, 2005 by the remaining attorney(s) of record. All future correspondence will be directed to the address below.

There is an outstanding Office action mailed February 21, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Amelia Au at 571.272.7414.

Amelia Au
Petitions Examiner
Office of Petitions

cc: BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON TX 77208-1389

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : February 07, 2007

TO SPE OF : ART UNIT 3737

09/938308

SUBJECT : Request for Certificate of Correction on Patent No.: 6790187 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Elisha Evans
Certificates of Correction Branch
Tel. No. 703-308-9390 EXT 110

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

_____

_____

_____

_____

_____

_____ 3768
SPE **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper 15

ACCENTURE C/O MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304

COPY MAILED

JUL 2 8 2003

OFFICE OF PETITIONS

In re Application of
Chris Scotto, Greg Boyer, Robert Hope,
Maureen Krezmien and Andrew Hopkins
Application No. 09/938,328
Filed: August 23, 2001
Attorney Docket Number: 426882000600
Title of Invention: METHOD FOR GUIDING A BUSINESS AFTER AN INITIAL FUNDING STATE TO AN INITIAL PUBLIC OFFERING READINESS STATE

: DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), filed July 21, 2003, to revive the above-identified application.

This above-identified application became abandoned for failure to file a response to the Decision on Petition which dismissed petitioner's request for Rule 47 status. The Decision on Petition was mailed on July 23, 2002 and set an extendable two month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on September 24, 2002. A Notice of Abandonment was mailed on March 17, 2003.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met.[1] This petition is hereby **Granted**.

Deposit account no. 03-1952 has been charged the $1300.00 petition fee.

The address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition. However, the Office will mail all future correspondence solely to the address of record.

This application is being forwarded to the Office of Initial Patent Examination for further processing of the application.

---

[1]Petitioner has obtained a fully executed declaration.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

cc: Robert E. Scheid
Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105

UNITED STATES 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

COPY MAILED

JUL 2 8 2003

OFFICE OF PETITIONS

ACCENTURE C/O MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304

In re Application of
Chris Scotto, Greg Boyer, Robert Hope,
Maureen Krezmien and Andrew Hopkins
Application No. 09/938,328
Filed: August 23, 2001
Attorney Docket Number: 426882000600
Title of Invention: METHOD FOR GUIDING A BUSINESS AFTER AN INITIAL FUNDING STATE TO AN INITIAL PUBLIC OFFERING READINESS STATE

ON RENEWED PETITION

This is in response to the renewed petition under 37 CFR 1.47(a), filed July 21, 2003.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered to be moot. This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this Office for further consideration under 37 CFR 1.47(a).

The 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 will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
Petitions Attorney
Office of Petitions

cc: Robert E. Scheid
Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105

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

MORRISON & FOERSTER LLP
2000 PENNSYLVANIA AVE, NW
SUITE 5500
WASHINGTON, DC 20006-1888

COPY MAILED

JUL 2 3 2002

OFFICE OF PETITIONS

In re Application of
Scotto, et al.
Application No. 09/938,328
Filed: August 23, 2001
Attorney Docket Number: 426882000600

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed on April 26, 2002 under 37 CFR §1.47(a).

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on August 23, 2001, without an executed oath or declaration. Accordingly, on September 26, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an the basic filing fee, executed oath or declaration and a $65.00 surcharge for its late filing.

In response, on April 26, 2002, applicant filed a $65.00 surcharge, a partially executed oath, basic filing fee and to make the petition timely a five month request for extension of time.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and, (4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (1) as set forth above. Rule 47 applicant states inventor Boyer can not be located. Rule 47 applicant provided a statement of facts that indicates assignment and declaration papers were mailed to inventor Boyer, which were returned because inventor Boyer no longer resides at the last known address. A phone call was made to inventor Boyer's last known number but the phone number was no longer in service and no forwarding information was provided.

However, rule 47 applicant has failed to provide sufficient facts that would prove diligent efforts were made to locate inventor Boyer. Additional efforts need to be demonstrated to illustrate diligent effort. Did inventor Boyer's personnel file contain an

emergency contact number? Did rule 47 applicant attempt to call the emergency contact for forwarding information? Did rule 47 applicant contact former colleagues to determine if they had a forwarding address for inventor Boyer? Did rule 47 applicant do an electronic search for inventor Boyer?

Upon renewed petition, rule 47 applicant may wish to state any additional actions that have been taken in an attempt to locate inventor Boyer to establish diligent effort was used to locate inventor Boyer.

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 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

FOLEY & LARDNER LLP
321 NORTH CLARK STREET
SUITE 2800
CHICAGO, IL 60610-4764

COPY MAILED

FEB 24 2006

OFFICE OF PETITIONS

In re Application of :
Souissi, et al. :
Application No. 09/938,357 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. 05118-45 (6507/60484)

This is a decision on the petition under 37 CFR 1.181 filed on February 13, 2006, to withdraw the holding of abandonment in the above-cited application.

The petition is **DISMISSED**.

The above-identified application became abandoned for failure to reply to the Notice of Allowance and Issue Fee Due, mailed January 14, 2005, which set a period for reply of three-months from its mailing date. No response was received within the allowable period, and the application became abandoned on April 15, 2005.

Petitioner argues that the Notice of Allowance and Issue Fee Due was sent to an incorrect address for the previous attorney of record. As evidence of the same, an Office date-stamp postcard whereby the Office acknowledged having received a change of correspondence address for the previous attorney on November 12, 2003 accompanied the instant petition. It does not appear that the change of correspondence address for the previous attorney was entered. The record does reflect that the Notice of Allowance and Issue Fee Due was returned to the Office as undeliverable.

Petitioner's argument is noted and is persuasive in many respects, however; petitioner has not established that Mr. Bartels was the attorney of record at the time the Notice of Allowance and Issue Fee Due was sent and that his address was supposed to be the correspondence address of record. Petitioner indicates that the application was transferred from Mr. Bartels' firm to Foley & Lardner, LLP; petitioner does not indicate when this transfer occurred. This is relevant to the disposition of the petition because applicant's are required to provided timely notification of a change of correspondence address and/or change of power of attorney. While it is regrettable that the Office failed to enter the request for change of correspondence address in November 2003, the Notice of Allowance and Issue Fee Due was not mailed until November 14, 2005, and petitioner has not established that the Mr. Bartels' was the attorney of record at that time and that his firm was properly recognized as the correspondence address of record. Petitioner is also advised that although the change of correspondence address filed August 29, 2005, by Foley and Lardner, LLP was entered it does not appear that it should have been because, according to Office records, Foley & Lardner has not been given power of attorney in this application, and had no authority to request a change in the correspondence address.

The renewed petition must establish that Mr. Bartles was the attorney of record on the date the Notice of Allowance and Issue Fee Due was mailed. A statement from a person having first-hand knowledge of this fact may accomplish this. Petitioner must also explain when Foley & Lardner, LLP was given power of attorney over this application and should provide a proper Revocation of Power of Attorney and Appointment of Power of Attorney.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries regarding this decision should be directed to the undersigned (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

FOLEY & LARDNER LLP
321 NORTH CLARK STREET
SUITE 2800
CHICAGO IL 60610-4764

COPY MAILED
SEP 28 2006
OFFICE OF PETITIONS

In re Application of

Souissi, et al.

Application No. 09/938,357

Filed: August 23, 20001

Attorney Docket No. 05118-45 (6507/60484)

DECISION ON PETITION

This is a decision on the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed June 30, 2006.

The renewed petition is **granted**.

The above-identified application became abandoned for failure to reply to the Notice of Allowance and Issue fee Due mailed January 14, 2005, which set a statutory period for reply of three-months from its mailing date. No response was received within the allowable period and the application became abandoned on April 15, 2005. A petition to withdraw the holding of abandonment was first filed n February 13, 2006, and dismissed by a decision mailed February 24, 2006.

Section 711.03(c)(II) of the *Manual of Patent Examining Procedure* ("MPEP") provides that in order to establish non-receipt of an Office action so as prove that the imposition of a holding of abandonment is improper, petitioner must: 1) provide a statement to the Office indicating that the Office action was not received by petitioner; 2) include in the statement an attestation to the fact that a review of the file jacket and docket records maintained by petitioner indicates that the Office action was not received; and 3) provide a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

Petitioner has met the burden of proof as established by Section 711.03(c)(II) of the MPEP. The holding of abandonment is, therefore, withdrawn.

The application file is being forwarded to Technology Center 2600, GAU 2614 for further processing that may include remailing of the Notice of Allowance and Issue Fee Due and resetting of the period for reply.

Questions concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 8

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

COPY MAILED

JUN 18 2002

OFFICE OF PETITIONS

In re Application of
Vyakarnam, et al.
Application No. 09/938,364
Filed: August 24, 2001
Attorney Docket No. ETH1595
FOR: FOAM COMPOSITE FOR THE REPAIR OR REGENERATION OF TISSUE

DECISION ON PETITION

This is a decision on the petition entitled, "Appeal of Dismissal of Petition Regarding Notice of Incomplete Non-provisional Application under 37 CFR 1.53(a)," filed May 20, 2002 (certificate of mailing date May 15, 2002), requesting that the above-identified application be accorded a filing date of August 24, 2001. The petition will be treated under 37 CFR 1.53(e).

