UNITED STATES PATENT AND TRADEMARK OFFICE

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

HAYES, SOLOWAY P.C.
3450 E. SUNRISE DRIVE, SUITE 140
TUCSON AZ 85718

COPY MAILED

MAR 0 5 2007

OFFICE OF PETITIONS

In re Application of	:	
Kram	:	
Application No. 09/953,417	:	
Filed: September 11, 2001	:	ON PETITION
Attorney Docket No. VMS 01.02	:	
For: SLIDE HEATER	:	

This is a decision on the petition under 37 CFR 1.137(a), filed February 9, 2007 (certificate of mailing date February 6, 2007), to revive the above-identified application.

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

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The Office contends that the above-identified application became abandoned for failure to submit a reply to the April 26, 2006 Notice of Panel Decision from Pre-Appeal Brief Review, which set an extendable one month period to file an appeal brief. No reply being received, the Office considered this application abandoned on May 27, 2006. The filing of the present petition precedes the mailing of A Notice of Abandonment.

Petitioner asserts that the April 26, 2006 was not received because it was mailed to an out of date correspondence address and the USPS did not forward the correspondence to practitioner's current address.

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). The instant petition lacks item (3).

Regarding (3) above, petitioner has not shown to the satisfaction of the Director that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

An adequate showing of diligence is the touchstone of a successful petition to revive under an unavoidable standard. Petitioner claims that he was unavoidably prevented from replying to the April 26, 2006 Notice because the Notice was mailed to an "old address" and the postal service did not forward the Notice to him.

Applicant has not shown that adequate provisions were made for the careful handling of Office correspondence in order to ensure a timely response. Petitioner is responsible for timely informing the Office of changes in correspondence address. Requesting that the United States Postal Office forward mail to a new address does not absolve applicant of the requirement of informing the United States Patent and Trademark Office of a change in correspondence address.

Petitioner has not provided acceptable, persuasive evidence that a change of address (listing petitioner's correct address) with a proper Rule 1.8 certification was filed prior to April 26, 2006. Therefore, the office mailed the April 26, 2006 Notice to the last address on record, which was not up-to-date. The only change of correspondence address on record was filed on December 22, 2006, which is well after the April 26, 2006 Notice was mailed.

Delay in prosecution resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not unavoidable. See, Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A delay caused by the failure on the part of the petitioner to provide the Office with a current correspondence address does not constitute an unavoidable delay. See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

The petition under 37 CFR 1.137(a) is **dismissed**.

Petitioner is strongly encouraged to file a petition to revive under the unintentional standard of 137(b). 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). The current Rule 137(b) petition fee is $750.00.

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 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

HAYES, SOLOWAY P.C.
3450 E. SUNRISE DRIVE, SUITE 140
TUCSON AZ 85718

COPY MAILED

DEC 19 2007

OFFICE OF PETITIONS

In re Application of	:	
Kram	:	
Application No. 09/953,417	:	
Filed: September 11, 2001	:	ON PETITION
Attorney Docket No. VMS 01.02	:	
For: SLIDE HEATER	:	

This is a decision on the reconsideration petition under 37 CFR 1.137(a), filed March 16, 2007 (certificate of mailing date March 13, 2007), to revive the above-identified application.

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

The Office contended that the above-identified application became abandoned for failure to submit a reply to the April 26, 2006 Notice of Panel Decision from Pre-Appeal Brief Review, which set an extendable one month period to file an appeal brief. No reply being received, the Office considered this application abandoned on May 27, 2006. The filing of the present petition precedes the mailing of A Notice of Abandonment.

The petition satisfies the requirements of 37 CFR 1.137(a) in that petitioner has supplied (1) the required reply in the form of an Appeal Brief and required fee; (2) the petition fee of $ 500.00; and (3) a showing to the satisfaction of the Director that the entire delay was unavoidable.

This application is being referred to Technology Center A.U. 1797 for consideration of the Appeal Brief filed on February 9, 2007 (certificate of mailing date February 6, 2007).

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

COPY MAILED

JUL 2 6 2002

OFFICE OF PETITIONS

In re Application of	:	
Wang et al.	:	
Application No. 09/953,418	:	DECISION DISMISSING
Filed: September 14, 2001	:	PETITION
Attorney Docket No. 155695-0237	:	

This is a decision on the petition filed February 12, 2002, to establish that page 17 of the specification was part of the originally filed application.

The petition is **dismissed**.

On September 14, 2001, the application was filed.

On November 16, 2001, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of September 14, 2001, and advising applicants that page 17 of the specification appeared to have been omitted.

In response, the present petition was filed alleging that page 17 was deposited on September 14, 2001. In support, petitioner has submitted a postcard receipt which acknowledges receipt of "Application - R ule 1.53(b) Continuation (46 pages)" on September 14, 2001.

All the evidence present in the file has been carefully considered, but is not persuasive that page 17 of the specification was submitted with the original application.

The last portion of MPEP 513 states,

> Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application) ... The Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g. a postcard receipt . . . .

MPEP 503 states (emphasis added),

> The identifying data on the postcard should include:
> (A) applicant's name(s);
> (B) title of invention;
> (C) **number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;**
> (D) whether oath or declaration is included;
> (E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and /or provisional application cover sheet); and
> (F) amount and manner of paying the fee.

> A return postcard should be attached to each patent application for which a receipt is desired.
>
> It is important that the return postcard itemize all of the components of the application. **If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO)**. . . .
>
> A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.
>
> The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. **The postcard should also identify the type of paper being filed**, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., **and the number of pages being submitted.** If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., **the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).**
>
> **The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard.** For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

While petitioner apparently believes that page 17 of the specification was filed on September 14, 2001, the file of application No. 09/953,418[1] shows that page 17 of the specification was not received, since no such paper is present in the file. An applicant alleging that a paper was filed in the USPTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

The application was deposited with a postcard receipt. The postcard receipt states that 46 pages are present. Upon receipt of the application papers, the Office reviewed the file and verified that at least 46 pages were present. In the instant file, the application papers, which include specification, claims, drawings, and transmittal paper consist of more than 46 pages. Therefore, the postcard receipt fails to establish that page 17 of the specification was submitted with the original application.

Since applicants have not filed a petition under 37 CFR 1.182 requesting February 12, 2002,, the date the missing pages were filed, as the filing date, the pages filed on February 12, 2002, will <u>not</u> be entered.

---

[1] The file contains the actual papers received and the file is an official government record prepared and maintained by disinterested USPTO employees as a part of their customary and usual duties.

An amendment to the specification deleting references to the missing pages should be filed prior to the first USPTO action in order to avoid further delays in the examination of the application. **In the alternative**, if petitioner desires for the examiner to consider pages which were not submitted as part of the original disclosure, then petitioner may seek to submit some or all of those pages as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a). The amendment is not new matter if the substance was a part of the disclosure of the prior application since the prior application was incorporated by reference.[2]

A petition fee of $130 has been charged to petitioner's deposit account.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 14, 2001, using only the application papers filed on September 14, 2001.

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

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

---

[2] The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 08/934,804 and the transmittal sheet specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:

> . . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant <u>to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition</u>. (emphasis supplied)

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

OPPENHEIMER WOLFF & DONNELLY LLP
38th Floor
2029 Century Park East
Los Angeles, CA 90067-3024

COPY MAILED

APR 0 9 2002

OFFICE OF PETITIONS

In re Application of :
Loeb et al. :
Application No. 09/953,425 :
Filed: September 14, 2001 :
Attorney Docket No. 20441-12 :

ON PETITION

This is a decision on the petition filed January 4, 2002, to accord the above-identified application a filing date of September 14, 2001, instead of September 15, 2001.

The petition is **granted**.

37 CFR 1.10(c) states,

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
> (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

All of the above requirements have been met. Therefore, the application will be accorded a filing date of September 14, 2001.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of September 14, 2001.

Petitioner should note that a Notice of Missing Parts requiring a signed oath/declaration and a surcharge was mailed on October 12, 2001. A response to the Notice is not in the file. It is possible that a response has been filed and that the response has not been matched with the file. Petitioner *may* wish to re-file[1] a copy of the response along with proof of its prior submission in case the original submission has been lost or misplaced. If a response has not been filed, then

[1] If such a paper is filed, it should be sent to Box: Missing Parts.

such a response and an appropriate extension of time must be filed in order to avoid abandonment.

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

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 13

KNOBBE MARTENS OLSON & BEAR
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

APR 1 0 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Ronald Gordon Bates :
Application No. 09/953,456 :
Filed: September 12, 2001 :
Attorney Docket No. DAVI123.001CP1 :

This is a decision on the petition, filed by facsimile transmission on April 9, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on March 4, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 3644 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

MAIL

FEB 23 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of
James M. Barton
Application No. 09/953,472
Filed: September 14, 2001
For: METHOD AND APPARATUS IMPLEMENTING A MULTIMEDIA DIGITAL NETWORK

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

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

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

Kevin L. Bray
Energy Conversion Devices, Inc.
2956 Waterview
Rochester Hills, MI 48309

COPY MAILED

FEB 2 2 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of	:
Timothy Ellison	:
Application No. 09/953,477	:
Filed: September 15, 2001	:
Attorney Docket No. 2080	:

This is a decision on the petition under 37 CFR 1.137(b), filed January 4, 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

SILICON EDGE LAW GROUP, LLP
6601 KOLL CENTER PARKWAY
SUITE 245
PLEASANTON CA 94566

COPY MAILED
JUN 23 2006
OFFICE OF PETITIONS

In re Application of	:	
Carl W. Werner et al	:	
Application No. 09/953,486	:	ON PETITION
Filed: September 14, 2001	:	
Attorney Docket No. RA-191	:	

This is a decision on the petition, filed June 20, 2006, and supplemented on June 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 May 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 2133 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

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

Paper No. _____

Date : June 23, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Carl W. Werner et al
Application No. :09/953,486
Filed :September 14, 2001

The above-identified application has been assigned Patent No. 7,076,704 and an issue date of July 11, 2006.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of July 11, 2006:

"All reference to Patent No. 7,076,704 to Carl W. Werner et al of California for MULTILEVEL SIGNAL INTERFACE TESTING WITH BINARY TEST APPARATUS BY EMULATION OF MULTILEVEL SIGNALS appearing in the Official Gazette of July 11, 2006 should be deleted since no patent was granted."

Karen Creasy

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

cc: Paul Harrison, MDW-4B03,(FAX-273-5468)
Deneise Boyd, MDE-3D39 (FAX-273-5124)
Mary Louise McAskill, ST-8C15 (FAX 305-4372)
Niomi Farmer, ST-8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE-7C71 (FAX 273-0038
Duane Davis P/OPC MDE-7D89

UNITED STATES PATENT AND TRADEMARK OFFICE

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

VISTA IP LAW GROUP LLP
1885 Lundy Avenue
Suite 108
SAN JOSE, CA 95131

Mail Date: 04/21/2010

Applicant	: Sreenivas Gollapudi	: DECISION ON REQUEST FOR
Patent Number	: 7580971	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/953,490	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/10/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **827** 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

COPY MAILED

APR 28 2006

OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

In re Application of	:	
BLAU et al.	:	
Application No. 09/953,496	:	DECISION ON PETITION
Filed: September 14, 2001	:	TO WITHDRAW
Attorney Docket No. 286002020601	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 22, 2005.

The request is **NOT APPROVED**.

A review of the file record indicates that Kate H. Murashige and those practitioners associated with Customer Number 25225 do not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

Applicant is reminded that there is no attorney of record at this time.

Please note that changes to the correspondence address in an application can be made only by those parties listed in 37 CFR 1.33(a)(2) (all applicants, registered practitioners of record appointed in compliance with § 1.32(b), and assignees as provided for under § 3.71(b)).

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- 4787.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

UNITED STATES 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 1 0 2005

OFFICE OF PETITIONS

GEORGE O. SAILE & ASSOCIATES
28 DAVIS AVENUE
POUGHKEEPSIE NY 12603

In re Patent No. 6,775,903	:	
Issue Date: August 17, 2004	:	
Application No. 09/953,546	:	ON PETITION
Filed: September 17, 2001	:	
Attorney Docket No. HT01-016	:	

This is a decision on the petition filed August 30, 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 the undersigned at (571) 272-3208. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

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

Karen Creasy

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

[1]See Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

OPPENHEIMER WOLFF & DONNELLY LLP
Attn: Marc Bobys
38th Floor
2029 Century Park East
Los Angeles, CA 90067-3024

COPY MAILED

SEP 22 2003

OFFICE OF PETITIONS

In re Application of :
Kim, et al. :
Application No. 09/953,576 : ON PETITION
Filed: September 14, 2001 :
Attorney Docket Number: 510015-243 :

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

The petition is **GRANTED**.

This application became abandoned March 4, 2003 for failure to timely file a proper response to the non-final Office action mailed December 3, 2002. The non-final Office action set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely obtained. Notice of Abandonment was mailed July 25, 2003.

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, no extension of time is necessary.

This application will be forwarded to Technology Center 2800 for further processing.

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

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

MAREK ALBOSZTA
LUMEN INTELLECTUAL PROPERTY SERVICES
SUITE 110
45 CABOT AVENUE
SANTA CLARA CA 95051

COPY MAILED

APR 16 2002

OFFICE OF PETITIONS

In re Application of
Forouhi, et al.
Application No. 09/953,578
Filed: September 14, 2001
Attorney Docket No. NAK-119

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the Petition Under 37 CFR 1.47, filed January 15, 2002 (Certificate of Mailing dated November 26, 2001), which is being treated as a petition pursuant to 37 CFR 1.47(a).

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

The above-identified application was filed on September 14, 2001, without an executed oath or declaration. Accordingly, on October 29, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. Applicant included a declaration signed by inventors Abdul Rahim Forouhi and John Lam, but lacking signatures from inventors Erik Maiken and Dave Harrison.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 C.F.R. 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventors.

On petition, attorney Ron Jacobs included a statement of facts from Tianhua Gu, the person who has firsthand knowledge of the transmittal of the application papers to the non-signing inventors. In addition, attorney Jacobs included copies of the cover letters, signed by Gu, which enclosed the application papers.

While applicant has not supplied a statement of the last known address of the non-signing inventors, the addresses listed in the petition and the declaration are assumed to be the last known addresses. Applicant must notify this Office if this assumption is not correct.

The declaration filed January 15, 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 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 returned 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.

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

ERIK MAIKEN
630 PARK VIEW DR # 314
SANTA CLARA CA 95054

COPY MAILED

APR 16 2002

OFFICE OF PETITIONS

In re Application of :
Forouhi, et al. :
Application No. 09/953,578 :
Filed: September 14, 2001 :
Title: METHOD OF INFERRING OPTICAL :
PARAMETERS OUTSIDE OF A MEASUREMENT
SPECTRAL RANGE

LETTER

Dear Mr. Maiken:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Cliff Congo at (703) 305-0272. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

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

Ron Jacobs
Lumen Intellectual Property Services
Suite 110
45 Cabot Avenue
Santa Clara, California 95051

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DALE A HARRISON
617 ROBERT L SMITH DR
TRACY CA 95376

COPY MAILED

APR 16 2002

LETTER OFFICE OF PETITIONS

In re Application of :
Forouhi, et al. :
Application No. 09/953,578 :
Filed: September 14, 2001 :
Title: METHOD OF INFERRING OPTICAL :
PARAMETERS OUTSIDE OF A MEASUREMENT
SPECTRAL RANGE

Dear Mr. Harrison:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Cliff Congo at (703) 305-0272. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

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

Ron Jacobs
Lumen Intellectual Property Services
Suite 110
45 Cabot Avenue
Santa Clara, California 95051

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

MICHAEL A. BLAKE
SIERRA PATENT GROUP, LTD.
P.O. BOX 6149
STATELINE NV 89449

COPY MAILED

MAY 2 0 2003

OFFICE OF PETITIONS

In re Application of	:
Wayne Wong	:DECISION GRANTING PETITION
Application No. 09/953,580	:UNDER 37 CFR 1.137(f)
Filed: September 13, 2001	:
Attorney Docket No. ACT-357	:

This is a decision on the petition filed May 12, 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 September 6, 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 August 28, 2003 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 2131 for examination in due course.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DRW 07-02

COPY MAILED

JUL 22 2002

OFFICE OF PETITIONS

Paper No. 6

RECEIVED
JUL 22 2002
PETITIONS OFFICE

CANCELED

RICHARD J. STREIT
C/O LADAS & PARRY
224 SOUTH MICHIGAN AVENUE
CHICAGO IL 60604

In re Application of	:	
Mashimo et al.	:	DECISION GRANTING
Application No. 09/953,596	:	PETITION
Filed: 12 September, 2001	:	
Attorney Docket No. CU-2663 RJS	:	

This is a decision on the petition filed by facsimile on 18 January, 2002, and supplemented by facsimile on 14 June, 2002, requesting that the above-identified application be accorded a filing date of 12 September, 2001.

The petition states that the application was attempted to be deposited on 12 September, 2001, by Express Mail, but the post office would not accept any Express Mail packages due to the state of emergency which existed. On 18 January, 2002, a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail was filed. The statement indicated the date on which the person attempted to deposit the correspondence with the USPS and that the USPS refused to accept the correspondence.

The U.S. Patent and Trademark Office declared the interruption in Express Mail service of the USPS a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e).

The petition is granted. No petition fee is required and none has been charged.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 12 September, 2001.

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

D Wood

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

Paper No.

FCI USA, INC.
825 OLD TRAIL ROAD
ETTERS PA 17319

COPY MAILED

JAN 31 2007

OFFICE OF PETITIONS

In re Application of	:	
Lemke et al.	:	DECISION ON APPLICATION
Application No. 09/953,631	:	FOR
Filed: 14 September, 2001	:	PATENT TERM ADJUSTMENT
Atty Docket No. 4469F	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE PURSUANT TO 37 CFR § 1.705," which is treated as a request under 37 CFR 1.705(b) filed on 23 March, 2006. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. § 154(b) be corrected from sixty-six (66) days to seven hundred eight (708) days.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is four hundred seventy-four **(474)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Applicants state that the patent issuing from this application is subject to a terminal disclaimer.

On 14 February, 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 66 days. On 23 March, 2006,

applicant timely[1] submitted the instant application for patent term adjustment. Applicants dispute the reductions pursuant to 1.704(b) and 1.704(c)(7) of 171 days and 150 days, respectively. Applicants request removal of the 171 day reduction on the basis that a response was received on 12 April, 2004, to the Restriction requirement mailed on 8 March, 2004, and that said response was fully responsive to the restriction requirement. Applicants state that the response received on 12 April, 2004, was lost in the USPTO, and that a copy was provided on 26 November, 2004. Applicants request removal of the 150-day reduction on the basis that the response filed 26 November, 2004 was fully responsive and that the notice of non-compliance mailed on 6 April, 2005, was issued in error.

Pursuant to 37 CFR § 1.704(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

With regards to the 171-day period of delay, a review of the record reveals a return receipt postcard showing an "Office-date" stamp of 12 April, 2004, and itemizing the filing of a response to a restriction requirement. This evidence shows that the response was received within the three-month period provided for in § 1.704(b).

Moreover, as no response to the Office action mailed 8 March, 2004, was considered timely filed by the Office, the application became abandoned. Applicants were advised of the abandonment by Notice mailed on 9 June, 2004. In response, on 6 July, 2004, applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to

---

[1] PALM records indicate that the Issue Fee payment was received on 15 May, 2006.

withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed on 2 September, 2004, the notice of abandonment was withdrawn on the basis that applicants had shown that a proper response was filed on 12 April, 2004.

In view thereof, it is concluded that applicants did not fail to engage in reasonable efforts to concluded processing or examination of the application by delaying in replying to the Office action (or by delaying in filing a petition to withdraw the holding of abandonment).

Accordingly, the reduction of 171 days will be removed and no period of reduction will be entered for applicant delay in filing a petition to withdraw holding of abandonment.

Given the showing of receipt of applicant's response in the Office on 12 April, 2004, but that no Office action was mailed under § 132 until 6 April, 2005, applicants are entitled to a period of adjustment for Office delay. Pursuant to § 1.702(a)(2) and § 1.703(a)(2), the period of adjustment is 237 days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, 12 August, 2004, and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, 6 April, 2005.

Given that a proper response was received on 12 April, 2004, applicants are entitled to an additional period of adjustment for Office delay in taking more than 4 months to act (6 April, 2005, noncompliant mailed). A period of adjustment of 237 days will be entered.

Pursuant to 37 CFR § 1.704(c), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

> (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was

filed and ending on the date that the reply or other paper correcting the omission was filed;

With regards to the 150-day period of delay, the record has been reviewed and it has been determined that the response filed 26 November, 2004 was properly held to be non-responsive. The Office action of 8 March, 2004 included two requirements under 35 USC 121 namely:

In paragraph 1:

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

I. Claims 1-9 and 11-15, drawn to an electrical connector and method, classified in class 439, subclass 83.

II. Claims 10, drawn to a method of using an electrical connector, classified in class 29.

III. Claim 16, drawn to a method of making an electrical connector, classified in class 29.

IV. Claim 17, drawn to a contact for an electrical connector, classified in class 439, subclass 874.

and in paragraph 5:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

and in paragraph 9:

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

As stated by the examiner in the Notice mailed 6 April, 2005, applicants did not elect a single invention as required in the previous Office action. Applicants did not indicate which Group and species is being elected, and apparently did not limit the elected claims to the same. As such, the reply was properly considered not fully responsive. Thus, a reduction for the delay of 150 days from the filing of the initial response on 26 November, 2004, to the filing of the response on 25 April, 2005, is warranted.

Lastly, with regards to applicants' assertion that "The USPTO's delay is at least 801 days, and probably more," petitioner has provided no basis for this assertion of entitlement to patent term adjustment. Additionally, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). This amount, if any, will be included in the patent term adjustment indicated on the patent.

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

In view thereof, it is concluded that the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is four hundred seventy-four (474) days.

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

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

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculation

Day : Tuesday
Date: 1/30/2007

PALM INTRANET

Time: 16:43:52

PTA Calculations for Application: 09/953631			
Application Filing Date:	09/14/2001	PTO Delay (PTO):	480
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	414
Post-Issue Petitions:	0	Total PTA (days):	474
PTO Delay Adjustment:	408		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
111	01/30/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	237		
110	01/30/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	171		
97	02/14/2006	MAIL NOTICE OF ALLOWANCE			
96	01/31/2006	ISSUE REVISION COMPLETED			
95	01/31/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
94	01/31/2006	CASE DOCKETED TO EXAMINER IN GAU			
93	01/31/2006	NOTICE OF ALLOWABILITY			
92	03/17/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
91	08/15/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
90	09/14/2001	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
89	04/12/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
88	09/15/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
87	01/20/2006	DATE FORWARDED TO EXAMINER			
86	01/17/2006	AMENDMENT AFTER FINAL REJECTION			
85	11/25/2005	MAIL FINAL REJECTION (PTOL - 326)			
84	11/22/2005	FINAL REJECTION			
83	11/18/2005	DATE FORWARDED TO EXAMINER			
82	11/14/2005	RESPONSE AFTER NON-FINAL ACTION		60	61
81	11/14/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
80	09/29/2005	PARALEGAL TD ACCEPTED			
79	09/15/2005	TERMINAL DISCLAIMER FILED			

78	09/29/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
77	09/08/2003	PRELIMINARY AMENDMENT			
76	03/17/2003	REFERENCE CAPTURE ON IDS			
75	03/17/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
74	08/15/2002	REFERENCE CAPTURE ON IDS			
73	08/15/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
72	09/14/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
71	09/14/2001	REFERENCE CAPTURE ON IDS			
70	09/14/2001	PRELIMINARY AMENDMENT			
69	04/12/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
68	04/12/2004	REFERENCE CAPTURE ON IDS			
66	09/15/2005	REFERENCE CAPTURE ON IDS			
65	09/15/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
64	09/15/2005	TERMINAL DISCLAIMER FEE PAID			
63	09/15/2005	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
62	09/28/2005	DATE FORWARDED TO EXAMINER			
61.1	09/15/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
61	09/15/2005	RESPONSE AFTER NON-FINAL ACTION		33	58
60	09/15/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
59	05/13/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
58	05/13/2005	MAIL NON-FINAL REJECTION			
57	05/12/2005	NON-FINAL REJECTION			
56	04/28/2005	DATE FORWARDED TO EXAMINER			
55	04/25/2005	RESPONSE TO ELECTION / RESTRICTION FILED		150	51
54	04/06/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
53	04/06/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
52	04/04/2005	DATE FORWARDED TO EXAMINER			
51.1	11/26/2004	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			

51	11/26/2004	RESPONSE TO ELECTION / RESTRICTION FILED		171	12
49	11/26/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
48	01/06/2005	APPLICATION RETURN FROM OIPE			
47	01/06/2005	APPLICATION RETURN TO OIPE			
46	01/05/2005	APPLICATION RETURN FROM OIPE			
45	01/06/2005	APPLICATION IS NOW COMPLETE			
44	01/05/2005	APPLICATION RETURN TO OIPE			
43	01/05/2005	APPLICATION RETURN FROM OIPE			
42	01/06/2005	APPLICATION IS NOW COMPLETE			
41	01/05/2005	APPLICATION RETURN TO OIPE			
40	01/05/2005	APPLICATION RETURN FROM OIPE			
39	01/05/2005	APPLICATION IS NOW COMPLETE			
38	12/17/2004	ADDITIONAL APPLICATION FILING FEES			
37	12/17/2004	APPLICANT HAS SUBMITTED A NEW SPECIFICATION TO CORRECT CORRECTED PAPERS PROBLEMS			
36	12/06/2004	CORRECTED PAPER			
35	12/04/2004	ADDITIONAL APPLICATION FILING FEES			
34	09/14/2001	A DOCUMENT THAT CONTAINS, AT LEAST IN PART, A WRITTEN DESCRIPTION OF AN INVENTION, AND OF THE MANNE			
33	11/21/2001	PRE-EXAM OFFICE ACTION WITHDRAWN			
32	09/02/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
31	12/04/2004	APPLICATION RETURN TO OIPE			
30	09/10/2004	REFERENCE CAPTURE ON IDS			
29	09/10/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
28	09/02/2004	APPLICATION RETURN FROM OIPE			
27	09/02/2004	APPLICATION IS NOW COMPLETE			
26	09/02/2004	APPLICATION RETURN TO OIPE			
25	09/02/2004	APPLICATION RETURN FROM OIPE			
24	09/02/2004	APPLICATION IS NOW COMPLETE			
23	09/14/2001	CLAIM PRELIMINARY AMENDMENT			
22	09/02/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
21	09/02/2004	APPLICATION RETURN TO OIPE			
20	09/02/2004	APPLICATION DISPATCHED FROM OIPE			
19	09/02/2004	APPLICATION IS NOW COMPLETE			
18	02/08/2002	ADDITIONAL APPLICATION FILING FEES			

17	02/08/2002	OMMITED DRAWINGS. APPLICANT HAS PETITIONED THAT THE FILING DATE NOT BE CHANGED AND THE PETITION HAS			
16	02/08/2002	APPLICANT HAS SUBMITTED A NEW SPECIFICATION TO CORRECT CORRECTED PAPERS PROBLEMS			
15	08/24/2004	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
14	07/06/2004	WORKFLOW INCOMING PETITION IFW			
13	11/23/2001	ABANDONMENT -- DURING PREEXAM PROCESSING			
12	03/08/2004	MAIL RESTRICTION REQUIREMENT	480		-1
11	03/04/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
10	03/04/2004	CASE DOCKETED TO EXAMINER IN GAU			
9	03/04/2004	DISPATCH FROM OIPE TO CORPS - U-P-R-D APPLICATION			
8	10/17/2003	REFERENCE CAPTURE ON IDS			
7	02/24/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
6	10/17/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
5	11/21/2001	CORRECTED PAPER			
3	11/20/2001	CORRESPONDENCE ADDRESS CHANGE			
2	11/01/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/14/2001	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.

FCI USA, INC.
825 OLD TRAIL ROAD
ETTERS PA 17319

COPY MAILED

JAN 18 2008

OFFICE OF PETITIONS

In re Patent No. 7,186,123	: DECISION ON
Issued: March 6, 2007	: APPLICATION FOR
Application No. 09/953,631	: PATENT TERM ADJUSTMENT
Filed: September 14, 2001	:
Atty Docket No. 4469F	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF 31 JANUARY 2007 ADJUSTMENT DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT," filed on February 15, 2007 requesting reconsideration of the decision of January 31, 2007, and requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) be corrected from four hundred seventy-four (474) days to add at least an additional 321 days (in effect, to at least seven hundred ninety-five (795) days).

The request for reconsideration of the decision of January 31, 2007 is granted to the extent that the decision of January 31, 2007, has been reconsidered; however, the request for reconsideration is **GRANTED** with respect to making a change in the patent adjustment determination under 35 U.S.C. § 154(b) of 474 days indicated in the decision of January 31, 2007.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is six hundred twenty-four (624) days.

Prior to this decision being rendered, on March 6, 2007, the above-identified application matured into U.S. Patent No. 7,186,123. The Patent issued with a revised Patent Term Adjustment of 896 days.

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a

certificate of correction showing a revised Patent Term Adjustment of **eight hundred nine (809)** days.

Patentees are given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136.

BACKGROUND

On February 14, 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 66 days.

On March 23, 2006, patentees filed the initial application for patent term adjustment, requesting correction of the initial determination of patent term adjustment from sixty-six (66) days to seven hundred eight (708) days.

On January 31, 2007, a Decision on Application for Patent Term Adjustment was mailed, stating that the initial determination of Patent Term Adjustment at the time of the mailing of the notice of allowance was corrected to 474 days. The period of reduction, pursuant to 37 CFR 1.704(b), associated with applicants' filing of a response to the Office action mailed March 8, 2004 on November 26, 2004 was removed. (It was shown that the response was originally filed on April 12, 2004 and lost by the Office). In addition, a period of adjustment, pursuant to 37 CFR 1.702(a)(2) and 1.703(a)(2), of 237 days for Office delay in taking action in response to the response shown to have been originally filed on April 12, 2004 was entered.

On March 6, 2007, the above-identified application matured into U.S. Patent No. 7,186,123. The Patent issued with a revised Patent Term Adjustment of 896 days. After the decision on application for patent term adjustment, the following periods of adjustment and reduction were entered: i) pursuant to 37 CFR 1.702(a)(4), a period of adjustment of 172 days was entered for Office delay in issuing the patent after payment of the issue fee and satisfaction of all outstanding requirements; ii) pursuant to 37 CFR 1.702(b), a period of adjustment of 251 days was entered for Office delay in issuing the patent more than 3 years after the actual filing date of the application; and iii) pursuant to 37 CFR 1.704(b), a period of reduction of 1 day was entered for applicant taking in excess of three months to file the issue fee after the mailing of the notice of allowance.

OPINION

Patentees essentially assert that there should have been no reduction in Patent Term Adjustment for the period from March 8, 2004, through April 25, 2005,[1] because (i) the response filed on November 27, 2004, was a proper reply to restriction requirement mailed on March 8, 2004, and (ii) the restriction requirement mailed on March 8, 2004, contained an Office error.

Patentees' argument that the response filed on November 26, 2004, to the restriction requirement was a proper reply has been considered and found persuasive.

A review of the response filed on November 26, 2004,[2] reveals that it contained an election. Accordingly, it is concluded that the response did not contain an omission. As such the entry of the period of reduction of 150 days, pursuant to 37 CFR 1.704(c)(7) is not warranted and is being removed.

However, a review of the patent term adjustment calculations also reveals that the entry of a period of adjustment of 251 days, pursuant to 37 CFR 1.702(b), for Office delay in issuing the patent more than 3 years after the actual filing date of the application is incorrect. It is noted that the instant patent issued 3 years and 903 days after its filing date. However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, the period of delay of 903 days attributable to the

[1] Although patentees state, in part, that "[t]he Petitions Office has denied the Applicants' term extension from 8 March 2004 through 26 November 2004," the PTA was increased by 171 days for this period of delay in the decision mailed on January 31, 2007. As such, the sole time period in dispute is the period of delay from November 27, 2004, through April 6, 2005.

[2] This is a replacement of the papers filed on April 12, 2004.

delay in the issuance of the patent overlaps with the adjustments totalling 889 days (480 + 237 + 172) attributable to grounds specified in § 1.702(a)(1), (2) and (4) respectively. Thus, at issuance, only an additional period of adjustment of 14 days should have been entered for a total of 903 days of Office delay.

CONCLUSION

In view thereof, the patent should have indicated a revised patent term adjustment of eight hundred nine (809) days (903 days of Office delay reduced by 94 (33 + 60 + 1)).

The $200.00 fee set forth in 37 CFR 1.18(e) was submitted on application for patent term adjustment filed March 23, 2006. No additional fees are required on request for reconsideration of the decision on the application for patent term adjustment. The $200 fee charged is being refunded to Deposit Account No. 02-2097, as authorized.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by eight hundred nine **(809)** days.

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

Nancy Johnson

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,186,123 B2

DATED : March 6, 2007

INVENTOR(S) : Timothy A. Lemke

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (896) days

Delete the phrase "by 896 days" and insert – by 809 days--

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5-5-08

TO SPE OF : ART UNIT 2833

SUBJECT : Request for Certificate of Correction on Patent No.: 7186123/09/953631

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.

Application Data Should it be entered?