The petition is granted.

The application was deposited on August 24, 2001. However, on September 14, 2001, the Office of Initial Patent Examination mailed a "Notice" requiring drawings of applicants' invention in compliance with 35 U.S.C. 113 and stating that the filing date would be the date of receipt of the omitted drawings. It is noted that the specification describes Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12,and 13. Applicants' first petition to accord an August 24, 2001 filing date to the above-identified application, filed January 2, 2002 (certificate of mailing date November 14, 2001), was dismissed on April 19, 2002.

In response to the April 19, 2002 dismissal, petitioners timely filed the present reconsideration petition. Petitioners request that the application be accorded an August 24, 2001 filing date on the basis that 15 sheets of drawing figures, including Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12,and 13, were received in the Patent and Trademark Office (PTO) on August 24, 2001. In support, the petition is accompanied by a copy of applicant's itemized postcard receipt showing an Office of Initial Patent Examination generated barcode citing August 24, 2001 as the date of receipt. The postcard lists, *inter alia*, that the filing included 15 sheets of drawings.

The return postcard constitutes *prima facie* evidence that 15 sheets of drawing figures, including Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12,and 13, were filed on August 24, 2001. MPEP 503. Accordingly, the request is granted.

The application is being returned to Office of Initial Patent Examination for further processing with a filing date of **August 24, 2001**, using the copies of Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12,and 13 submitted on January 2, 2002 (certificate of mailing date November 14,

2001). Office records will be corrected to show that 15 sheets of drawings were present on filing.

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

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. 6

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

COPY MAILED

APR 1 9 2002

OFFICE OF PETITIONS

In re Application of
Vyakarnam, et al.
Application No. 09/938,364
Deposited: August 24, 2001
Filing Date: January 2, 2002
Attorney Docket No. ETH1595

DECISION ON
PETITION

This is a decision on (1) the petition filed January 2, 2002(certificate of mailing date November 14, 2001), requesting that the above-identified application be accorded a filing date of August 24, 2001 and (2) the petition for acceptance of photographs, both black and white and color.

The petition to accord an August 24, 2001 filing date is dismissed.

The petition to accept black and white and color photographs is 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(a) are permitted.

PETITION FOR FILING DATE OF AUGUST 24, 2001

The application was deposited on August 24, 2001. However, on September 14, 2001, the Office of Initial Patent Examination mailed a "Notice" requiring drawings of applicants' invention in compliance with 35 U.S.C. 113 and stating that the filing date would be the date of receipt of the omitted drawings. It is noted that the specification describes Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12,and 13.

In response, on January 2, 2002 (certificate of mailing date November 14, 2001), fifteen (15) sheets of drawings containing Figures 1-13 as listed above and the present petition were filed. Petitioners argue that 15 sheets of drawings containing Figures 1-13 as listed above were filed on August 24, 2001, and that the sheets of drawings containing Figures 1-13 as listed above must have been misplaced in the Patent and Trademark Office (PTO). In support, the petition is accompanied by declarations of Ms. Karen Hall-Morgan, Patent Paralegal for Johnson and Johnson and an itemized post card receipt showing 15 sheets of drawings were part of the application on August 24, 2001.

Ms. Hall-Morgan states that on August 24, 2001, she placed the application, including 15 sheets of drawings into Express Mail.

The evidence has been considered, but is not persuasive that the 15 sheets of drawings were filed on August 24, 2001. The PTO file is the official record of the papers originally filed in this application. A review of the official file reveals that no drawings were filed on August 24, 2001, since no such drawings are present in the file. An applicant alleging that a paper was filed in the PTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence. The declaration relied on contain the declarant's recall of routine events which occurred over 2 months earlier and is not more persuasive than the record of what was filed as shown by the official file.

Further, Petitioner is advised that the provisions of 37 CFR 1.10(e) cannot be utilized to prove the contents of a mailing. MPEP 513 states, "Where there is a dispute as to the contents of correspondence submitted to the Office,...an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s)... were filed in the Office with such correspondence. Even if the "date-in" on Express Mail receipt label no. EL691435329US were filled in, it would not impact the analysis at hand. Rather, where the records of the Office (e.g. the file of the application) contain any document(s)... corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP 503 containing specific itemization of the document(s)... purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s)...that is not among the official records of the Office."

The best evidence of what was filed on August 24, 2001, is applicants' postcard receipt. A date stamped return postcard constitutes *prima facie* evidence that the application was filed on the date that is stamped on the postcard. MPEP 503. In this case, unfortunately, the itemized postcard in this case was not date stamped.

The request for an August 24, 2001 filing date is dismissed. The filing date, as of now, is January 2, 2002, which is the date of receipt in the Office of the drawings required by 35 U.S.C. 113, first sentence.[1]

Pursuant to petitioners' authorization, deposit account no. 10-0750 will be charged the $130.00 petition fee associated with a petition under 37 CFR 1.53(e)(2).

If petitioner is unable to provide a date stamped itemized postcard receipt, petitioner is urged to file a petition under 37 CFR 1.182. A review of the file confirms that the transmittal letter deposited on August 24, 2001, incorporated by reference the entire disclosure of prior application No. 09/469,118. The entire disclosure, including the drawings of application No. 09/469,118 was specifically incorporated by reference in the present application on August 24, 2001.

If the drawings supplied on January 2, 2002, are a part of the disclosure of application No. 09/469,118, then the drawings would have been present in the Office on August 24, 2001, albeit in the file of another application, i.e., application No. 09/469,118. Petitioner has not represented that the drawings supplied on January 2, 2002 are copies of the drawings filed in application No.

[1] November 14, 2001, the certificate of mailing date, cannot be relied upon to obtain a filing date.

09/469,118.

A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material (the drawing figures), 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 upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

PETITION FOR ACCEPTANCE OF PHOTOGRAPHS

Regarding the black and white photographs, petitioners have stated that the photographs are the only practicable medium for illustrating the claimed invention.

Regarding the color photographs, a grantable petition under 37 CFR § 1.84(b)(2) must be accompanied by the fee set forth under 37 CFR § 1.17(h), 3 (three) sets of the color photographs in question, and the specification must contain, or be amended to contain, the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings:

"The file of this patent contains at least one photograph executed in color. Copies of this patent with color photograph(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

Pursuant to petitioners' authorization, deposit account no. 10-0750 will be charged the $130.00 petition fee. The petition was filed with the required fee and 3 (three) sets of color photographs of figures 10 and 11. The requested amendment to the specification contains the language required under 1.84 (a)(2)(I).

The petition to accept photographs, both black and white and color, is **GRANTED**.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of January 2, 2002, using the 15 sheets of drawings submitted with the instant petition on January 2, 2002. Thereafter, the application file will be forwarded to Drafting Division, Drawing Review Branch for review of the drawing figures in light of this decision.

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
Attn: E. Shirene Willis

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.gov

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COPY MAILED

NOV 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Murty N. Vyakarnam et al :
Application No. 09/938,364 : ON PETITION
Filed: August 24, 2001 :
Attorney Docket No. ETH1595 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 20, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue/publication fee in a timely manner in reply to the Notice of Allowance mailed August 28, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on November 29, 2003.

There is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: PTOL-85(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

SAWYER LAW GROUP LLP
2465 E. BAYSHORE ROAD, SUITE NO. 406
PALO ALTO, CA 94303

RECEIVED
JAN 30 2009
OFFICE OF PETITIONS

In re Application of :
Harry S. HVOSTOV et al. :
Application No. 09/938,373 : DECISION ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. M-11996 US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 14, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, April 06, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 7, 2005.

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

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (almost 3 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 July 06, 2005. 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, counsel of record at the time of abandonment should explain why this application became abandoned while it was under their control and what efforts were 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 persons, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been,

without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 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 and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.

David Bucci
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

KENNETH I KOHN
KOHN & ASSOCIATES
30500 NORTHWESTERN HIGHWAY, SUITE 410
FARMINGTON HILLS, MI 48334

COPY MAILED

JUL 1 5 2002

OFFICE OF PETITIONS

In re Application of :
Xiao Tong et al :DECISION DISMISSING PETITION
Application No. 09/938,391 :PETITION UNDER 37 CFR 1.137(b)
Filed: August 24, 2001 :
Attorney Docket No. 3153.0034/PC10790A :

This is a decision on the petition under 37 CFR 1.137(b), filed June 20, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 18., 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice to submit an executed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the application number and filing date, and a $130 surcharge fee for its late filing. No reply or timely extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 19, 2001.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a

statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

The reply does not satisfy the requirements of 37 CFR 1.63. In this regard, the declaration submitted fails to identify the application by application number and filing date. Further, the page of the declaration executed by inventor Tong fails to indicate that additional inventors are being named in a supplemental sheet. Accordingly, a newly executed oath or declaration identifying each inventor and identifying the application by application number and filing date in compliance with the provisions of 37 CFR 1.63(a)(2) and 37 CFR 1.63(b)((1) is required.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $1,960 extension of time fee submitted with the petition on June 20, 2002 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account in due course.