Eva James

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

/renee s luebke/
Renee Luebke
SPE - AU 2833

SPE **Art Unit**

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

chk

Mailed: APR 2 2004

Paper Number 13

In re application of:
King et al.
Serial No. 09/953,641
Filed: May 21, 1999
For: RECORDING MATERIAL AND METHOD

DECISION ON PETITION

This is a response to the PETITION TO ADD INVENTOR PURSUANT TO 37 C.F.R.§ 1.48, filed September 16, 2003. The petition requests that Karen Taylor, Stefan Schuttel and Meinrad Schaer be added as inventors in the instant application.

37 CFR 1.48(a) requires that the amendment to the application be accompanied by: (1) a petition including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the fee set forth in 37 CFR 1.17 (i); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The instant petition has met all of these requirements. Therefore, the petition is granted. The application will be forwarded to the appropriate section of the USPTO for correction of the record.

The Petition is **GRANTED**.

Cynthia H. Kelly
Supervisory Patent Examiner
Art Unit 1774
Technology Center 1700

ONOFRIO LAW
1133 BROADWAY SUITE 1600
NEW YORK, NEW YORK 10010

UNITED STATES 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

Jean Kyle
PO Box 2274
Hamilton, MT 59840-4274

COPY MAILED

NOV 1 0 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of	:
Richard Morgenstern	:
Application No. 09/953,678	:
Filed: September 15, 2001	:
Attorney Docket No. MOG-T100	:

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

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final Office action mailed September 5, 2002, which set a shortened statutory period for reply of three months from the mail date of the Notice. A one-month extension of time was submitted on February 12, 2003. Accordingly, the application became abandoned on February 13, 2003.

The application file is being forwarded to Technology Center AU 3635 for further processing.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJr.:08-02
Paper 8

MICHAEL L. GOLDMAN
NIXON PEABODY LLP
CLINTON SQUARE
P.O. BOX 31051
ROCHESTER NY 14603

COPY MAILED

AUG 0 5 2002

OFFICE OF PETITIONS

In re Application of
Miller, et al.
Application No. 09/953,686
Filed: 17 September, 2001
Attorney Docket No.: 20609/183 (UTRC PD-98076)

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §1.10[1] filed on 21 May, 2002, and the request for a corrected filing date of 17 September, 2001.[2]

The petition is **GRANTED**.[3]

The record demonstrates that:

- Petitioner place the Express Mail label number EL801321944US on the application transmittal form and the Express Mail certificate;

---

[1] The regulations at 37 C.F.R. §1.10 provide in pertinent part:

§1.10 Filing of papers and fees by "Express Mail."

* * *

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

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

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

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

* * *

[48 Fed. Reg. 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983, paras. (a) & (c), 49 Fed. Reg. 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a) - (c) revised and paras. (d) - (f) added, 61 Fed. Reg. 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

[2] Petitioner is reminded that the regulation provides that Petitioner is to act promptly upon becoming aware that the Office has accorded or will accord a filing date other than that which Petitioner believes is proper.

[3] No fee has been charged for this petition.

- Petitioner's receipt copy of the United States Postal Service (USPS) Express Mail label number EL801321944US is date-stamped 17 September, 2001, by the USPS, Rochester, NY;

- the data base of USPS Express Mail service evidences that package bearing Express Mail label number EL801321944US was deposited with and accepted by the USPS at 4:39 p.m. on 17 September, 2001, and delivered to the Office at 12:07 p.m. on 18 September, 2001;

therefore, the application is entitled to a filing date of 17 September, 2001, under the provisions of 37 C.F.R. §1.10.

As to the instant application, the Office of Initial Patent Examination is specifically instructed to:

- assign a filing date of 17 September, 2001, and

- issue a corrected filing receipt specifying the filing date as that of 17 September, 2001.

Therefore, this application file is being forwarded to Office of Initial Patent Examination for assignment of the filing date of 17 September, 2001, and issuance of a corrected Filing Receipt reflecting that filing date for Application No. 09/953,686.

The application file will then be forwarded for processing as necessary.

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

John J. Gillon, Jr.
Senior 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

ROSENMAN & COLIN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

COPY MAILED

FEB 08 2007

OFFICE OF PETITIONS

In re Application of	:	
Hideyuki Aoki et al	:	
Application No. 09/953,694	:	DECISION ON PETITION
Filed: September 17, 2001	:	
Attorney Docket No. FUJY 19.005	:	

This is a decision on the petition, filed July 19, 2006, 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 December 28, 2005, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on July 13, 2006.

Petitioner asserts that the Office action dated December 28, 2005 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 nonreceived Office action would have been entered had it been received and docketed 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 3621 for re-mailing the Office action of December 28, 2005. The period for reply will run from the mailing date of the Office action.

Irvin Dingle
Petition Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PVF – BROCADE COMMUNICATIONS SYSTEMS INC.
c/o PARK VAUGHAN & FLEMING, LLP
2820 FIFTH STREET
DAVIS, CA 95618

MAILED

JAN 21 2010

OFFICE OF PETITIONS

In re Application of	:	
Thomas Lee WATSON, et *al.*	:	
Application No. 09/953,714	:	DECISION GRANTING PETITION
Filed: September 17, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **FDRY-0180-US**	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 19, 2010, 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 11, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2444 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the information disclosure statement filed January 8, 2010.

/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

PVF -- Brocade Communications Systems Inc.
c/o Park, Vaughan & Fleming LLP
2820 Fifth Street
Davis CA 95618

MAILED

JUL 15 2010

OFFICE OF PETITIONS

In re Application of	:	
Thomas Lee Watson, et al.	:	
Application No. 09/953,714	:	DECISION ON PETITION
Filed: September 17, 2001	:	
Attorney Docket No. FDRY-0180-US	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 8, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before May 5, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed February 5, 2010. Accordingly, the date of abandonment of this application is May 6, 2010. The Notice of Abandonment was mailed May 24, 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 $1,510 and the publication fee of $300, (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay.

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

This application is being referred to Office of Data Management for processing into a patent.

Terri Johnson

Terri Johnson
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

TEXAS INSTRUMENTS INCORPORATED
P.O. BOX 655474, M/S 3999
DALLAS, TX 75265

COPY MAILED

AUG 2 8 2002

OFFICE OF PETITIONS

In re Application of :
Peter Maimone, Al Morton and :
Chii-Fa Chou : NOTICE OF ABANDONMENT
Application No. 09/953,739 :
Filed: September 17, 2001 :
Title: METHOD AND APPARATUS FOR AN :
ACTIVE READ/WRITE HEAD :

This is in response to the petition under 37 CFR 1.47, filed June 10, 2002.

The petition is **DISMISSED AS UNTIMELY**.

The above-identified application was filed on September 17, 2001, without an executed oath or declaration. Peter Maimone, Al Morton and Chii-Fa Chou were named as joint inventors. Accordingly, on October 15, 2001, applicants were mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration and payment of the surcharge for late filing under §1.16(e). This Notice set a two-month period for reply, with extensions of time obtainable under §1.36(a), to avoid abandonment.

On June 10, 2002 (certificate of mailing May 31, 2002), applicants filed the instant petition with a constructive petition for any extension of time required. However, 37 CFR 1.136 provides that a petition for extension of time for filing a response to an Office action must be filed prior to the expiration of the maximum period obtainable to avoid abandonment. The maximum extension of time obtainable under 37 CFR 1.136(a) for reply to a Notice to File Missing Parts of an Application is 5 months. In this instance, this extendable period ended on May 15, 2002. Accordingly, the constructive petition is not effective to extend the period for reply and the petition submitted June 10, 2002 (certificate of mailing May 31, 2002) cannot be accepted as a timely reply to the Notice[1]. No reply having been received and no extension of time obtained, the above-identified application became abandoned on December 16, 2001.

Applicants may wish to file a petition to revive the application under the provisions of 37 CFR §1.137(a) or §1.137(b), as appropriate. Under either provision, the petition under §1.47, including the general authorization to charge any required fee

[1] As an extension of time cannot be entered, the authorized extension of time fee will not be charged to petitioner's Deposit Account.

(i.e. the surcharge under §1.16(e)), may be identified as the previously filed reply to the Outstanding notice. However, applicants are advised that: An assignee may prosecute the application on behalf of the inventors under §1.47(b) only where no inventors are available to join in the application. Where as here, there is an available joint inventor, that inventor may prosecute the application on behalf of himself and on behalf of the non-signing inventors pursuant to 37 CFR 1.47(a). Moreover, any petition under §1.47 must include proof of the unavailability of the non-signing inventors; and if applicants allege that the inventor refuses to sign, proof that a bona fide attempt was made to present all of the application papers (specification, claims and drawings) to the non-signing inventor. See MPEP 409.03. The petition under §1.47 filed June 10, 2002 does not appear to include any declarations of fact or supporting documentary evidence.

Finally, the filing of a petition under §1.137 should not be delayed, as petitioner bears the burden of establishing that the entire delay, including the delay from the due date for the reply until the filing of a grantable petition, was unavoidable or unintentional.

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: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

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

Nancy Johnson

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. 9

TEXAS INSTRUMENTS INCORPORATED
P.O. BOX 655474, M/S 3999
DALLAS, TX 75265

COPY MAILED

DEC 0 9 2002

OFFICE OF PETITIONS

In re Application of :
Peter Maimone, Al Morton and :
Chii-Fa Chou :
Application No. 09/953,739 :
Filed: September 17, 2001 :
Title: METHOD AND APPARATUS FOR AN :
ACTIVE READ/WRITE HEAD :

DECISION ON PETITION

This is in response to the petition under 37 CFR 1.47, filed June 10, 2002, and the petition under § 1.137(b), filed November 25, 2002.

The petition under § 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 CFR 1.136(a).

A decision on the petition under § 1.137(b) is being held in abeyance.

The above-identified application was filed on September 17, 2001, without an executed oath or declaration. Peter Maimone, Al Morton and Chii-Fa Chou were named as joint inventors. Accordingly, on October 15, 2001, applicants were mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration and payment of the surcharge for late filing under §1.16(e). This Notice set a two-month period for reply, with extensions of time obtainable under § 1.36(a), to avoid abandonment. No reply having been received and no extension of time obtained, the above-identified application became abandoned on December 16, 2001. A late reply filed June 10, 2002, was not considered, and applicants were informed that the application was abandoned (Notice mailed August 28, 2002).

In response, applicants filed the instant petition under § 1.137(b), including the petition fee and the required statement of unintentional delay. For the required reply, applicants submitted the petition under § 1.47(a). This reply was made timely by an accompanying petition and fee for a one-month extension of time.

A grantable petition under 37 CFR 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 is deficient because applicants have not provided adequate proof of the unavailability of the non-signing inventors.

Rule 47 applicants have failed to show that the non-signing inventors refused to sign the declaration after having been presented with the application papers[1]. As noted in the decision mailed August 28, 2002, 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 inventors. See MPEP 409.03(d). A careful review of the petition reveals that it only shows that the inventors were presented with the assignment and declaration for the above-identified application. Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to the non-signing inventors and they each refused to sign. A copy of the application papers should be sent by certified mail return-receipt requested to the last known address of each of the non-signing inventors, or, if the inventors are represented by counsel, to the address of each non-signing inventor's attorney. On renewed petition, documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

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

---

[1] It is further noted that if petitioner's contention is that the inventor cannot be reached or found to join in the application, diligent efforts to locate him must be shown. The instant petition does not reflect diligent effort. If reasonable attempts to obtain forwarding addresses or to locate the non-signing inventors by other means such as through E-mail, or the Internet fail, then applicants will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached or found after diligent effort. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicants should also submit documentary evidence such as the results of any E-mail or Internet searches.

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

Paper No. 8

ILYA ZBOROVSKY
6 Schoolhouse Way
Dix Hills NY 11746

COPY MAILED

JAN 0 9 2004

OFFICE OF PETITIONS

In re Application of
Bruce Barton, et al.
Application No. 09/953,743
Filed: September 17, 2001
Attorney Docket No. N/A

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 30, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 2, 2003, which set a shortened statutory period for reply of three(3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 3, 2003.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111.

The application file is being forwarded to Technology Center 2800, Art Unit 2836.

Cheryl Gibson Baylor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Ilya Zborovsky
6 Schoolhouse Way
Dix Hills, NY 11746

COPY MAILED

AUG 1 9 2002

OFFICE OF PETITIONS

In re Application of :
Leonid Leykin, Aleksandr Kofman and:
Leonid Khodor :
Application No. 09/953,744 :
Filed: September 17, 2001 :
Title: CONTAINER FOR CONTAINING, :
TREATING AND DISPENSING A BUN IN A :
HOT DOG DISPENSING MACHINE :

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

This is in response to the letter filed May 24, 2002, which is being treated as a petition under §1.47 to accept a declaration without the signature of joint inventor Leonid Khodor.

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 CFR 1.136(a).

The above-identified application was filed on September 17, 2001, with a declaration executed by joint inventors Leonid Leykin and Aleksandr Kofman on behalf of themselves and on behalf of non-signing inventor Khodor. Included therewith was a statement that inventor Khodor refused to sign and that an employment agreement was enclosed.

On October 16, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application," requesting a declaration with inventor Khodor's signature and a late surcharge under §1.16(e). In reply on December 16, 2001, petitioner timely filed the instant petition, stating that:

> together with the application papers, a copy of the Employment Agreement has been submitted, in which it is stated that Mr. Khodor's inventions belong to the Company, and therefore, the Company has rights to file the applications in which he is a co-inventor without his signature.

The petition did not include payment of the petition fee, proof of the unavailability of inventor Khodor, or a statement of the last known address of inventor Khodor.

A grantable petition under 37 CFR 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 petition is deficient because applicants have met none of these requirements.

As to requirement (1), Rule 47 applicant has failed to show that the non-signing inventor refused to sign the declaration after having been presented with the application papers. 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). Thus, on renewed petition, applicant 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 by certified mail return-receipt requested 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.

Moreover, where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. When it is concluded by rule 1.47 applicants that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. On request for reconsideration, applicants must be specific and fully describe the facts relied on to conclude that inventor Khodor refuses to join in the application. Any affidavit or declaration of facts submitted must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

As to requirement (2), applicants submitted on filing a declaration executed by inventors Leykin and Kofman on behalf of themselves and on behalf of non-signing inventor Khodor. The declaration does not include the citizenship of inventor Khodor. This is a statutory requirement. See 35 U.S.C. 115[1].

As to requirements (3) and (4), the petition does not include the petition fee or a statement of the last known address of inventor Khodor.

Applicants are further advised that no copy of an employment agreement, as stated on petition, has been received by the Office. This is of no consequence as proof of proprietary interest is an element of 37 CFR 1.47(b), not 1.47(a). See MPEP 409.03(b).

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

---

[1] By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent and Trademark Office."

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 11

Ilya Zborovsky
6 Schoolhouse Way
Dix Hills, NY 11746

COPY MAILED

MAY 2 1 2003

OFFICE OF PETITIONS

In re Application of :
Leonid Leykin, Aleksandr Kofman and :
Leonid Khodor :
Application No. 09/953,744 :
Filed: September 17, 2001 :
Title: CONTAINER FOR CONTAINING, :
TREATING AND DISPENSING A BUN IN A :
HOT DOG DISPENSING MACHINE :

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

This is in response to the "Petition under 37 C.F.R. § 1.47(a)," filed February 19, 2003, to accept a declaration without the signature of joint inventor Leonid Khodor.

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

The above-identified application was filed on September 17, 2001, with a declaration executed by joint inventors Leonid Leykin and Aleksandr Kofman on behalf of themselves and on behalf of non-signing inventor Khodor. Included therewith was a statement that inventor Khodor refused to sign and that an employment agreement was enclosed. No petition under § 1.47 was filed. Accordingly, on October 16, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application," requesting a declaration with inventor Khodor's signature and a late surcharge under §1.16(e). A reply filed December 16, 2001, was treated as a petition under § 1.47, but was dismissed for failure to include payment of the petition fee, proof of the unavailability of inventor Khodor, or a statement of the last known address of inventor Khodor. In addition, the declaration filed September 17, 2001 was found unacceptable as it did not include the citizenship of non-signing inventor Khodor (Decision mailed August 19, 2002).

On instant petition, petitioner submitted proof that inventor Khodor had been presented with the application papers, but refused to join in the application; paid the petition fee; and made a statement of inventor Khodor's last known address. The petition also included a new declaration. To make this response timely, petitioner submitted a petition (and fee) for a extension of the period for response to February 19, 2003.

The declaration filed February 19, 2003, has been reviewed and found in compliance with 35 USC §§ 115 and 116.

Having reviewed the petition, it is concluded that petitioner has met the requirements for acceptance of this declaration under § 1.47(a).

This application is hereby accorded Rule 1.47(a) status.

As provided in new Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing 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 the Office of Initial Patent Examination for completion of pre-examination processing.

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

Nancy Johnson
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

John P. Maldjian
TyCom (US) Inc.
Rm 2B 106
250 Industrial Way West
Eatontown, NJ 07724

COPY MAILED

OCT 17 2002

OFFICE OF PETITIONS

In re Application of
Steven R. Johnson
Application No. 09/953,754
Filed: September 17, 2001
Attorney Docket No. 1043

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 23, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Corrected Application Papers mailed October 16, 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 December 17, 2002.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

COPY MAILED

SEP 16 2009

OFFICE OF PETITIONS

In re Application of :
Ramakrishnan et al. :
Application No. 09/953,807 :
Filed: September 17, 2001 :
Attorney Docket No. 26505-510CIP :

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 USC § 1.705" filed May 26, 2009. Applicants request that the determination of patent term adjustment be corrected from one hundred eighty seven (187) days to seven hundred seventy-five (775).

This application for patent term adjustment was timely filed with payment of the Issue Fee on May 26, 2009. As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

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

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

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, 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

---

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

FIFTEEN (315) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 24, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 187 days. The instant application for patent term adjustment was timely filed on May 26, 2009, with payment of the issue fee.

Applicants contend that the Office incorrectly calculated 220 days of applicants' delay for the filing of a response on September 13, 2002 to a Notice to File Missing Parts mailed on November 5, 2001. Applicants state that a Notice to Filing Missing Parts was not mailed on November 5, 2001. Instead, applicants contend based on the mailing of a Notice to File Missing Parts dated March 13, 2002 the correct reduction for submission of a reply on September 13, 2002 is 92 days.

Applicants' arguments have been considered and found persuasive. A review of the record confirms that a Notice to File Missing Parts was mailed on March 13, 2002 and not November 5, 2001. As such since a reply to the Notice to File Missing Parts was submitted on September 13, 2002 (92 days in excess of three months from the mailing of the Notice to File Missing Parts) a reduction of 92 days pursuant to 37 CFR 1.704(b) is appropriate.

Thus, the total calculation for applicant delay prior to the mailing of the Notice of Allowance is 309 days.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 315 days (624 days of Office delay reduced by 309 (92 + 81 + 45 + 91) days of applicant delay).

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

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding

requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Tuesday
Date: 9/15/2009

PALM INTRANET

Time: 18:07:35

PTA Calculations for Application: 09/953807			
Application Filing Date:	09/17/2001	PTO Delay (PTO):	624
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	437
Post-Issue Petitions:	0	Total PTA (days):	315
PTO Delay Adjustment:	128		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
127	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	220		
126	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		92	
114	02/24/2009	MAIL NOTICE OF ALLOWANCE			
113	02/18/2009	ISSUE REVISION COMPLETED			
112	02/18/2009	DOCUMENT VERIFICATION			
111	02/18/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
110	02/18/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
109	02/02/2009	EXAMINER'S AMENDMENT COMMUNICATION			
108	02/02/2009	NOTICE OF ALLOWABILITY			
94	01/07/2009	PARALEGAL TD ACCEPTED			
93	12/17/2008	TERMINAL DISCLAIMER FILED		0	91
92	01/06/2009	DATE FORWARDED TO EXAMINER			
91	12/17/2008	AMENDMENT AFTER FINAL REJECTION			
90	12/17/2008	TERMINAL DISCLAIMER FILED			
89	10/17/2008	MAIL FINAL REJECTION (PTOL - 326)			
88	10/16/2008	FINAL REJECTION			
86	09/03/2008	DATE FORWARDED TO EXAMINER			
85	07/24/2008	RESPONSE AFTER NON-FINAL ACTION		91	83
84	07/24/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
83	01/24/2008	MAIL NON-FINAL REJECTION			
82	01/22/2008	NON-FINAL REJECTION			
80	11/29/2007	DATE FORWARDED TO EXAMINER			
79	10/29/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			

78	11/29/2007	DATE FORWARDED TO EXAMINER			
77	10/29/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		45	72
76	11/29/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
75	10/29/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
74	10/29/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
73	06/14/2007	MAIL NOTICE OF WITHDRAWN ACTION			
72	06/14/2007	MAIL FINAL REJECTION (PTOL - 326)			
71	06/11/2007	FINAL REJECTION			
70	06/11/2007	LETTER WITHDRAWING / VACATING OFFICE ACTION			
69	06/07/2007	CORRESPONDENCE ADDRESS CHANGE			
68	05/30/2007	CORRESPONDENCE ADDRESS CHANGE			
67	05/30/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
66	02/28/2007	MAIL FINAL REJECTION (PTOL - 326)			
65	02/26/2007	FINAL REJECTION			
64	01/03/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
63	01/16/2007	DATE FORWARDED TO EXAMINER			
62	01/03/2007	RESPONSE AFTER NON-FINAL ACTION			
61	10/03/2006	MAIL NON-FINAL REJECTION			
60	09/29/2006	NON-FINAL REJECTION			
59	06/30/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
58.7	06/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	56
58	06/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
57	07/17/2006	DATE FORWARDED TO EXAMINER			
56	06/30/2006	RESPONSE AFTER NON-FINAL ACTION			
55	04/14/2006	MAIL NON-FINAL REJECTION			
54	04/12/2006	NON-FINAL REJECTION			
53	02/07/2006	DATE FORWARDED TO EXAMINER			
52	01/31/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
51	02/07/2006	DATE FORWARDED TO EXAMINER			
50	01/31/2006	REQUEST FOR CONTINUED EXAMINATION			

		(RCE)			
49	02/07/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
48	01/31/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
47	12/22/2005	MAIL ADVISORY ACTION (PTOL - 303)			
46	12/20/2005	ADVISORY ACTION (PTOL-303)			
45	12/13/2005	DATE FORWARDED TO EXAMINER			
44	12/01/2005	AMENDMENT AFTER FINAL REJECTION			
43	10/31/2005	MAIL FINAL REJECTION (PTOL - 326)			
42	10/26/2005	FINAL REJECTION			
41	08/25/2005	DATE FORWARDED TO EXAMINER			
40	08/15/2005	RESPONSE AFTER NON-FINAL ACTION			
39	07/20/2005	CASE DOCKETED TO EXAMINER IN GAU			
38	05/23/2005	MAIL NON-FINAL REJECTION	40		34
37	05/16/2005	NON-FINAL REJECTION			
36	03/31/2005	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS			
35	01/07/2005	DATE FORWARDED TO EXAMINER			
34	12/13/2004	RESPONSE TO ELECTION / RESTRICTION FILED		81	27
33	12/13/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	12/23/2004	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
28	12/13/2004	WORKFLOW INCOMING AMENDMENT IFW			
27	06/23/2004	MAIL RESTRICTION REQUIREMENT	584		-1
26	06/22/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
25	05/23/2004	CASE DOCKETED TO EXAMINER IN GAU			
24	05/11/2004	CASE DOCKETED TO EXAMINER IN GAU			
23	03/05/2004	CASE DOCKETED TO EXAMINER IN GAU			
22	02/24/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
21.7	08/13/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	08/13/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
20	02/24/2004	CASE DOCKETED TO EXAMINER IN GAU			
19	11/21/2003	APPLICATION IS NOW COMPLETE			
18	11/21/2003	APPLICATION DISPATCHED FROM OIPE			
17	11/21/2003	APPLICATION IS NOW COMPLETE			

16	09/13/2002	ADDITIONAL APPLICATION FILING FEES		220	5
15	09/13/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
14	09/13/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
12	09/13/2002	SMALL ENTITY STATEMENT (37 CFR 1.27)			
10	05/15/2002	RECEIPT OF ACKNOWLEDGMENT LETTER			
9	05/15/2002	RECEIPT OF ACKNOWLEDGMENT LETTER			
8	03/29/2002	LETTER TO APPLICANT - NO GOVERNMENT INTEREST / PATENT TO ISSUE			
6	11/09/2001	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
5	11/05/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	10/29/2001	CORRESPONDENCE ADDRESS CHANGE			
3	10/10/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	09/17/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	09/17/2001	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

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED

MAR 15 2010

OFFICE OF PETITIONS

In re Patent No. 7,606,670	:
Ramakrishnan et al.	: DECISION ON REQUEST FOR
Issue Date: October 20, 2009	: RECONSIDERATION OF
Application No.09/953,807	: PATENT TERM ADJUSTMENT
Filed: September 17, 2001	: AND NOTICE OF INTENT
Attorney Docket No. 26505-510CIP	: TO ISSUE CERTIFICATE OF CORRECTION
Title: CRYSTAL STRUCTURE OF THE 30S RIBOSOME AND ITS USE	:

This is a decision on the petition filed on December 18, 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 seven hundred ninety-seven (797) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by seven hundred ninety-seven (797) days is **GRANTED.**

The application is being forwarded to the Certificate of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **seven hundred ninety-seven (797)** days.

The $200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed from deposit account no. 50-0311. No additional fees are required.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

/Kery A. Fries/

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

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,606,670 B2

DATED : **October 20, 2009** **DRAFT**

INVENTOR(S) : Ramakrishnan 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 337 days

Delete the phrase "by 337 days" and insert – by 797 days--

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

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON, MA 02111

Mail Date: 04/21/2010

Applicant	: Venkatraman Ramakrishnan	: DECISION ON REQUEST FOR
Patent Number	: 7606670	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/953,807	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/17/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1257** 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

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED

MAY 18 2010

OFFICE OF PETITIONS

In re Patent No. 7,606,670	:	DECISION ON REQUEST FOR
RAMAKRISHNAN et al.	:	RECONSIDERATION OF
Issue Date: October 20, 2009	:	PATENT TERM ADJUSTMENT
Application No. 09/953,807	:	AND
Filed: September 17, 2001	:	NOTICE OF INTENT TO ISSUE
Docket No. 26505-510CIP	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on December 18, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting correction of the patent term adjustment indicated on the above-identified patent.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The term of the above-identified patent is extended or adjusted by **seven hundred ninety-seven (797) days**.

On December 18, 2009, patentee submitted a petition under 37 CFR 1.705(d) and fee. On February 23, 2010, patentee filed a Request for Recalculation of Patent Term Adjustment in View of *Wyeth*. On March 15, 2010, the Office mailed a decision granting the petition under 37 CFR 1.705(d) to the extent that a certificate of correction would be issued indicating that the term of the patent was extended or adjusted by 797 days. On April 21, 2010, the Office mailed a "DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION" indicating that the patent term adjustment had been determined to be 1257 days.

The Office notes that the decision of April 21, 2010, was issued in error as it accorded patentee 460 more days of patent term adjustment than were warranted. Accordingly, the decision of April 21, 2010, is withdrawn. The present decision supersedes the decision mailed on April 21, 2010.

The Office has determined that the patent term adjustment for the above-identified patent is **797 days**. The 460 additional days of adjustment will be removed.

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, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges the previous submission of the required fee of $200.00 set forth in 37 CFR 1.18(e).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **797 days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,606,670 B2

DATED : Oct. 20, 2009 **DRAFT**

INVENTOR(S) : RAMAKRISHNAN 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 337 days

Delete the phrase "by 337 days" and insert – by 797 days--

Day : Monday
Date: 5/17/2010

PALM INTRANET

Time: 11:55:13

PTA Calculations for Application: 09/953807			
Application Filing Date:	09/17/2001	PTO Delay (PTO):	1108
Issue Date of Patent:	10/20/2009	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	439
Post-Issue Petitions:	0	Total PTA (days):	797
PTO Delay Adjustment:	128		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
146	05/17/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		460	
143	04/17/2010	PETITION DECISION - GRANTED			
142	03/26/2010	POST ISSUE COMMUNICATION - CERTIFICATE OF CORRECTION			
141	03/15/2010	MAIL-RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE			
140	03/15/2010	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE			
140	03/15/2010	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE			
139	12/18/2009	PETITION ENTERED			
138	03/14/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	460		
138	03/14/2010	ADJUSTMENT OF PTA CALCULATION BY PTO			
137	02/23/2010	PETITION ENTERED			
135	11/06/2009	SEQUENCE MOVED TO PUBLIC DATABASE			
134	10/20/2009	RECORDATION OF PATENT GRANT MAILED			
133	09/30/2009	ISSUE NOTIFICATION MAILED			
132.5	01/30/2006	PTA 36 MONTHS	500		
132	10/20/2009	PATENT ISSUE DATE USED IN PTA CALCULATION	24		123
131	09/22/2009	EXPORT TO FINAL DATA CAPTURE			
130	09/21/2009	DISPATCH TO FDC			
129	09/16/2009	MAIL-RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
128	09/16/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			

128	09/16/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
127	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO			
127	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	220		
126	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO			
126	09/15/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		92	
125	05/28/2009	APPLICATION IS CONSIDERED READY FOR ISSUE			
124	05/26/2009	APPLICANT HAS FILED A VERIFIED STATEMENT OF SMALL ENTITY STATUS IN COMPLIANCE WITH 37 CFR 1.27			
123	05/26/2009	ISSUE FEE PAYMENT VERIFIED		2	114
122	05/26/2009	PETITION ENTERED			
121	05/26/2009	ISSUE FEE PAYMENT RECEIVED			
120	04/01/2009	FINISHED INITIAL DATA CAPTURE			
119	03/16/2009	SEQUENCE FORWARDED TO PUBS ON TAPE			
118	03/10/2009	RECEIPT INTO PUBS			
117	03/10/2009	RECEIPT INTO PUBS			
116	03/03/2009	EXPORT TO INITIAL DATA CAPTURE			
114	02/24/2009	MAIL NOTICE OF ALLOWANCE			
113	02/18/2009	ISSUE REVISION COMPLETED			
112	02/18/2009	DOCUMENT VERIFICATION			
111	02/18/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
110	02/18/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
109	02/02/2009	EXAMINER'S AMENDMENT COMMUNICATION			
108	02/02/2009	NOTICE OF ALLOWABILITY			
94	01/07/2009	PARALEGAL TD ACCEPTED			
93	12/17/2008	TERMINAL DISCLAIMER FILED		0	91
92	01/06/2009	DATE FORWARDED TO EXAMINER			
91	12/17/2008	AMENDMENT AFTER FINAL REJECTION			
90	12/17/2008	TERMINAL DISCLAIMER FILED			
89	10/17/2008	MAIL FINAL REJECTION (PTOL - 326)			
88	10/16/2008	FINAL REJECTION			
86	09/03/2008	DATE FORWARDED TO EXAMINER			
85	07/24/2008	RESPONSE AFTER NON-FINAL ACTION		91	83
84	07/24/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			

83	01/24/2008	MAIL NON-FINAL REJECTION			
82	01/22/2008	NON-FINAL REJECTION			
80	11/29/2007	DATE FORWARDED TO EXAMINER			
79	10/29/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
78	11/29/2007	DATE FORWARDED TO EXAMINER			
77	10/29/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		45	72
76	11/29/2007	DISPOSAL FOR A RCE / CPA / R129			
75	10/29/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
74	10/29/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
73	06/14/2007	MAIL NOTICE OF WITHDRAWN ACTION			
72	06/14/2007	MAIL FINAL REJECTION (PTOL - 326)			
71	06/11/2007	FINAL REJECTION			
70	06/11/2007	LETTER WITHDRAWING / VACATING OFFICE ACTION			
69	06/07/2007	CORRESPONDENCE ADDRESS CHANGE			
68	05/30/2007	CORRESPONDENCE ADDRESS CHANGE			
67	05/30/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
66	02/28/2007	MAIL FINAL REJECTION (PTOL - 326)			
65	02/26/2007	FINAL REJECTION			
64	01/03/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
63	01/16/2007	DATE FORWARDED TO EXAMINER			
62	01/03/2007	RESPONSE AFTER NON-FINAL ACTION			
61	10/03/2006	MAIL NON-FINAL REJECTION			
60	09/29/2006	NON-FINAL REJECTION			
59	06/30/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
58.7	06/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	56
58	06/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
57	07/17/2006	DATE FORWARDED TO EXAMINER			
56	06/30/2006	RESPONSE AFTER NON-FINAL ACTION			
55	04/14/2006	MAIL NON-FINAL REJECTION			
54	04/12/2006	NON-FINAL REJECTION			

53	02/07/2006	DATE FORWARDED TO EXAMINER			
52	01/31/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
51	02/07/2006	DATE FORWARDED TO EXAMINER			
50	01/31/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
49	02/07/2006	DISPOSAL FOR A RCE / CPA / R129			
48	01/31/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
47	12/22/2005	MAIL ADVISORY ACTION (PTOL - 303)			
46	12/20/2005	ADVISORY ACTION (PTOL-303)			
45	12/13/2005	DATE FORWARDED TO EXAMINER			
44	12/01/2005	AMENDMENT AFTER FINAL REJECTION			
43	10/31/2005	MAIL FINAL REJECTION (PTOL - 326)			
42	10/26/2005	FINAL REJECTION			
41	08/25/2005	DATE FORWARDED TO EXAMINER			
40	08/15/2005	RESPONSE AFTER NON-FINAL ACTION			
39	07/20/2005	CASE DOCKETED TO EXAMINER IN GAU			
38	05/23/2005	MAIL NON-FINAL REJECTION			34
37	05/16/2005	NON-FINAL REJECTION			
36	03/31/2005	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS			
35	01/07/2005	DATE FORWARDED TO EXAMINER			
34	12/13/2004	RESPONSE TO ELECTION / RESTRICTION FILED		81	27
33	12/13/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	12/23/2004	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
28	12/13/2004	WORKFLOW INCOMING AMENDMENT IFW			
27	06/23/2004	MAIL RESTRICTION REQUIREMENT	584		-1
26	06/22/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
25	05/23/2004	CASE DOCKETED TO EXAMINER IN GAU			
24	05/11/2004	CASE DOCKETED TO EXAMINER IN GAU			
23	03/05/2004	CASE DOCKETED TO EXAMINER IN GAU			
22	02/24/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
21.7	08/13/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	08/13/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

20	02/24/2004	CASE DOCKETED TO EXAMINER IN GAU			
19	11/21/2003	APPLICATION IS NOW COMPLETE			
18	11/21/2003	APPLICATION DISPATCHED FROM OIPE			
17	11/21/2003	APPLICATION IS NOW COMPLETE			
16	09/13/2002	ADDITIONAL APPLICATION FILING FEES		220	5
15	09/13/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
14	09/13/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
12	09/13/2002	SMALL ENTITY STATEMENT (37 CFR 1.27)			
10	05/15/2002	RECEIPT OF ACKNOWLEDGMENT LETTER			
9	05/15/2002	RECEIPT OF ACKNOWLEDGMENT LETTER			
8	03/29/2002	LETTER TO APPLICANT - NO GOVERNMENT INTEREST / PATENT TO ISSUE			
6	11/09/2001	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
5	11/05/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	10/29/2001	CORRESPONDENCE ADDRESS CHANGE			
3	10/10/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	09/17/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	09/17/2001	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

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO IL 60606

COPY MAILED
NOV 30 2006
OFFICE OF PETITIONS

In re Application of Nixon et al. :
Application No. 09/953,811 : Decision on Petition
Filing Date: September 17, 2001 :
Attorney Docket No. 06005/37331 :

This is a decision on the petition under 37 CFR 1.181, filed September 6, 2006, to withdraw the holding of abandonment.