In order to expedite revival of this application, petitioner may wish to consider submitting the items required by this decision on petition in a renewed petition under 37 CFR 1.137(b) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

RECEIVED
JUL 18 2002
TECHNOLOGY CENTER

Paper No. 8

KENNETH I KOHN
KOHN & ASSOCIATES
30500 NORTHWESTERN HIGHWAY, SUITE 410
FARMINGTON HILLS, MI 48334

FAX RECEIVED
AUG 0 7 2002
PETITIONS OFFICE

COPY MAILED

JUL 1 5 2002

OFFICE OF PETITIONS

In re Application of
Xiao Tong et al
Application No. 09/938,391
Filed: August 24, 2001
Attorney Docket No. 3153.0034/PC10790A

:DECISION DISMISSING PETITION
:PETITION UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed June 20, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 18., 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice to submit an executed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the application number and filing date, and a $130 surcharge fee for its late filing. No reply or timely extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 19, 2001.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a

statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

The reply does not satisfy the requirements of 37 CFR 1.63. In this regard, the declaration submitted fails to identify the application by application number and filing date. Further, the page of the declaration executed by inventor Tong fails to indicate that additional inventors are being named in a supplemental sheet. Accordingly, a newly executed oath or declaration identifying each inventor and identifying the application by application number and filing date in compliance with the provisions of 37 CFR 1.63(a)(2) and 37 CER 1.63(b)((1) is required.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $1,960 extension of time fee submitted with the petition on June 20, 2002 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account in due course.

In order to expedite revival of this application, petitioner may wish to consider submitting the items required by this decision on petition in a renewed petition under 37 CFR 1.137(b) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 10

KENNETH I KOHN
KOHN & ASSOCIATES
30500 NORTHWESTERN HIGHWAY, SUITE 410
FARMINGTON HILLS, MI 48334

COPY MAILED

SEP 13 2002

OFFICE OF PETITIONS

In re Application of	:
Xiao Tong et al	:DECISION DISMISSING PETITION
Application No. 09/938,391	:PETITION UNDER 37 CFR 1.137(b)
Filed: August 24, 2001	:
Attorney Docket No. 3153.0034/PC10790A	:

This is a decision on the renewed petition under 37 CFR 1.137(b), filed by facsimile transmission on August 7, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

The petition filed on June 20, 2002 was dismissed in a decision mailed July 15, 2002 in

view of the submission of a defective declaration. More specifically, the decision stated:

> The reply does not satisfy the requirements of 37 CFR 1.63. In this regard, the declaration submitted fails to identify the application by application number and filing date. Further, the page of the declaration executed by inventor Tong fails to indicate that additional inventors are being named in a supplemental sheet. Accordingly, a newly executed oath or declaration identifying each inventor and identifying the application by application number and filing date in compliance with the provisions of 37 CFR 1.63(a)(2) and 37 CFR 1.63(b)((1) is required.

It is further noted that the originally filed declaration further fails to identify the instant application by title of the invention.[1] Nevertheless, the declaration submitted with the instant renewed petition to revive is unacceptable for the additional reason that it has been altered after execution. Accordingly, a declaration in compliance with 37 CFR 1.63 and 1.64 must be submitted to revive the instant application.

In order to expedite revival of this application, petitioner may wish to consider submitting the items required by this decision on petition in a renewed petition under 37 CFR 1.137(b) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

---

[1] It appears that the first page of the declaration was not submitted at the time of filing of the petition to revive on June 20, 2002.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 13

KENNETH I KOHN
KOHN & ASSOCIATES
30500 NORTHWESTERN HIGHWAY, SUITE 410
FARMINGTON HILLS, MI 48334

COPY MAILED

OCT 1 5 2002

OFFICE OF PETITIONS

In re Application of :
Xiao Tong et al :DECISION GRANTING RENEWED
Application No. 09/938,391 :PETITION UNDER 37 CFR 1.137(b)
Filed: August 24, 2001 :
Attorney Docket No. 3153.0034/PC10790A :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed by facsimile transmission on October 4, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 18., 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice to submit an executed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the application number and filing date, and a $130 surcharge fee for its late filing. No reply or timely extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 19, 2001.

The declaration submitted on October 4, 2002 has been found to be acceptable and has been made of record in the application file. All requirements for a grantable petition under 37 CFR 1.137(b) have now been satisfied.

This application is being forwarded to the Office of Initial Patent Examination to complete processing of the application.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(703) 305-8680

UNITED STATES 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

DEC 0 6 2004

OFFICE OF PETITIONS

KAREN J. LENKER
408 PANGRAMA DRIVE
LAGUNA BEACH, CA 92651

In re Application of
Eugene Michael Breznovk, et al.
Application No. 09/938,428
Filed: August 23, 2001
Attorney Docket No: None

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed October 5, 2004.

The petition is GRANTED.

The application became abandoned for failure to pay the issue fee on or before September 3 2004. Receipt is acknowledged of the requisite issue fee on October 5, 2004, using a Certificate of Mailing or Transmission under 37 CFR 1.8 dated September 30, 2004.

It is noted that a Notice to Pay Balance of Issue Fee was mailed November 22, 2004. However, the notice was mailed in error since the issue fee was paid using a certificate of mailing or transmission under 37 CFR 1.8 dated before the effective date of the fee increase.

The application is being forwarded to Publishing Division.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (703) 305-8283.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

FEB 14 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ACLARA BIOSCIENCES, INC.
1288 PEAR AVENUE
MOUNTAIN VIEW CA 94043

In re Application of:
Hooperr et al.
Serial No.: 09/938,439
Filed: August 23, 2001
Attorney Docket No.: 057.01US

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicants' petition under 37 CFR § 1.181(a) filed on April 7, 2003, requesting withdrawal of the holding of abandonment based on the timely filing of a response to the Office action mailed September 3, 2002. The delay in responding to this petition is regretted.

A review of the file history shows that the examiner mailed an Office action to applicants on September 3, 2002, setting a one-month statutory time period for reply. On March 20, 2003, the examiner mailed a notice of abandonment for failure to respond to the outstanding Office action.

Applicants state that a response to the Office action was filed on September 18, 2002, as evidenced by the post card identifying the papers filed and showing a USPTO date-stamped receipt of September 18, 2002.

In view of this evidence, applicants are considered to have submitted a timely reply.

Applicants' petition is **GRANTED** retroactively as this application is no longer in abandoned status.

Should there be any questions about this decision, please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile at 703-872-9306.

Marianne C. Seidel for

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. **12**

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COPY MAILED

JAN 3 0 2003

OFFICE OF PETITIONS

In re Application of
Carol J. Collins et al
Application No. 09/938,454
Filed: August 24, 2001
Attorney Docket No. NEU-40

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(f)

This is a decision on the petition, filed by facsimile transmission on January 10, 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 or after August 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 under 37 CFR 1.137(f) must be accompanied by:

(1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Corrected Filing Receipt which sets forth the projected publication date of May 8, 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 1615 for appropriate action on the reply received January 8, 2003 to the nonfinal Office action mailed September 3, 2002.

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

ZILKA-KOTAB, PC
P.O. BOX 721120
SAN JOSE CA 95172-1120

COPY MAILED
JUN 2 2 2006
OFFICE OF PETITIONS

In re Application of :
Biskeborn :
Application No. 09/938,457 : ON PETITION
Filed: August 23, 2001 :
Attorney Docket No. SJ09-2001-0135US1/IBM1P00 :

This is a decision on the petition under 37 CFR 1.181, filed May 24, 2005 and resubmitted on June 7, 2005 and November 7, 2005 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 is **GRANTED**.

The Office contended that the above-identified application became abandoned for failure to submit a response to the November 4, 2004 Restriction Requirement, which set an extendable one (1) month period for reply. No extensions of time or reply being received, the Office contended that this application became abandoned on December 5, 2004. A Notice of Abandonment was mailed on June 3, 2005.

Petitioner alleges that the November 4, 2004 Restriction Requirement was not received at the correspondence address of record.

The showing required to establish non-receipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
2. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1]

[1] See notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Petitioner has submitted a copy of two docket records where the requirement would have been entered had the November 4, 2004 Restriction Requirement been received. In addition, practitioner referenced the records in the petition and stated that a review of the application's file and docket records for the November 4, 2004 Restriction Requirement was fruitless.

For future reference when filing a Rule 181 petition alleging non-receipt, petitioner should not modify docket records **by word processing** to show where the outstanding requirement would have been entered had it been received. Annotations to the docket records should be handwritten, so to avoid confusion as to when the changes were made.

Petitioner has established non-receipt. The petition is **granted**, the Notice of Abandonment is vacated, and the holding of abandonment is withdrawn.

Regarding finances, petitioner was charged two $130.00 petition fees. No petition fee is required. Therefore, deposit account no. 09-0466 will be refunded $260.00.

After the mailing of this decision, the application will be returned to Technology Center AU 3724 for the re-mailing of the November 4, 2004 Restriction Requirement with a new period set for reply.

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

Paper No. None

COPY MAILED

MAR 0 9 2006

OFFICE OF PETITIONS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of :
John R. Milton :
Application No. 09/938,465 : DECISION ON PETITION UNDER
Filed: August 23, 2001 : 37 C.F.R. §1.181(A)
Attorney Docket Number: :
10010979-1 :
Title: SYSTEM AND METHOD FOR :
TRACKING PLACEMENT AND USAGE OF :
CONTENT IN A PUBLICATION :

This is a decision on the petition under 37 CFR §1.181(a), filed January 24, 2006, to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed April 21, 2005, which set a shortened statutory period for reply of three (3) months. An after-final amendment was received on May 25, 2005, and an advisory action was mailed on June 13, 2005. No further responses were received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 22, 2005. A notice of abandonment was mailed on December 23, 2005.

With the present petition, Petitioner has asserted that he did not believe that any action needed to be taken after receiving the advisory action, due to a telephone conversation he allegedly had with the Examiner. Petitioner asserts that he was informed over the phone that a new office action would be forthcoming - and thus he "took no further action in the case[1]," relying on this oral promise.

1 Petition, paragraph 8.

In short, Petitioner decided it best to discount the advisory action, based on an understanding he purportedly had with the Examiner. 37 C.F.R. §1.2 sets forth, *in toto*:

> All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

As such, Petitioner cannot rely on the oral assurance which was allegedly made by the Examiner, and this petition must be **DISMISSED**.

NOTICE:

Any request for reconsideration of this decision under 37 C.F.R. §1.137(a) 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 request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181," and should only address the deficiencies noted in this decision.

Thereafter, there will be no further reconsideration of this matter[2, 3].

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries

---

2 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

3 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will **not** apply to that decision.

concerning examination procedures or status of the application should be directed to the Technology Center.

Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) or (b). No assurance can be made that any remedy will be forthcoming.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at http://www.uspto.gov/web/forms/sb0122.pdf.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

cc: DAURELIO,MICHAEL
Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Parkway, N.W.
Suite 1750
Atlanta, GA 30339--594

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

COPY MAILED
SEP 25 2006
OFFICE OF PETITIONS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of :
John R. Milton :
Application No. 09/938,465 : DECISION ON RENEWED PETITION
Filed: August 23, 2001 : UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: :
10010979-1 :
Title: SYSTEM AND METHOD FOR :
TRACKING PLACEMENT AND USAGE OF :
CONTENT IN A PUBLICATION :

Background

This is a decision on the renewed petition under 37 CFR §1.181(a), filed May 1, 2006, to withdraw the holding of abandonment.

The request to withdraw the holding of abandonment is **DENIED**[1].

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed April 21, 2005, which set a shortened statutory period for reply of three (3) months. An after-final amendment was received on May 25, 2005, and an advisory action was mailed on June 13, 2005. No further responses were received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 22, 2005. A notice of abandonment was mailed on December 23, 2005.

The original petition was submitted on January 24, 2006, and was dismissed via the mailing of a decision on March 9, 2006. With

1 This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

the present petition pursuant to 37 C.F.R. §1.181(a), Petitioner has again failed to establish that the holding of abandonment should be withdrawn. A discussion follows.

The Relevant Law and Regulations

35 U.S.C. 133: Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. §1.2: 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.

§ 1.113: Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1,

2003; para. (a) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Analysis

With the original petition, Petitioner asserted that he did not believe that any action needed to be taken after receiving the advisory action which was mailed in response to an after-final amendment, due to a telephone conversation he had with the Examiner. Petitioner asserted that he was informed over the phone that a new office action would be forthcoming - and thus he "took no further action in the case[2]," relying on this oral understanding.

In short, Petitioner decided it best to discount the advisory action, based on an understanding he had with the Examiner. The original petition was dismissed via the mailing of a decision on March 9, 2006, since 37 C.F.R. §1.2 prohibits reliance on an oral assurance which was made by the Examiner.

Since the mailing of this decision, the Examiner has introduced an interview summary into the record, where a conversation which took place more than 6 months prior is memorialized. With this renewed petition, Petitioner would have the Office grant his

2 Original petition, paragraph 8.

request and withdraw the holding of abandonment, as this interview summary constitutes "written evidence of record[3]."

It is noted in passing that this interview summary indicates that the Examiner would issue a new office action, but nowhere is it stated that the final Office action would be withdrawn.

The failure to submit a response

As described above, Petitioner received a final Office action, submitted an after-final amendment, and received an advisory action in response thereto. Petitioner then spoke with the Examiner and received an oral assurance that a new office action would be forthcoming. 35 U.S.C. §1.113(c) clearly states that the proper response to a final rejection must include either the cancellation or appeal from the rejection of each rejected claim, and that if any claims stand allowed, the reply to the final rejection must comply with any requirements or objections to form. Put simply, a reply to a final rejection must consist of some form of a response. However, Petitioner did not submit any response, as he decided against taking any further action.

Petitioner will note U.S.C. §133 is a self-executing law, which indicates that upon the failure of the applicant to prosecute the application within six months after any action therein, the application shall be regarded as abandoned by the parties thereto. Petitioner received an advisory action, and did not continue the prosecution of this application. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

Petitioner will further note that 37 C.F.R. §1.135 is a self-executing regulation which indicates that the failure to reply within the time period provided under 37 C.F.R. §§1.134 and § 1.136 will result in the abandonment of the application. Furthermore, Petitioner did not further prosecution of this application to save the same from abandonment, as no reply was submitted in response to the advisory action. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

The reliance on an oral assurance

The decision on the original decision dismissed Petitioner's request to withdraw the holding of abandonment, on the grounds that Petitioner's reliance on an oral promise is expressly prohibited by 37 C.F.R. §1.2. With the

3 Renewed petition, page 1.

introduction of this oral understanding into the record via the interview summary, nothing has changed. This information was not placed into the record until more than six months after Petitioner's reliance. At the time of Petitioner's reliance, the understanding was a mere oral promise. This section of the C.F.R. expressly prohibits Petitioner's reliance on the oral understanding, and withdrawal of the holding of the abandonment based on an action which is in contravention to a regulation would be improper.

Furthermore, it is noted that the interview on which this interview summary is based took place on November 10, 2005, which is subsequent to the date on which the present application became abandoned (July 22, 2005). Petitioner cannot rely on this interview summary, for an Examiner no longer has jurisdiction over an application once an application becomes abandoned.

CONCLUSION

The prior decision which refused to withdraw the holding of abandonment under 37 C.F.R §1.181(a) has been reconsidered. For the above stated reasons, the holding of abandonment will not be withdrawn.

As stated in the previous decision, no further reconsideration or review of this matter will be undertaken.

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 Senior Attorney Paul Shanoski at (571) 272-3225.

Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office

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.
09/932,465	08/23/2001	John R. Milton	10010979-1	4080

7590 04/24/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
CORRIELUS, JEAN M	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

BEST AVAILABLE COPY

notice mailed by the Office on December 23, 2005 be withdrawn and that the prosecution of the application be resumed.

2. Submitted herewith is:

- ☐ A copy of the page of the response mailed _____ showing a Certificate of Mailing executed on _____.
- ☐ A copy of the post card identifying the papers filed and showing the USPTO receipt stamp dated _____.
- ☐ A copy of the complete response previously filed.
- ☐ A copy of the attorney's Deposit Account Statement in which the item corresponding to the response referred to above is checked.
- ☐ A statement of facts as set forth in the 37 CFR 1.181(b).
- ☒ Interview Summary mailed on April 24, 2006.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Michael J. D'Aurelio

Michael J. D'Aurelio
Registration Number: 40,977

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

PAGE 2/5 * RCVD AT 5/1/2006 3:09:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/20 * DNIS:2738300 * CSID:7709510933 * DURATION (mm-ss):01-52

BEST AVAILABLE COPY

RECEIVED
CENTRAL FAX CENTER
MAY 0 1 2006

CERTIFICATION UNDER 37 CFR 1.8
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted on the date indicated below via facsimile to the United States Patent and Trademark Office facsimile number (571) 273-8300. Total number of pages in this transmission 6.
Date 5/01/2006
Gloria L. Knox

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: John R. Milton
Application No.: 09/938,465
Filed: August 23, 2001
Confirmation No.: 4080
Group Art Unit: 2162
Examiner: Cornelius, J.
Docket No. 10010979-1
Title: SYSTEM AND METHOD FOR TRACKING PLACEMENT AND USAGE OF CONTENT IN A PUBLICATION

RENEWED PETITION UNDER 37 C.F.R. §1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

1. On March 9, 2006, a Decision was rendered denying a petition filed in the above-identified patent application to withdraw the holding of abandonment. In particular, the Decision noted that the written record did not reflect the oral promise of the Examiner in the above-identified case to render a new Office Action and that any reliance by the Applicant on such oral promises were misplaced as all business must be conducted in writing.

Applicant respectfully renews the Petition to Withdraw the Holding of Abandonment under 37 C.F.R. §1.181 as the record now includes an Interview Summary that evidences the promise that was made during conversations between the Examiner and the undersigned that the Examiner would issue a new Office Action in the case after issuing the Advisory Action of June 13, 2005. Attached is a copy of the Interview Summary in the above-identified application that states the amendment of May 25, 2005 would be considered and that a new Office Action would be forth coming.