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 March 27, 2006, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on June 28, 2006. A Notice of Abandonment was mailed on August 23, 2006.

Petitioner has established non-receipt of the Notice of Allowance and Notice of Allowability mailed March 27, 2006. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Technology Center Art Unit 2154 will be informed of the instant decision. Thereafter, the Technology Center's technical support staff will mail a new Notice of Allowance and a new Notice of Allowability. The time period for responding to the new Notices will be set to run from the mailing date of the new Notices.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

WILLIAM S. GOTTSCHALK
CARLSON GASKEY & OLDS P C
400 W MAPLE, SUITE 350
BIRMINGHAM, MI 48009

COPY MAILED

OCT 1 8 2001

OFFICE OF PETITIONS

In re Application of	:	
Jianmei Pan et al	:	DECISION GRANTING
Application No. 09/953,817	:	PETITION
Filed: September 17, 2001	:	
Attorney Docket No. 60,130-561	:	
99MRA069	:	

This is a decision on the petition under 37 CFR 1.10(c) filed September 24, 2001, which is properly treated as a petition under 37 CFR 1.10 (d), requesting that the above-identified application be accorded a filing date of September 17, 2001, rather than the presently accorded filing date of September 18, 2001.

Applicants request the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on September 17, 2001. The petition is accompanied by, inter alia, a copy of the USPS Track/Confirm system information showing that the package bearing Express Mail label No. EL747234104US was enroute on September 17, 2001. The same Express Mail receipt number was referred to in the copy of the original transmittal letter found in the present application.

In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on September 17, 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 for correction of the filing date to September 17, 2001.

Telephone inquires specific to this matter should be directed to Wan Laymon at (703) 306-5685.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

COPY MAILED

APR 2 7 2005

OFFICE OF PETITIONS

In re Application of	:	
Lisenbee, Layne	:	
Application No. 09/953,835	:	ON PETITION
Filed: September 17, 2001	:	
Attorney Docket No. TI-32411	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 6, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed December 27, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on March 29, 2005.

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

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

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper 3

COPY MAILED

JAN 2 2 2002

OFFICE OF PETITIONS

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

In re Application of
Ara Patpoutian et al.
Application No. 09/953,845
Filed: September 17, 2001
Attorney Docket No. 108047-0046
For: METHOD AND APPARATUS FOR USING MODULATION CODES THAT PRODUCE MAXIMIZED SAMPLE TIMING INFORMATION

DECISION DISMISSING PETITION

This is a decision on the petition filed October 23, 2001 under 37 CFR 1.183 to suspend the requirements of 37 CFR 1.213(a)(1), to allow the filing of a Non-publication Request after the filing of the above-identified application.

The petition is dismissed.

Any request for reconsideration of this decision must be filed within TWO (2) MONTHS from the mail date of this decision. **See** 37 CFR 1.181(f). Extensions of time under 37 CFR 1.136(a) are **not** permitted.

35 U.S.C. 122(b) requires the United States Patent and Trademark Office (USPTO) to publish, eighteen months after filing, utility and plant applications filed on or after November 29, 2000, unless applicant upon filing makes a nonpublication request, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement. [1]

The instant application was filed September 17, 2001 without a request for non-publication and this petition prays for the allowance of a late request under 35 USC 122(b)(2)(B)(i).

37 CFR 1.183 provides that, "In an extraordinary situation, when justice re quires, 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 Section 1.17(h).

There is no provision to accept this request after the filing date of the application, as the requirement for any request for non-publication to be made on filing is a statutory requirement. Accordingly, the nonpublication request filed with the petition will not be recognized. The above-identified application is scheduled to be published on March 20, 2003.

If applicant desires to avoid publication of the above-identified application, he may file a continuation application under 37 CFR 1.53(b) claiming benefit to the above-identified application under 35 U.S.C. 120 with a nonpublication request and, thereafter, abandon the above-identified application by filing a petition under 37 CFR 1.138(c) for express abandonment to avoid publication, including a petition fee

---

[1] *See final rules related to publication of patent applications, titled Changes to Implement Eighteen-Month Publication of Patent Applications, published in the Federal Register on September 20, 2000 (65 Fed. Reg. 57024), and in the Official Gazette on October 10, 2000 (1239 Off. Gaz. Pat. Office 63).*

($130.00). This petition should be mailed to Box PGPUB-ABD or fax to the Pre-Grant Publication Division at (703) 305-8568.

This application is being forwarded to Technology Center AU 2651, for examination in due course.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Patricia Faison-Ball at (703) 305-4497.

Patricia Faison-Ball
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.

MARK R. BUSCHER
P.O. BOX 161
CATHARPIN, VA 20143

COPY MAILED

AUG 1 8 2005

OFFICE OF PETITIONS

In re Patent No. 6,727,367 Karel Pospisilik Issue Date: April 27, 2004 Application No. 09/953,870 Filed: September 18, 2001 Atty Docket No. PAL-010US	: DECISION ON : APPLICATION FOR : PATENT TERM ADJUSTMENT : and : NOTICE OF INTENT TO ISSUE : CERTIFICATE OF CORRECTION : :

This is a decision on the PETITION UNDER 37 C.F.R. § 1.183, filed June 28, 2004, to suspend the timing requirements of 37 CFR § 1.705(d) from 30 days to two months and to accept as timely filed the request for reconsideration of Patent Term Adjustment submitted herewith. Patentee requests that the patent term adjustment indicated in the patent be corrected from fifty-two (52) days to one hundred four (104) days.

For the reasons set forth herein, the petition under 37 CFR 1.183 is **DISMISSED**.

Accordingly, the accompanying request for reconsideration of patent term adjustment indicated in the patent is **DISMISSED AS UNTIMELY FILED**.

However, a review of the record reveals that the patent issued with more patent term adjustment than it was entitled. The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of ZERO **(0)** days.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

On April 27, 2004, the above-identified application matured into U.S. Patent No. 6,727,367, with a patent term adjustment of 52 days printed on the front page. It is undisputed that, more than 30 days later, the instant request for reconsideration of patent term adjustment was filed.

The Office has no authority to grant an adjustment (or extension) of patent term due to administrative delays except as authorized by 35 U.S.C. § 154. The implementing regulations for an adjustment are set forth at § 1.702- 1.705. 37 CFR 1.705(d)

provides the sole avenue for requesting reconsideration of the patent term adjustment indicated in the patent. Moreover, § 1.705(d), in effect on April 27, 2004, stated that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." As the instant request for reconsideration was not filed within thirty days, § 1.705(d) requires that it be dismissed as untimely.

Moreover, in this situation, waiver of the timing requirement of § 1.705(d) is not warranted. 37 CFR § 1.183 provides that:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the 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).

Having considered applicant's arguments, it is concluded that in this instance waiver of the requirement that the request for reconsideration of the patent term adjustment indicated in the patent be filed within 30 days of issuance of the patent is not appropriate. Patentee has not shown that the circumstance of the failure to comply with the time period for filing an application for patent term adjustment set forth in § 1.705(d), is an extraordinary situation for which justice requires waiver.

Patentee argues that the error was extraordinary, but does not set forth a sufficient basis for concluding that the circumstance of the failure to comply was extraordinary. Patentee states simply that the applicant did not immediately recognize the error. Lacking an explanation for the failure to timely file, it can only be inferred that the failure to timely file a request for reconsideration was inadvertent. It is well-established that a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183.

Moreover, patentee contends that the small delay in filing the request for reconsideration of patent term adjustment is of no consequence to the USPTO's review of the situation, that it creates no extra burden or hardship. The burden on the Office of taking this action is not dispositive of whether under the circumstance justice requires waiver. On balance, justice does not require waiver. Patentee has failed to comply with a timeliness requirement clearly set forth in the rule. Patentee has not set forth circumstances distinguishing him from any other patentee who fails to timely file and is precluded from consideration of the request for reconsideration of patent term adjustment under § 1.705(d). Justice does not require that patentee obtain relief unavailable to other patentees who inadvertently fail to comply with this rule.

Moreover, patentee requests reconsideration of a period of reduction entered prior to the mailing of the notice of allowance

mailed July 17, 2003. Accordingly, patentee had an opportunity to request reconsideration prior to payment of the Issue Fee on September 12, 2003[1]. This does not make the situation especially harsh. Rather, here patentee had more time to recognize any error in the calculation than where the error arises after the mailing of the notice of allowance.

No error on the part of the Office led to patentee's failure to timely file an application for patent term adjustment. Nor has patentee shown that any extraordinary situation prevented him from timely filing. Under these circumstances, justice does not require that this patentee's failure to timely file a request for reconsideration of patent term adjustment be treated any differently than any other patentees. Waiver of the requirement is not warranted.

As there is no dispute that this request for reconsideration of PTA was filed more than 30 days after issuance of the patent and it has been concluded that waiver of the requirement is not warranted, it is appropriate to dismiss this request for reconsideration of patent term adjustment as untimely filed.

However, a review of the application file reveals further grounds for reduction of the patent term adjustment. First, of all, a period of reduction pursuant to 37 CFR § 1.704(c)(8) should have been entered in this application for the filing of an IDS after a reply had been filed. 37 CFR § 1.704(c)(8) provides that the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. On November 13, 2002, applicant filed a response. Then, on January 24, 2003, applicant filed an Information Disclosure Statement (IDS). The record does not support a conclusion that this IDS was expressly requested by the examiner. Nor is the IDS accompanied by a § 1.704(d) statement. Accordingly, the PTA should have been reduced by 72 days, the number of days beginning on the day after the date the initial reply was filed, November 14, 2002, and ending on the date that the supplemental reply or other such paper was filed, January 24, 2003 for the filing of the IDS. Moreover, an additional period of reduction pursuant to § 1.704(c)(10) should have been entered in this application for the filing of a certified copy of a priority document after the mailing of the notice of allowance. 37 CFR § 1.704(c)(10) provides that circumstances that constitute a failure to engage in reasonable efforts to conclude prosecution include:

> Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

---

[1] Patentee's argument that there was no adjustment of record at the time of the mailing of the notice of allowance is persuasive to the extent that this request for reconsideration is not treated as filed under § 1.705(b), and dismissed as untimely filed after payment of the Issue Fee.

> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;
>
> or
>
> (ii) Four months;

Patentee's attention is further directed to the notice entitled *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), which provides that:

> the submission of other papers after a "Notice of Allowance" is mailed that do cause substantial interference and delay in the patent issue process are considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers:
>
> (1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

In this instance, a certified copy of a priority document was filed on September 9, 2003, after the mailing of the notice of allowance on July 17, 2003. On January 12, 2004, the Office responded with the mailing of a supplemental notice of allowability. Thus, a period of reduction of the lesser period of four months should have been entered in this application (the number of days beginning on the date the paper was filed, September 9, 2003, and ending on the mailing date of the supplemental notice of allowability, January 12, 2004, is greater than four months).

In view thereof, it is concluded that the patent should have issued with a revised Patent Term Adjustment of zero (0) days (It is noted that the total number of days in the undisputed periods of reduction of 2 days and of 72 days plus the period of reduction of 120 days are greater than the total number of days in the period of adjustment of 106 days).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) and the $130 fee set forth in § 1.17(h)(the rate in effect on the date of filing of the petition under § 1.183). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ZERO (0)** days.

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

Karin Ferriter
for

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

Enclosure: Copy of DRAFT Certificate of Correction

Day : Thursday
Date: 8/18/2005

PALM INTRANET

Time: 10:35:59

PTA Calculations for Application: 09/953870			
Application Filing Date:	09/18/2001	PTO Delay (PTO):	106
Issue Date of Patent:	04/27/2004	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	54
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-52		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
40	08/18/2005	ADJUSTMENT OF PTA CALCULATION BY PTO		52	
34	04/27/2004	PATENT ISSUE DATE USED IN PTA CALCULATION	106		31
33	03/26/2004	RECEIPT INTO PUBS			
32	03/23/2004	APPLICATION IS CONSIDERED READY FOR ISSUE			
31	09/12/2003	ISSUE FEE PAYMENT VERIFIED			
30	02/25/2004	RECEIPT INTO PUBS			
29	02/03/2004	WORKFLOW - QUERY REQUEST - FINISH			
28	11/28/2003	CORRESPONDENCE ADDRESS CHANGE			
27	10/14/2003	WORKFLOW - QUERY REQUEST - BEGIN			
26	09/22/2003	WORKFLOW - FILE SENT TO CONTRACTOR			
25	09/12/2003	ISSUE FEE PAYMENT RECEIVED			
24	07/17/2003	MAIL NOTICE OF ALLOWANCE			
23	07/14/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
22	07/14/2003	CASE DOCKETED TO EXAMINER IN GAU			
21	07/14/2003	NOTICE OF ALLOWABILITY			
20	07/08/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	07/08/2003	DATE FORWARDED TO EXAMINER			
18	06/20/2003	AMENDMENT AFTER FINAL REJECTION			
17	03/20/2003	MAIL FINAL REJECTION (PTOL - 326)			
16	03/20/2003	FINAL REJECTION			
15	03/20/2003	DATE FORWARDED TO EXAMINER			
14	11/22/2002	RESPONSE AFTER NON-FINAL ACTION		9	11
13	11/22/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			

12	01/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	08/13/2002	MAIL NON-FINAL REJECTION			
10	08/12/2002	NON-FINAL REJECTION			
9	03/08/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	02/28/2002	APPLICATION DISPATCHED FROM OIPE			
7	02/26/2002	APPLICATION IS NOW COMPLETE		45	4
6	01/14/2002	ADDITIONAL APPLICATION FILING FEES			
5	01/14/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
4	10/12/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	10/12/2001	CORRESPONDENCE ADDRESS CHANGE			
2	09/24/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/18/2001	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.

KED & ASSOCIATES, LLP
P.O. Box 221200
Chantilly VA 20153-1200

COPY MAILED

JAN 25 2008

OFFICE OF PETITIONS

In re Patent No. 6,727,367	:	DECISION ON REQUEST FOR
Karel Pospisilik	:	RECONSIDERATION OF
Issue Date: April 27, 2004	:	DECISION ON APPLICATION
Application No. 09/953,870	:	FOR
Filed: September 18, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. PAL-010US	:	AND
	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is in response to the "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION," filed October 18, 2005, requesting that a certificate of correction correcting the patent term adjustment determination for the above-identified patent to zero (0) days be cancelled and the original patent term adjustment of fifty-two (52) days be maintained.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **GRANTED** to the extent indicated herein.

Patentee is given TWO (2) MONTHS from the mail date of this decision to file a request for reconsideration. This period is not extendable under 37 CFR 1.136.

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of zero (0) days.

BACKGROUND

On April 27, 2004, the above-identified application matured into U.S. Patent No. 6,727,367, with a patent term adjustment of 52 days printed on the front page.

On June 28, 2004, patentee filed a PETITION UNDER 37 C.F.R. § 1.183 to suspend the timing requirements of 37 C.F.R. § 1.705(d) from 30 days to two months and to accept as timely filed a request for reconsideration of Patent Term Adjustment.

By decision mailed August 18, 2005, the Office dismissed the petition under 1.183 to waive the timing requirements of 1.705(d) and accordingly, dismissed as untimely filed the request for reconsideration of patent term adjustment under 37 CFR 1.705(d). However, the decision directed the issuance of a Certificate of Correction to correct the patent term adjustment indicated in the patent from 52 days to 0 days.

On October 18, 2005, patentee timely filed the instant request for reconsideration of decision on petition.

OPINION

On the date of issuance of the instant patent, April 27, 2004, § 1.705(d) provided, in pertinent part, that:

> … Any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of 1.705(b)(1) and 1.705(b)(2).

However, on April 22, 2004, the Office issued a final rule[1], effectively changing the period for filing a request for reconsideration under § 1.705(d) to within two (2) months of the issue date of the patent. The request for reconsideration filed Monday, June 28, 2004, was filed outside of the thirty-day

---

[1] Effective May 24, 2004, para. (d) was revised to provide that any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued. Revision of Patent Term Extension and Patent Term Adjustment Provisions, Final rule, 69 FR 21704 (April 22, 2004).

period, but within the two (2) month period. Thus, the request for reconsideration was properly subject to dismissal as being untimely filed under the old rules, but timely if the new rules applied.

It is further noted that in this case, there was an error in patentee's favour such that the patent issued with more patent term than it was entitled. By decision mailed August 18, 2005, the Certificate of Corrections branch was directed to issue a Certificate of Correction to correct the patent term adjustment indicated in the patent from 52 days to 0 days. (To date, no Certificate of Correction has been issued).

The circumstances have been reconsidered and it is determined that waiver of the timing requirement is warranted in this case.

Consideration now turns to the merits of the petition. First, of all, patentees do not dispute the accuracy of the entry of additional periods of reduction on decision on application for patent term adjustment mailed August 18, 2005. The decision entered a period of reduction of 72 days, pursuant to 37 CFR 1.704(c)(8), for the filing of an IDS on January 24, 2003. The decision also entered a period of reduction of 120 days, pursuant to 37 CFR 1.704(c)(10), for the filing of a certified copy of a priority document on September 9, 2003 after the mailing of the notice of allowance. These entries are affirmed. These reductions have been made of record in PAIR. (Previously, they were in the record by way of the decision, but an entry of 52 days for applicant delay was simply entered to yield an overall revised patent term adjustment of 0 days).

On July 17, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days, including periods of reduction of 45 and 9 days for applicant delay. There was no dispute as to the accuracy of this determination because as of the mailing of the notice of allowance, there were properly no entries for Office delay. As the Office does not set forth negative balances of patent term adjustment, the initial determination of patent term adjustment of 0 days was properly not disputed.

However, upon issuance of the patent, a period of adjustment of 106 days, pursuant to 37 CFR 1.702(a)(4), was properly entered for Office delay in issuance of the patent after payment of the

issue fee and satisfaction of all outstanding requirements. In view thereof, the entry of the periods of reduction for applicant delay before the mailing of the notice of allowance became an issue. Patentees disputed the reduction of 45 days, entered pursuant to 37 CFR 1.704(b), on the basis that a complete response to the Notice to File Missing Parts of Application mailed October 12, 2001, was received in the Office on January 14, 2002 not February 26, 2002. Patentees disputed the reduction of 9 days, also entered pursuant to 37 CFR 1.704(b), on the basis that the response to the Office action mailed August 13, 2002 was received in the Office on November 12, 2002. Patentees disputed filing any paper on November 22, 2002. The patent issued with a revised patent term adjustment of 52 days. Patentees maintained that as the period of reduction of 45 days should have been a period of reduction of 2 days and no period of reduction of 9 days should have been entered, the patent should have issued with a revised patent term adjustment of 104 days.

With respect to the periods of reduction of 45 and 9 days, patentees are correct with respect to the proper basis for and amounts of the reductions. The period of reduction of 45 days has been corrected to 2 days. The period of reduction of 9 days has been corrected to 0 days. The record confirms that no paper was filed in this application on November 22, 2002 or any date thereabout warranting entry of a period of reduction.

Nonetheless, in view of the entry of the undisputed additional periods of reduction of 72 and 102 days pursuant to the decision mailed August 18, 2005, the patent should have issued with a revised patent term adjustment of zero (0) days (106 days of Office delay reduced by 2 + 72 + 120 days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) on initial application for patent term adjustment filed June 28, 2004. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. (It is noted that it does not appear that the certificate of correction requested August 18, 2005 ever issued). The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by zero (0) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosures: Copy of PALM INTRANET screen
Copy of DRAFT Certificate of Correction

Day : Thursday
Date: 1/24/2008

PALM INTRANET

Time: 20:18:00

PTA Calculations for Application: 09/953870			
Application Filing Date:	09/18/2001	PTO Delay (PTO):	106
Issue Date of Patent:	04/27/2004	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	54
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-140		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
48	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	9		
47	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		2	
46	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	45		
45	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		120	
44	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		72	
43	01/24/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	52		
40	08/18/2005	ADJUSTMENT OF PTA CALCULATION BY PTO		52	
34	04/27/2004	PATENT ISSUE DATE USED IN PTA CALCULATION	106		31
33	03/26/2004	RECEIPT INTO PUBS			
32	03/23/2004	APPLICATION IS CONSIDERED READY FOR ISSUE			
31	09/12/2003	ISSUE FEE PAYMENT VERIFIED			
30	02/25/2004	RECEIPT INTO PUBS			
29	02/03/2004	WORKFLOW - QUERY REQUEST - FINISH			
28	11/28/2003	CORRESPONDENCE ADDRESS CHANGE			
27	10/14/2003	WORKFLOW - QUERY REQUEST - BEGIN			
26	09/22/2003	WORKFLOW - FILE SENT TO CONTRACTOR			
25	09/12/2003	ISSUE FEE PAYMENT RECEIVED			
24	07/17/2003	MAIL NOTICE OF ALLOWANCE			
23	07/14/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
22	07/14/2003	CASE DOCKETED TO EXAMINER IN GAU			
21	07/14/2003	NOTICE OF ALLOWABILITY			
20	07/08/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	07/08/2003	DATE FORWARDED TO EXAMINER			

18	06/20/2003	AMENDMENT AFTER FINAL REJECTION			
17	03/20/2003	MAIL FINAL REJECTION (PTOL - 326)			
16	03/20/2003	FINAL REJECTION			
15	03/20/2003	DATE FORWARDED TO EXAMINER			
14	11/22/2002	RESPONSE AFTER NON-FINAL ACTION		9	11
13	11/22/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
12	01/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	08/13/2002	MAIL NON-FINAL REJECTION			
10	08/12/2002	NON-FINAL REJECTION			
9	03/08/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	02/28/2002	APPLICATION DISPATCHED FROM OIPE			
7	02/26/2002	APPLICATION IS NOW COMPLETE		45	4
6	01/14/2002	ADDITIONAL APPLICATION FILING FEES			
5	01/14/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
4	10/12/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	10/12/2001	CORRESPONDENCE ADDRESS CHANGE			
2	09/24/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/18/2001	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

CERTIFICATE OF CORRECTION

PATENT : 6,727,367 B2

DATED : **April 27, 2004**

INVENTOR(S) : Pospisilik

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 52 days

Delete the phrase "by 52 days" and insert – by 0 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

COPY MAILED

MAR 26 2009

OFFICE OF PETITIONS

KED & ASSOCIATES, LLP
P.O. Box 221200
Chantilly VA 20153-1200

In re Patent No. 6,727,367	: DECISION ON RENEWED
Karel Pospisilik	: REQUEST FOR
Issue Date: April 27, 2004	: RECONSIDERATION OF
Application No. 09/953,870	: DECISION ON APPLICATION FOR
Filed: September 18, 2001	: PATENT TERM ADJUSTMENT
Attorney Docket No. PAL-010US	: AND
	: NOTICE OF INTENT TO ISSUE
	: CERTIFICATE OF CORRECTION

This is in response to the "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION," filed April 14, 2008, requesting that a certificate of correction correcting the patent term adjustment determination for the above-identified patent to zero (0) days be cancelled and the original patent term adjustment of fifty-two (52) days be maintained.

The request for reconsideration is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of fifty-two (52) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosures: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,727,367 B2

DATED : **April 27, 2004** **DRAFT**

INVENTOR(S) : Pospisilik

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 0 days" and insert – by 52 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

MAIL

APR 2 3 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Miller Thompson, LLP
20 Queen Street West
Suite 2500
Toronto, Ontario M5H 3S1
CANADA

In re Application of: Steven B. Meyer)
Application No. 09/953,897)
Filed: September 18, 2001)
For: SYSTEM, COMPUTER PRODUCT)
AND METHOD FOR INTERFACING)
WITH A PRIVATE)
COMMUNICATION PORTAL FROM)
A WIRELESS DEVICE)

DECISION ON PETITION UNDER M.P.E.P. §708.02(II): INFRINGEMENT

This is a decision on the petition, filed January 24, 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.

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(h) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed: and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. A fee under 37 C.F.R. for such a petition is required.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**. The application file is being forwarded to the Examiner of Record for expedited examination.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
09/953,904	09/18/2001	Phil-Kyu Choi	P56550	6342

7590 07/22/2003

Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington, DC 20005

EXAMINER
EDWARDS, ANTHONY Q

ART UNIT	PAPER NUMBER
2835	9

DATE MAILED: 07/22/2003

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Robert E. Bushnell
1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005

In re Application of:	:	
Phil-Kyu Choi	:	
Application No. 09/953,904	:	DECISION ON PETITION
Filed: September 18, 2001	:	
Attorney Docket No. P56550	:	

This is a decision on the petition filed on June 2, 2003 under 37 C.F.R. § 1.181 requesting the withdrawal of the requirement that Figures 6-8 be labeled as "Prior Art".

The petition is GRANTED.

A review of the record indicates that Figures 6-8 are nowhere indicated as being "Prior Art" within applicant's disclosure. As such, the examiner's assertion that the figures be labeled as such are incorrect, and the requirement is withdrawn.

The status of this application is as follows: A non-final office action was mailed on May 22, 2003. A response by the applicant to this action is pending.

Arthur Grimley, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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

SEYFARTH SHAW LLP
131 S. DEARBORN ST., SUITE 2400
CHICAGO, IL 60603-5803

Mail Date: 07/02/2010

Applicant	: Steven C. Lemay	: DECISION ON REQUEST FOR
Patent Number	: 6645073	: RECALCULATION of PATENT
Issue Date	: 11/11/2003	: TERM ADJUSTMENT IN VIEW
Application No	: 09/953,977	: OF WYETH
Filed	: 09/17/2001	:
		:

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

UNITED STATES 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

COPY MAILED

JUL 16 2003

OFFICE OF PETITIONS

ON PETITION

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20037-3202

In re Application of
Hiroshi Tanaka et al
Application No. 09/954,005
Filed: September 18, 2001
Attorney Docket No. Q66271

This is a decision on the petition, filed July 15, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on June 30, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 3736 for processing of 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

OIPE JC102
FEB 2 3 2004
PATENT & TRADEMARK OFFICE

JUN 2003
Received
Chiron Corporation
Intellectual Property

COPY

PAPER NO.

STEVEN W. COLLIER
CHIRON CORPORATION
INTELLECTUAL PROPERTY - R440
P.O. BOX 8097
EMERYVILLE, CA 94662-8097

COPY MAILED

JUN 1 3 2003

OFFICE OF PETITIONS

In re Application of
Verena D. Huebner, et al.
Application No. 09/954,039
Filed: September 18, 2001
Attorney Docket No. 1534.206/CHIRP018D1

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed on June 12, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 27, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 1626 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).

DOCKETED on/by 6/23/03 OW
Atty. SWC PA
File # PP01534.206
Due Date Ext
Final Date 10/12/03 STC 1st OA rec'd (after Decision to grant

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KENNETH D. BAUGH
2413 BLODGETT
HOUSTON TX 77004

COPY MAILED

MAR 1 4 2008

OFFICE OF PETITIONS

In re Application of
Rodney Porter
Application No. 09/954,063
Filed: September 18, 2001
Title of Invention: **APPARATUS AND METHOD FOR NOX REDUCTION IN NATURAL GAS FURNACES**

: DECISION ON PETITION

This is a decision on the petition filed November 8, 2007 under 37 CFR 1.137(b)[1] to revive the above-identified application.

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

The above-identified application became abandoned as a result of petitioner's failure to file a proper appeal brief within the time period provided in 37 CFR 1.192(a). A Notice of Appeal was filed May 7, 2004. On December 10, 2004, an appeal brief was filed with a certificate of mail dated December 6, 2007 and a five month extension of time. On February 15, 2005, a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) was mailed. In response, a Supplemental Appeal Brief was filed August 18, 2005 with a certificate of mail dated August 15, 2005 and a five month extension of time. On February 7, 2006, a second Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed and in response another Appeal Brief was filed on August 10, 2006 with a certificate of mail dated August 7, 2006 and a five month extension of time.
Since the Appeal Brief filed August 10, 2006 was also non-compliant, the appeal was dismissed and a Notice of Abandonment and Notification of Non-Compliant Appeal Brief (37 CFR 41.37) were both mailed on November 3, 2006.

Comes now petitioner with the instant petition to revive and an Substitute Appeal Brief under 37 CFR 41.37.

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

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

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

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The Examiner of record has indicated that the Appeal Brief submitted November 8, 2007 with the instant petition is acceptable.

This application is being forwarded to Technology Center 3749 for review of the Appeal Brief filed November 8, 2007.

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

APR 21 2003

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

George E. Darby
P.O. Box 893010
Mililani, HI 96789-3010

MAILED

APR 21 2003

OFFICE OF THE DIRECTOR
TC 3600

In re application of
Daniel G. Baillargeon et al.
Application No. 09/954,089
Filed: September 14, 2001
For: MULTI-NODAL MEETING PLANNING SYSTEM AND METHOD

: DECISION ON REQUEST
: FOR WITHDRAWAL OF
: ATTORNEY

This is a decision on the request filed on April 7, 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 in the above-identified application is not approved as moot because the attorney making the request does not now have, and apparently never have had, power of attorney in this application.

There is no record of power of attorney ever being given to the attorney making the request. The original declaration does not include a power of attorney and no separate paper conferring power of attorney to the attorney making the request was filed.

Steven N. Meyers, Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868
(703) 605-0586 (facsimile)

SNM/tpl: 4/18/03

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

KENNETH J. HOVET
NORDMAN CORMANY HAIR & COMPTON
P.O. BOX 9100
1000 TOWN CENTER DRIVE
OXNARD, CA 93031-9100

COPY MAILED

JUN 21 2006

OFFICE OF PETITIONS

In re Application of	:	
Brad Greenwald	:	
Application No. 09/954,127	:	DECISION ON PETITION
Filed: September 18, 2001	:	TO WITHDRAW
Attorney Docket No. HM-64821	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 9, 2005.

The petition 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 Kenneth J. Hovet on behalf of all attorneys/agents of record who are associated with customer No. 24982.

All attorneys/agents associated with customer No. 24982 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future communications from the Office will continue to be directed to the named inventor at the below-listed address.

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

This application is being referred to Technology Center AU 3629.

David Bucci
Petitions Examiner
Office of Petitions

cc: BRADLEY GREENWALD
3078 RIVOLL
NEWPORT BEACH, CA 92660

UNITED STATES 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

BROUILLETTE & PARTNERS
SUITE 2300
1100 RENE-LEVESQUE BOULEVARD WEST
MONTREAL, QC H3B 5C9
CANADA

COPY MAILED

JUN 07 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Gilles Soucy et al :
Application No. 09/954,168 :
Filed: September 18, 2001 :
Attorney Docket No. 04104-015-US-01 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 27, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed October 11, 2002, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The amendment submitted on January 10, 2003, did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed February 6, 2003. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on January 12, 2003.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of a continuing application No. 10/414,557 .

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

The application file is being forwarded to Files Repository.

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

GEORGE A. LOUD
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA VA 22314

MAILED

MAY 20 2010

OFFICE OF PETITIONS

In re Patent No. 6,855,498	:	
Issue Date: February 15, 2005	:	
Application No. 09/954,225	:	ON PETITION
Filed: September 18, 2001	:	
Attorney Docket No.	:	

This is a decision on the petition under 37 CFR 1.378(c), filed December 1, 2009 and supplemented on December 3, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired at midnight February 15, 2008, for failure to pay the 3½ 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.