In this respect, Applicant restates the facts and arguments presented with the petition filed on January 24, 2006. In view of the written evidence of record in the above-identified application, Applicant respectfully requests that that the abandonment set forth in the

PAGE 1/5 * RCVD AT 5/1/2006 3:09:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/20 * DNIS:2738300 * CSID:7709510933 * DURATION (mm-ss):01-52

BEST AVAILABLE COPY

Interview Summary	Application No. 09/938,485	Applicant(s) MILTON, JOHN R.	
	Examiner Jean M. Corrielus	Art Unit 2162	

All participants (applicant, applicant's representative, PTO personnel):

(1) Jean M. Corrielus. (3)____.

(2) Michael D'Aurelio (reg. no. 40,977). (4)____.

Date of Interview: 10 November 2005. Case was already abandoned. 711.03

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☐ No.
If Yes, brief description: ____.

Claim(s) discussed: 1.

Identification of prior art discussed: ____.

Agreement with respect to the claims f)☐ was reached. g)☒ was not reached. h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: It was agreed that the amendment filed on May 25, 2005 will consider and a new office action will be forth coming..

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Jean M. Corrielus
Examiner's signature, if required

PAGE 4/5 * RCVD AT 5/1/2006 3:09:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/20 * DNIS:2738300 * CSID:7709510933 * DURATION (mm-ss):01-52

BEST AVAILABLE COPY

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)
In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or 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.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the Examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

PAGE 5/5 * RCVD AT 5/1/2006 3:09:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/20 * DNIS:2738300 * CSID:7709510933 * DURATION (mm-ss):01-52

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Benjamin JAMES
1419 Mandela PKWY
Oakland, CA 94607

MAILED

FEB 15 2006

TECHNOLOGY CENTER 2100

In re Application of:
Benjamin JAMES et al.
Application No. 09/938,472
Filed: August 3, 2000
For: METHOD AND APPARATUS FOR VOUCHER SORTING AND RECONCILLIATION IN SOFT COUNT PROCESS

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR §1.181

This is a decision on the petitions, filed 13 September 2005, under 37 CFR §1.181 to withdraw holding of abandonment of the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to file a timely response to the Final Office action mailed on 30 November 2004. A Notice of Abandonment was mailed on 26 July 2005.

In support of the petition, petitioner asserts that the Office action mailed 30 November 2004 was not received, and that no record of the Office action was found in the applicant's file for this application. Petitioner supplies (1) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; (2) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed; and (3) a Sworn Statement from Inventor, Mr. Benjamin James Jr.

The provided copy of the docket record shows no entry indicating receipt of the Office action mailed 30 November 2004.

Petitioner has met the criteria of set out in MPEP § 711.03(c) for establishing failure to receive the Office action mailed 30 November 2004.

For the above, the petition is **GRANTED**. The abandonment is **WITHDRAWN**.

The application is being forwarded to the Technology Center Support Staff to re-mail the Office action ~~of~~ 30 November 2004.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Zilka-Kotab, PC
P.O. Box 721120
San Jose CA 95172-1120

COPY MAILED

SEP 19 2008

OFFICE OF PETITIONS

In re Application of :
Vignoles et al. :
Application No. 09/938489 :
Filing or 371(c) Date: 08/27/2001 :
Attorney Docket Number: :
01.018.01 : ON PETITION

This is a decision on the "Petititon for Withdrawal of Abandonment," filed August 6, 2008. The petition is properly treated under 37 C.F.R. § 1.181.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed January 9, 2007. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). No response having been received, the application became abandoned on April 10, 2007. A Notice of Abandonment was mailed June 4, 2008.

Applicant files the present petition and asserts that a timely reply to the Office action to wit, a Notice of Appeal (and fee), was filed on March 9, 2007, under the Certificate of Mail procedure set forth in 37 CFR 1.8. In support of this assertion Applicant files a copy of the reply, and a copy of their Electronic Acknowledgment Receipt, which acknowledges receipt by this Office of Notice of Appeal and fee, on March 9, 2008.

A review of Office records also reveals that the Office received a Notice of Appeal and fee on March 9, 2008.

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

Accordingly, the petition is granted. The application is being referred to Technology Center Art Unit 2137 to await the brief in support of appeal.

Applicant has two (2) months from the mailing date of this Decision to file an appeal brief. Extensions of time are available under 37 CFR 1.136(a). Accord, MPEP 1215.01

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

FEB 18 2009

OFFICE OF PETITIONS

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

In re Patent No. 7,226,406	:	
Issued: June 27, 2007	:	
Application No. 09/938,533	:	NOTICE
Filed: August 27, 2001	:	
Attorney Docket No. 22409-00382-US	:	

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED.**

This application no longer qualifies for small entity status. Accordingly, all future fees must be paid at the large entity rate.

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

Foley and Lardner LLP
Suite 500
3000 K Street NW
Washington, DC 20007

COPY MAILED

FEB 0 1 2008

OFFICE OF PETITIONS

In re Application of	:	
Xianxhang Yu et al.	:	
Application No. 09/938,623	:	DECISION ON PETITION
Filed: August 27, 2001	:	TO WITHDRAW
Attorney Docket No. 035879-0125	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 4, 2007.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Foley and Lardner LLP has been revoked by the assignee of the patent application on January 30, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Terri Williams at 571-272-2991.

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Howrey LLP**
c/o IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/20/08

TO SPE OF : ART UNIT 1765 Alanko, Anita

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/938644 Patent No.: 7033514

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

☒ **Approved** — All changes apply.

☐ **Approved in Part** — Specify below which changes **do not** apply.

☐ **Denied** — State the reasons for denial below.

Comments: _____

SPE

1792
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

JJGJr: 03-05

Paper No: __

STANISLAUS AKSMAN
HUNTON & WILLIAMS
SUITE 1200
1900 K STREET, N.W.
WASHINGTON DC 20006

COPY MAILED

MAR 1 1 2005

OFFICE OF PETITIONS

In re Application of
Petersen :
Application No. 09/938,669 : ON PETITION
Filed: 27 August, 2001 :
Attorney Docket No.: 60117.000004 :

This is a decision on the petition filed (with fee) via 18 January, 2005, under 37 C.F.R. §1.182 to withdraw the terminal disclaimers as to Application No. 09/938,667, Application No. 09/938,668, and Application No. 09/938,670.

The petition is **GRANTED**.

BACKGROUND

The petition alleges that Terminal Disclaimers required during prosecution as to the above-identified applications are no longer required after amendment(s) and the close of prosecution because claims previously covered by those Terminal Disclaimers have been cancelled.

The commentary at MPEP §1490 provides in pertinent part:

* * *

A. Before Issuance Of Patent

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un–happy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to

> rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).
>
> Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 C.F.R. 1.182 requesting withdrawal of the recorded terminal disclaimer.
>
> * * *

The Examiner has reviewed the record in the instant case and in the above-identified related cases and has approved the withdrawal of the Terminal Disclaimers as to Application No. 09/938,667, Application No. 09/938,668, and Application No. 09/938,670. (A copy of the Examiner's authorization is being forwarded to be entered into the record.)

The instant application is released to Technology Center 1600 for processing consistent with the instant decision before being released to the Publications Branch to be processed into a patent in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Gillon, John

From: Azpuru, Carlos
Sent: Thursday, March 10, 2005 4:06 PM
To: Gillon, John
Subject: RE: 09/938,669

John,

The correct serial number should be 09/938,670. Sorry about the typo! Carlos Azpuru

-----Original Message-----
From: Gillon, John
Sent: Thursday, March 10, 2005 4:00 PM
To: Azpuru, Carlos
Subject: RE: 09/938,669
Importance: High

Carlos, did you mean to refer to 09/938,670 below, or were you correct as to 09/938,970

The petition refers to 09/938,670

-----Original Message-----
From: Azpuru, Carlos
Sent: Thursday, March 03, 2005 2:51 PM
To: Gillon, John
Subject: RE: 09/938,669

John,

The terminal diclaimer should be withdrawn in 09/938,667 and 09/938,668 since applicant has amended around the rejection. The claims in question in case 09/938,970 have also been cancelled. So all three should be withdrawn. Thanks, Carlos Azpuru

-----Original Message-----
From: Gillon, John
Sent: Thursday, March 03, 2005 10:42 AM
To: Azpuru, Carlos
Cc: Pearson, Charles; Lazarus, Ira
Subject: 09/938,669
Importance: High

Examiner,

The attorney is seeking to withdraw the terminal disclaimers in this case.

Do you approve? YES or NO?

Thanks!

John J. Gillon, Jr., J.D., M.P.H.
Senior Attorney
US Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

STANISLAUS AKSMAN
HUNTON & WILLIAMS
SUITE 1200
1900 K STREET, N.W.
WASHINGTON, DC 20006

COPY MAILED

JUN 27 2005

OFFICE OF PETITIONS

In re Application of :
Jens Petersen :
Application No. 09/938,669 : ON PETITION
Filed: August 27, 2001 :
Attorney Docket No. 60117.000004 :

This is a decision on the petition, filed June 20, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on April 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 1615 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

STANISLAUS AKSMAN
HUNTON & WILLIAMS
SUITE 1200
1900 K STREET, N.W.
WASHINGTON, DC 20006

COPY MAILED

JUL 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Jens Petersen, et al. :
Application No. 09/938,670 : ON PETITION
Filed: August 27, 2001 :
Attorney Docket No. 60117.000007 :

This is a decision on the petition, filed June 20, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 3738 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date : July 7, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Jens Petersen, et al.
Application No. : 09/938,670
Filed : August 27, 2001

The above-identified application has been assigned Patent No. 6,918,932 and an issue date of July 19, 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 July 19, 2005:

"All reference to Patent No. 6,918,932 to JENS PETERSEN, ET AL. of DENMARK for POLYACRYLAMIDE HYDROGEL AND ITS USE AS AN ENDOPROSTHESIS appearing in the Official Gazette of July 19, 2005, should be deleted since no patent was granted."