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. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

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 JoAnne Burke at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Randall H. Cherry
U.S. Environmental Protection Agency
Office of General Counsel – Mail Stop0 2377A
1200 Pennsylvania Ave. NW
Washington, DC 20460

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 06-03

BEST AVAILABLE COPY

Paper No. 10

ATMI, INC.
7 COMMERCE DRIVE
DANBURY CT 06810

COPY MAILED

JUN 1 9 2003

OFFICE OF PETITIONS

In re Application of	:	
Mullee, Jankins, and Jones	:	
Application No. 09/954,231	:	DECISION REFUSING STATUS
Filed: 17 September, 2001	:	UNDER 37 CFR 1.47(a)
Attorney Docket No. 436	:	

This is in response to the petition filed under 37 CFR 1.47(a) on 17 December, 2001. The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 September, 2001, without an executed oath or declaration. Accordingly, on 16 October, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application requiring a signed oath or declaration and a surcharge for its late filing. In response, on 17 December, 2001 and 9 May, 2003 (certificate of mailing date 17 December, 2001), petitioners filed, *inter alia*, the present petition and authorization to charge the petition fee, and a declaration naming William Mullee, Glenn Jankins, and Michael Jones as joint inventors and signed by joint inventor Jones on behalf of joint inventors Mullee and Jankins.

Petitioners assert that a copy of the application was sent by

BEST AVAILABLE COPY

petitioners' counsel, Robert A. McLauchlin, to the non-signing joint inventors, but that they have not returned the executed declaration. Joint inventor Mullee further stated orally to counsel during a telephone call that he would not sign the declaration without compensation.

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

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding 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;

(4) a surcharge of $130 or $65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). First, the declaration is defective because it does not include the residence, mailing address and citizenship of non-signing inventor Mullee. In this regard, the signature block for the non-signing inventor should contain the non-signing inventors' mailing address, residence, if the inventor lives at a location which is different from where the inventor customarily receives mail, and citizenship. In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. Furthermore, a statement of the inventor's citizenship is a statutory requirement and cannot be waived.[1] Lastly, with respect to joint inventor Jones, both the residence and mailing address should be completed. A new oath or declaration, signed by all of the signing inventors on behalf of themselves and the non-signing inventor in compliance with 37 CFR 1.63 and 1.67 is required.

The petition fee will be charged to counsel's deposit account, No. 11-0600, as authorized on the extension of time request.

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

---

[1] 35 U.S.C. § 115, MPEP 605.01.

BEST AVAILABLE COPY

By mail: Mail Stop Petition
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, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

1723

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW 02-04

ATMI, INC.
7 COMMERCE DRIVE
DANBURY CT 06810

COPY MAILED
FEB 13 2004
OFFICE OF PETITIONS

In re Application of	:
Mullee, Jankins, and Jones	:
Application No. 09/954,231	: DECISION ACCORDING STATUS
Filed: 17 September, 2001	: UNDER 37 CFR 1.47(a)
Attorney Docket No. 436	:

This is in response to the petition filed under 37 CFR 1.47(a) on 12 December, 2003.

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventors have refused to join in the filing of the above-identified application after having been sent a copy of the application papers. Specifically, petitioners have established, via the declaration of Robert McLauchlan, that a copy of the application was sent to the non-signing inventors, William Mullee and Glenn Jankins. However, joint inventor Mullee orally refused during a telephone call to sign and return the declaration. Joint inventor Jankins also did not return an executed declaration listing him as a joint inventor along with William Mullee and Michael Jones.

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

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

The extension of time fee will be charged to counsel's deposit account, No. 50-0860, as authorized in the extension of time request.

After this decision is mailed, the application will be forwarded to Technology Center 1700 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW 02-04

Glen Jenkins
10086 Circleview Drive
Austin TX 78733

COPY MAILED

FEB 13 2004

OFFICE OF PETITIONS

In re Application of
Mullee et al.
Application No. 10/954,231
Filed: 17 September, 2001
For: PREPARATION OF HIGH PERFORMANCE SILICA SLURRY USING A CENTRIFUGE

Dear Mr. Jenkins:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at 703/308-6918. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

ATMI, INC.
7 COMMERCE DRIVE
DANBURY CT 06810

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW 02-04

William Mullee
10592 Southwest 63rd Drive
Portland, OR 97219

COPY MAILED
FEB 13 2004
OFFICE OF PETITIONS

In re Application of
Mullee et al.
Application No. 10/954,231
Filed: 17 September, 2001
For: PREPARATION OF HIGH PERFORMANCE SILICA SLURRY USING A CENTRIFUGE

Dear Mr. Mullee:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at 703/308-6918. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

ATMI, INC.
7 COMMERCE DRIVE
DANBURY CT 06810

UNITED STATES 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 10, 2006

Patent No. :7,039,955
Inventor(s) :Raynold M. Kahn et al.
Issued :May 2, 2006
Title :EMBEDDED BLACKLISTING FOR DIGITAL BROADCAST SYSTEM SECURITY
Doc./File No.: PD-200125

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.

Applicants' request to change column 8, lines 18-23 is not warranted entry. The changes are the result of a decision made by the examiner and is therefore considered in accordance with the records of the Patent and Trademark Office.

In view of the forgoing applicants' request in this matter is hereby denied. Any telephone inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123

Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308-9380 ext. 123

Georgann S. Grunebach,
Esq., The DIRECTV Group, Inc.,
P.O. Box 956,
2230 E. Imperial Highway,
El Segundo, CA 90245-0956

CBN/arg

UNITED STATES 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

ROBERT McKELLAR
McKELLAR STEVENS
784 S. POSEYVILLE ROAD
MIDLAND, MI 48640

COPY MAILED

OCT 20 2004

OFFICE OF PETITIONS

In re Application of :
Michael John Watson :
Application No. 09/954,262 :
Filed: September 17, 2001 :
Attorney Docket No. DC 4951 :

ON PETITION

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 **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 application became abandoned for failure to file a reply within the meaning of 37 CFR 1.113 to the final rejection of October 27, 2003, within the time period for reply. The proposed reply required for consideration of a petition to revive must be

a Notice of Appeal (and fee required by law), an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance; a Request for Continued Examination (RCE), along with the required fee and submission in accordance with 37 CFR 1.114, or the filing of a continuing application pursuant to the provisions of 37 CFR 1.53(b). Since the amendment submitted does not *prima facie* place the application in condition for allowance (see attached Advisory Action), petitioner must submit the reply required to continue prosecution in order to effect revival of the instant 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: U.S. Patent and Trademark Office
220 20th Street S
Customer Window, Mail Stop Petitions
Crystal Plaza Two Lobby, Room 1B03
Arlington, VA 22202

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

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

Frances Hicks

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

ATTACHMENT: Copy of Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 17

ROBERT McKELLAR
McKELLAR STEVENS
784 S. POSEYVILLE ROAD
MIDLAND, MI 48640

COPY MAILED

DEC 1 0 2004

OFFICE OF PETITIONS

In re Application of	:	
Michael John Watson	:	
Application No. 09/954,262	:	DECISION GRANTING PETITION
Filed: September 17, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. DC 4951	:	

This is a decision on the renewed petition under 37 CFR 1.137(b), filed November 22, 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 a Request for Continued Examination (RCE) and submission; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of October 27, 2003 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 Technology Center AU 1773 for appropriate action in view of the filing of the RCE.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Margaret Chappuis
Advanced Technology Materials, Inc.
7 Commerce Drive
Danbury CT 06810

COPY MAILED

SEP 19 2008

OFFICE OF PETITIONS

In re Application of	:	
Wojtczak et al.	:	
Application Number: 09/954284	:	
Filing or 371(c) Date: 09/17/2001	:	ON PETITION
Attorney Docket Number: ATMI-393-CIP	:	

This is a decision on the Petition to the Commissioner Under 37 C.F.R. § 1.182 for Withdrawal of a Terminal Disclaimer in U.S. Patent Application No. 09/954,284," filed January 17, 2006. The delay in treating this petition is regretted.

The petition is **dismissed**.

Applicant files the present petition and provides that, due to extensive amendments in the claims since the filing of the Terminal Disclaimer on December 16, 2003, the Terminal Disclaimer is no longer required.

The Manual of Patent Examining Procedure ("MPEP") 1490, states:

> 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).

The Examiner has reviewed the request and has not agreed that the Terminal Disclaimer is no longer required, ord to the withdrawal of the Terminal Disclaimer.

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

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

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

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

Telephone inquiries regarding the Terminal Disclaimer should be directed to the Examiner. 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

PARSONS, HSUE & DE RUNTZ, LLP
595 MARKET STREET
SUITE 1900
SAN FRANCISCO, CA 94105

COPY MAILED
JUL 21 2006
OFFICE OF PETITIONS

In re Application of	:	
Mehrdad Nikoonahad, et. al.	:	
Application No. 09/954,287	:	ON PETITION
Filed: September 11, 2001	:	
Attorney Docket No. M-10575-3C US	:	

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

A review of the record discloses that the above application became abandoned for failure to timely pay the issue fee on or before September 23, 2004. A Notice of Abandonment was mailed on May 16, 2005.

The application is being revived for consideration of a submission under 37 CFR 1.114. However, 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. Therefore, the requisite issue fee has been charged to counsel's deposit account, as authorized in the RCE filed December 5, 2005.

The petition is **GRANTED**.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination) filed December 5, 2005.

Petitioner is advised that the issue fee paid in the above-identified application cannot be refunded. However, if the above application is again allowed, petitioner may request that the issue fee paid on December 5, 2005, be applied towards the issue fee required by the new Notice of Allowance and Fee(s) Due.

The application file is being forwarded to Technology Center AU 2877, for further processing of the request for continued examination under 37 CFR 1.114 filed December 5, 2005.

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. 3

Wall, Marjama & Bilinski
101 South Salina Street, Suite 400
Syracuse, NY 13202

COPY MAILED

OCT 1 1 2001

OFFICE OF PETITIONS

In re Application of
Barry H. Keys et al.
Application No. 09/954,301
Filed: September 11, 2001
Attorney Docket No. 283-338

DECISION GRANTING PETITION

This is a decision on the petition filed September 12, 2001, requesting that the above-identified application be accorded a filing date of September 11, 2001.

The petition states that the application was attempted to be deposited on September 11, 2001, by Express Mail but the post office would not accept any Express Mail packages. The petition included a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail. The statement indicated the date on which the person attempted to deposit the correspondence with the USPS and that the USPS refused to accept the correspondence for mailing by Express Mail.

The petition also states that the Post Office supervisor informed applicants' attorney that the Express Mail package containing the application could be packaged in a priority envelope having a certified mail receipt which could be stamped with the September 11, 2001 date and that this is the procedure that was followed. The petition was accompanied by Exhibit A, a copy of a written statement from a post office employee stating that the USPS would not accept Express Mail on September 11, 2001, and Exhibit B, a copy of the certified mail receipt. The petition and a copy of the application papers were hand-carried to the USPTO on September 12, 2001.

On September 18, 2001, the application that was sent by certified mail was received in the Office. The application was processed with a September 18, 2001 filing date.

The U.S. Patent and Trademark Office declared the interruption in Express Mail service of the USPS a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e).

The petition is granted. No petition fee is required and none has been charged.

The application is being returned to Initial Patent Examination Division for further processing and

correction of the filing date to **September 11, 2001**.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.

Eugenia A. Jones

Eugenia A. Jones
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

Richard Burgujian
Finnegan, Henderson, Farbow, Garrett & Dunner
901 New York Avenue, NW
Washington, DC 20001-4413

MAILED

JAN 3 0 2007

Technology Center 2100

In re Application of:
Satoshi Mizuno
Application No. 09/954,303
Filed: September 18, 2001
For: DISK CONTROL SYSTEM AND METHOD

DECISION ON PETITION

This is a decision on the petition filed on April 18, 2006, pursuant to the provisions of M.P.E.P. § 710.06, requesting that the period for reply to the Office Action of January 3, 2006, be restarted in view of the delay in receiving the Office Action from the U.S. Postal Service.

On April 18, 2006, applicant's counsel, Mr. Burgujian, filed a petition seeking that the period for reply to the Office Action of January 3, 2006, be restarted, stating that the office action was received at the attorney's firm only on April 5, 2006. A copy of the first page of the office Action showing the date of receipt of the Office Action at the correspondence address stamped thereon was also enclosed.

On review of the file, prosecution history reveals that a Notice of Allowability and a Notice of Allowance and Issue Fee Due were mailed on December 19, 2006.

The petition is hereby **DISMISSED AS MOOT**.

A delay to render a decision on this petition is hereby regretted.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-4210.

Mano Padmanabhan
Quality Assurance Specialist,
Technology Center 2100, Workgroup 2180

UNITED STATES 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 13 2006

OFFICE OF PETITIONS

Christie, Parker & Hale, LLP
P.O. Box 7068
Pasadena, CA 91109-7068

In re Application of	:	
Walter C. Pitts	:	
Application No. 09/954,315	:	DECISION ON PETITION
Filed: September 17, 2001	:	TO MAKE SPECIAL UNDER
Attorney Docket No. 45420/DAP/P477	:	37 CFR 1.102(c)(1)
	:	

This is a decision on the petition under 37 CFR 1.102(c)(1), filed August 28, 2006, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED.**

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age, must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required.

The instant petition includes a statement from the applicant declaring that he is 72 years of age. Accordingly, the above-identified application has been accorded "special" status.

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

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 3762 for action on the merits commensurate with this decision.

Denise Pothier
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

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

Mail Date: 04/20/2010

Applicant	: Rajesh Bhalla	: DECISION ON REQUEST FOR
Patent Number	: 7613811	: RECALCULATION of PATENT
Issue Date	: 11/03/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/954,320	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/17/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1768** 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.

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)
6610023	2003-08-26	09954324	2001-09-12	

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	/stephen a. steponovich/	Date (YYYY-MM-DD)	2009-02-09
Name	stephen a. steponovich		

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. 6610023
Issue Date: August 26,2003
Application No. 09954324
Filed: September 12,2001
Attorney Docket No. STEPONOVICH

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

This is a decision on the electronic petition, filed February 9,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 9,2009 . 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 PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 2023
www.uspto.go

JJGJr 12-02

Paper 15

DUNLAP, CODDING
& ROGERS, P.C.
SUITE 420
9400 NORTH BROADWAY
OKLAHOMA CITY OK 73114

COPY MAILED

DEC 0 9 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Bower. :
Application No. 09/954,345 :
Filed: 14 September 2001 :
Attorney Docket No.: 1230.041 :

This is a decision on the petition filed on 14 September, 2002, to revive under 37 C.F.R. §1.137(a),[1] and in light of the allegations considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.[2]

---

[1] A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:
(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for 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 required by 37 C.F.R. §1.17(l);
(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

[2] The regulations at 37 C.F.R. §1.181 provide, in pertinent part:
§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 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 or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief 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 declaration (and exhibits, if any) must accompany the petition.
© 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 (§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 decision upon the matters averred in the petition, supplying a copy thereof 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. * * *
(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

For the reasons set forth below:

- the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **GRANTED**; and
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**.

BACKGROUND

A review of the record reveals:

- it appeared that the Applicant/Petitioner (Petitioner) failed to respond timely to the Notice of Allowability requiring the submission of corrected drawings (as to "reference number '20'") mailed on 22 April, 2002, and due on or before 22 July, 2002;
- the instant matter went abandoned after midnight 22 July, 2002;
- on 16 July, 2002, Petitioner paid the Issue Fee;
- Notice of Abandonment was mailed on 9 September, 2002;
- Petitioner submits, *inter alia*:

  (a) what purports to be copies of Petitioner's amendment under 37 C.F.R. §1.312[3] timely filed via US Postal Service (USPS) Express Mail on 22 May, 2002, to delete the "reference number '20'"--and so satisfy the Allowability requirement--which amendment was entered on 12 June, 2002;

  (b) Petitioner's declaration as to the matter.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[4]

---

[3] The regulations at 37 C.F.R. §1.312 provide:
§1.312 Amendments after allowance.
No amendment may be made as a matter of right in an application after the mailing of the notice of allowance.Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.
[Para.(b) revised, 58 FR 54504, Oct.22, 1993, effective Jan.3, 1994; para.(b) revised, 60 FR 20195, Apr.25, 1995, effective June 8,1995; para.(b) 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)]

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

CONCLUSION

Therefore , the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **granted**.

Accordingly, the holding of Abandonment is withdrawn, the Notice of Abandonment of 9 September, 2002, was mailed in error and is vacated, and the petition fee is waived.[5]

Thus, the petition under 37 C.F.R. §1.137(a) is **dismissed as moot**.

This application is being forwarded to Publications Branch to be processed into a patent.

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

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[5] Pursuant to Petitioner's authorization, the petition fee ($110.00) is being refunded to Deposit Account 04-1700.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Genencor International, Inc.
Attention: Legal Department
925 Page Mill Road
Palo Alto, CA 94304

COPY MAILED

AUG 0 3 2004

OFFICE OF PETITIONS

In re Application of	:	
Nathaniel T. Becker, et. al.	:	
Application No. 09/954,386	:	ON PETITION
Filed: September 12, 2001	:	
Attorney Docket No. GC645-3	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 21, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed February 24, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned after midnight May 24, 2004.

In response, petitioner submitted with the instant petition $1,330 for the petition to revive fee, $1,330 for the issue fee, $300 for the publication fee, and an amendment after allowance.

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

The petition is **GRANTED**.

The application file is being forwarded to Technology Center Art Unit 1751, for review of the amendment filed with the instant petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. NIXON ET AL.	:	
Issue Date: Jan. 6, 2004	:	**DECISION GRANTING**
Appl No.: 09/954,392	:	**PETITION**
Filed: September 12, 2001	:	*37 CFR 1.324*
For: Methods of Detecting Specific Cell Lysis	:	
	:	
	:	
	:	

This is a decision on the petition filed Oct. 1, 2004 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

/Cecilia Tsang/

Cecilia Tsang
Supervisory Patent Examiner
Art Unit 1654
Technology Center 1600

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

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.
09/954,392	09/12/2001	Douglas Nixon	GLAD005	7288

24353 7590 02/12/2009
BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

EXAMINER
WINSTON, RANDALL O

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
02/12/2009	PAPER

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

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

BOZICEVIC, FIELD & FRANCIS LLP

INTELLECTUAL PROPERTY LAW

1900 UNIVERSITY AVENUE, SUITE 200
EAST PALO ALTO, CALIFORNIA 94303

TELEPHONE (650) 327-3400
FACSIMILE (650) 327-3231

URGENT

Date: January 21, 2009

To: Examiner Cecelia Tsang (Supervisor of Tech Center Art Unit 1654)	**Fax:** (571) 273-0562	☐ Use this fax number only
Company: U.S. Patent and Trademark Office	**Phone:** (571) 273-0562	☐ Notify recipient before sending

From: Paula A. Borden	**Phone:** (650) 833-7710	**Return Fax:** (650) 327-3231

Original: ☐ To follow via mail ☐ To follow via courier ☐ To follow via email ☒ Original will not follow

Fax Contains: 24 pages *(including this sheet)*. If incomplete, call **Martha Cisneros (650) 833-7722**

Re: Issued Patent No. 6,673,556
U.S. Patent Application for 09/954,392
"METHODS OF DETECTING SPECIFIC CELL LYSIS"
First Named Inventor: NIXON, DOUGLAS F.
Our Reference: GLAD-005

Message:

Dear Examiner Tsang,

Attached please find courtesy copies of the following:

1. Status Inquiry filed electronically on September 8, 2008
2. Status Inquiry filed by facsimile on May 24, 2006
3. Status Inquiry filed by first class on October 13, 2005
4. **Copy of the Petition for Correction of Inventorship filed on October 1, 2004.**

If you have any questions regarding these copies please call me at (650) 833-7722.

Thank You,Martha Cisneros

Ref: GLAD-005 Return Original to: Martha Cisneros Location:

****

WARNING: This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

Filed Electronically on:
September 8, 2008

STATUS INQUIRY		
	Customer Number	24353
	Atty. Docket No.	GLAD-005
	Application Number	09/954,392
	Patent No.	6,673,556
Address to: Mail Stop **Petitions Branch** Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Confirmation Number	7288
	Filing Date	September 12, 2001
	First Named Inventor	NIXON, DOUGLAS F.
	Examiner Name	WINSTON, RANDALL O.
	Group Art Unit	1654

Sir:

A **Petition for Correction of Inventorship in Patent** was filed with the U.S. Patent and Trademark Office on **October 1, 2004** in the above-identified patent. Since almost 4 years have passed and status inquiries were filed on March 29, 2005, October 13, 2005, May 24, 2006, and March 29, 2007, and no communication has been received from the Patent and Trademark Office in response thereto, applicants respectfully request to be informed of the current status of this request. Copies of the statuses filed and petition to correct inventorship are attached herewith.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: September 8, 2008

By: /Paula A. Borden, Reg. No. 42,344/
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

Auto-Reply Facsimile Transmission

COPY

TO: Fax Sender at 6503273231

Fax Information
Date Received: 5/24/2006 5:46:34 PM [Eastern Daylight Time]
Total Pages: 1 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received Cover Page =======>

MAY-24-2006 13:48 From:BFF LLP 6503273231 To:USPTO P.2/1

FAX TO 571-273-8300

STATUS INQUIRY		
Address to: Mail Stop ASSIGNMENT Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Customer Number	24353
	Atty. Docket No.	GLAD-005
	Application Number	09/954,392
	Patent No.	6,673,556
	Confirmation Number	7288
	Filing Date	September 12, 2001
	First Named Inventor	NIXON, DOUGLAS F.
	Examiner Name	WINSTON, RANDALL O.
	Group Art Unit	1654

Sir:

A Petition for Correction of Inventorship in Patent was filed with the U.S. Patent and Trademark Office on October 1, 2004 in the above-identified application. Since over 19- months have passed and no communication has been received from the Patent and Trademark Office in response thereto, applicants respectfully request to be informed of the current status of this request.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 24, 2006

By: _____
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

PAGE 1/1 * RCVD AT 5/24/2006 5:48:34 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/1 * DNIS:2730300 * CSID:6503273231 * DURATION (mm-ss):00-42

5/24/06 DOCKETED FAXED 5/24/06

FAX TO 571-273-8300

STATUS INQUIRY		
	Customer Number	24353
	Atty. Docket No.	GLAD-005
	Application Number	09/954,392
	Patent No.	6,673,556
Address to: Mail Stop ASSIGNMENT Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Confirmation Number	7288
	Filing Date	September 12, 2001
	First Named Inventor	NIXON, DOUGLAS F.
	Examiner Name	WINSTON, RANDALL O.
	Group Art Unit	1654

Sir:

A **Petition for Correction of Inventorship in Patent** was filed with the U.S. Patent and Trademark Office on **October 1, 2004** in the above-identified application. Since over **19-** months have passed and no communication has been received from the Patent and Trademark Office in response thereto, applicants respectfully request to be informed of the current status of this request.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 24, 2006

By: _____
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

Message Confirmation Report

MAY-24-2006 01:48 PM WED

Fax Number : 6503273231
Name : BFF LLP

Name/Number : USPTO / 915712738300
Page : 1
Start Time : MAY-24-2006 01:48PM WED
Elapsed Time : 00'29"
Mode : STD ECM
Results : [O.K]

FAX TO 571-273-8300

STATUS INQUIRY Address to: Mail Stop ASSIGNMENT Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Customer Number	24353
	Atty. Docket No.	GLAD-005
	Application Number	09/954,392
	Patent No.	6,673,556
	Confirmation Number	7288
	Filing Date	September 12, 2001
	First Named Inventor	NIXON, DOUGLAS F.
	Examiner Name	WINSTON, RANDALL O.
	Group Art Unit	1654

Sir:

A **Petition for Correction of Inventorship in Patent** was filed with the U.S. Patent and Trademark Office on **October 1, 2004** in the above-identified application. Since over 19- months have passed and no communication has been received from the Patent and Trademark Office in response thereto, applicants respectfully request to be informed of the current status of this request.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 24, 2006

By: [signature]
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

P:\DOCUMENT\GLAD (Gladstone)\005\status inq3.doc

Atty/Sec: PAB/CKH
Atty Docket No. GLAD-005 Date Mailed: October 13, 2005
Application No.: 09/954,392 Filing Date: September 12, 2001

Inventor(s): NIXON, DOUGLAS F.

Title: "METHODS OF DETECTING SPECIFIC CELL PHYSIS"

Enclosure(s):

- Status Inquiry (1 pg.)
- Return Postcard

Acknowledge Receipt of enclosures
By imprinting PTO Date Stamp and Returning to addressee

OFFICE OF PUBLIC RECORDS
2005 OCT 17 AM 9:
FINANCE SECTION

COPY

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.			
Typed or Printed Name	Cindy Kim Hoang		
Signature		Date	~~March 29, 2005~~ 10/13/05

STATUS INQUIRY		
	Customer Number	24353
	Atty. Docket No.	GLAD-005
	Application Number	09/954,392
	Patent No.	6,673,556
Address to: Mail Stop Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Confirmation Number	7288
	Filing Date	September 12, 2001
	First Named Inventor	NIXON, DOUGLAS F.
	Examiner Name	WINSTON, RANDALL O.
	Group Art Unit	1654

Sir:

A **Petition for Correction of Inventorship in Patent** was filed with the U.S. Patent and Trademark Office on **October 1, 2004** in the above-identified application. Since over 12- months have passed and no communication has been received from the Patent and Trademark Office in response thereto, applicants respectfully request to be informed of the current status of this petition.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: Oct. 13, 2005

By: _____
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

10/13/05 DOCKETED

F:\DOCUMENT\GLAD (Gladstone)\005\status inq.doc

COPY

Atty/Sec: PAB/CKH
Atty Docket No. GLAD-005 Date Mailed: October 1, 2004
Application No.: 09/954,392 Filing Date: September 12, 2001

Inventor(s): NIXON, DOUGLAS F.

Title: "METHODS OF DETECTING SPECIFIC CELL LYSIS"

Enclosure(s):

- Transmittal (1 pg.)
- Fee Transmittal + Duplicate (2 pgs.)
- Petition for Correction of Inventorship in Patent (1 pg.)
- Statement by Current Inventors (12 pgs.)
- Consent of Assignee to Change of Invetorship (1 pg.)
- Return Postcard

EXPRESS MAIL LABEL NO.EV462738066US

Acknowledge Receipt of enclosures
By Imprinting PTO Date Stamp and
Returning to addressee

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (05-03)
Approved for use through 04/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/954,392
Filing Date	September 12, 2001
First Named Inventor	NIXON, DOUGLAS
Group Art Unit	1654
Examiner Name	WINSTON, RANDALL O.
Attorney Docket Number	GLAD-005

COPY

ENCLOSURES (check all that apply)

- [x] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment / Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Documents
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Assignment Papers *(for an Application)*
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s
- [ ] After Allowance Communication to Group
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) *(please identify below)*:
  1) Petition for Correction of Inventorship in Patent (1 pg.)
  2) Statement by Current Named Inventors (12 pgs.)
  3) Consent of Assignee to Change of Invetorship (1 pg.)
  4) Return Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Signing Attorney/Agent (Reg. No.)	PAUL A. BORDEN, 42,344 BOZICEVIC, FIELD & FRANCIS, LLP
Signature	
Date	October 1, 2004

10/01/04

EXPRESS MAIL LABEL NO. EV462738066US

This collection of information is required by 37 CFR 1.5. 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 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.

PTO/SB/17 (10-03)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 130.00

Complete if Known	
Application Number	09/954,392
Filing Date	September 12, 2001
First Named Inventor	NIXON, DOUGLAS F.
Examiner Name	WINSTON, RANDALL O.
Art Unit	1654
Attorney Docket No.	GLAD-005

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:
Deposit Account Number: 50-0815
Deposit Account Name: Bozicevic, Field & Francis, LLP

The Director is authorized to: (*check all that apply*)
☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge Any Additional Fee(s) Required under 37 C.F.R. 1.17.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
				SUBTOTAL (1)	0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims		Fee from below		Fee Paid
Total Claims	-20** =		x	=	
Indep. Claims	-3**=		x	=	
Multiple Dependent				=	

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	88	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) $ 0.00

**or number previously paid, if greater; For Reissues, see above.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge – late filing fee or oath	
1052	50	2052	25	Surcharge – late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examination action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive – unavoidable	
1453	1,330	2453	665	Petition to revive – unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1462	130	1462	130	Petitions to the Commissioner	130.00
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					
*Reduced by Basic Filing Fee Paid				SUBTOTAL (3) ($)	130.00

SUBMITTED BY			Complete (*if applicable*)		
Name (Print/Type)	Paula A. Borden	Registration No. (Attorney/Agent)	42,344	Telephone	(650) 833-7710
Signature				Date	10/01/2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, 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

EXPRESS MAIL NO. EV462738066US

PETITION FOR CORRECTION OF INVENTORSHIP IN PATENT PURSUANT TO 35 U.S.C. § 256 UNDER 37 C.F.R. §1.324		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392 COPY
Address to: Commissioner for Patents PO Box 1450 Alexandria, VA 22313	Confirmation No.	7288
	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Dear Sir:

Applicant hereby petitions to correct the inventorship in the above-referenced patent to delete Martin Bigos as an inventor of the claimed invention.

Applicant request that the Commissioner issue a certificate naming only Douglas Nixon, Adrian B. McDermott, Scott Furlan, Megan Sheehy and Paul Klenerman as the inventors of the claims of the above-referenced patent.

As required by 37 C.F.R. 1.324(b), this petition is accompanied by:

1) A statement from the current named inventors (Douglas Nixon, Scott Furlan, Adrian B. McDermott, Megan Sheehy and Paul Klenerman) either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change (37 C.F.R. §1.324(b)(2);
2) A statement from the assignee, The J. David Gladstone Institutes, agreeing to the change of inventorship in the patent, which statement complies with the requirements of 37 C.F.R. §3.73(b) (37 C.F.R. §1.324(b)(3)); and
3) The fee set forth in 37 C.F.R. §1.20(b).

The Commissioner is authorized to charge the required fee of $130.00 as set forth in 37 C.F.R. §1.20(b) to our Deposit Account No.50-0815.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: Oct. 1, 2004

By: _____
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

F:\DOCUMENT\UCAL\170cip\Petition to Correct Inventorship in Patent.doc

Express Mail No.
EV462738066US

CONSENT OF ASSIGNEE TO CHANGE OF INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)(4) AND STATEMENT UNDER 37 C.F.R. § 3.73(b)		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Application Number	6,673,556
	Issued Date	January 6, 2004
	Group Art Unit	1654
Address to: Commissioner for Patents PO Box 1450 Alexandria, VA 22313	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. The J. David Gladstone Institutes is the assignee of the entire right, title, and interest in the above-referenced application by virtue of an assignment from the original inventors to The J. David Gladstone Institutes on June 17, 2002 on Reel 012993, Frame 0707.

2. The J. David Gladstone Institutes hereby agrees to the change of inventorship in the above-referenced application to delete Martin Bigos as an inventor as requested in the accompanying petition.

I, the person signing below, state that I am empowered to sign this statement on behalf of the assignee with which my name is associated.

Date: 3/15/04

Robert W. Mahley, M.D., Ph.D.
President
The J. David Gladstone Institutes

F:\DOCUMENT\GLAD (Gladstone)\005\consent of assignees to change inventorship.rtf

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 8/19/04 _____
Douglas Nixon

Date: _____ _____
Adrian B. McDermott

Date: _____ _____
Martin Bigos

Date: _____ _____
Megan Sheehy

Date: _____ _____
Paul Klenerman

Date: _____ _____
Scott Furlan

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____ _____
Douglas Nixon

Date: 7-2-04 _____
Adrian B. McDermott

Date: _____ _____
Martin Bigos

USSN: 09/954,392
Attorney Docket No. GLAD-005

Date: _____ _____
Megan Sheehy

Date: _____ _____
Paul Klenerman

Date: _____ _____
Scott Furlan

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____ _____
Douglas Nixon

Date: _____ _____
Adrian B. McDermott

Date: 04/03/04 _____
Martin Bigos

USSN: 09/954,392
Attorney Docket No. GLAD-005

Date: _____ _____
Megan Sheehy

Date: _____ _____
Paul Klenerman

Date: _____ _____
Scott Furlan

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____ _____
Douglas Nixon

Date: _____ _____
Adrian B. McDermott

Date: _____ _____
Martin Bigos

USSN: 09/954,392
Attorney Docket No. GLAD-005

Date: 3/26/04 _____
Megan Sheehy

Date: _____ _____
Paul Klenerman

Date: _____ _____
Scott Furlan

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____ _____
Douglas Nixon

Date: _____ _____
Adrian B. McDermott

Date: _____ _____
Martin Bigos

USSN: 09/954,392
Attorney Docket No. GLAD-005

Date: _____ _____
Megan Sheehy

Date: 18/3/04 Paul Klenerman
Paul Klenerman

Date: _____ _____
Scott Furlan

Express Mail No.
EV462738066US

STATEMENT BY CURRENT NAMED INVENTORS UNDER 37 C.F.R. § 1.324(b)(2) REGARDING CHANGE TO INVENTORSHIP IN PATENT		
	Attorney Docket	GLAD-005
	First Named Inventor	NIXON
	Patent No. Issue Date	6,673,556 January 6, 2004
	Serial No.	09/954,392
	Confirmation No.	7288
Address to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313	Group Art Unit	1654
	Examiner Name	R. Winston
	Title	METHODS OF DETECTING SPECIFIC CELL LYSIS

Sir:

1. I am among the current named inventors of the claims of the above-referenced patent, which current named inventors are Douglas Nixon, Scott Furlan, Martin Bigos, Megan Sheehy, and Paul Klenerman.