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Paul Harrison, Crystal Park 3-44l (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-9l0 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane K.Davis, P/OCS, CM1-6A07
Tamara K. Greene, PK3-910

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 23313-1450
WWW.USPTO.GOV

Pet. Dec.

Mailed: JUN 18 2004

DWW
Paper No. ____

In re Application of
Donald Frederick Lyons et al.
Serial No.: 09/938,695
Filed: August 24, 2001

DECISION ON PETITION UNDER *37 CFR 1.48(b)*

For: PROCESS FOR PRODUCING FLUOROELASTOMERS

This is a decision on the request for CORRECTION OF INVENTORSIP UNDER 37 C.F.R. 1.48(b) (herein treated as PETITION TO DELETE CORRECTLY NAMED PERSON WHO IS NOT INVENTOR OF INVENTION NOW BEING CLAIMED) filed December 19, 2003 to correct inventorship under 37 CFR 1.48(b) by deleting the names of Antonio Vidal and J. Francis Wehner from the list of inventors of the instant application.

It is noted that the applicant has met the requirements of (1) a petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (2) the fee set forth in 37 CFR 1.17(i).

The petition is **GRANTED**.

The application file is being forwarded to the appropriate section of the Patent and Trademark Office for correction of the record.

David W. Wu
Supervisory Patent Examiner
Art Unit 1713
Technology Center 1700

DUPONT DOW ELASTOMERS, LLC
Patent Records Center
4417 Lancaster Pike
Barley Mill Plaza 25
Wilmington, DE 19805

ETK 1cm

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

RECEIVED
APR 07 2004
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
LOS ANGELES

Paper No. 21

42390.P12533
Intel Corporation

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

RECEIVED
APR 15 2004
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
COSTA MESA

COPY MAILED
APR 05 2004
OFFICE OF PETITIONS

ON PETITION

In re Application of
Prabhu et al.
Application No. 09/938,699
Filed: August 23, 2001
Attorney Docket No. 42390P12533

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 26, 2004, to revive the above-identified application.

The petition is **granted.** ✓

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed October 10, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on January 13, 2004. A Notice of Abandonment was mailed on February 27, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to the Publishing Division for processing into a patent.

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

ENTERED
APR 14 2004
INTO DATABASE

Date 10/5/2004 ✓ Client: Intel Corporation
Docket Initials _____ 42390.P12533
Dock. Sup. Initials _____
Atty Initials _____ EHT WWS WEA ETK
Pat/Ser/Reg 938,699
Description: 89

Next office action due; if not received, file request for status; application reinstated and forwarded to examiner for further processing on 4/5/2004

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)
6550549	2003-04-22	09938811	2001-12-04	HNY-P10

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	/glenn f ostrager/	Date (YYYY-MM-DD)	2008-06-19
Name	Glenn F. Ostrager	Registration Number	29963

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. 6550549
Issue Date: April 22,2003
Application No. 09938811
Filed: December 4,2001
Attorney Docket No. HNY-P10

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed June 19,2008 ,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 June 19,2008 . 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

JJGJR.: 06-06

Paper No: __

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

COPY MAILED

JUN 19 2006

OFFICE OF PETITIONS

In re Application of :
Suda, et al. : DECISION
Application No.: 09/938,866 :
Filing Date: 24 August, 2001 :
Attorney Docket No. 4233-4005 :

This is a decision on the petition filed on 10 April, 2006, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 27 December, 2005, with reply due absent extension of time on or before 27 March, 2006;
- the instant application went abandoned after midnight 27 March, 2006;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;
- the record indicates that the Office action was returned by the US Postal Service to the Office as undelivered–and it appears that the materials were incorrectly addressed;

- on 10 April, 2006, Petitioner filed the instant petition, averred non-receipt–it is noted that Petitioner does not appear to have changed address without Notice to the Office and, as indicated above, the record reflects that the Office action was returned by the USPS to the Office as undelivered and the materials appeared to bear an incorrect mailing address;

- Petitioner has requested the Office to correct his mailing address to that which previously had been of record and that correction has been made;

- 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]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[2] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[4] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

Further, the commentary at MPEP §711.03(c) provides:

* * *

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

* **

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).

---

[8] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

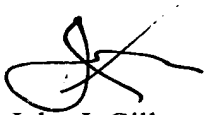
As of this writing Petitioner appears to have satisfied the showing requirements described above.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **granted**.

The application is released to Technology Center 2100 to remail and reset the reply time for the non-final Office action previously mailed on 27 December, 2005, in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 11

FOSTER & FOSTER, LLC
MR. LYNN G. FOSTER
602 EAST 300 SOUTH
SALT LAKE CITY, UT 84102

COPY MAILED

JUL 13 2005

OFFICE OF PETITIONS

In re Application of :
Plaia et al. :
Application No. 09/938,882 : ON PETITION
Filed: August 24, 2001 :
Attorney Docket No. 5770.CD2C.2 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 18, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed December 17, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on March 18, 2004. A Notice of Abandonment was mailed July 13, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This file is being forwarded to Technology Center 3700 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

FOSTER & FOSTER, LLC
MR. LYNN G. FOSTER
602 E. 300 S.
SALT LAKE CITY, UT 84102

COPY MAILED

JUN 1 3 2006

OFFICE OF PETITIONS

In re Application of	:	
Plaia et al.	:	DECISION ON PETITION
Application No. 09/938,882	:	TO WITHDRAW
Filed: August 24, 2001	:	FROM RECORD
Attorney Docket No. 5770.CD2C.2	:	

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 6, 2006.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Lynn G. Foster, the sole attorney of record. Lynn G. Foster has been withdrawn as attorney 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 at the first below-listed address until otherwise properly notified by the applicants.

There is an outstanding Office action mailed February 24, 2006 that requires a reply.

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

David Bucci
Petitions Examiner
Office of Petitions

Cc:

MARK PLAIA
9741 SW MCDONALD STREET
TIGARD, OR 97224

THOMAS A. WIITA, PRESIDENT & CEO
ENDOVASCULAR INSTRUMENTS, INC.
2501 SE COLUMBIA WAY, SUITE 150
VANCOUVER, WA 98661-8038

UNITED STATES 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

Paper No. 11

FEB 12 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES CA 90025

In re Application of MUKESH K. PATEL, ET AL.
Application No.: 09/938,886
Filed: August 24, 2001
For: **JAVA VIRTUAL MACHINE HARDWARE FOR RISC AND CISC PROCESSORS**

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(II)

This is a decision on the petition, filed December 11, 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(II) 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), and (2) 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, and has sent one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

The petition filed December 11, 2003 meets all of the requirements above; accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for promptly examining this application out of turn according to the procedures set forth in M.P.E.P. §708.02.

Bot LeDynh, J.D., Ph.D.
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 305-0651

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

JUN 26 2006

OFFICE OF PETITIONS

Allen-Bradley Company LLC
Patent Department/704P Floor 8 T-29
1201 South Second Street
Milwaukee, Wisconsin 53204

In re Application of
Nisley et al.
Application No. 09/938,888
Patent No.6,939,053
Filed: August 24, 2001
Attorney Docket No.
DODG:0045/YOD/EUB01RE151

: DECISION GRANTING PETITION

This decision is in response to Applicants' "APPLICATION FOR PATENT TERM ADJUSTMENT under (37 CFR 1.705(d)) " filed on November 4, 2005 requesting that the Office adjust the PTA determination at the time of the mailing of the notice of issuance from a determination of 29 days to a determination of 730 or 850 days.

The application for PTA is **GRANTED.** The Office will adjust the PTA calculation at the time of the issuance of the patent to reflect a determination of 730 days. The Office will *sua sponte* issue a certificate of correction. The Office will further adjust the PAIR calculation to reflect this decision.

Applicants are given **thirty (30) days** to file a response to this decision. If applicants agree with this decision, then applicants need not further reply.

Applicants assert that the Office erred in the PTA calculation. The Office provided four hundred and ninety-seven (497) days of administrative delay for the failure to initially act upon the application within 14 months of the filing date of the application. See 37 CFR 1.702(a)(1). Applicants agree with this determination. However, applicants disagree with the failure to provide an additional three hundred and fifty-three (353) days for the failure to issue the application within four months of the payment of the issue fee under 37 CFR 1.702(a)(4). Applicants assert that the Office erred in entering the date of issue fee receipt in Office as 5/18/2005 rather than the correct date of 5/18/2004. Accordingly, the 353 days was not added to the Office delay.. Applicants assert that the applicants did not submit drawings after notice of allowance.