2. I understand that the inventorship of the above-referenced patent is to be changed to delete Martin Bigos as an inventor.

3. I either agree to the change in inventorship or have no disagreement in regard to the change in inventorship.

4. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____ _____
Douglas Nixon

Date: _____ _____
Adrian B. McDermott

Date: _____ _____
Martin Bigos

USSN: 09/954,392
Attorney Docket No. GLAD-005

Date: _____ _____
Megan Sheehy

Date: _____ _____
Paul Klenerman

Date: 9/10/04 _____
Scott Furlan

UNITED STATES 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: __

STEUBING MCGUINESS
& MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

COPY MAILED
JUN 14 2005
OFFICE OF PETITIONS

In re Application of	:	
Rasimas, et al.	:	
Application No. 09/954406	:	DECISION
Filing Date: 17 September, 2001	:	
Attorney Docket No. 14318RNUS01U	:	

This is a decision on the petition filed on 16 September, 2004, alleging unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTES:

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

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

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 3 December, 2003, with reply due absent extension of time on or before Wednesday, 3 March, 2004;
- the application went abandoned after midnight 3 March, 2004;
- the Office mailed the Notice of Abandonment on 2 July, 2004;
- Petitioner filed via FAX, *inter alia*, contemporaneously with the instant petition an amendment, however, the record as of this writing does not reflect that Petitioner paid or authorized payment of the petition fee.

Petitioner is cautioned always to check the Office website (www.uspto.gov) for the current fees before filing.

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]

---

[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.

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

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

Petitioner has failed to satisfy the fee requirement of the regulation.

CONCLUSION

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

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

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

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

---

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

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

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

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

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

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

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

UNITED STATES 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: __

STEUBING MCGUINESS
& MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

COPY MAILED
SEP 09 2005
OFFICE OF PETITIONS

In re Application of	:	
Rasimas, et al.	:	
Application No. 09/954,406	:	DECISION
Filing Date: 17 September, 2001	:	
Attorney Docket No. 14318RNUS01U	:	

This is a decision on the (renewed) petition filed on 29 July, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 3 December, 2003, with reply due absent extension of time on or before Wednesday, 3 March, 2004;
- the application went abandoned after midnight 3 March, 2004;
- the Office mailed the Notice of Abandonment on 2 July, 2004;

- Petitioner filed via FAX, *inter alia*, contemporaneously with the original petition an amendment, however, the record as of that time reflected that Petitioner had not paid or authorized payment of the petition fee, and so the petition was dismissed on 14 June, 2005;

- that deficiency now has been corrected with the instant petition.

STATUTES, REGULATIONS AND ANALYSIS

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

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

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and

---

[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.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

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

Petitioner has satisfied the requirementa of the regulation.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is released to Technology Center 2100 for further processing in due course.

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

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

[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.

UNITED STATES 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 2 0 2008

ANDERSON GORECKI
& MANARAS LLP
33 NAGOG PARK
ACTON MA 01720

In re Application of	:	
Rasimas, et al.	:	
Application No. 09/954,406	:	DECISION
Filing Date: 17 September, 2001	:	
Attorney Docket No.: 120-457	:	

This is a decision on the petition filed on 17 December, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

PLEASE NOTE:

The information on the petition filed herein suggests that Petitioner has changed address. However there is no indication that Petitioner herein ever properly Notice the Office as to a change of address.

Petitioner is reminded that inserting a change of address into another paper is not proper Notice under the rules.

If Petitioner desires to receive future correspondence at a new address or one associated with a Customer Number not previously associated with this application, the appropriate Notice must be submitted.

A copy of this decision is being mailed to the address on the petition as a courtesy. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received indicating otherwise.

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

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that Petitioner has satisfied the requirements of the regulation, as set forth below:

BACKGROUND

The record reflects that:

Applicant failed to reply timely and properly to the final Office action mailed on 4 May, 2007, with reply due absent and extension of time on or before Tuesday, 4 August, 2007.

Petitioner filed a Notice of Appeal on 4 June, 2007.

The instant application went abandoned by operation of law after midnight 4 August, 2007.

It does not appear that the Office mailed a Notice of Abandonment before the original petition was filed.

On 17 December, 2007, Petitioner filed the instant petition (with fee) with averment of unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an appeal brief and fee, and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts

of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

STATUTES, REGULATIONS

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

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.[2,3]

CONCLUSION

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

The instant application is released to Technology Center/AU 2182 to await the Examiner's Answer in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

---

[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). See specifically, the regulations at 37 C.F.R. §10.18.

[2] 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).

[3] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

cc:
HOLMES W. ANDERSON
MCGUINNESS & MANARAS LLP
125 NAGOG PARK
ACTON MA 01720

[4] The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

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

COPY MAILED

JAN 29 2002

OFFICE OF PETITIONS

In re Application of	:	
Radoje T. Drmanac et al	:	DECISION GRANTING
Application No. 09/954,426	:	PETITION
Filed: September 10, 2001	:	
Attorney Docket No. 9598-083-999	:	

This is in response to the "Request For Correction Of Filing Date..." filed December 19, 2001, requesting that the above-identified application be issued a corrected filing date of September 10, 2001.

A review of the original application papers show that the papers were stamped in the Patent and Trademark Office (PTO) with a September 10, 2001 date. Therefore, the filing date of the application is the date shown on the application papers. Obviously, the September 17, 2001 filing date shown on applicants' filing receipt is a typographical error.

No petition fee is required and none has been charged.

Receipt is acknowledged of the statutory basic filing fee, an amendment, formal drawings, and Sequence Listing filed December 19, 2001, in response to the Notice mailed November 27, 2001.

The application is being returned to Initial Patent Examination Division for correction of the filing date to September 10, 2001.

Telephone inquires specific to this matter should be directed to Wan Laymon at (703) 306-5685.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET, N.E.
ATLANTA GA 30309

COPY MAILED

APR 06 2007

OFFICE OF PETITIONS

In re Application of	:	
Adair et al.	:	
Application No. 09/954,443	:	LETTER REGARDING
Filed: September 17, 2001	:	PATENT TERM ADJUSTMENT
Atty Docket No. 17244-0129	:	

This letter is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION" filed December 21, 2006, pursuant to applicants' duty of candor and good faith. Applicants disclose that the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is three hundred forty-four (344) days, not three hundred forty-five (345) days.

The request for correction of the initial determination of patent term adjustment (PTA) is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance is three hundred forty-four (344) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 26, 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 345 days. Applicants disclose that the period of delay caused by successful appellate review should run to the correct mailing date of the Final Decision by the Board of Patent Appeals and Interferences as stamped on the Decision, August 23, 2006, not August 24, 2006 as shown in PAIR.

Applicants are correct. A review of the BPAI decision confirms that the correct date of the BPAI decision is August 23, 2006. Accordingly, the period of adjustment delay caused by successful appellate review, pursuant to 35 U.S.C. 154(b)(1)C(iii) and 37 CFR 1.702(e) is 548 days, not 549 days (e.g., beginning on February 22, 2005 and ending on August 23, 2006).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred forty-four (344) days.

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

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

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

PALM INTRANET

Day : Sunday
Date: 4/1/2007
Time: 18:13:49

PTA Calculations for Application: 09/954443			
Application Filing Date:	09/17/2001	PTO Delay (PTO):	593
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	248
Post-Issue Petitions:	0	Total PTA (days):	344
PTO Delay Adjustment:	-1		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
84	04/01/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	548		
83	04/01/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		549	
70	10/26/2006	MAIL NOTICE OF ALLOWANCE			
69	10/12/2006	ISSUE REVISION COMPLETED			
68	10/12/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	10/12/2006	NOTICE OF ALLOWABILITY			
66	08/24/2006	MAIL BPAI DECISION ON APPEAL - REVERSED	549		45
65	08/23/2006	BPAI DECISION - EXAMINER REVERSED			
64	06/28/2006	CONFIRMATION OF HEARING BY APPELLANT			
63	05/11/2006	DOCKETING NOTICE MAILED TO APPELLANT			
62	05/09/2006	ASSIGNMENT OF APPEAL NUMBER			
61	04/13/2006	APPEAL AWAITING BPAI DOCKETING			
60	04/10/2006	MAIL REPLY BRIEF NOTED BY EXAMINER			
59	04/06/2006	REPLY BRIEF NOTED BY EXAMINER			
58	02/02/2006	REQUEST FOR ORAL HEARING			
57	02/08/2006	DATE FORWARDED TO EXAMINER			
56	02/02/2006	REPLY BRIEF FILED			
55	12/01/2005	MAIL EXAMINER'S ANSWER			
54	11/28/2005	EXAMINER'S ANSWER TO APPEAL BRIEF			
53	11/17/2005	DATE FORWARDED TO EXAMINER			
52	11/14/2005	APPEAL BRIEF FILED			
51	10/11/2005	NOTICE -- DEFECTIVE APPEAL BRIEF			
50	08/26/2005	DATE FORWARDED TO EXAMINER			
49.1	08/22/2005	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
49	08/22/2005	APPEAL BRIEF FILED			

48	07/21/2005	NOTICE -- DEFECTIVE APPEAL BRIEF			
47	05/31/2005	DATE FORWARDED TO EXAMINER			
46.1	04/18/2005	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
46	04/18/2005	APPEAL BRIEF FILED			
45	02/22/2005	NOTICE OF APPEAL FILED		90	37
44	03/03/2005	MAIL ADVISORY ACTION (PTOL - 303)			
43	03/02/2005	ADVISORY ACTION (PTOL-303)			
42	02/18/2005	DATE FORWARDED TO EXAMINER			
41	02/14/2005	AMENDMENT AFTER FINAL REJECTION			
40	02/14/2005	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
39	02/14/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
38	02/14/2005	WORKFLOW INCOMING AMENDMENT IFW			
37	08/24/2004	MAIL FINAL REJECTION (PTOL - 326)			
36	08/23/2004	FINAL REJECTION			
35	06/30/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
34	06/30/2004	DATE FORWARDED TO EXAMINER			
33	05/20/2004	RESPONSE AFTER NON-FINAL ACTION		64	30
32	05/20/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
31	05/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
30	12/17/2003	MAIL NON-FINAL REJECTION			
29	12/12/2003	NON-FINAL REJECTION			
28	11/26/2003	DATE FORWARDED TO EXAMINER			
27	11/14/2003	REQUEST FOR CONTINUED EXAMINATION (RCE)		62	17
26	11/26/2003	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
25	11/14/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
24	11/14/2003	WORKFLOW - REQUEST FOR RCE - BEGIN			
23	10/24/2003	MAIL ADVISORY ACTION (PTOL - 303)			
22	10/23/2003	ADVISORY ACTION (PTOL-303)			
21	10/16/2003	DATE FORWARDED TO EXAMINER			
20	10/06/2003	AMENDMENT AFTER FINAL REJECTION			
19	10/06/2003	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			

18	10/06/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
17	06/13/2003	MAIL FINAL REJECTION (PTOL - 326)			
16	06/12/2003	FINAL REJECTION			
15	05/13/2003	DATE FORWARDED TO EXAMINER			
14	05/02/2003	RESPONSE AFTER NON-FINAL ACTION		32	12
13	05/02/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
12	12/31/2002	MAIL NON-FINAL REJECTION	44		-1
11	12/27/2002	NON-FINAL REJECTION			
10	01/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	03/15/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	02/26/2002	TRANSFER INQUIRY TO GAU			
7	12/12/2001	APPLICATION DISPATCHED FROM OIPE			
6	12/11/2001	APPLICATION IS NOW COMPLETE			
4	10/15/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	10/15/2001	CORRESPONDENCE ADDRESS CHANGE			
2	09/27/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/17/2001	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

BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO IL 60610

COPY MAILED

NOV 1 6 2004

OFFICE OF PETITIONS

In re Application	:	
Robert K. Ellis	:	
Application No. 09/954,447	:	DECISION ON APPLICATION
Filed: September 14, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. 3410/11	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)," filed April 19, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from seventeen (17) days to forty-four (44) 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 **forty-four (44) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 20, 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 seventeen (17) days. On April 19, 2004, Applicant 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 forty-four (44) days.

Applicant asserts entitlement to a patent term adjustment of forty-four (44) days on the basis that the PTO improperly assessed Applicant a delay of seventy (70) days for responding to a Notice to File Missing Parts mailed on October 15, 2001. Applicant asserts that while he did not timely file a response within the three month period pursuant to 37 C.F.R. 1.704(b), their response was filed on February 27, 2002. Accordingly, Applicant states that he should have only been assessed delay of forty-three (43) days, not seventy (70) days.

Applicant states that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of seventeen (17) days based on an adjustment for PTO delay of one hundred fifty-one (151) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by Applicant's delays of seventy (70) days and sixty-four (64) days, both pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b). The PTO delay of 64 days has been reviewed and found to be correct. The adjustment of 70 days is at issue.

The adjustment of seventy (70) days has been found to be incorrect. Applicant has submitted a copy of a postcard receipt for the instant application, itemizing a declaration and the proper fees, and bearing a USPTO date stamp of February 27, 2002. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.[2] Accordingly, it is concluded that Applicant filed a complete reply in response to the October 15, 2001 Notice to File Missing Parts on February 27, 2002, and therefore should have only been assessed a delay of forty-three (43) days.

---

[1] Applicant filed the application for patent term adjustment on the same date as the filing of the issue fee.

[2] MPEP 503.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **forty-four (44) days** (151 days of PTO delay and 107 (43 + 64) days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e).

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

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

Kery A Fries
for

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

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO IL 60610

COPY MAILED

JUL 0 5 2005

OFFICE OF PETITIONS

In re	: DECISION ON APPLICATION
Robert K. Ellis	: FOR PATENT TERM ADJUSTMENT
Application No. 09/954,447	: AND
Filed: September 14, 2001	: NOTICE OF INTENT TO ISSUE
Patent No. 6,843,177	: CERTIFICATE OF CORRECTION
Issued: January 18, 2005	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR § 1.705(d)," filed March 21, 2005, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The petition is **GRANTED.**

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **one hundred ninety-six (196)** days.

On January 18, 205, the above-identified application matured into U.S. Patent No. 6,843,177. The patent issued with a Patent Term Adjustment of seventy-six (76) days. Patentee points out that he was improperly assessed applicant delay of one hundred twenty (120) days for previously filing an application for patent term adjustment on April 19, 2004.

Patentees state that the patent is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of seventy-six (76) days based on an adjustment for PTO delay of one hundred fifty-one (151) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and one hundred fifty-two (152) days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. 1.703(a)(6), reduced by Applicant's delay of sixty-four (64) and forty-three (43) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and one hundred twenty (120) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(1). The adjustment of 120 days is at issue.

Pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application.

Accordingly, issuance of a certificate of correction pursuant to 35 U.S.C. 254 and 37 C.F.R. § 1.322 is appropriate.

Given the basis for granting this petition, no fee was required, and none has been charged.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify 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 **one hundred ninety-six (196)** 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

Enclosure: copy of draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEPHEN B. SALAI, ESQ.
HARTER, SECREST & EMERY LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER NY 14604-2711

COPY MAILED

JUL 29 2005

OFFICE OF PETITIONS

In re Application of	:
Nicholas F. Borrelli et al.	:
Application No. 09/945,500	: DECISION GRANTING
Filed: September 17, 2001	: PETITION
Attorney Docket No. BORRELLI 83A	:

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

The petition is **GRANTED**.

This application became abandoned September 20, 2004, for failure to timely respond to the Notice of Drawing Inconsistency, mailed August 18, 2004. Accordingly, a Notice of Abandonment was mailed October 21, 2004.

As the issue fee and publication fee have both already been paid, this application is being forwarded to the Publishing Division for review of the drawings shown as having been received in the PTO on July 18, 2005.

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

Copied from 09945500 on 08/11/2005

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

STEPHEN B. SALAI, ESQ.
HARTER, SECREST & EMERY LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER NY 14604-2711

COPY MAILED

AUG 1 1 2005

OFFICE OF PETITIONS

In re Application of Nicholas F. Borrelli et al. Application No. 09/954,500 Filed: September 17, 2001 Attorney Docket No. BORRELLI 83A	DECISION GRANTING PETITION

CORRECTED DECISION[1]

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

The petition is **GRANTED**.

This application became abandoned September 20, 2004, for failure to timely respond to the Notice of Drawing Inconsistency, mailed August 18, 2004. Accordingly, a Notice of Abandonment was mailed October 21, 2004.

As the issue fee and publication fee have both already been paid, this application is being forwarded to the Publishing Division for review of the drawings shown as having been received in the PTO on July 18, 2005.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

[1]Incorrect serial number included with decision mailed July 29, 2005.

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

LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

Mail Date: 04/20/2010

Applicant	: Ivan A. Todorov	: DECISION ON REQUEST FOR
Patent Number	: 7644120	: RECALCULATION of PATENT
Issue Date	: 01/05/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/954,508	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/14/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2105** 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

LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

Mail Date: 04/20/2010

Applicant	: Barry Omshehe	: DECISION ON REQUEST FOR
Patent Number	: 7647407	: RECALCULATION of PATENT
Issue Date	: 01/12/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/954,509	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/14/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1876** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Sept. 12, 2009

TO SPE OF : ART UNIT 1772

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/954515 Patent No.: 7303809

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Magdalene Talley
Certificates of Correction Branch
703-308-9390 ext. 116

Thank You For Your Assistance

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

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

Comments: _____

All changes approved. /David R. Sample/ SPE, 1794

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

Hunton & Williams
Attn Patrick A Doody
1900 K Street NW
Washington, DC 20006

COPY MAILED

APR 16 2002

OFFICE OF PETITIONS

In re Application of
Pitzen et al.
Application No. 09/954,526
Filed: March 5, 2001
Attorney Docket Number: 54525.000055

DECISION ACCORDING STATUS-
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition for status under 37 C.F.R. §1.47(b), filed January 4, 2002.

The petition is **GRANTED**.

The above-identified application was filed on March 5, 2001, without an executed oath or declaration. Accordingly, on November 5, 2001, a Notice to File Missing Parts of Application - Filing Date Granted was mailed, requiring applicant to submit an executed oath or declaration, and pay a surcharge for late filing.

In response, on January 4, 2002 applicant filed:

- a declaration of Patrick A. Doody, attorney of applicant,
- assignment documents between 3M and Linvatec,
- documents to establish ownership of invention,
- correspondence with non-signing inventors,
- declaration and power of attorney signed by Patrick Doody on behalf of Linvatec Corporation,(assignee),
- the surcharge under 1.16(e)for late filing, and
- a petition (and fee) under §1.47(b).

Applicant has satisfied the requirements of §1.47(b)[1]. Applicant, by declaration of persons with first hand knowledge and documentary evidence, demonstrated that the non-signing inventors have been presented with a copy of the application papers for signature and that they have refused by their conduct to sign the declaration. Applicant submitted a declaration signed by Patrick A. Doody, attorney for assignee Linvatec Corporation. This declaration has been reviewed and is found in compliance with 1.63, 1.64 and 1.175. Applicant paid the petition fee and included a statement of the non-signing inventors' last known address in the petition. The assignment agreement and documents which establish the chain of ownership establish the applicant's proprietary interest in the application. Applicant has also made a showing of irreparable harm.

This application is hereby accorded Rule 1.47(b) status.

---

[1] A grantable petition under 37 C.F.R. §1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of last known address of the non-signing inventor; (5) proof of proprietary interest; and (6)a showing of irreparable damage or the need to preserve the rights of the parties.

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 application file is being forwarded to Technology Center 1700 for further processing of the application.

Telephone inquiries regarding this decision should 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

Hunton & Williams, LLP
Intellectual Property Department
1900 K Street, N. W., Suite 1200
Washington, DC 20006-1109

COPY MAILED

DEC 10 2004

OFFICE OF PETITIONS

In re Application of :
James F. Pitzen, et al. :
Application No. 09/954,526 :
Filed: March 5, 2001 :
Attorney Docket No. 54525.000055 :

ON PETITION

This is in response to the petition under 37 CFR 1.183(a), filed December 6, 2004 seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by a named inventor.

The petition is **GRANTED**.

REVIEW OF FACTS

1. On March 5, 2001, the application was filed as an application for reissue of U. S. Patent No. 5,792,573.

2. A petition for status under 37 CFR § 1.47(b) was filed on January 4, 2002 and granted on April 16, 2002.

2. On June 17, 2004, a final Office action was mailed to applicants requesting an additional oath or declaration, setting a three (3) month shortened statutory period for reply.

3. On August 25, 2004, applicant responded to the final Office action by filing an amendment.

4. On December 6, 2004, the present petition was filed whereby petitioner requests that the Supplemental Declaration filed concurrently with the petition, be accepted without the signatures of all of the joint inventors, since a petition under 37 CFR 1.47(b) had been granted previously in this application.

DECISION ON PETITION UNDER 37CFR 1.183 TO WAIVE §§ 1.67 AND 1.175

In view of the efforts recounted in the original petition under 37 CFR 1.47(b) and the decision granting Rule 47 status, it is agreed that the non-signing inventors would be unavailable for signing the supplemental declaration. Accordingly, justice would be served by waiving the requirement for the signatures of the joint inventors on the supplemental declaration filed with the present petition, and the petition is granted.

The application file is being forwarded to Technology Center 1700 for further processing.

Telephone inquiries regarding this decision only should be directed to Marianne Jenkins at (571) 272-3223.

Kenneth M. Schor
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

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW, SUITE 1200
WASHINGTON, DC 20006-1109

COPY MAILED

MAR 16 2006

OFFICE OF PETITIONS

In re Application of	:
James F. Pitzen et al	:
Application No. 09/954,526	: DECISION GRANTING PETITION
Filed: March 5, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 54525.000055	:

This is a decision on the petition, filed March 15, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 12, 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 1745 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Mar9\954526.wpd

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCKELLAR IP LAW, PLLC
784 SOUTH POSEYVILLE ROAD
MIDLAND MI 48640

COPY MAILED

JAN 07 2009

OFFICE OF PETITIONS

In re Patent No. 6,784,555 :
Issue Date: August 31, 2004 :
Application No. 09/954,528 : ON PETITION
Filed: September 17, 2001 :
Attorney Docket No. DC4952 :

This is a decision on the petition, filed October 7, 2008, under 37 CFR 1.378(c) to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 31, 2008 for failure to pay the first 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 3 ½ year maintenance fee in this case is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. Petitioner is reminded, however, that the mere filing of a change of correspondence address does not affect fee address. Therefore, if petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which may be mailed regarding maintenance fees for the above-identified patent, an appropriate "fee address" and/or "customer number" form should be submitted to the Maintenance Fee Division. A courtesy copy of this decision is being mailed to the address given on the petition.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Cc: CATHERINE U. BROWN
DOW CORNING CORPORATION
ATTN: PATENT DEPARTMENT MAIL CO 1232
P.O. BOX 994
MIDLAND, MI 48686-0994

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : October 10,2007

TO SPE OF : ART UNIT 3734

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/954,557 Patent No.: 7175655 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.

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

Comments: _____

M J Hayes
SPE

3734
Art Unit

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)
6730103	2004-05-04	09954614	2001-09-18	

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	/Pepi Dakov/	Date (YYYY-MM-DD)	2010-04-21
Name	Pepi Dakov		

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. 6730103
Issue Date: May 4,2004
Application No. 09954614
Filed: September 18,2001
Attorney Docket No.

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

This is a decision on the electronic petition, filed April 27,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 27,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,616,382 B2
DATED : September 9, 2003
INVENTOR(S) : Woolford et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title page,
Item [56], OTHER PUBLICATIONS, "Garden Wall" Prodct Literature (1991)." should read -- Garden Wall" Product Litreature (1991). --
"Standard Load Bearing Wall Tire Literature (1924)." should read -- Standard Load Bearing Wall Tile Literature (1924). --

Column 5,
Line 16, "26and" should read -- 26 and --
Line 32, "sidewall A second" should read -- sidewall second --

Column 6,
Line 57, "the,present" should read -- the present --

Column 13,
Line 12, "A The block of" should read -- The block of --

Column 15,
Line 8, "unit of claim 40," should read -- unit of claim 41, --
Line 21, "unit of claim 41," should read -- unit of claim 44, --
Line 35, "unit of claim 40," should read -- unit of claim 41, --

Column 16,
Line 1, "unit of claim 40," should read -- unit of claim 41, --

Signed and Sealed this

Sixth Day of April, 2004

JON W. DUDAS
Acting Director of the 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

Paper No. 8

LAW OFFICE OF DANIEL O'NEILL
17108 GRAPE ARBOR CT
POWAY, CA 92064

COPY MAILED

APR 0 9 2004

OFFICE OF PETITIONS

In re Application of
Le et al.
Application No. 09/954,618
Filed: September 11, 2001
Attorney Docket No. P-005-005

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 25, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 16, 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 December 17, 2001. A Notice of Abandonment was mailed on November 6, 2003.

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

[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.

under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

The instant petition lacks item (2). Petitioner only submitted $650.00 towards payment of the petition fee. Effective October 1, 2003, the small entity petition fee is $665.00. Accordingly, petitioner must submit an additional $15.00.

The Revocation of Power of Attorney with New Power of Attorney and Change of Correspondense Address submitted with the instant petition on March 25, 2004, is hereby not accepted. Although petitioner properly submitted a Revocation from each individual inventor, only the one submitted by Kiem Tinh Le was signed. The remaining inventors need to submit a signed copy of the Revocation of Power of Attorney in order for it to be accepted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

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

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

Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the existing Customer Window located at:

2011 South Clark Place
Crystal Plaza 1 Lobby
Room 1B03
Arlington, VA 22202

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

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

Liana Chase

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

cc: LAN Q. NGO
MCFATRIDGE, BAKER & DEEN, P.C.
3900 ESSEX LANE, SUITE 730
HOUSTON, TX 77027

---

[2] See MPEP 711.03(c)(III)(C) and (D).

UNITED STATES 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

LAW OFFICE OF DANIEL O'NEILL
17108 GRAPE ARBOR CT
POWAY, CA 92064

COPY MAILED

APR 3 0 2004

OFFICE OF PETITIONS

In re Application of
Le et al.
Application No. 09/954,618
Filed: September 11, 2001
Attorney Docket No. P-005-005

ON PETITION

This is a decision on the renewed petition under 37 C.F.R. § 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 reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 16, 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) was obtained. Accordingly, the above-identified application became abandoned on December 17, 2001. A Notice of Abandonment was mailed on November 6, 2003.

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

Petitioner's request to forward all correspondence to the address listed in the instant petition cannot be honored until **all** of the inventors have submitted signed copies of the Revocation of Power of Attorney and Change of Correspondence Address. Until such time, the Office will mail all future correspondence solely to the address of record. A courtesy copy of this decision is being mailed to the address given on the petition.

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

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

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

cc: LAN Q. NGO
MCFATRIDGE, BAKER & DEEN, P.C.
3900 ESSEX LANE, SUITE 730
HOUSTON, TX 77027

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NGO & MELENDEZ, PLLC
9950 WESTPARK
SUITE 275
HOUSTON TX 77063

MAILED

JUL 13 2010

OFFICE OF PETITIONS

In re Patent No. 6,941,220	:	
Issue Date: September 6, 2005	:	
Application No. 09/954,618	:	ON PETITION
Filed: September 11, 2001	:	
Attorney Docket No. P-005-005	:	

This is a decision on the petition under 37 CFR 1.378(c), filed May 27, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

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

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

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. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

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

The patent file is being forwarded to Files Repository.

Terri Johnson
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

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

COPY MAILED

FEB 2 4 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Robert O. Dempcy et al :
Application No. 09/954,624 :
Filed: September 12, 2001 :
Attorney Docket No. 17682A-007400US :

This is a decision on the petition, filed February 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 March 19, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1623 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

10-18-07

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

Patent No. : 7,103,193 B2
Inventor(s) : James J. Croft, III
Issued : September 5, 2006
For: BANDPASS OOFER ENCLOSURE WITH MULTILE ACOUSTC FIBERS

Re. Request for Certificate of Correction

Consideration has been given your request under the provisions of Rule 1.322.

The alleged error on the title page item [54] the title is printed in accordance with the record. Therefore, no correction is in order here under United States Codes (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1.322.

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

Further correspondence concerning this matter, should be directed to:

U.S. Patent and Trademark Office
Washington, DC 20231
Attn: Decisions & Certificates of Correction Branch

Eva James
For Cecelia B. Newman
Decisions & Certificate
of Correction Branch
(703) 308-9390 ext. 124 or 305-8309

Thorpe North & Western
P.O. Box 1213
Sandy, UT 84091-1219

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James A. Wilke
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee WI 53202-5367

COPY MAILED

JAN 2 7 2004

OFFICE OF PETITIONS

In re Application of
William J. O'Connell, et al.
Application No. 09/954,677
Filed: September 15, 2001
Attorney Docket No. 061300-0242

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 9, 2004, to revive the above-identified application.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts (Notice) mailed October 16, 2001. The notice required the statutory basic filing fee, an oath or declaration under 37 CFR 1.63 and the requisite surcharge. Since no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the application became abandoned on December 17, 2001. A Notice of Abandonment was mailed on November 10, 2003. In response, on January 9, 2004, petitioner filed the present petition, the requisite filing fee and surcharge, and a partially executed declaration.

The petition is **DISMISSED**.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (**2**) the petition fee required by 37 CFR 1.17(m); (**3**) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (**4**) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (1) above.

The Office acknowledges receipt of the statutory basic filing fee and the $130.00 surcharge on January 9, 2004. However, petitioner did not submit a properly executed declaration in compliance with 37 CFR 1.63, as required by the Notice mailed October 16, 2001. While the declaration of Attorney James A. Wilke includes a statement that joint inventor Harowitz cannot be contacted and joint inventor O'Connell is refusing to sign, this statement alone is not sufficient for acceptance of a declaration without the signatures of all the joint inventors. Petitioner's attention is directed to 37 CFR 1.47(a) which provides for acceptance of a declaration without the signatures of all the joint inventors.

The above-identified application cannot be revived until a proper declaration under 37 CFR 1.63 is filed **or** a grantable petition in compliance with 37 CFR 1.47(a) is submitted.

Application No. 09/954,677

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)", and the missing items noted above. Petitioner is advised that this is not a final agency decision.

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

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

By Hand: 2011 South Clark Place
Crystal Plaza Two, Lobby
Room 1B03
Arlington, VA 22202

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

Any questions concerning this matter may be directed to the undersigned at (703) 305-9220.

Sherry D. Brinkley

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

James A. Wilke
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee WI 53202-5367

COPY MAILED

APR 3 0 2004

OFFICE OF PETITIONS

In re Application of :
William J. O'Connell, et al. :
Application No. 09/954,677 :
Filed: September 15, 2001 :
Attorney Docket No. 061300-0242 :

ON PETITION

This is a decision on the communication filed April 15, 2004, which is being treated as a renewed petition under 37 CFR 1.137(b) and 37 CFR 1.47(a).

The declaration and the petition have been reviewed and found to be in compliance with 37 C.F.R. § 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

In view of the decision granting 1.47(a) status, the requirements under 37 CFR 1.137(b) have now been satisfied.

The petitions are **GRANTED**.

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

The application is being returned to Initial Patent Examination Division for further processing using the declaration executed by Michael B. Calhoun on behalf of himself and nonsigning joint inventors William J. O'Connell and Jack Harowitz filed June 9, 2004.

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

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

UNITED STATES 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.

WILLIAM J. O'CONNELL
5548 SOUTHERN HILLS DRIVE
FRISCO, TX 75034

COPY MAILED

APR 3 0 2004

OFFICE OF PETITIONS
LETTER

In re Application of
William J. O'Connell, Michael B. Calhoun
and Jack Harowitz
Application No. 09/954,677
Filed: September 15, 2001
Title: ENVIRONMENTAL SHIELD FOR A
TRUCK MOUNTED CONCRETE MIXER

Dear Mr. O'Connell:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-9220. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

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

cc: James A. Wilke
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee WI 53202-5367

UNITED STATES 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.

JACK HAROWITZ
6331 E. ROCHELLE STREET
MESA, AZ 85215

COPY MAILED
APR 3 0 2004
OFFICE OF PETITIONS

LETTER

In re Application of
William J. O'Connell, Michael B. Calhoun
and Jack Harowitz
Application No: 09/954,677
Filed: September 15, 2001
Title: ENVIRONMENTAL SHIELD FOR A
TRUCK MOUNTED CONCRETE MIXER

Dear Mr. Harowitz:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-9220. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

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

cc: James A. Wilke
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee WI 53202-5367

UNITED STATES 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 A. Wilke
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee, WI 53202-5367

COPY MAILED

APR 0 1 2004

OFFICE OF PETITIONS

In re Application of :
William J. O'Connell, Michael B. Calhoun :
and Jack Harowitz :
Application No. 09/954,677 :
Filed: September 15, 2001 :
For: ENVIRONMENTAL SHIELD FOR :
A TRUCK MOUNTED CONCRETE :
MIXER :

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a) filed March 16, 2004.

A review of the record discloses that the above-identified application was filed on September 16, 2001 without an executed oath or declaration and naming William J. O'Connell, Michael B. Calhoun and Jack Harowitz as joint inventors. On October 16, 2001, a "Notice to File Missing Parts of Application was mailed requiring an executed oath or declaration , filing fee and requisite surcharge. Since no response was filed, a Notice of Abandonment was mailed on November 10, 2003. In response, on January 9, 2004, applicant filed a petition to revive under 37 CFR 1.137(b), the requisite filing fee and surcharge and a partially executed declaration. The petition was dismissed in a decision mailed January 27, 2004. On March 16, 2004, the present petition under 37 CFR 1.47(a) was filed.