Applicants further advise the Office that the Office erred in not entering the IDS submission of March 11, 3004 into PALM. Accordingly, the office did not reduce applicants PTA by one hundred and twenty (120) days for the submission. The Office thanks applicants for their good faith and candor in advising the office of the submission.

A review of the file reflects that applicants' arguments are persuasive. The record reflects that the Office failed to issue the action within four months of the payment of the issue fee pursuant

to 37 CFR 1.702(a)(4).[1] Accordingly, the Office errantly failed to grant applicants an additional 353 days of PTA. The Office reduction of 120 for drawings was also in error since such drawings were actually submitted on filing. However, the applicants admission of an IDS submission on 3/11/2004 amounts to a 120-day reduction under 37 CFR 1.704(c)(10). Applicants could have such IDS submission waived if applicant can make the required 1.704(d) statement. Overall, the correct amount of PTA at the time of the issuance of the patent is 730 days (497 + 353 -(120) = 730).

After the mailing of this decision, the Office will forward this patented file to the certificate of correction branch for an issuance of a certificate of correction after the expiration of the thirty day period.

The Office has assessed the $200.00 fee. No additional fees are required in this deciding this application.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy, at 571-272-7757.

Kery Fries
Senior Legal
Office of Patent Legal Administration
Office of Deputy Commissioner
For Patent Examination Policy

cc: adjusted Pair calculation
DRAFT Cert. Of Correction

[1]The Office notes the issue fee was paid on May 18, 2004 and the patent issue on September 6 2005, a three hundred and fifty-three day delay.

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	6,939,053 B2
DATED	:	Sep. 6, 2005
INVENTOR(S)	:	Nisley 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 (0) days

Delete the phrase "by 29 days" and insert – by 730 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

SEP 15 2006

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In re Application of:
Robert SESEK, et al.
Application Serial No.: 09/938,893
Filed: August 24, 2001
For: **OPTICAL SCANNING DEVICE HAVING SELECTABLE IDENTIFIABLE SCAN WINDOW**

DECISION
ON PETITION
REQUESTING REFUND

This is a decision on the petition under 37 CFR 1.181 filed June 27, 2006 to request a refund of fees paid for extension of time filed with the RCE (Request for Continued Examination).

Petitioner asserts that the charge for a two (2) month extension of time fee for timely filing of the RCE was not appropriate given that the examiner checked the wrong box on the Advisory Action. Petitioner requests a refund to Deposit Account No. 08-2025 in the amount of money equal to the difference between the 2 month extension of time fee that was charged to the deposit account and the 1 month extension of time that should have been charged.

A review of the file history finds a Final Office action was mailed January 30, 2006 and a response to the Final Office action was filed on March 27, 2006. It is also noted that the examiner checked box 1. a). on the Advisory Action mailed June 1, 2006; therefore, improperly advising applicant that the time period for response expired 3 months from the mailing date of the Final. Since applicant's first response to the Final rejection was filed within 2 months of the mailing date of the Final, the examiner should have checked box 1. **b)** on the Advisory action mailed on June 1, 2006; to advise applicant that the period for reply expired on the date of mailing of the Advisory Action (which is later than the date set forth in the Final action). Accordingly, only a 1 month extension of time was required with the filing of the RCE on June 9, 2006.

The Petition is **GRANTED**.

The application file is being forwarded to Tecnology Center 2600 support staff for refunding $330 (the difference between the 2 month extension of time fee that was paid and the 1 month extension of time fee that was required) to Deposit Account No. 08-2025, as requested.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED Paper No. 4

SEP 0 5 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

PEACOCK MYERS AND ADAMS P C
P O BOX 26927
ALBUQUERQUE NM 87125-6927

In re Application of :
DAVIS, BRAD :
Application No. 09/938,907 :
Filed: August 24, 2001 :
For: **METHOD AND APPARATUS FOR ASSIGNING DATA RATE IN A MULTICHANNEL COMMUNICATION SYSTEM** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on July 17, 2003.

A grantable request to withdraw as attorney/agent of record must do the following:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All of the attorneys/agents listed in the request are granted the request for withdraw. Andrea L. Mays remains of record.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: DAVID HUFFAKER, ESQ.
KYOCERA WIRELESS CORPORATION
10300 CAMPUS POINT DRIVE
SAN DIEGO, CA 92121

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

OCT 16 2003

Paper No. 8

TOWNSEND AND TOWNSEND AND CREW, LLP
Two Embarcadero Center
Eight Floor
San Francisco, CA 94111-3834

In re Application of	)	
James P. Campbell	)	
Application No. 09/938,911	)	DECISION ON REQUEST TO
Filed: August 24, 2001	)	WITHDRAW FROM RECORD
For: Attorney Docket No. 020472-000410US	)	

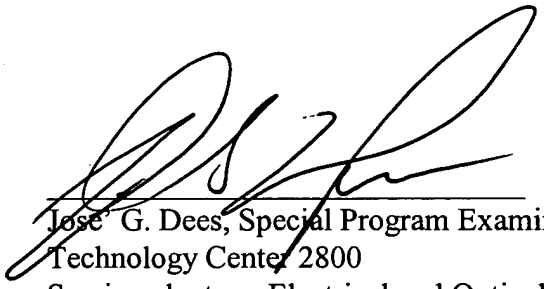
This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed April 30, 2003.

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 request meets all the above listed requirements.

The request is APPROVED.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.



José G. Dees, Special Program Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Karl D. Kovach, Senior Patent Attorney
Stratos Lightwave, Inc.
7444 West Wilson Avenue
Chicago, Illinois 60706

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 3

MAIL

NOV 2 0 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

SILICON VALLEY INTELLECTUAL PROPERTY GROUP
P.O. BOX 721120
SAN JOSE CA 95172-1120

In re Application Serial No.:
09/938,916

ON REQUEST TO
WITHDRAW AS ATTORNEY

The Request to Withdraw as Attorney is **GRANTED**.

Further communications will be directed to the address listed below until such a time as applicant properly notifies the Patent and Trademark Office of a change of address. This address has been provided by the withdrawing attorney(s).

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

cc: BeVocal, Inc.
685 Clyde Avenue
Mountain View, CA 94043-2213

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

LEONARD CHARLES SUCHYTA ESQ
C/O CHRISTIAN ANDERSEN
VERIZON SERVICES GROUP
600 HIDDEN RIDGE, HQE03H01
IRVING TX 75038

COPY MAILED

MAY 28 2002

OFFICE OF PETITIONS

In re Application of :
Ruixi Yuan et al :DECISION DISMISSING PETITION
Application No. 09/938,923 :UNDER 37 CFR 1.137(f)
Filed: August 24, 2001 :
Attorney Docket No. 98-409RCE1CON1 :

This is a decision on the petition under 37 CFR 1.137(f),[1] filed March 26, 2002, to revive the above-identified application.

The petition is **dismissed** for the reasons stated below.

The record discloses that, on August 24, 2001, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention disclosed in the attached **application has not and will not** be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing."

Petitioner requests under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded and the application revived under the provisions of 37 CFR 1.137(f). Petitioner states that this application became abandoned on its filing date in view of the filing of a PCT application on June 15, 1999 corresponding to the parent application (09/098,622).

---

[1] 37 CFR 1.137(f) provides for revival of a nonprovisional application which became abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

The instant nonprovisional application did not become abandoned as a result of the published international application **filed prior** to the present application. In this regard, 35 U.S.C. § 122((b)(2)(B)(iii) states:

> An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional [emphasis supplied].

The statute does not provide for the situation where a certification under 35 USC 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under the multilateral international agreement. The statute at 35 USC 122(b)(2)(B)(iii) only provides for revival in the situation where a certification was made under 35 USC 122(b)(2)(B)(i) at the time of filing the application and an application was subsequently filed in a foreign country without notifying the Office within 45 days of the filing thereof.

In view of the above and since this application did not become abandoned pursuant to the provisions of 35 USC 122(b)(2)(B)(iii), a petition to revive under the provisions of 37 CFR 1.137(f) is inappropriate and must be dismissed.

As requested, the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Corrected Filing Receipt indicating the projected date of publication of September 5, 2002 accompanies this decision.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(c)(7). Accordingly, the petition fee of $1,280 charged to petitioner's deposit account on March 27, 2002 will not be refunded.

This application is being forwarded to Technology Center AU 2661 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 9

AGILENT TECHNOLOGIES INC
LEGAL DEPARTMENT DL429
INTELLECTUAL PROPERTY ADMINISTRATION
PO BOX 7599
LOVELAND CO 80537-0599

COPY MAILED

JUL 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Yakhini, et al. :
Application No. 09/938,937 : ON PETITION
Filed: August 24, 2001 :
Attorney Docket No. 10003516-1 :

This is a decision on the paper titled "Petition", filed April 9, 2002, in which applicant has requested that the Notice of Incomplete Reply mailed March 14, 2002 set a new 30 day period for reply, or alternatively, that the time period for response be tolled. The instant petition is being treated as a petition under 37 CFR 1.183 to waive the requirements for an extension of time fee as set forth in 37 CFR 1.136(a) and 37 CFR 1.17(a).

The petition under 37 CFR 1.183 is **DISMISSED**.