The petition is DISMISSED.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

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. Any extensions of time will be governed by 37 CFR 1.136(a).

As to item (1) applicant has demonstrated that Mr. O'Connell has received the application papers and refused to sign. However, the petition is defective as it relates to Mr. Harowitz, who purportedly cannot be reached. Rule 47 applicant has simply stated that inquiries were made regarding Mr. Harowitz' whereabouts and calls were made, for which there were no answers. Applicant does not state that a copy of the application papers was sent to the last known address of Mr. Harowitz. Accordingly, a copy of the application papers should be sent to the last known address of Mr. Harowitz with a request that he sign the declaration for the patent application. A forwarding address should be requested. If the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached.

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

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

By Hand: 2011 South Clark Place
Crystal Plaza Two, Lobby
Room 1B03
Arlington, VA 22202

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

The decision on the petition to revive under 37 CFR 1.137(b) will be held in abeyance pending timely resolution of the 37 CFR 1.47(a) matter.

Any questions concerning this matter may be directed to the undersigned at (703) 305-9220.

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

UNITED STATES 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
777 EAST WISCONSIN AVE
SUITE 3800
MILWAUKEE WI 53202-5308

COPY MAILED

SEP 01 2005

OFFICE OF PETITIONS

In re
O'Connell, et al. : DECISION ON APPLICATION
Application No. 09/954,677 : FOR PATENT TERM ADJUSTMENT
Filed: September 15, 2001 :
Attorney Docket No. 061300-0242 :

This letter is in response to the "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed June 24, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty-three (643) days.

The application for patent term adjustment is **DISMISSED**.

On March 30, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On June 24, 2005, Applicants

timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty-three (643) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of six hundred forty-three (643) days, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by eight hundred thirty-five (835) days of Applicant delay pursuant to 37 C.F.R. § 1.704(c)(3).

A review of the record reveals that Applicants were properly assessed applicant delay pursuant to 37 C.F.R. § 1.704(c)(3). A Notice to File Missing Parts was mailed on October 16, 2001. Applicants failed to timely reply. Accordingly, the application became abandoned on December 17, 2001. A petition to revive was first filed on January 9, 2004, and was finally granted in a decision mailed on April 30, 2004.

Applicants state that the Office mailed a Withdrawal of Previously Sent Notice on July 29, 2004, indicating that the Notice of Abandonment mailed on November 10, 2003 was mailed in error. However, a review of the application file fails to reveal the presence of that paper. The application file is the official file of record. An applicant alleging the presence of a paper not contained therein bears the weight of that allegation by a preponderance of the evidence.

37 C.F.R. § 1.704(c)(3) states:

> (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> (3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

---

[1] Applicant filed the application for patent term adjustment on the same date as the issue fee.

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

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

Therefore, Applicant should have been assessed delay for the period from December 17, 2001 (the date the application became abandoned) to April 30, 2004 (the date of mailing of the decision reviving the application), or 865 days, not 835 days.

In view thereof, the correct determination of patent term adjustment is **zero (0) days** (643 days of PTO delay, reduced by 865 days of applicant delay).

Receipt of the $200 fee under 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

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

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
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
777 EAST WISCONSIN AVE
SUITE 3800
MILWAUKEE WI 53202-5308

COPY MAILED

DEC 0 2 2005

OFFICE OF PETITIONS

In re	
O'Connell, et al.	: DECISION ON APPLICATION
Application No. 09/954,677	: FOR PATENT TERM ADJUSTMENT
Filed: September 15, 2001	:
Patent No. 6,957,908	:
Issued: October 25, 2005	:
Attorney Docket No. 061300-0242	

This letter is in response to the "REQUEST FOR RECONSIDERATION OF APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed September 28, 2005. Applicants request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty-three (643) days.

The application for patent term adjustment is **DISMISSED**.

On March 30, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment

(PTA) to date is zero (0) days. On June 24, 2005, Applicants timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty-three (643) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of six hundred forty-three (643) days, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by eight hundred thirty-five (835) days of Applicant delay pursuant to 37 C.F.R. § 1.704(c)(3).

A Notice to File Missing Parts was mailed on October 16, 2001. Applicants failed to timely reply. Accordingly, the application became abandoned on December 17, 2001. A petition to revive was first filed on January 9, 2004, and was finally granted in a decision mailed on April 30, 2004.

In their application for patent term adjustment filed June 24, 2005, Applicants stated that the Office mailed a Withdrawal of Previously Sent Notice on July 29, 2004, indicating that the Notice of Abandonment mailed on November 10, 2003 was mailed in error. However, the application for patent term adjustment was dismissed in a decision mailed on September 1, 2005. The decision pointed out that a review of the application file failed to reveal the presence of a Withdrawal of Previously Sent Notice.

On renewed petition, applicants have supplied the Office with a copy of the July 29, 2004 Withdrawal of Previously Sent Notice. However, a further review of the record reveals that the Withdrawal of Previously Sent Notice was in fact mailed in error. The application was properly abandoned on December 17, 2001. The Notice to File Missing Parts mailed October 16, 2001 was properly mailed to the address of record (James A. Wilke, Foley & Lardner, Firstar Center, 777 East Wisconsin Avenue, Milwaukee, WI 53202-5367). A copy of the Notice is enclosed for petitioner's records.

Rather than file a petition to withdraw the holding of abandonment due to non-receipt of the Notice to File Missing Parts, applicants filed a petition to revive the application

---

[1] Applicant filed the application for patent term adjustment on the same date as the issue fee.

under 37 C.F.R. § 1.137(b) on January 9, 2004.[2] The petition was granted in a decision mailed on April 30, 2004. The decision revived the application under 37 C.F.R. § 1.137(b); it did not *sua sponte* withdraw the holding of abandonment.

37 C.F.R. § 1.704(c)(3) states:

> (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> (3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
>
> (i) **The date of mailing of the decision reviving the application** or accepting late payment of the issue fee; or
>
> (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed; (emphasis added)

Therefore, Applicant should have been assessed delay for the period from December 17, 2001 (the date the application became abandoned) to April 30, 2004 (the date of mailing of the decision reviving the application), or 865 days, not 835 days.

In view thereof, the correct determination of patent term adjustment is **zero (0) days** (643 days of PTO delay, reduced by 865 days of applicant delay).

---

[2] A petition to revive an abandoned application should not be confused with a petition to withdraw the holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, controlling dates, or applicant contends he did not receive an Office action), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g. the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 is necessary to revive the abandoned application.

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

Kery A. Fries

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

Enc: October 16, 2001 Notice to File Missing Parts (1 page)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVE
SUITE 3800
MILWAUKEE WI 53202-5308

COPY MAILED
APR 19 2006
OFFICE OF PETITIONS

In re
O'Connell, et al.
Application No. 09/954,677
Filed: September 15, 2001
Patent No. 6,957,908
Issued: October 25, 2005
Attorney Docket No. 061300-0242

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
: AND PETITION TO SUSPEND
: THE RULE UNDER
: 37 C.F.R. § 1.183

This letter is in response to the "SECOND REQUEST FOR RECONSIDERATION OF PREVIOUS APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) IN THE ALTERNATIVE: PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R § 1.183", filed January 31, 2006. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty-three (643) days. In the alternative, patentees request the suspension of 37 C.F.R. § 1.704(c)(3).

The application for patent term adjustment is **DISMISSED**.

Procedural History / Background:

On March 30, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On June 24, 2005, Applicants timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty-three (643) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of six hundred forty-three (643) days, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by eight hundred thirty-five (835) days of Applicant delay pursuant to 37 C.F.R. § 1.704(c)(3).

A Notice to File Missing Parts was mailed on October 16, 2001. Applicants failed to timely reply. Accordingly, the application became abandoned on December 17, 2001. A petition to revive was first filed on January 9, 2004, and was finally granted in a decision mailed on April 30, 2004.

In their application for patent term adjustment filed June 24, 2005, Applicants stated that the Office mailed a Withdrawal of Previously Sent Notice on July 29, 2004, indicating that the Notice of Abandonment mailed on November 10, 2003 was mailed in error. However, the application for patent term adjustment was dismissed in a decision mailed on September 1, 2005. The decision pointed out that a review of the application file failed to reveal the presence of a Withdrawal of Previously Sent Notice.

On renewed petition filed September 28, 2005, applicants supplied the Office with a copy of the July 29, 2004 Withdrawal of Previously Sent Notice. However, a further review of the record revealed that the Withdrawal of Previously Sent Notice was in fact mailed in error. The application was properly abandoned on December 17, 2001. The Notice to File Missing Parts mailed October 16, 2001 was properly mailed to the address of record

---

[1] Applicant filed the application for patent term adjustment on the same date as the issue fee.

(James A. Wilke, Foley & Lardner, Firstar Center, 777 East Wisconsin Avenue, Milwaukee, WI 53202-5367).

The Office mailed a decision dismissing applicants' renewed petition on December 2, 2006. The decision pointed out that rather than file a petition to withdraw the holding of abandonment due to non-receipt of the Notice to File Missing Parts, applicants filed a petition to revive the application under 37 C.F.R. § 1.137(b) on January 9, 2004.[2] The petition was granted in a decision mailed on April 30, 2004. The decision revived the application under 37 C.F.R. § 1.137(b); it did not *sua sponte* withdraw the holding of abandonment.

37 C.F.R. § 1.704(c)(3) states:

> (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> (3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
>
> (i) **The date of mailing of the decision reviving the application** or accepting late payment of the issue fee; or
>
> (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed; (emphasis added)

Therefore, the December 2, 2005 decision stated that applicants should have been assessed delay for the period from December 17, 2001 (the date the application became abandoned) to

---

[2] A petition to revive an abandoned application should not be confused with a petition to withdraw the holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, controlling dates, or applicant contends he did not receive an Office action), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g. the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 is necessary to revive the abandoned application.

April 30, 2004 (the date of mailing of the decision reviving the application), or 865 days, not 835 days. Accordingly, the decision held that the correct determination of patent term adjustment was **zero (0) days** (643 days of PTO delay, reduced by 865 days of applicant delay).

The Instant Request for Reconsideration:

Patentees assert that under MPEP 711.03(c)(II), a petition to revive an abandoned application or a petition to withdraw a holding of abandonment is an effective method of "overcoming abandonment" of an application when an Office action is not received by the applicant. In addition, patentees state that in this instance when they filed their grantable 37 C.F.R. § 1.137(b) petition, the "basis for overcoming abandonment" was that the Notice to File Missing Parts was not received by applicants. Lastly, patentees state they consulted with a USPTO employee on November 13, 2003, who suggested that the applicants filed a petition to revive the abandoned application. Patentees' arguments have been considered, but are not persuasive. After discussing the procedures for filing a petition to withdraw the holding of abandonment based upon failure to receive an Office action, MPEP 711.03(c)(II) states:

> Two additional procedures are available for **reviving** an application that has become abandoned due to **failure to reply to an Office Action**: (1) a petition under 37 CFR 1.137(a) based on unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.[3]

In fact, MPEP 711.03(c)(I) specifically states that where an applicant contends that the application is not in fact abandoned (for example, because applicant never received an Office action), "a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action." Accordingly, when an application becomes abandoned and the applicant contends that he never received the Office action, he should file a petition to withdraw the holding of abandonment, together with the required showing. "If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action."[4]

---

[3] Emphasis added.

[4] MPEP 711.03(c)(II).

However, if applicant can not provide the required showing of nonreceipt, then applicant may file a petition to revive the abandoned application. 37 C.F.R. § 1.137(b) requires no showing at all, merely "a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional". Accordingly, when patentees states that the "basis for overcoming abandonment" was that the Notice to File Missing Parts was not received, patentees are incorrect. The Office granted the 37 C.F.R. § 1.137(b) petition because applicants paid the petition fee, submitted the required reply, and made the proper statement of unintentional delay - **not** because applicants successfully demonstrated that they failed to receive the Notice to File Missing Parts.

Lastly, patentees state that they filed the 37 C.F.R. § 1.137(b) petition upon the suggestion of a USPTO employee. Patentees are directed to MPEP 711.03(c)(III)(C)(2), which cautions applicants not to rely upon oral advice from USPTO employees. See also 37 C.F.R. § 1.2.

Petition to Suspend 37 CFR 1.704(c)(3):

37 C.F.R. § 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 this section must be accompanied by the petition fee set forth in § 1.17(f).

Petitioner has not demonstrated that this is an extraordinary situation where justice requires waiver of the rules. The instant scenario is one that could have been avoided with the reasonable exercise of due care. Applicants chose to revive the application pursuant to 37 C.F.R. § 1.137(b), rather than demonstrate that they did not receive the Notice to File Missing Parts by filing a grantable petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181.

Effective December 8, 2004, the fee for a petition under 37 C.F.R. § 1.183 was increased to $400. See § 1.17(f).

Petitioner submitted $130. However, as petitioner included an authorization to charge any additional fees to his deposit account, $270 has been charged to Deposit Account No. 06-1447, as authorized.

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

Kery A Fries

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

UNITED STATES 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

STEPHEN D. SCANLON
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

COPY MAILED

JAN 2 8 2005

OFFICE OF PETITIONS

In re Application of
William H. Thesling, et al.
Application No. 09/954,698
Filed: September 11, 2001
Attorney Docket No. 74448/07215

ON PETITION

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed April 2, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned at midnight on July 2, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition and publication fees; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

In view of the submission of the petition and issue fee in the large entity amount of $1330.00, status as a small entity has been removed.

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

This application file is being forwarded to the Publishing Division for further processing.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEPHEN D. SCANLON
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND OH 44114

COPY MAILED

MAR 1 6 2005

OFFICE OF PETITIONS

In re Application of	:	
William H. Thesling et al	:	
Application No. 09/954,698	:	ON PETITION
Filed: September 11, 2001	:	
Attorney Docket No. 74448/07215	:	

This is a decision on the petition, filed March 15, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on August 12, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of petitions, the file will be forwarded to Technology Center AU 2133 to consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
09/954,719	09/17/2001	John R. Bair JR.	577288027US1	7605

25096 7590 03/25/2008
PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER
FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
2162	

MAIL DATE	DELIVERY MODE
03/25/2008	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Rajiv P. Sarathy
PERKINS COIE LLP
PATENT-SEA
P.O. Box 1247
Seattle, Washington 98111-1247

In re Application of:
BAIR et al.
Application No. 09/954,719
Filed: September 17, 2001
For: SEARCHING DOCUMENTS USING A DIMENSIONAL DATABASE

DECISION ON PETITION UNDER 37 C.F.R. § 1.181

This is a decision on the petition, filed on 24 September 2007, under 37 CFR § 1.181 to invoke the supervisory authority of the Director of the U.S. Patent and Trademark Office to (1) issue a Notice of Allowance and (2) refund fees paid in connection with a Notice of Appeal filed on 20 September 2007.

The petition is **GRANTED**.

A view of the application indicates that the outstanding rejection of claims 53-55 was mooted in view of the Amendment-after-Final submitted on 21 May 2007 by canceling these claims 53-55 and the pending claims 1-5, 27-35 and 50 were allowed in the Final action mailed on 20 March 2007. Thus, the mailing of Advisory action on 31 May 2007 was considered as improper.

Accordingly, the petition filed on 24 September 2007 is **GRANTED**. The Advisory action is hereby withdrawn. The filing of Notice of Appeal on 20 September 20 2007 was not necessary, and the fees associated with filing the Notice of Appeal and the three months extension of time (total of $1,520) is hereby refunded to the Deposit Account No. 50-0665.

The application is being forwarded to the examiner to issue an appropriate Office action.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

Vincent N. Trans, SPRE/QAS
Technology Center 2100
Computer Architecture, Software, and
Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
925 PAGE MILL ROAD
PALO ALTO CA 94304

COPY MAILED

JAN 19 2007

OFFICE OF PETITIONS

In re Application of	:	
Bron et al.	:	
Application No. 09/954,737	:	ON PETITION
Filed: September 17, 2001	:	
Attorney Docket No. GC634-2	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 4, 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 a Request for Continued Examination (RCE) and an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 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) 272-3206.

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

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED

JUN 2 8 2005

OFFICE OF PETITIONS

In re Application of	:	
Toan Trinh et al	:	
Application No. 09/954,772	:	ON PETITION
Filed: September 18, 2001	:	
Attorney Docket No. 6009RXD	:	

This is a decision on the petition under 37 CFR 1.137(b), filed February 4, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 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 October 9, 2003.

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

This matter is being referred to Technology Center AU 1751.

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

01192006

PETER MIKHAIL
1306 6th Avenue
San Francisco CA 94122

JAN 26 2006

In re Application of:
PETER G. MIKHAIL
Serial No.: 09/954,801
Filed: 18 September 2001
Title: LOCATION SENSING CAMERA

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed on December 14, 2004, to withdraw the holding of abandonment of the above-identified application under 37 C.F.R. § 1.181.

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

An Office action (final rejection) was mailed April 16, 2004, setting a three-month shortened statutory period for reply. In the absence of receipt of a response, the application became abandoned.

Petitioner states that he diligently checked his mail and he did not receive the previous Office action, which should have arrived over the summer. Petitioner further states that because he lives in San Francisco, but spent much of the summer in Washington, DC for a job related emergency, his mail was retrieved and routed to him, but he did not receive any correspondence from the Patent Office.

A review of the file 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 petitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the practitioner did not receive the Office action and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record 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 requirements for the copy of the docket record are set forth in M.P.E.P. § 711.03(c):

> 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.

Petitioner does not provide the required documentary evidence showing a record of all Office correspondence received throughout a time range in which the Office action mailed April 16, 2004 would reasonably have been expected to be received.

Since applicant has not made the requisite showing required under M.P.E.P §711.03(c), the holding of abandonment is proper.

Request for reconsideration of this decision must be submitted within 2 (two) months of the mailing date of this decision in order to be considered timely.

Any inquiry regarding this decision should be directed to Jose G. Dees, Special Program Examiner, at (571) 272-1569.

Arthur Grimley, Acting Director
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & 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

PETER MIKHAIL
1306 6TH AVENUE
SAN FRANCISCO, CA 94122

COPY MAILED

APR 25 2006

OFFICE OF PETITIONS

In re Application of :
Peter G. Mikhail :
Application No. 09/954,801 : ON PETITION
Filed: September 18, 2001 :
Title of Invention: LOCATION SENSING CAMERA :

This is a decision on the request for reconsideration filed March 24, 2006, under 37 CFR 1.181, to withdraw the holding of abandonment for the above-identified application.

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

The application was held abandoned on July 23, 2004, for failure to file a timely reply to the Final Office Action mailed April 22, 2004. A three month period for reply was set. Accordingly, a Notice of Abandonment was mailed on October 26, 2004. A petition filed December 14, 2004 was dismissed in a decision mailed January 26, 2006 because petitioner had not established a showing of non-receipt of the office action mailed April 16, 2004.

Comes now petitioner, a pro-se applicant with additional evidence which, while it is not tantamount to a formal docketing system, does show the procedures used for retrieving, handling and filing mail received from the USPTO.

In that the statement from the petitioner shows how he diligently handles mail from the USPTO and is indicative of non-receipt of the office action due to no fault of the petitioner, it is concluded that the Final Office Action was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and the Notice of Abandonment is vacated. No petition fee Is due and none has been charged.

The file is being forwarded to Technology Center 2851 for the re-mailing of the Final Office Action originally mailed on April 22, 2004. Telephone inquiries concerning the re-mailing of the Final Office Action should be referred to the Technology Center. All other inquiries regarding this decision 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 DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 2023

April 15, 2003

Gerald P. Joyce III
Agilent Technologies
Legal Department, DL425
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

In re application of:
Vahe Adamian DECISION ON PETITION
Serial No.: 09/954,809
Filed: September 18, 2001
For: METHOD AND APPARATUS FOR CALIBRATING A MULTIPORT TEST SYSTEM FOR MEASUREMENT OF A DUT

This is a decision on the petition received on October 3, 2002, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed October 22, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned December 26, 2001.

On October 23, 2002, the office received a communication from attorney of record. Enclosed was an acknowledgment that the attorney never received the Notice to File Missing Parts mailed October 22, 2001.

The evidence submitted is sufficient to establish that the petitioners never received the Notice to File Missing Parts mailed October 22, 2001.

The petition is hereby GRANTED.

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

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

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

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

LLOYD G. FARR
NELSON MULLINS RILEY & SCARBOROUGH LLP
P O BOX 11070
COLUMBIA SC 29211

COPY MAILED

JUL 1 7 2002

OFFICE OF PETITIONS

In re Application of	:
Robert O. Huff et al	:
Application No. 09/954,829	: DECISION ON PETITION
Filed: September 12, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 03752/09148CON5	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 2, 2002, 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). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;[1]

---

[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

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on September 12, 2001, and was pending at the time of filing of the instant petition. Further, copendency exists between the instant application and between each of the prior-filed nonprovisional applications noted in the amendment, for which a claim for benefit of priority is now being sought. A reference to each of the prior-filed applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(3).[2]

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). Also, the reference to the prior-filed applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted as of the date of filing the petition.

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

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

---

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).

[2] The amendment contains typographical errors in two of the application numbers; namely, "08/704,148" should read -- 08/704,418 -- and "07/449,772" should read -- 07/449,722 --. These corrections have been noted in the amendment.

This application is being forwarded to Technology Center Art Unit 3722 for appropriate action on the response to the Office action of December 28, 2001 and for processing and consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(3) for the benefit of priority to the prior-filed applications.

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

MAIL

JUL - 7 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 5

Kenneth F. Kozik
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

In re Application of:
PIKE et al..
Application No.: 09/954,872
Filed: September 18,, 2001
For:COMMUNICATION SYSTEM

DECISION ON REQUEST TO
WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw from Representation filed June 11, 2003.

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

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

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

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

for James R. Matthews

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 9

DEC 1 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

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

In re Application of
Melissa PIKE, et al
Application No. 09/954,872
Filed: September 18, 2001
For: COMMUNICATION SYSTEM

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed July 28, 2003.

A Revocation And Substitution Of Power Of Attorney Under 37 CFR § 1. 36 was filed on July 14, 2003. The Power Of Attorney revoked all prior Powers Of Attorney and appointed LAHIVE & COCKFIELD LLP as the attorneys of record of the instant application. The Power Of Attorney of July 14, 2003 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by LAHIVE & COCKFIELD LLP.

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

No further communication to you regarding this application will be made.

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

cc: Kevin J. Canning, Esq.
LAHIVE & COCKFIELD LLP
28 State Street
Boston, MA 02109

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

Robert C. Curfiss
Jackson Walker, LLP
112 E. Pecan, Suite 2100
San Antonio, TX 78205

COPY MAILED

JAN 07 2004

OFFICE OF PETITIONS

In re Application of :
Robert Billingsley :
Application No. 09/954,891 : ON PETITION
Filed: September 18, 2001 :
Attorney Docket No. 007102.00001 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 29, 2003, to revive the above-identified application.

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner to the Non-Final Office action mailed November 19, 2002. 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 January 20, 2003.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THORPE NORTH & WESTERN LLP
8180 SOUTH 700 EAST SUITE 200
SANDY UT 84070

COPY MAILED

MAR 2 0 2009

OFFICE OF PETITIONS

In re Application of	:	
Jie Zhang	:	
Application No. 09/954,904	:	DECISION ON PETITION
Filed: September 18, 2001	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 24055.CIP2	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 8, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional application No. 09/878,558.

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 Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy items (1) and (3) above.

With respect to item (1), Applicant has not submitted a separate amendment to the specification. Rather, the reference to application No. 09/878,558 was contained in the petition. Pursuant to 37 CFR 1.4(c), the amendment must be contained in a separate paper.

With respect to item (3), Applicant has not submitted a statement "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."

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or an amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are 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) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Petitions Attorney Cliff Congo at (571) 272-3207.

Anthony Knight
Supervisor
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

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

COPY MAILED

JUL 25 2002

OFFICE OF PETITIONS

In re Application of:
Harri Vatanen
Application No. 09/954,932
Filed: September 17, 2001
Title of Invention: METHOD AND APPARATUS FOR SECURE COMMUNICATION AND KEY DISTRIBUTION IN A TELECOMMUNICATION SYSTEM

DECISION GRANTING STATUS UNDER 37 CFR 1.47(b)

This is a decision on the Petition under 37 CFR 1.47(b), filed mAY 20, 2002, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application for patent on behalf of and as agent for the inventor.

The petition is **granted**.

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

Petitioner has demonstrated that the non-signing inventor refuses to sign the application. Specifically, Petitioner established that the nonsigning inventor, Harri Vatanen, refuses to sign the declaration after being presented with a copy of the above-identified application and declaration.

As provided in Rule 1.47(b), 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 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 8

STEVEN F. WEINSTOCK
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

COPY MAILED

NOV 2 1 2003

OFFICE OF PETITIONS

In re Application of :
Clark A. Briggs et al :
Application No. 09/954,936 : ON PETITION
Filed: September 18, 2001 :
Attorney Docket No. 6017.US.D1 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 10, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee/publication fee in a timely manner in reply to the Notice of Allowance mailed July 29, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on October 30, 2003.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of

agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Publishing Division.

Wan Laymon

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

cc: WOOD PHILLIPS KATZ MORTIMER & CLARK
500 WEST MADISON STREET, SUITE 3800
CHICAGO, IL 60662-2511

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

MAIL

MAR 2 4 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Bruce P. Bardes
7651 Cornell Road
Montgomery OH 45242

In re Application of
BEWLEY et al.
Application No. 09/954,946
Filed: September 18, 2001
For: **APPARATUS AND METHOD FOR THREE-DIMENSIONAL SCANNING OF A SUBJECT, FABRICATION OF A NATURAL COLOR MODEL THEREFROM, AND THE MODEL PRODUCED THEREBY**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on January 21, 2004.

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

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Attorneys/agents listed in the Request 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 to TC 2600 central files to await action in due course.

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

cc: Wilbur C. Bewley, Jr.
211 Savannah Street
Nicholasville, Kentucky 40356

UNITED STATES 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

MAR 02 2009

OFFICE OF PETITIONS

In re Patent No. 6,961,565 :
Issue Date: September 18, 2001 :
Application No. 09/954,956 : ON PETITION
Filed: September 18, 2001 :
Attorney Docket Number: 15689.79 :

This is a decision on the petition, filed April 11, 2008, under 37 CFR 1.182, requesting the issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

Since it is U.S. Patent and Trademark Office practice to assure mailing of all papers on the date indicated, there is a strong presumption that papers duly addressed and indicated as mailed, such as the Letters Patent in this application, are timely delivered to the addressee. To overcome this presumption, a verified statement with supporting evidence, such as any records which would disclose the receipt of other correspondence mailed from the U.S. Patent and Trademark Office on or about September 18, 2001, but fail to disclose receipt of the Letters Patent mailed on that date, should be promptly submitted. Further, copies of records on which receipt of the Letters Patent would have been entered had it been received are required.

However, if the loss of the Letters Patent was not the fault of the U.S. Patent and Trademark Office or if petitioner simply wishes to avoid overcoming the above-noted presumption, a petition may be filed under 37 CFR 1.182 accompanied by a petition fee of $400.00 requesting a duplicate Letters Patent. Upon receipt of the petition and petition fee, the request for a duplicate Letters Patent will be granted.

As the petition fee of $400.00 has been received, the petition is granted.

A copy of this decision is being forwarded to Office of Data Management for issuance of a duplicate Letters Patent.

The Office of Data Management is directed to issue a duplicate Letters Patent.

Telephone inquiries concerning this decision may be directed to the undersigned Senior Petitions Attorney at (571) 272-3212. Inquiries regarding the issuance of a duplicate Letters Patent may be directed to the Office of Data Management at (703) 308-9250.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc: Niomi Farmer (Fax – (571) 270-9753)

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)
6,516,061	2003-02-04	09/954,958	2001-09-18	076322-0010

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	/Atabak R Royaee/	Date (YYYY-MM-DD)	2007-04-26
Name	Atabak R. Royaee	Registration Number	59037

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. 6516061
Issue Date: February 4,2003
Application No. 09954958
Filed: September 18,2001
Attorney Docket No. 55152-034 (MCK-001)

:

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

:

This is a decision on the electronic petition, filed April 26,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 26,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

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

COPY MAILED

JUL 21 2006

OFFICE OF PETITIONS

In re Application of
Kazuo Shiota et al.
Application No. 09/954,964
Filed: September 19, 2001
Attorney Docket Number: 2091-0245P
Title: NETWORK PHOTOGRAPH SERVICE SYSTEM

DECISION ON PETITION
UNDER 37 C.F.R. §1.181(A)

This is a decision on the petition under 37 CFR §1.181(a), filed April 10, 2006, to withdraw the holding of abandonment.

Background

The above-identified application became abandoned for failure to file a proper response to the Requirement for Information, mailed July 15, 2005, which set a shortened statutory period to reply for two months. No extensions of time under the provisions of 37 C.F.R 1.136(a) were received. Accordingly, the above-identified application became abandoned on September 16, 2005. A Notice of abandonment was mailed on February 13, 2006.

With the present petition pursuant to 37 C.F.R. §1.181(a), Petitioner has alleged that no response was submitted, because Applicant did not believe that a response was required. A discussion follows.

The Relevant Law, Regulations, and Portion of the MPEP

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.

37 C.F.R. § 1.105 Requirements for information

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search: Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(3) revised and paras. (a)(1)(viii) and (a)(4) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

<u>§ 1.135: Abandonment for failure to reply within time period</u>.

(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]

MPEP §502.03(V): Interviews.

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

Analysis

With the present petition, Petitioner has asserted that he received the request for information, and was informed by the Examiner's supervisor that the applicants were "not required to file a reply to the Office Action dated July 15, 2005," as the "Examiner should be mailing a new Office Action for the subject application[1]." Petitioner then sent an e-mail to the supervisor, the relevant portion of which is reproduced below:

> To memorialize our recent phone conversation, it is our understanding that the USPTO will be mailing out a new office action in place of the Rule 105 Request for Information dated July 15, 2002. Therefore, our client does not need to Reply to the July 15, 2005 Request. It is also our understanding that we will be receiving a fax within the next week or so to further confirm the status of this case.

The Supervisor then sent a one word response: "confirmed."

Petitioner thus asserts that the Office improperly held the present application to be abandoned, as there was no need to file a response to the Request for Information.

The Office Petitioner's assertion is incorrect, for the following reasons.

First, regarding the e-mail which petitioner sent to the Supervisor of the Examiner, The Office cannot view this electronic communication as an acceptable method of exchanging information similar to a telephone or personal interview: the electronic file does not appear to contain a written authorization under Patent Internet Usage Policy Article 5 to use Internet e-mail, as required by MPEP §502.03(V). As such, Petitioner's communication with the Supervisor of the Examiner lies outside of the official channels of communication.

---

1 Petition, page 1.

Secondly, *assuming arguendo* that the e-mail can be accepted and that it constitutes both a waiver by the Supervisor of Petitioner's need to respond to the Office action and a guarantee that a new Office action would be forthcoming, this still would not bring about the withdrawal of the holding of abandonment. The record has been reviewed, and it does not appear that the Request for Information of July 15, 2005 was ever withdrawn by the Office. The e-mail response from the Supervisor of the Examiner cannot serve to waive Petitioner's obligation to submit a response to the Request for Information, for the following reasons.

35 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 a Request for Information which set a two-month period for response, and did not continue the prosecution of this application via the submission of a response. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment. Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but the Office does not have the authority to waive 35 U.S.C. §133. The power to waive or suspend the requirements of a statute is beyond the discretion or the authority of the Office[2].

Similarly, 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 an acceptable reply was not submitted in response to the Request for Information. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment. Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but a rule cannot

---

2 See A. F. Stoddard & Co. v. Dann, 184 U.S. App. D.C. 71, 564 F.2d 556, 1977 U.S. App. LEXIS 11815, 195 U.S.P.Q. (BNA) 97 (1977) ("Executive Branch agencies, such as the PTO, having the obligation to carry out their duties under their authorizing statutes, and if they would avoid an exercise of the powers of another Branch, must in almost every case, follow the strict provisions of the applicable statute.").

be waived via the sending of an e-mail. The waiver of a rule is accomplished via obtaining a decision which grants a petition under 37 C.F.R. §183, and it does not appear that such a petition was ever filed.

CONCLUSION

For the reasons discussed above, the petition under 37 C.F.R. §1.181 must be **DISMISSED**.

Petitioner's only relief is a petition under 37 C.F.R. §§1.137(a) and or (b), and - having been made aware of this reality - Petitioner's delay in promptly seeking relief under 37 C.F.R. §1.137 may be considered evidence of intentional delay and an absolute bar to revival.

NOTICE:

Any renewed petition under 37 C.F.R. §1.181 must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The renewed petition 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[3, 4].

---

[3] 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.

4 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.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[5], hand-delivery[6], or facsimile[7].

ALTERNATE VENUE

Petitioner may also wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b).

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

5 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
6 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
7 (571) 273-8300- please note this is a central facsimile number.

UNITED STATES 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

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

COPY MAILED

JAN 19 2007

OFFICE OF PETITIONS

In re Application of
Kazuo Shiota et al.
Application No. 09/954,964
Filed: September 19, 2001
Attorney Docket Number: 2091-0245P
Title: NETWORK PHOTOGRAPH SERVICE SYSTEM

DECISION ON RENEWED PETITION UNDER 37 C.F.R. §1.181(A)

This is a decision on the renewed petition under 37 C.F.R. §1.181(a), filed August 15, 2006, to withdraw the holding of abandonment and/or revive the present application.

The renewed petition pursuant to 37 C.F.R. §1.181 is **DENIED**[1].

Background

The above-identified application became abandoned for failure to file a proper response to the Requirement for Information, mailed July 15, 2005, which set a shortened statutory period to reply for two months. No extensions of time under the provisions of 37 C.F.R 1.136(a) were received. Accordingly, the above-identified application became abandoned on September 16, 2005. A Notice of abandonment was mailed on February 13, 2006.

With the original petition pursuant to 37 C.F.R. §1.181(a), Petitioner has alleged that no response was submitted, because Applicant did not believe that a response was required.

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.

Procedural History

The original petition under 37 C.F.R. §1.181(a) was filed on April 10, 2006, and was dismissed via the mailing of a decision on July 21, 2006.

The Relevant Law, Regulations, and Portion of the MPEP

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.

37 C.F.R. § 1.105 Requirements for information

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search: Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(3) revised and paras. (a)(1)(viii) and (a)(4) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

<u>§ 1.135: Abandonment for failure to reply within time period</u>.

(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]

MPEP §502.03(V): Interviews.

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

ANALYSIS

With the original petition, Petitioner asserted that he received the request for information, and was informed by the Examiner's supervisor that the applicants were "not required to file a reply to the Office Action dated July 15, 2005," as the "Examiner should be mailing a new Office Action for the subject application[2]." Petitioner then sent an e-mail to the supervisor, the relevant portion of which is reproduced below:

> To memorialize our recent phone conversation, it is our understanding that the USPTO will be mailing out a new office action in place of the Rule 105 Request for Information dated July 15, 2002. Therefore, our client does not need to Reply to the July 15, 2005 Request. It is also our understanding that we will be receiving a fax within the next week or so to further confirm the status of this case.

The Supervisor then sent a one-word response: "confirmed."

Petitioner asserted that the Office improperly held the present application to be abandoned, as there was no need to file a response to the Request for Information.

2 Original petition, page 1.

The decision on the original petition indicated that the electronic file does not appear to contain a written authorization under Patent Internet Usage Policy Article 5 to use Internet e-mail, as required by MPEP §502.03(V), and therefore, Petitioner's communication with the Supervisor of the Examiner lies outside of the official channels of communication. It does not appear that this point has been addressed on renewed petition.

The decision on the original petition further indicated that the e-mail cannot constitute a waiver by the Supervisor of Petitioner's need to respond to the Office action. On renewed petition, Petitioner has explained that he did not submit a copy of the e-mail in order to seek a waiver, but rather to submit evidence that the Office action had been issued in error.

Even if the Office action was issued in error, this does not change the fact that Petitioner had an obligation to submit a written response pursuant to 35 U.S.C. §133 and 37 C.F.R. §1.135.

The decision on the original petition indicated that the application went abandoned by the operation of law, pursuant to 35 U.S.C. §133 and 37 C.F.R. §1.135. It does not appear that this point has been addressed on renewed petition.

As set forth in the decision on the original petition:

> 35 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 a Request for Information which set a two-month period for response, and did not continue the prosecution of this application via the submission of a response. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment. Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but the Office does not have the authority to waive 35 U.S.C. §133. The power to waive or suspend the requirements of a statute is beyond the discretion or the authority of the Office[3].

Neither the Examiner, his supervisor, nor any member of the Office of Petitions has the authority to waive 35 U.S.C. §133.

---

3 See A. F. Stoddard & Co. v. Dann, 184 U.S. App. D.C. 71, 564 F.2d 556, 1977 U.S. App. LEXIS 11815, 195 U.S.P.Q. (BNA) 97 (1977) ("Executive Branch agencies, such as the PTO, having the obligation to carry out their duties under their authorizing statutes, and if they would avoid an exercise of the powers of another Branch, must in almost every case, follow the strict provisions of the applicable statute.").

Petitioner received an Office action which set a period for response, the Office action was never withdrawn by the Office, and no response was ever filed. As such, the application went abandoned for failure to respond to said Office action.

CONCLUSION

The prior decision which refused to withdraw the holding of abandonment for the above-identified application has been reconsidered. Pursuant to the discussion above, the holding of abandonment will not be withdrawn.

No further reconsideration or review of this matter will be undertaken.

The alternate petitions under 37 C.F.R. §§1.137(a) and/or (b) have not been considered and the petition fees have not been charged to Petitioner's Deposit Account. Petitioner will note that each of these petitions requires the submission of a reply to the outstanding Office action, and it does not appear that Petitioner has submitted the same. Therefore, were they to be considered at the present time, they would merely be dismissed and $2,000 would be charged to Petitioner's Deposit Account.

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

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

Paper No. None

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

COPY MAILED
FEB 21 2007
OFFICE OF PETITIONS

In re Application of Kazuo Shiota et al. Application No. 09/954,964 Filed: September 19, 2001 Attorney Docket Number: 2091-0245P Title: NETWORK PHOTOGRAPH SERVICE SYSTEM	DECISION ON PETITION UNDER 37 C.F.R. §1.137(A)

This is a decision on the petition pursuant to 37 C.F.R. §1.137(a)[1], to revive the above-identified application, filed on February 5, 2007.

The above-identified application became abandoned for failure to file a proper response to the Requirement for Information, mailed July 15, 2005, which set a shortened statutory period to reply for two months. No extensions of time under the provisions of 37 C.F.R 1.136(a) were received. Accordingly, the above-identified application became abandoned on September 16, 2005. A Notice of abandonment was mailed on February 13, 2006.

A petition pursuant to 37 C.F.R. §1.181(a) was submitted on April 10, 2006, which was dismissed via the mailing of a decision on July 21, 2006. A renewed petition was filed on

1 A grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:

(1) the required reply;
(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.

August 15, 2006, which was denied via the mailing of a decision on January 19, 2007.

With the present petition, Petitioner has submitted the petition fee, a reply pursuant to 37 C.F.R. §1.105, and a showing to the satisfaction of the Commissioner that the entire delay was unavoidable. A terminal disclaimer is not required.

Petitioner has also submitted a three-month extension of time. An extension of time under 37 C.F.R. §1.136 must be filed prior to the expiration of the maximum extendable period for reply[2]. Accordingly, since the $1020 extension of time submitted with the petition on February 5, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to Petitioner's deposit account.

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

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the reply that was received with the present petition can be processed.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[3]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

2 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).
3 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED
OCT 07 2008
OFFICE OF PETITIONS

In re Application of

Shiota, et al.

Application No. 09/954,964

Filed: September 19, 2001

Attorney Docket No. 2091-0245P

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed September 12, 2008.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

This application was held abandoned on February 15, 2008, after it was believed that no response was received to the restriction/election requirement mailed January 14, 2008. The notice allowed a shortened period for reply of one (1) month from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on July 28, 2008, indicating that a reply to the election/restriction requirement was not received.

Petitioner states that a response to the election/restriction requirement was filed on July 14, 2008, with a request for an extension of time within the fifth month. A review of the application file reveals that a response was filed on July 14, 2008, with a request for an extension of time within the fifth month[1]. Based on the aforementioned, it appears that the application was improperly held abandoned as a proper response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

Further inquires regarding this decision may be directed to the undersigned at (571) 272-3222.

The application file is being forwarded Technology Center 3600, GAU 3696 for further processing including review of the response filed July 14, 2008.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

[1] It is noted that the period for reply to the restriction/election requirement is not set by statute. Pursuant to 37 CFR 1.136, the period for response to a restriction/election requirement is extendable five additional months, accordingly.

UNITED STATES 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

MELVIN K. SILVERMAN
SUITE 500
500 WEST CYPRESS CREEK ROAD
FORT LAUDERDALE FL 33309

COPY MAILED

DEC 3 0 2003

OFFICE OF PETITIONS

In re Application of Montoya Application No. 09/954,970 Filed: September 19, 2001 Attorney Docket No. 1187.07 For: DUAL PIZZA PIE CONTAINER SYSTEM	DECISION DISMISSING PETITION TO WITHDRAW OF HOLDING OF ABANDONMENT

This is a decision on the paper entitled, "RESPONSE TO NOTICE OF ABANDONMENT," filed December 9, 2003. The paper will be treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to timely submit a reply to the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001, which required petitioner to submit the statutory basic filing fee, a late filing fee, and an abstract.

The Office contended that the application became abandoned on December 20, 2001 because the Office claimed it did not receive a reply. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner asserts that a timely response to the October 19, 2001 Notice to File Missing Parts was deposited as first class mail on February 19, 2002. Petitioner has provided a copy of the original cover letter which states that a check in the amount of $615, comprising a two month extension of time, a small entity basic filing fee, and a small entity late filing fee surcharge was enclosed. The cover letter has a valid certificate of mailing dated February 19, 2002 affixed thereto. In addition, petitioner has provided a copy of petitioner's itemized postcard receipt showing an Office of Initial Patent Examination stamp citing March 6, 2002 as the date of receipt. The postcard lists that the filing included a copy of the October 19, 2001 Notice, a small entity declaration, and check no. 3685 for $615.

The return postcard constitutes *prima facie* evidence that the check was mailed on certificate of mailing date February 19, 2002 and received in the Office on March 6, 2002. MPEP 503. A review of the application file reveals the original cover letter is present and Office financial records show that the check for $615 was negotiated. Thus, the Office did receive a timely reply and The Notice of Abandonment was incorrect to state that no reply was received.

Unfortunately, petitioner did not submit a **complete** reply. The October 19, 2001 Notice to File Missing Parts required petitioner to timely submit fees and ***an abstract*** to avoid abandonment. The Office did not receive an abstract and there is no mention of an abstract on the March 6, 2002

postcard receipt.

Therefore, the application became abandoned on February 20, 2002 for failure to submit an abstract within the 2 month extended period for reply.

Accordingly, the petition is **DISMISSED**.

Petitioner must file a petition to revive under 37 CFR 1.137(a) or (b) and pay the proper petition fee. Unless petitioner can demonstrate that petitioner was "unavoidably" prevented from submitting a proper reply to the October 19, 2001 Notice, a petition under 37 CFR 1.137(b) is suggested.

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
ATTN: E. Shirene Willis

By hand: Crystal Plaza 1 Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202
ATTN: E. Shirene Willis

By FAX: (703) 872-9306
ATTN: Office of Petitions -- E. Shirene Willis

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

MELVIN K. SILVERMAN
SUITE 500
500 WEST CYPRESS CREEK ROAD
FORT LAUDERDALE FL 33309

COPY MAILED

JAN 3 0 2004

OFFICE OF PETITIONS

In re Application of
Montoya
Application No. 09/954,970
Filed: September 19, 2001
Attorney Docket No. 1187.07
For: DUAL PIZZA PIE CONTAINER SYSTEM

DECISION DISMISSING PETITION UNDER 37 CFR 1.137(a)

This is a decision on the petition under 37 CFR 1.137(a), filed January 13, 2004, to revive the above-identified application.[1]

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

This application was held abandoned for failure to timely submit a reply to the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001, which required petitioner to submit the statutory basic filing fee, a late filing fee, and an abstract. The Office contended that the application became abandoned on December 20, 2001 because the Office claimed it did not receive a reply. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner asserts that a timely response to the October 19, 2001 Notice to File Missing Parts was deposited as first class mail on February 19, 2002. Petitioner has provided a copy of the original cover letter which states that a check in the amount of $615, comprising a two month extension of time, a small entity basic filing fee, and a small entity late filing fee surcharge was enclosed. The copy of the cover letter has a valid certificate of mailing dated February 19, 2002 affixed thereto.A review of the application file reveals the original cover letter is present and Office financial records show that the check for $615 was negotiated. Thus, the Office did receive a timely reply and The Notice of Abandonment was incorrect to state that no reply was received.

Unfortunately, petitioner did not submit a **complete** reply. The October 19, 2001 Notice to File Missing Parts required petitioner to timely submit fees and ***an abstract*** to avoid abandonment. The Office did not receive an abstract and there is no mention of an abstract on the March 6, 2002 postcard receipt.

Therefore, the application became abandoned on February 20, 2002 for failure to submit an abstract within the 2 month extended period for reply.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application

[1] Pursuant to petitioner's authorization, deposit account no. 50-2557 will be charged a $55.00 petition fee.

abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable.
While petitioner asserts that an abstract has been in this file for many years, the Office has no record of receiving an abstract until January 2004.

The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. Petitioner was provided notice that an abstract was not part of the application papers filed on September 19, 2001 in the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001. Petitioner was required to provide an abstract within an extendable two month period from October 19, 2001 to avoid abandonment. Petitioner did not do so. The fact that the Office did not respond to petitioner's incomplete reply does not alter the time period running against petitioner to submit an abstract. The requirement was set in the October 19, 2001 Notice and the time period for response, once properly set, would not have been reset.

The only way petitioner can prevail under an unavoidable standard is if petitioner proves that an abstract was filed upon initial filing or at latest, by February 19, 2002. If petitioner can provide an itemized Office date stamped return receipt postcard that lists "abstract" as one of the papers filed on September 19, 2001 OR any evidence that an abstract was submitted by February 19, 2002, then the petition under 37 CFR 1.137(a) will be granted.

If petitioner cannot prove that an abstract was filed upon initial filing or at latest, by February 19, 2002, then petitioner's only option to revive will be under the unintentional standard of 37 CFR 1.137(b). The current fee associated with the filing of a petition under 37 CFR 1.137(b) is $665.00. For petitioner's convenience, a blank copy of Form PTO/SB/64: Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) is enclosed. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450
ATTN: E. Shirene Willis

By hand: Crystal Plaza 1 Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202
ATTN: E. Shirene Willis

By FAX: (703) 872-9306
ATTN: Office of Petitions -- E. Shirene Willis

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

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

enclosure: blank copy of Form PTO/SB/64: Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(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. 13

MELVIN K. SILVERMAN
SUITE 500
500 WEST CYPRESS CREEK ROAD
FORT LAUDERDALE FL 33309

COPY MAILED

MAR 1 6 2004

OFFICE OF PETITIONS

In re Application of Montoya Application No. 09/954,970 Filed: September 19, 2001 Attorney Docket No. 1187.07 For: DUAL PIZZA PIE CONTAINER SYSTEM	DECISION GRANTING PETITION UNDER 37 CFR 1.137(a)

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

This application was held abandoned for failure to timely submit a reply to the Notice to File Missing Parts of Nonprovisional Application, mailed October 19, 2001, which required petitioner to submit the statutory basic filing fee, a late filing fee, and an abstract within an extendable two month period for reply. Petitioner purchased a two month extension of time and submitted the required the filing fees. Unfortunately, petitioner did not submit an abstract within the extended period for reply. Therefore, the application became abandoned on February 20, 2002. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner has submitted a reply in the form of an abstract commencing on a separate page, an acceptable statement of the unintentional nature of the delay in responding to the October 19, 2001 Notice, and the petition fee.[1]

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

After the mailing of this decision the application will be returned to the Office of Initial Patent Examination for further processing.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

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

[1] Pursuant to petitioner's authorization, deposit account no. 50-2557 was charged a $665.00 petition fee on February 17, 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

OCT - 8 2003

#9

MCHALE & SLAVIN, P.A.
2855 PGA BLVD
PALM BEACH GARDENS FL 33410

In re Application of	:
George Jackowski	:
Serial No.: 09/954,972	: PETITION TO MAKE SPECIAL
Filed: September 17, 2001	:
Attorney Docket No.: 2132.074	:

This is in response to applicants' petition filed July 30, 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, XII. Therefor the petition is **GRANTED**.

The petition fee of $130.00 will be charged toa pplicant's Deposit Account No. 50-1803, as directed.

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, PO BOX 1450, ALEXANDRIA, VA 22313-1450, 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
Washington, D.C. 20231
www.uspto.gov

Paper No. 9

THOMPSON & KNIGHT LLP
PATENT PROSECUTION DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1200
AUSTIN TX 78701

COPY MAILED

JUL 1 2 2002

OFFICE OF PETITIONS

In re Application of
Surendra N. Naidoo et al
Application No. 09/954,976
Filed: September 18, 2001
Attorney Docket No. 4017-03001

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(f)

This is a decision on the petition, filed June 25, 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 May 7, 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 October 10, 2002 accompanies this decision on petition.

The "General Power of Attorney" filed concurrently with the instant petition is not acceptable since compliance with 37 CFR 3.73(b) has not been satisfied. See the attached blank Certificate under 37 CFR 3.73(b). In view of the nonentry of the power of attorney, future correspondence will be directed to the address of record until such time as the proper power of attorney documentation is submitted. A courtesy copy of this decision is being mailed to the petitioner herein.

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 2613 for examination in due course.

Frances Hicks

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

ATTACHMENTS: Corrected Filing Receipt
Blank Certificate under 37 CFR 3.73(b)

cc:

Conley Rose & Tayon PC
5700 Granite Parkway, Suite 330
Plano TX 75024

UNITED STATES 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

HANSRA PATENT SERVICES
4525 GLEN MEADOWS PLACE
BELLINGHAM, WA 98226

COPY MAILED

JUL 2 1 2005

OFFICE OF PETITIONS

In re Application of :
Bruce Liikanen, et al. :
Application No. 09/954,997 :
Filed: September 17, 2001 :
Attorney Docket No. 3123-376 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 17, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 17, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned at midnight on May 18, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137 (b) in that (1) the reply in the form of an Amendment; (2) the petition fee; (3) the required statement of unintentional delay have been received. Accordingly, the petition filed March 17, 2005 is accepted as having been unintentionally delayed.

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

The application file is being forwarded to Technology Center 2600, Art Unit 2651 for further processing.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper 5

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

COPY MAILED

FEB 1 5 2002

OFFICE OF PETITIONS

In re Application of
Atsushi Hozumi et al.
Application No. 09/955,074
Filed: September 19, 2001
Attorney Docket No. 214010US0

DECISION GRANTING PETITION

This is a decision on the petition filed December 21, 2001, under 37 CFR 1.182, which is treated under 37 CFR 1.53, in response to the "Notice of Omitted Items" mailed October 25, 2001.

The instant application was filed September 19, 2001 and a filing date was accorded. However, according to the Notice of Omitted Items, the application papers submitted did not include figure 3.

Petitioner asserts, in essence, that three sheets of drawings (figures 1-3) were among the papers filed on September 19, 2001, and submits a postcard receipt in evidence thereof. The postcard receipt, identifies the application and acknowledges, inter alia, the number of drawing sheets to be 3 and bears a United States Patent and Trademark Office date-stamp of September 19, 2001. Further, the postcard receipt lacks any notation of non-receipt of any item listed.

In view of the foregoing, the petition is **Granted.**

Given the basis for granting the petition, no petition fee is due and therein, petitioner's deposit account no. 15-0030 will be credited in the amount of $130.00.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing, using the application papers received in the Office on September 19, 2001 and the three sheets of drawings (figures 1-3) resubmitted on petition.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Patricia Faison-Ball at (703) 305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan

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

07/28/03 14:00 P.002/002

OIPE JC177
NOV 2 6 2003
PATENT & TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. ____

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

COPY MAILED

JUL 2 8 2003

OFFICE OF PETITIONS

In re Application of
Yoshinobu Honkura et al
Application No. 09/955,078
Filed: September 19, 2001
Attorney Docket No. 213712USO

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

This is a decision on the petition, filed by facsimile transmission on July 28, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 27, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 1742 for processing of the request for continued examination under 37 CFR 1.114.

Frances Hicks

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

---

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

COPY

RECEIVED: 7/28/03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: B 7/29/03
Type of Resp(s): ____
Due Date(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

Date : October 16, 2007

Patent No. :7,248,782
Inventor(s) :Eiji KASUTANI
Issue :July 24, 2007
Title :IMAGE RETRIEVING APPARATUS, IMAGE RETRIEVINGMETHOD
:AND RECORDING MEDIUM FOR RECORDING PROGRAM TO
:IMPLEMENT MEDIUM FOR RECORDING PROGRAM TO IMPLEMENT
:THE IMAGE RETRIEVING METHOD

Docket No :040373-0309

Review of the application file has revealed the omission of the Foreign Priority data on the printed patent as a result of applicant's failure to fully comply with 35 U.S.C. 119, in that conditional requirements were not met. Applicant's attention is directed to MPEP 201.14(a), 37 CFR 1.17(i).

In view of the forgoing, applicant's request in this matter is hereby denied.

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308- 9380 ext. 123

Washington Harbour
3000 K Street NW
Ste 500
Washington, DC 20007-5143

CBN/arg

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ANDREW C. AITKEN
VENABLE
POST OFFICE BOX 34385
WASHINGTON DC 20043-9998

COPY MAILED

SEP 0 1 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Koji Okamoto et al :
Application No. 09/955,155 :
Filed: September 19, 2001 :
Attorney Docket No. 36748-175097 :

This is a decision on the petition, filed August 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 June 2, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2839 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

NIXON PEABODY LLP
P.O. BOX 60610
PALO ALTO CA 94306

MAILED

JAN 26 2010

OFFICE OF PETITIONS

In re Application of	:	
Koji Miyajima et al	:	
Application No. 09/955,180	:	DECISION GRANTING PETITION
Filed: September 19, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 434620-096	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 22, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on December 14, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application is being referred to Technology Center AU 2424 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/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 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

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON DC 20036

COPY MAILED

JUL 27 2007

OFFICE OF PETITIONS

In re Application of :
Hiroto Hirakoso :
Application No. 09/955,196 :
Filed: September 19, 2001 :
Attorney Docket No. SON-2213 :

ON PETITION

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

The petition is **DISMISSED** as moot.

A review of the record discloses that the amendment filed on March 5, 2007 was timely filed in response to the non-final rejection mailed December 4, 2007. A further review of the record indicates that the application was not abandoned at the time of filing the petition under 37 CFR 1.137(b).

In view of the above, the petition under 37 CFR 1.137(b) is unnecessary and the $1500 petition fee that was paid on March 5, 2007 will be refunded to the petitioner's deposit account.

The application is being referred back to Technology Center Art Unit 2624 for prosecution in due course.

Telephone inquiries concerning this decision should be directed to the April Wise at (571) 272-1642. Telephone inquires related to further prosecution should be directed to the Technology Center.

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

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3800

COPY MAILED
APR 2 0 2006
OFFICE OF PETITIONS

In re Patent No. 6,980,238 B2	:	DECISION ON
Masanori Kawashima	:	PATENT TERM ADJUSTMENT
Issue Date: December 27, 2005	:	AND NOTICE OF INTENT
Application No. 09/955,206	:	TO ISSUE
Filed: September 19, 2001	:	CERTIFICATE OF
Attorney Docket No. 03500.011186.1	:	CORRECTION

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(D)", filed February 22, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from six hundred seventy-six (676) days to seven hundred ninety-six (796) days.

The petition is **GRANTED**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **seven hundred ninety-six (796)** days.

On December 27, 2005, the above-identified application matured into U.S. Patent No. 6,980,238. The instant request for reconsideration filed February 22, 2006 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 six hundred seventy-six (676) days.

Patentee states that the patent is not subject to a terminal disclaimer.

Patentee asserts that he should not have been assessed applicant delay of one hundred twenty (120) days for the submission of a "STATEMENT OF SUBSTANCE OF INTERVIEW".

The "STATEMENT OF SUBSTANCE OF INTERVIEW" is not identified as one of the papers the filing of which the Director has specifically deemed not to be a failure to engage in reasonable efforts under 37 C.F.R. §1.704(c)(10).[1] Nevertheless, under the circumstances of this case, it is concluded that the filing of applicant's "STATEMENT OF SUBSTANCE OF INTERVIEW" is not a failure to engage under 37 C.F.R. §1.704(c)(10). Accordingly, the assessment of one hundred twenty (120) days of applicant delay with respect to this filing is not warranted.

In view thereof, the correct determination of PTA at the time of issuance is seven hundred ninety-six (796) days (796 days of PTO delay and 0 days of applicant delay).

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **seven hundred ninety-six (796)** days subject to any disclaimers.

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

Kery A. Fries

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

Enc: draft certificate of correction

---

[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

CERTIFICATE OF CORRECTION

PATENT : 6,980,238 B2

DATED : December 27, 2005

INVENTOR(S) : Masanori Kawashima

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 (676) days

Delete the phrase "by 676 days" and insert – by 796 days—

Day : Wednesday

PALM INTRANET

Date: 4/19/2006
Time: 11:42:15

PTA Calculations for Application: 09/955206			
Application Filing Date:	09/19/2001	PTO Delay (PTO):	796
Issue Date of Patent:	12/27/2005	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	120
Post-Issue Petitions:	0	Total PTA (days):	796
PTO Delay Adjustment:	120		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
39	04/19/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	120		
35.5	12/07/2005	PTA 36 MONTHS			
35	12/27/2005	PATENT ISSUE DATE USED IN PTA CALCULATION	82		28
34	11/02/2005	EXPORT TO FINAL DATA CAPTURE			
33	11/01/2005	DISPATCH TO FDC			
32	05/26/2005	MISCELLANEOUS INCOMING LETTER		120	
31	09/30/2005	FINISHED INITIAL DATA CAPTURE			
30	05/26/2005	RESPONSE TO REASONS FOR ALLOWANCE			
29	08/16/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
28	06/06/2005	ISSUE FEE PAYMENT VERIFIED			
27	07/05/2005	EXPORT TO INITIAL DATA CAPTURE			
26	06/06/2005	ISSUE FEE PAYMENT RECEIVED			
25	05/11/2005	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
24	05/10/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
23	05/09/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
21	04/20/2005	MAIL NOTICE OF ALLOWANCE			
20	04/18/2005	ISSUE REVISION COMPLETED			
19	04/18/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
18	04/18/2005	NOTICE OF ALLOWABILITY			
17	04/08/2005	DATE FORWARDED TO EXAMINER			
16	02/02/2005	RESPONSE AFTER NON-FINAL ACTION			
15	02/02/2005	WORKFLOW INCOMING AMENDMENT IFW			

14	11/02/2004	MAIL NON-FINAL REJECTION	714		-1
13	11/01/2004	NON-FINAL REJECTION			
12	08/26/2004	CASE DOCKETED TO EXAMINER IN GAU			
11	08/24/2004	CASE DOCKETED TO EXAMINER IN GAU			
10	08/16/2004	CLAIMS PTO			
9	08/16/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
8	09/19/2001	REFERENCE CAPTURE ON IDS			
7	09/19/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
6	09/19/2001	PRELIMINARY AMENDMENT			
5	03/05/2004	CASE DOCKETED TO EXAMINER IN GAU			
4	10/31/2001	APPLICATION DISPATCHED FROM OIPE			
3	10/30/2001	CORRESPONDENCE ADDRESS CHANGE			
2	09/24/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/19/2001	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

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE CA 92614-2558

COPY MAILED

MAY 09 2007

OFFICE OF PETITIONS

In re Application of	:	
Barry Freel et al.	:	
Application No. 09/955,267	:	DECISION DISMISSING PETITION
Filed: September 18, 2001	:	UNDER 37 CFR 1.313(a)
Attorney Docket No. 18153.4003	:	

This is a decision on the petition under 37 CFR 1.313(a), filed April 17, 2007, requesting withdrawal of the above-identified application from issue.

The petition is **dismissed** as moot for the reasons stated below.

A review of the file record discloses that a Notice of Allowance and Fee(s) Due was mailed on January 22, 2007, with the issue fee being due on or before April 23, 2007. While the office received Part B of the Fee(s) Transmittal form, no deposit account No. was given for charging the issue and publication fees. Therefore, the issue and publication fees have not been paid in this case.

The filing of a petition under 37 CFR 1.313(a) is unnecessary, since the mere filing of an RCE and submission will effectively withdraw an application from issue prior to payment of the issue fee. In view thereof, the petition to withdraw from issue is dismissed as involving a moot issue. *Note* MPEP §§ 706.07(h)(IX) and 1308.

Inquiries concerning this decision may be directed to Terri Williams at (571) 272-2991.

The matter is being referred to Technology Center AU 1764 for appropriate processing of the RCE filed April 17, 2007, and for consideration of the concurrently filed Information Disclosure Statement.

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

JOHN WAGNER
WAGNER MURABITO AND HAO LLP
TWO N. MARKET ST FLOOR THIRD
SAN JOSE, CA 95113

COPY MAILED

JUN 29 2006

OFFICE OF PETITIONS

In re Application of	:	
John S. Wang et al	:	
Application No. 09/955,278	:	DECISION ON PETITION
Filed: September 11, 2001	:	TO WITHDRAW
Attorney Docket No. Bear-P020	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 15, 2005.

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

A review of the file record indicates that the power of attorney to John P. Wagner has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

David Bucci
Petitions Examiner
Office of Petitions

cc: Christie, Parker & Hale, LLP
PO Box 7068
Pasadena, CA 91109-7068

cc: Christie, Parker & Hale, LLP
3501 Jamboree Road
North Tower, Suite 6000
Newport Beach, CA 92660

UNITED STATES 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
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

COPY MAILED

APR 10 2007

OFFICE OF PETITIONS

In re Application of
Carsten Rohr et al.
Application No.09/955,297
Filed: September 19, 2001
Attorney Docket No.: SCS-550-269

ON PETITION

This is a decision on the petition filed February 28, 2007, under 37 CFR 1.181, to withdraw the holding of abandonment for the above-identified application.

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

This application was held abandoned on February 9, 2007 and a Notice of Abandonment was mailed February 22, 2007, for the appellant's failure to timely take action after the Board of Patent Appeals and Interferences decision rendered December 8, 2006.

Petitioner asserts that a response was filed and, in support, petitioner has submitted, *inter alia*, a copy of the response in the form of a "Request For Rehearing Under 37 CFR § 41.52(a)(1)" filed February 8, 2007 and a copy of a post card receipt date stamped February 8, 2007 by the USPTO.

A search of the application file and the USPTO records reveals that in fact the "Request For Rehearing Under 37 CFR § 41.52(a)(1)" was filed on February 8, 2007 and is of record. Accordingly, the Notice of Abandonment mailed February 22, 2007 was mailed in error and is hereby withdrawn. No petition fee is due and none has been charged.

This matter will be referred to Technology Center 3683 for appropriate action on the "Request For Rehearing Under 37 CFR § 41.52(a)(1)" filed February 8, 2007.

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

APR 26 2005

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

Westerman, Hattori, Daniels & Adrian, LLP
1250 Connecticut Avenue, NW
Suite 700
Washington, DC 20036

Paper No. 11

In re Application of
Hiroshi Kawai
Serial No. : 09/955,334
Filed : September 19, 2001
For : Turret Punch Press

: DECISION ON PETITION
: TO WITHDRAW
: HOLDING OF
: ABANDONMENT

This is a decision on petitioner's request filed January 27, 2005, to review the holding of abandonment mailed March 9, 2004, for failure to respond to the Office action mailed August 27, 2003. There is no fee required for this petition.

In support of the request, petitioner has submitted a copy of a response and a copy of a PTO stamped receipt dated November 21, 2003 as evidence of the timely filing of a response.

In view of the above, the Notice of Abandonment mailed March 9, 2004 is in error and is hereby vacated. The holding of abandonment is withdrawn. Upon the mailing of this decision, the application will be forwarded to the Examiner via the Legal Instruments Examiner for entry and consideration of the response received November 21, 2003 as well as the Information Disclosure Statement filed January 5, 2005.

Summary: Holding of Abandonment Withdrawn.

Richard A. Bertsch, Director
Technology Center 3700
Phone: (571) 272-3750

ak/04/14/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Nicholas J. Seay
Quarles & Brady LLP
1 South Pinckney Street
P.O. Box 2113
Madison, WI 53701-2113

COPY MAILED

JUL 24 2002

OFFICE OF PETITIONS

In re Application of	:	
Alan D. Attie, et al.	:	
Application No. 09/955,367	:	ON PETITION
Filed: September 18, 2001	:	
Attorney Docket No. 960296.97478	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 18, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts Of Non-Provisional Application mailed November 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 January 20, 2002.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ORGANOGENESIS
150 DAN ROAD
CANTON MA 02021

COPY MAILED
OCT 27 2008
OFFICE OF PETITIONS

In re Application of
Parenteau et al.
Application No. 09/955,414
Filed: September 18, 2001
Attorney Docket No. 56001/02021

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 26, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This above-identified application became abandoned for failure to timely file a reply to the non-final Office Action of December 10, 2007. The non-final Office Action set a three (3) month shortened statutory period for reply. No extension of time was obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on March 11, 2008. A Notice of Abandonment was mailed on June 26, 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 $770.00, and (3) a proper statement of unintentional delay.

There is no indication that Petitioner herein was ever empowered to prosecute the instant application. If appropriate, proper authorization to prosecute the application should be submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3215.

This application is being referred to Technology Center AU 3774 for appropriate action by the Examiner in the normal course of business on the reply received

Charlema Grant
Petitions Attorney
Office of Petitions

8UNITED STATES PATENT AND TRADEMARK OFFICE

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

CHAPIN & HUANG L.L.C.
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE, SUITE 120
WESTBOROUGH, MA 01581

COPY MAILED
MAY 27 2005
OFFICE OF PETITIONS

In re Application :
Bernard, et al. :
Application No. 09/955,415 : PATENT TERM ADJUSTMENT
Filed: September 18, 2001 :
Dkt. No.: MCE04-12 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed March 15, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **DISMISSED**.

Applicants request that the Determination of Patent Term Adjustment be corrected from 125 days as indicated on the Determination of Patent Term Adjustment mailed March 3, 2004 to 316 days.