BACKGROUND:

The above-identified application was filed on August 24, 2001. On September 10, 2001, the Office mailed a Notice to File Missing Parts of Nonprovisional Application. The Notice stated that to avoid abandonment, the following items must be submitted within two months from the mail date of the Notice: (1) an oath or declaration, (2) the surcharge for late filing of the oath or declaration, (3) substitute drawings in compliance with 37 CFR 1.84, and (4) a sequence listing in compliance with 37 CFR 1.821 - 1.825. The Notice stated that extensions of time under 37 CFR 1.136(a) were available.

In response to the Notice to File Missing Parts, on January 22, 2002, applicant filed an executed declaration together with the surcharge for its late filing.[1] Applicants failed to file substitute drawings or a sequence listing. Accordingly, on March 14, 2002, the Office mailed a Notice of Incomplete Reply (Nonprovisional). The Notice reminded applicants that substitute drawings and a sequence listing must be timely filed to avoid abandonment of the application. Furthermore, the Notice stated that the period for reply remained as set forth in the Notice to File Missing Parts.

PETITION UNDER 37 CFR 1.183:

In response to the Notice of Incomplete Reply, applicants have filed substitue drawings and a sequence listing. In addition, applicants have filed the instant petition, arguing that their response to the Notice to File Missing Parts was *bona fide*. Accordingly, applicants assert that the Notice of Incomplete Reply should have set a new 30 day period for reply to submit the substitute drawings and a sequence listing. Applicants maintain that because their response to the Notice to File Missing Parts was mailed more than four months prior to the mailing of the Notice of Incomplete Reply, "it would be manifestly unfair to require that the Applicant petition for an extension of time to reply to the Notice of Incomplete Reply."

37 CFR 1.136(a)(1) states, in relevant part:

> If an applicant is required to reply within a nonstatutory or shortened statutory period time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set forth in § 1.17(a) are filed.

The Notice to File Missing Parts set a nonstatutory period for reply of two months. Accordingly, applicant is permitted to extend that period for reply by up to five months by filing a petition for an extension of time and paying the fee as set forth in 37 CFR 1.17(a). As of the date of the instant petition and reply to the Notice of Incomplete Reply, the fee for a five month extension of time was $1,960.[2]

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under

---

[1] This reply was made timely because applicant included a Certificate of Mailing dated November 13, 2001, and because November 12, 2001 fell on a federal holiday.

[2] 37 CFR 1.17(a)(5).

this section must be accompanied by the petition fee set forth in § 1.17(h).

Petitioner has not demonstrated that this is an extraordinary situation where justice requires waiver of the rules. The Notice to File Missing Parts clearly set forth the four items which petitioner was required to timely file to avoid abandonment of the application. In response, petitioner only filed two - an executed declaration and the surcharge for its late filing. Petitioner's reply outright lacked the additional two items required to avoid abandonement - the substitute drawings and a sequence listing. Accordingly, petitioner's reply was on its face **not** a *bona fide* reply.[3]

Furthermore, the fact that the Notice of Incomplete Reply was mailed more than four months after petitioner filed his response to the Notice to File Missing Parts is not an extraordinary situation.

With his petition and response to the Notice of Incomplete Reply, petitioner submitted a check in the amount of $110 for a one month extension of time. However, in order for the substitute drawings and the sequence listing to be considered timely, a five month extension of time ($1,960) is necessary. Accordingly, the difference of $1,850 has been charged to Deposit Account No. 50-1078, as authorized. In addition, the fee of $130 for the instant petition under 37 CFR 1.183 has also been charged to petitioner's deposit account.

The application file is being forwarded to the Office of Initial Patent Examination for preexamination processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

Beverly Flanagan
Supervisory Petitions Attorney
Office of Petitions

[3] Contrast petitioner's failure to file substitute drawings and a sequence listing with the sitation where an applicant filed these two items, but they failed to comply with the rules.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.g

David L. Alberti
GRAY CARY WARE & FREIDENRICH
Attn: Patent Group
1755 Embarcadero Road
Palo Alto, CA 94303-3340

MAILED

APR 22 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 7

In re application of
Eiland Glover, et al.
Application No. 09/938,950 : **DECISION ON REQUEST**
Filed: August 23, 2001 : **FOR WITHDRAWAL OF**
For: CUSTOMER AWARD AND INCENTIVE SYSTEM : **ATTORNEY**

This is a decision on the request filed on March 19, 2003, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with Item A).

As to Item A, it is not clear whether the attorney signing the request is signing to withdrawal on behalf of himself or all the attorneys of record.

All the attorneys given power in the original Declaration/Power of Attorney are not indicated as being withdrawn in the Request for Withdrawal of Attorney. The Patent Office does not recognize law firms as entities since their complement changes over time. Further, since power of attorney was not given by customer number in the original declaration it is recommended that applicants' representative renew the request and withdraw on behalf of himself and all the attorneys of record.

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(703) 308-2121

RAR/cps 4/9/04

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

MAY 0 4 2005

OFFICE OF PETITIONS

GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

In re Application of :
Alan N. WILLSON et al. :
Application No. 09/938,978 : DECISION GRANTING PETITION
Filed: August 24, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. G&C 31006.2-US-U1 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 24, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 3, 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 before the expiration of the maximum extendable period for reply. Accordingly, the above-identified application became abandoned on September 4, 2004.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the extension of time submitted on January 24, 2005 was subsequent to the maximum period obtainable for reply, this fee cannot be accepted to extend the period. Therefore, the $55 extension of time fee has been credited to counsel's deposit account.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of June 3, 2004 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Betsy Deppe at (571) 272-6052 or in her absence, the undersigned at (571) 272-3217.

The application file is being referred to Technology Center AU 2124 for appropriate action on the concurrently filed amendment.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 10

CLARK HILL, P.C.
500 WOODWARD AVENUE, SUITE 3500
DETROIT, MI 48226

COPY MAILED

JAN 23 2004

OFFICE OF PETITIONS

In re Application of
Opperthauser, Orval A.
Application No. 09/938,993
Filed: August 24, 2001
Attorney Docket No. 20544-087525

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 12, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed July 28, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on October 29, 2003. A Notice of Abandonment was mailed on December 10, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to the Publishing Division for processing into a patent.

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

571-272-4200

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Reg. No. 41,596

RECEIVED

JAN 27 2004

CLARK HILL

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI
& BIANCO P.L.
ONE BOCA COMMERCE CENTER
551 NORTHWEST 77TH STREET, SUITE 111
BOCA RATON FL 33487

COPY MAILED
APR 13 2006
OFFICE OF PETITIONS

In re Application of :
Jason D. Hibbeler et al. :
Application No. 09/939,005 : ON PETITION
Filed: August 24, 2001 :
Attorney Docket No. POU920010019US1 :

This is a decision on the petition filed March 28, 2006, to withdraw the holding of abandonment under 37 CFR 1.181.

The petition to withdraw the holding of abandonment is **GRANTED**.

The application was held abandoned on September 16, 2005 for failure to file a timely response to the non-Final Office Action mailed June 15, 2005, 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 March 13, 2006.

Petitioner asserts that a proper response, was filed via facsimile transmission on August 3, 2005. 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 2191 for appropriate action on the amendment filed August 3, 2005, a copy of which was submitted March 28, 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

UNITED STATES 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.

Christopher M. Goff (27839)
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS MO 63102

COPY MAILED

JUL 10 2008

OFFICE OF PETITIONS

In re Application of	:	
Sawyer et al.	:	
Application No. 09/939,061	:	LETTER REGARDING
Filed: August 24, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 27839-2052	:	
(K-C 16,208)	:	
Title: THIN, HIGH CAPACITY	:	
ABSORBENT STRUCTURE AND METHOD	:	
FOR PRODUCING SAME	:	

This is a decision on the "LETTER REGARDING ERROR IN PATENT TERM ADJUSTMENT," filed April 10, 2008. Patentees request that the patent term adjustment indicated on the Notice of Allowance and Issue Fee Due be corrected from seven hundred and twenty-one (721) days to six hundred and twenty-one (621) days.

The request for reconsideration of the patent term adjustment is **DISMISSED**.

A Notice of Allowance and Issue Fee Due was mailed on January 18, 2008, with an indication that the patent term adjustment to date was 721 days.

Patentees' attempt at candor is appreciated. However, Patentees appear to have incorrectly evaluated the period of adjustment. Pursuant to 37 C.F.R. § 1.704(b), the failure to reply to an Office action within three months is a failure to engage in reasonable efforts to conclude prosecution. The Notice to File Missing Parts was mailed on September 28, 2001, and a response was not filed until April 11, 2002, which constitutes three

months and 104 days after the mailing of the Office communication.

Petitioner has argued that due to the fact that the notice set a two-month period for response, the period of delay should be based not on the date that is three months after the mailing of the communication, but rather the date on which a response was actually due (two months after the mailing of this communication). This argument is not persuasive, due to the fact that the Rule makes it clear that the shortened statutory period for reply of two months that is set in the notice has no effect on the three-month period set forth in the Rule.

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 was 863 (120 + 65 + 678) days. The proper period of reduction at the time of mailing of the notice of allowance was 142 (104 + 1 + 30 + 7) days.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance was 721 (863 - 142) days.

To the extent that 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 C.F.R. § 1.18(e). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

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