A review of the application history reveals that an adjustment under 37 CFR 1.702(a)(1) of 232 days can be attributed to the Office. In accordance with 37 CFR 1.703(a)(1), the adjustment began November 19, 2002, the day after the date that is fourteen months from the date the application was filed, and ended July 8, 2003, the date the non-final Office action was mailed.

A further adjustment under 37 CFR 1.702(a)(2) of 90 days can be attributed to the Office. In accordance with 37 CFR 1.703(a)(2), the adjustment began December 5, 2003, the day after the date that is four months from the date a response to the non-final Office action was filed, and ended March 3, 2004, the date of mailing of Notice of Allowance.

In accordance with 37 CFR 1.704(c)(8), however, the adjustment of 322 days is reduced 191 days for applicants' failure to engage in reasonable efforts to conclude prosecution. The reduction began August 5, 2003, the day after the date that an initial response to the non-final Office action was filed, and ended February 11, 2004, the date of submission of the information disclosure statement. The reduction is pursuant to

37 CFR 1.704(c)(8). Nothing in the record reflects that the supplemental papers (IDS submissions on September 24, 2003 and February 11, 2004) were expressly requested by the examiner.

In view thereof, at the time of Notice of Allowance the application is entitled to a patent term adjustment of 125 days as indicated in the Determination of Patent Term Adjustment mailed March 3, 2004.

The required application fee of $200.00 has been charged to Deposit Account No. 23-0804.

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

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

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

Enclosure: Copy of Adjustment PAIR Calculation

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)
6964321	2005-11-15	09955417	2001-09-18	KEG 2-001

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/J.K. Mueller, Jr./	Date (YYYY-MM-DD)	2010-02-02
Name	Jerry K. Mueller, Jr.	Registration Number	27576

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. 6964321
Issue Date: November 15,2005
Application No. 09955417
Filed: September 18,2001
Attorney Docket No. KEG 2-001

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

This is a decision on the electronic petition, filed February 2,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 2,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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

FALK AND FISH
16590 OAK VIEW CIRCLE
MORGAN HILL, CA 95037

COPY MAILED

MAR - 4 2002

OFFICE OF PETITIONS

In re Application of	:	
Tommi Virtanen et al	:	
Application No. 09/955,433	:	NOTICE
Filed: September 10, 2001	:	
Attorney Docket No. BER-019	:	

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 2662.

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

BIRCH STEWART KOLASCH & BIRCH
P. O. BOX 747
FALLS CHURCH, VA 22040-0747

COPY MAILED

MAY 11 2007

OFFICE OF PETITIONS

In re Application of	:
Mikio Ihama et al	:
Application No. 09/955,438	: DECISION GRANTING PETITION
Filed: September 19, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 0042-0455P-SP	:

This is a decision on the petition, filed May 10, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 27, 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) 272-3218.

This matter is being referred to Technology Center AU 1752 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\fhicks\My Documents\470\May10\955438.wpd

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment.*

UNITED STATES 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

MORRIS E. COHEN
SUITE 217
1122 CONEY ISLAND AVENUE
BROOKLYN, NY 11230-2345

COPY MAILED

MAY 0 5 2004

OFFICE OF PETITIONS

In re Application of	:
Morris E. Cohenl	: DECISION ON PETITION
Application No. 09/955,464	: UNDER 37 CFR 1.78(a)(3)
Filed: September 18, 2001	:
Attorney Docket No. 4018.016	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed September 4, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant application was filed on September 18, 2001, and was pending at the time of filing of the instant petition.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The reference to the prior-filed applications was not included in the manner specified in 37 CFR 1.78(a)(2)(i) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

The instant petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The amendment filed September 4, 2003, states that Application No. 09/369,902, filed August 6, 1999 claims benefit of Provisional Application No. 60/161,283 filed October 25, 1999, and Provisional Application No. 60/165,231, filed November 11, 1999. However, the above provisional applications were filed after the filing of Nonprovisional Application No. 09/369,902, filed August 6, 1999.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment correcting the above-noted deficiencies along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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

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

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. 9

MORRIS E COHEN
SUITE 217
1122 CONEY ISLAND AVENUE
BROOKLYN NY 11230-2345

COPY MAILED
JUL 0 2 2004
OFFICE OF PETITIONS

In re Application of
Cohen
Application No. 09/955,464
Filed: September 18, 2001
Attorney Docket No. 4018.016

: 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 under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed May 10, 2004, 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 September 109, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR §§ 1.78(a)(2)(iii) and 1.78(a)(5)(iii).

Additionally, the prior copending nonprovisional international application and the referenced

prior nonprovisional national applications were all filed within twelve months of the provisional applications, for which the appropriate priority is claimed. A reference to the prior-filed applications 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)(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 <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 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.

It should be noted that it is applicant's responsibility to ensure that the appropriate priority claim(s) in each prior non provisional application is made in each prior non provisisonal application as merely making the correct priority claim in this application does not operate to correct any omissions in the prior claim(s) for each application in the chain. See MPEP 201.11 . For example, USPTO continuity records fail to reflect that application No. 09/280,483 claimed benefit under 35 USC 119(e) of 60/079,884. Any priority claim error(s) in a pre APIA filed patent may be corrected by way of a Certificate of Correction, see MPEP 1481; any priroty claim error(s) in a pre AIPA abandoned application my be corrected by way of petition unde 37 CFR 1.182.

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 (703) 305-1820..

This application is being forwarded to Technology Center Art Unit 3624 for appropriate action on the amendment submitted September 4, 2003, 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 applications, and for consideration of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional application.

Brian Hearn
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.

KRIEGSMAN & KRIEGSMAN
665 FRANKLIN STREET
FRAMINGHAM, MA 01702

COPY MAILED

SEP 16 2004

OFFICE OF PETITIONS

In re Application of :
Henry J. Riblet :
Application No. 09/955,467 :
Filed: September 17, 2001 : ON PETITION
Title of Invention: :
BRACKET ASSEMBLY LOCK :

This is a decision on the Petition to Revival Unavoidably Abandoned Application, filed July 30, 2004, to revive the above-identified application.

The petition is **dismissed.**

Any further petition to revive the above-identified application (under 37 CFR 1.137(a)), 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 "Request for Reconsideration of Petition under 37 CFR 1.137", and be addressed to Petitions Attorney Derek L. Woods. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed September 5, 2003. The Office action set a three (3) month period for reply.

Applicant filed a response to the Office action on December 4, 2003; however, the response failed to place the application in condition for allowance. Applicant was so notified in an Advisory Action mailed January 27, 2004.

Accordingly, the application became abandoned for failure to timely and properly reply to the final Office action that was mailed on September 5, 2003, on December 6, 2003. A Notice of Abandonment was mailed on April 22, 2004.

Applicant's Response

In response to the Notice, Applicant files the instant petition wherein Applicant avers that the unavoidable abandonment of the application because Applicant received no word from the patent lawyer between January 27, 2004 and May 17, 2004.

Requirements for a Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (**2**) the petition fee as set forth in 37 CFR 1.17(l); (**3**) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and ~~(**4**) any terminal disclaimer (and fee as set forth in 37 CFR~~ 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (1) and (3) as set forth above.

Applicant is initially advised that the Advisory Action did not extend the deadline for filing a complete and proper reply to the final Office action, which was mailed on September 5, 2003. The Advisory Action simply informed Applicant that his response to the final Office action, that Applicant filed on December 4, 2003, was not a complete and proper response to the September 5, 2003 final Office action and therefore failed to place the application in condition for allowance. The application became abandoned because Applicant failed to timely and properly reply to the final Office action, mailed September 5, 2003. The Advisory Action advised Applicant that the time period for a reply to the September 5, 2003 Office action continued to run from the mail date of the September 5, 2003 final rejection. The final rejection informed applicant that he had three (3) months to reply, and that extensions of time were available. Applicant could have bought three (3) additional months within which to reply; thereafter, the application became \

abandoned - on the day after the expiration of the three (3) month period for filing a reply. Applicant has filed the instant petition, but has not filed a reply to the September 5, 2003 Office action that would place the application in condition for allowance. Accordingly, Applicant has failed to satisfy item (1) above.

Further to this Applicant is directed to the MPEP, section 711.02, which reads:

> 37 CFR 1.135(a) specifies that an application becomes abandoned if applicant 'fails to reply' to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a 'complete and proper reply, as the condition of the case may require' within the statutory period (37 CFR 1.135(b)).

This section clearly explains that abandonment occurs when petitioner fails to timely and properly reply to the outstanding Office action.

Petitioner is also directed to 37 CFR 1.135(b), Abandonment For Failure to Reply Within Time Period, which reads:

> 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.

This section is further clarified in the Manual of Patent Examining Procedure ("MPEP"), which provides

> [f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not □unavoidable□ when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

This section explains that a delay is not unavoidable when the applicant-petitioner is awaiting an action from the examiner.

In other words, when Applicant filed the response to the final Office action, it was Applicant's responsibility to file a complete and proper reply as the application required. The Advisory Action was a courtesy mailed to Applicant which attempted to notify Applicant that the filed response failed to comply with what was required. The time to file a complete and proper reply continued to run from the mailing of the final Office action on September 5, 2003. Petitioner was not given a new period to reply with the mailing of the Advisory Action.

In addition, Applicant has failed to satisfy item (3) above. The following is the law that governs revival of an application abandoned unavoidably:

Applicable Law

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

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

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As to Applicant's lack of knowledge of the patent rules, Applicant is advised that nonawareness of the content of, or a

misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay. Moreover, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See* In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm□r Pat. 1994)(*while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction*) (Emphasis supplied). Accordingly, Applicant may not rely upon his lack of knowledge of patent law to support an unavoidable delay.

Applicant is further advised that it is his responsibility to provide a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Here, the period of the delay is from the due date for the reply, December 5, 2003, until the filing of a grantable petition, which, at a minimum, runs to the filing of this petition. This petition is not grantable and, as such, the period of delay continues to run. Applicant attempts to account for the period between January 27, 2004 and May 17, 2004; however, Applicant must account for the period between December 5, 2003 and the filing of a grantable petition.

Conclusion

Applicant has failed to address both items (1) and (3). Applicant must file a complete and proper reply to the final Office action, and Applicant must account for the entire delay in responding to the September 5, 2003 Office action.

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently $665.00.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

It is also noted that the correspondence address on the petition differs from the correspondence address of record. While a courtesy copy of this Decision is being mailed to the person filing the instant petition, future correspondence will be mailed to the correspondence address of record until such time that a Power of Attorney and/or change of correspondence address is filed.

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

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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

By hand: 2201 South Clark Place
Customer Window
Crystal Plaza Two, Lobby Room 1B03
Arlington, VA 22202

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

Derek L. Woods
Petitions Attorney
Office of Petitions

This Page is Inserted by IFW Indexing and Scanning Operations and is not part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ❑ BLACK BORDERS
- ❑ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ❑ FADED TEXT OR DRAWING
- ❑ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ❑ SKEWED/SLANTED IMAGES
- ❑ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ❑ GRAY SCALE DOCUMENTS
- ❑ LINES OR MARKS ON ORIGINAL DOCUMENT
- ❑ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ❑ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.
As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KRIEGSMAN & KRIEGSMAN
665 FRANKLIN STREET
FRAMINGHAM, MA 01702

COPY MAILED

FEB 2 4 2005

OFFICE OF PETITIONS

In re Application of :
Henry J. Riblet :
Application No. 09/955,467 :
Filed: September 17, 2001 : ON PETITION
Title of Invention: :
BRACKET ASSEMBLY LOCK :

This is a decision on the Petition to Revive Unintentionally Abandoned Application under 37 CFR 1.137(b), filed January 18, 2005.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed September 5, 2003. The Office action set a three (3) month period for reply.

Applicant filed a response to the Office action on December 4, 2003; however, the response failed to place the application in condition for allowance. Applicant was so notified in an Advisory Action mailed January 27, 2004.

Accordingly, the application became abandoned for failure to timely and properly reply to the final Office action that was mailed on September 5, 2003, on December 6, 2003. A Notice of Abandonment was mailed on April 22, 2004.

Applicant filed a petition to revive the application based upon unavoidable delay on July 30, 2004, which was dismissed in a Decision mailed September 16, 2004, for failing to meet the requirements of a grantable petition under 37 CFR 1.137(b).

With the instant petition, Applicant has filed a Request for Continued Examination ("RCE") and a submission in the form of an Amendment.

Having found that all of the requirements for a grantable petition under 37 CFR 1.137(b) have been met, **this petition is hereby granted.**

The Power of Attorney and Correspondence Address Change has been entered and made of record.

Applicant is advised that, effective December 8, 2004, the fee for filing a petition under 37 CFR 1.137(b) is increased to $750.00. As authorized in the instant petition, deposit account 02-3285 has been charged the difference between the amount paid, $685.00, and the amount due, $750.00, or $65.00.

This application is an image file wrapper ("IFW") and, as such, no forwarding of the file is necessary. An electronic mail message will be sent to Technology Center 3632 for processing of the RCE and Amendment in due course.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney/Advisor
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)
6,961,586	2005-11-01	09/955,543	2001-09-17	ORTIZ-1001

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	/LUIS M ORTIZ/	Date (YYYY-MM-DD)	2009-12-31
Name	LUIS M. ORTIZ	Registration Number	36230

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. 6961586
Issue Date: November 1,2005
Application No. 09955543
Filed: September 17,2001
Attorney Docket No. ORTIZ-1001

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

This is a decision on the electronic petition, filed December 31,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 31,2009 . 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

Technology Center 1700.

Mailed: 1/4/06

rvk
Paper No. _____

In re application of:	:	
Charles S. Vann et al	:	
Serial No.: 09/955,554	:	DECISION ON
Filed: September 18, 2001	:	PETITION
For: MATRIX STORAGE AND DISPENSING SYSTEM	:	

This is a response to the PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT, filed July 29, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of June 10, 2003, for failure to timely file a proper response to the Office letter dated November 15, 2002 be withdrawn. The petitioner asserts that applicants timely filed a proper response on January 10, 2003.

DECISION

The instant request is accepted as a petition under 37 C.F.R. 1.181 (no fee).

A review of the instant application file indicates that the error status of the instant application was administratively corrected via the Notice of Rescinded Abandonment dated March 15, 2005. Subsequently, a non-Final rejection and a Final rejection were mailed out on May 16, 2005 and November 18, 2005, respectively. Therefore, no further action is required.

The Petition is **DISMISSED.**

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

HARNESS, DICKEY & PIERCE, P.L.C.
P.O.BOX 828
BLOOMFIELD HILLS, MI 48303

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DIGEO, INC C/O STOEL RIVES LLP
201 SOUTH MAIN STREET, SUITE 1100
ONE UTAH CENTER
SALT LAKE CITY UT 84111

COPY MAILED

SEP 2 8 2005

OFFICE OF PETITIONS

In re Application of :
GREENBERG, Mark et al. :
Application No.: 09/955,558 :
Filing Date: September 17, 2001 :
Docket No.: 50588/345 :
For: APPARATUS AND METHOD FOR :
EFFICIENT DECODER :
NORMALIZATION :

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

This is a decision on Petition Under 37 CFR 1.137(b), filed on July 12, 2005.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed January 14, 2004, which set a shortened statutory period for reply of three (3) months. The application went abandoned at midnight on April 14, 2004.

Petitioner has met the requirements for revival under §1.137(b). Petitioner submitted the reply in the form of an amendment, paid the petition fee and made the required statement of unintentional delay. Since this utility application was filed after June 8, 1995, no terminal disclaimer is required. Accordingly, the petition is granted under §1.137(b).

This application is being referred to Technology Center AU 2133 for continued processing.

Erin P. Thomson

Erin Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

Frances Hicks for

Brian Hearn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

COPY MAILED

APR 1 6 2003

OFFICE OF PETITIONS

In re Application of	:	
Phillip M. Ginsberg	:	
Application No. 09/955,594	:	DECISION GRANTING PETITION
Filed: September 5, 2001	:	UNDER 37 CFR 1.137(f)
Attorney Docket No. CF-47	:	

This is a decision on the petition, filed April 8, 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 August 23, 2002. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

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

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

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

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

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

The instant petition has been found in compliance with 37 CFR 1.137(f). However, while the statement of unintentional delay does not comply with the rule, the statement presented will be construed as meaning that "the entire delay in filing the required reply [Notice to Rescind Previous Nonpublication Request Under 35 U.S.C. § 122(b)(2)(B)(ii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

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 2155 for examination in due course.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

COPY MAILED

MAY 19 2008

In re Application of	:	
GINSBERG, Phillip M.	:	
Application No. 09/955,594	:	DECISION ON PETITION
Filed: September 05, 2001	:	TO WITHDRAW
Attorney Docket No. **01-1047**	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 19, 2008.

The request is **Moot** because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to ROPES & GRAY LLP has been revoked by the assignee of the patent application on April 23, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Petitions Examiner
Office of Petitions

cc: **DEAN P. ALDERUCCI**
CANTOR FITZGERALD, L.P.
110 EAST 59TH STREET (6TH FLOOR)
NEW YORK NY 10022

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

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

COPY MAILED

OCT 0 7 2003

OFFICE OF PETITIONS

In re Application of
Jack Zezhong Peng
Application No. 09/955,641
Filed: September 18, 2001
Attorney Docket No. 384848001US

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed June 30, 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 September 17, 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 15, 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 2824 for examination in due course.

Sherry D. Brinkley

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

Conferee: Frances M. Hicks
Lead Petitions Examiner

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
DIW Aug-06

Paper No. 10

SAIL KATTA REDDY
1010 N. DIVISION STREET
URBANA IL 61801

COPY MAILED

AUG 28 2006

OFFICE OF PETITIONS

In re Application of	:	
Sail Katta Reddy	:	
Application No. 09/955,671	:	DECISION ON PETITION
Filed: 19 September, 2001	:	
For: DOUGH PERFORATOR METHOD	:	
AND USE	:	

This is a decision on the petition filed on 10 January, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The petition is **GRANTED**.

The application became abandoned on 28 October, 2002, for failure to timely reply to the Office action requiring restriction or election mailed on 27 September, 2002, which set a thirty (30) day shortened period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 5 May, 2003.

Petitioner states, *inter alia*, 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."

The record does not necessitate a finding that the delay between 28 October, 2002, and 10 January, 2006, was not unintentional.

Rather, 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 and until the filing of the petition was unintentional.[2]

Receipt of the paper entitled "ELECTION OF INVENTION TO BE EXAMINED" is acknowledged.

This application is being forwarded to Technology Center 1700 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

---

[2] 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).

UNITED STATES 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 DEPARTMENT
MITSUBISHI ELECTRIC RESEARCH LABORATORIES, INC.
201 BROADWAY
CAMBRIDGE, MA 02139

COPY MAILED

OCT 31 2006

OFFICE OF PETITIONS

In re Application of	:	
David B. Anderson et al	:	
Application No. 09/955,696	:	DECISION GRANTING PETITION
Filed: September 19, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. CR1351	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 17, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 12, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 14, 2006 (March 12, 2006, the due date, was a Sunday).

Initially, it is noted that, prior to any decision by the deciding official having been rendered on the petition to revive, a Notice of Allowability and a Notice of Allowance and Fee (s) Due were mailed on August 14, 2006. As this application was abandoned for failure to timely reply to the final Office action of December 12, 2005, within the extendible six month period provided therefor, the Examiner had no procedural authority with respect to the abandoned application. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964). Therefore, the examiner was without authority to act further in the case absent a grantable petition reviving the application. Nevertheless, in view of this decision granting the petition to revive, the subsequent action taken by the examiner in the mailing of a Notice of Allowability and Notice of Allowance and Fee(s) Due on August 24, 2006 has been ratified.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply, (2) the $1,500 petition fee, and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of December 12, 2005 is accepted as having been unintentionally delayed.

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

As noted above, a Notice of Allowance and Fee(s) Due was mailed on August 24, 2006, which requires the submission of the $1,400 issue fee and the $300 publication fee. Petitioner is advised that failure to timely submit the issue and publication fees will again result in the abandonment of this application.

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

KLARQUIST SPARKMAN LLP
121 S.W. SALMON STREET
SUITE 1600
PORTLAND, OR 97204

Mail Date: 04/21/2010

Applicant	: Jordi Ribas-Corbera	: DECISION ON REQUEST FOR
Patent Number	: 7646816	: RECALCULATION of PATENT
Issue Date	: 01/12/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/955,731	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/19/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **867** 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. 7

SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX AZ 85004-0001

COPY MAILED

AUG 1 2 2002

OFFICE OF PETITIONS

In re Application of
Babbrah
Application No. 09/955,743
Filed: September 17, 2001
Attorney Docket Number: 32643.3550

DECISION GRANTING STATUS
UNDER 37 C.F.R. §1.47(b)

This is in response to the April 17, 2002 petition under 37 C.F.R. §1.47(b)[1].

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the declaration of facts of dated, establishes that the inventor was given a copy of the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration. In addition, Petitioner has shown that has a proprietary interest in the above-identified application with the Assignment from inventor to dated. Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(b). This application is hereby accorded Rule 1.47(b) status and the Office of Initial Patent Examination is authorized to

(1) accept this application under Rule 1.47(b);

(2) process the application with the inventor being Bobby Babbrah and with the indication that the application was filed by as the party in interest under 35 U.S.C. § 118, inventor authority code 08, using the Declaration filed on April 17, 2002; and

(3) mail a filing receipt with a filing date of September 17, 2001.

As provided in Rule 1.47(b), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

---

[1] A grantable petition under 37 CFR 1.47(b) requires:
(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
(2) an acceptable oath or declaration;
(3) the petition fee;
(4) a statement of the last known address of the non-signing inventor;
(5) proof of proprietary interest; and
(6) proof of irreparable damage.

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

Telephone inquiries regarding this communication should be directed to the undersigned at 703-306-5593.

Scott M. Ledford
Senior 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

Mr. Bobby Babbrah
1082 W. Chilton Drive
Tempe, AZ 85283

COPY MAILED

AUG 1 2 2002

OFFICE OF PETITIONS

In re Application of
Babbrah, *et al.*
Application No. 09/955,743
Filed: September 17, 2001

Dear Mr. Babbrah:

You are named as the 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(b) (Rules of Practice in Patent Cases). Should a patent be granted on the application you will be designated therein as the inventor.

As the 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, 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 the undersigned at 703-306-5593. 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).

Scott M. Ledford
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX AZ 85004-0001

UNITED STATES 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 Jul-07

Paper No. 11

STITES & HARBISON, PLLC
400 W MARKET ST
SUITE 1800
LOUISVILLE KY 40202-3352

COPY MAILED

JUL 10 2007

OFFICE OF PETITIONS

In re Application of :
Janice Richardson :
Application No. 09/955,778 : ON PETITION
Filed: 09/18/2001 :
Atty Dckt No. RI118/000RI :

This is a decision on the petition filed on 30 May, 2007, under 37 CFR 1.137(a),[1] to revive the above-identified application, which is first treated as a petition to withdraw the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition to withdraw the holding of abandonment," or as discussed below "Renewed Petition under 37 CFR 1.137(b)."

The application became abandoned on 5 June, 2003, for failure to timely submit the issue fee as required by the Notice of

---

[1] A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. 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(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Allowance and Fee(s) Due and corrected drawings as required by the Notice of Allowability, both mailed on 4 March, 2003, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 4 August, 2003.

Petitioner asserts unavoidable delay in that her former patent attorney, Joseph N. Breaux, did not inform her that the issue fee was due and that petitioner subsequently learned that Breaux "was no longer licensed to practice law in the State of Louisiana and … could no longer continue to represent me before the U.S. Patent and Trademark Office."

Specifically, petitioner states, in pertinent part:

> 5. I did not hear from Mr. Breaux's office again until June 2003. In a letter dated June 27, 2003, Linda Alleman (an assistant to Mr. Breaux) informed me that she had requested a copy of the Official Filing Receipt from the U.S. Patent and Trademark Office, and that she would forward a copy of such receipt to me. This was the last correspondence I received from Mr. Breaux's office.
>
> 6. In March 2004, William David Kiesel of Roy, Kiesel, Keegan & DeNicola of Baton Rouge, Louisiana, notified me that Mr. Breaux was no longer licensed to practice law in the State of Louisiana and that he could not continue to represent me before the U.S. Patent and Trademark Office. Mr. Kiesel informed me that he was the court-appointed curator of my file, but had not reviewed my file. He offered to provide me a complete copy of the file upon request. I immediately requested my file, which was sent to me on April 5, 2004.
>
> 7. I immediately reviewed my file. Nothing in the file indicated that there were any outstanding actions that required response. Specifically, the file did not contain any information regarding the NOTICE OF ALLOWANCE or the NOTICE OF ABANDONMENT, which I subsequently discovered had been mailed to Mr. Breaux in 2003.
>
> 8. In May, 2007, I contacted David Nagle, a registered patent attorney with Stites & Harbison, PLLC, of Louisville, Kentucky. He promptly obtained a copy of the complete prosecution history from the U.S. Patent and Trademark Office. Mr. Nagle informed me that a

NOTICE OF ALLOWANCE had been mailed from the U.S. Patent and Trademark Office on 3/04/03, and that a NOTICE OF ABANDONMENT had been mailed on 8/04/03. As stated above, Mr. Breaux's file did not contain either document or any indication that either document had been received by Mr. Breaux's office or responded to in any fashion. Furthermore, the request by Mr. Breaux's assistant for the Official Filing Receipt almost two years after the application was filed is unusual and suggests a possible breakdown in the mailing and receipt of communications regarding my patent application between the U.S. Patent and Trademark Office and Mr. Breaux's office.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioner asserts that the Notice of Allowance and Fee(s) Due and the Notice of Allowability (hereinafter referred to collectively as "the Notices") mailed on 4 March, 2003, were never received. A review of the record indicates no irregularity in the mailing of the Notices, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notices were properly mailed to the address of record. This presumption may be overcome by a showing that the Notices were not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the Office 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.[2] 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 action was lost in the mail (*e.g.*, if the practitioner has a history of not receiving Office actions).

A review of the record shows that Breaux was presumably representing petitioner and prosecuting the application as of 4 March, 2003, the date the Notices were mailed. Breaux's address was the address of record. Additionally, the power of attorney filed with the application papers appointed Breax as the sole

---

[2] 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).

attorney of record. Furthermore, the letter of June 27, 2003, referenced by petitioner suggests that Breaux was prosecuting the application. As such, any allegation that the Notices were not received must be supported by a showing that they were not received at the address of record, in this case, Breaux's address of Suite A, 10630 N. Oak Pkwy, Baton Rouge, LA 70810.

Petitioner would therefore need to contact Breaux and obtain a copy of the records, and the statement from the practitioner, as referenced above in order to show that the Notices were not received by Breaux at the correspondence address of record at the time the Notices were mailed. If petitioner cannot provide such documentation, petitioner will not be able to show that the Notices were not received.

The showing of record is insufficient at this time is insufficient to show that the Notices mailed on 4 March, 2003, were not received. Accordingly, the petition to withdraw the holding of abandonment must be **dismissed**.

PETITION UNDER 37 CFR 1.137(a)

The petition lacks the reply required by 37 CFR 1.137(a)(1). The petition is dismissed because petitioner failed to submit corrected drawings. The Notice of Allowability, mailed on 4 March, 2003, concurrently with the Notice of Allowance and Fee(s) Due, set forth a statutory period of three months from the mailing date in which petitioner was required to submit corrected drawings. Thus, the Notice of Allowability and the Notice of Allowance set forth concurrent but distinct requirements with which petitioner was required to comply. Accordingly, pursuant to the provisions of 37 CFR 1.137(b)(1) and in accordance with 35 U.S.C. §§ 133 and 151, the submission of corrected drawings is a necessary component of the required reply.

A copy of the Notice of Allowability including the drawing requirement is enclosed for petitioner's reference.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".[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. 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.[4]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[5] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[5]

The showing of record suggests that the failure to respond to the Notices resulted from the failure of petitioner's former counsel

---

[3] 35 U.S.C. § 133.

[4] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[5] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

as well as petitioner herself. With regard to Breaux's suspension from practice before the USPTO, petitioner must provide evidence of the date Breaux ceased practice before the USPTO. In particularly, petitioner must explain whether Breaux was representing her at the time the Notice was mailed and whether Breaux was permitted to practice before the USPTO as of the date the Notices were mailed, and for a reasonable time thereafter. In this regard, petitioner should sent a letter by certified mail to Breaux, (and perhaps to Keisel, as the court-appointed curator of Breaux's files), stating that the Office is requesting their assistance in determining whether the delay in responding to the why the Notices mailed on 4 March, 2003, was unavoidable. A copy of the letter, and any response received thereto, should be included in any renewed petition.

As stated previously, the showing of record is that, notwithstanding his later suspension from practice, Breaux was petitioner's validly appointed attorney and was empowered to represent petitioner before the USPTO at the time the Notices were mailed.

While petition allegedly chose to rely upon Breaux, such reliance per se does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c).[6] Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether Breaux acted reasonably and prudently.[7] Nevertheless, petitioner is bound by any errors that may have been committed by Breaux.[8]

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.[9] Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.[10]

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP

---

[6] See California Med. Prod. v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

[7] Id.

[8] California, *supra*.

[9] Link v. Wabash, 370 U.S. 626, 633-34 (1962).

[10] Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

does not constitute an "unavoidable" delay.[11] A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.[12]

Finally, petitioner is reminded that the U.S. Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative.[13]

In summary, the showing of record is that the abandonment resulted from a mistake on the part of petitioner's counsel in failing to timely file a reply rather than as a result of unavoidable delay. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

More importantly, petitioner must explain the long period of delay between the date of her receipt of the file and the date she took action which resulted in learning that the application was abandoned. In particular, petitioner allowed over three (3) years to elapse between learning that Breaux was no longer authorized to practice and obtaining the file from Kiesel on 5 April, 2004, and contacting attorney Nagle in May, 2007. Petitioner has not shown whether any other steps were taken during the intervening time to inquire about the status of the application or whether any efforts were made to continue prosecution.

Further to this point, with respect to petitioner's statement that she "was not aware that any action was necessary until Mr. Nagle reviewed the prosecution history of my application" the showing of record is that petitioner chose to prosecute the application *pro se* from 5 April, 2004, until May, 2007. Petitioner was not forced, but rather made a conscious decision to prosecute the application *pro se*, and therefore must be held accountable for her actions, or lack thereof, before the Office. There are numerous resources available to petitioner, as to the

---

[11] Id.

[12] See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

[13] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

others who have chosen this path of prosecution, to obtain the necessary information to prosecute the application before the Office.

The showing of record, therefore, particularly with respect to the extended period between 5 April, 2004, and May, 2007, the date of the filing of the present petition, is that rather than unavoidable delay, there was a lack of diligence on the part of petitioner. Specifically, it appears that petitioner was preoccupied with other matters during this period. Petitioner's preoccupation with other matters which took precedence over prosecution of the above-identified application does not constitute unavoidable delay.[14]

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[15] As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

In summary, rather than unavoidable delay, the showing of record is that petitioner failed to take adequate precautions to ensure that a response to the Notices mailed on 4 March, 2003, was timely filed, or that a petition to revive the application or withdraw the holding of abandonment was timely filed. As petitioner has not shown that she exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[16]

As the showing of record is insufficient to satisfy the requirements of a grantable petition under 37 CFR 1.137(a), the petition will be dismissed.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A

---

[14] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[15] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[16] See note 7, supra.

grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioners decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be $750.00 for a small entity.

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioners' convenience.

Receipt of the power of attorney and change of correspondence address is acknowledged.

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

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

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

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

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

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Notice of Allowability mailed 4 March, 2003
Form PTO/SB/64
Privacy Act Statement
Fee Schedule

UNITED STATES 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 Apr-08

Paper No. 14

STITES & HARBISON, PLLC
400 W MARKET ST
SUITE 1800
LOUISVILLE KY 40202-3352

COPY MAILED

APR 0 3 2008

OFFICE OF PETITIONS

In re Application of	:	
Janice Richardson	:	
Application No. 09/955,778	:	ON PETITION
Filed: 09/18/2001	:	
Atty Dckt No. RI118/000RI	:	

This is a decision on the petition filed on July 31, 2007, under 37 CFR 1.137(b).

The petition is **granted**.

The application became abandoned on 5 June, 2003, for failure to timely submit the issue fee as required by the Notice of Allowance and Fee(s) Due and corrected drawings as required by the Notice of Allowability, both mailed on 4 March, 2003, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 4 August, 2003. The petition filed on May 30, 2003 was dismissed on July 10, 2007.

Receipt of the issue fee and corrected drawings is acknowledged.

Petitioner has appointed a representative to conduct all business before the U.S. Patent and Trademark Office (Office). The Office will not engage in dual correspondence with petitioner and petitioner's representative. Accordingly, petitioner must conduct all future correspondence with this Office through the representative of record. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or patent agent should be submitted. A correspondence address must be included on the correspondence instructing the Office where all future communications are to be mailed. *See* 37 CFR 1.33(a).

The file does not indicate a change of address has been submitted, although the address given on the petition differs

from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Cc:

JANICE RICHARDSON
708 NALAN DRIVE
LOUISVILLE KY 40291-1816

Encl: PTO/SB/82

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7-28-05

TO SPE OF : ART UNIT 3736

SUBJECT : Request for Certificate of Correction on Patent No.: 6875183

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.

Check foreign Priority info.

Thank You For Your Assistance

Ennis Young
Certificates of Correction Branch
Tel. No. 703-305-8309

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

Note your decision on the appropriate box.

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

Comments:

_____

_____

_____

_____

_____

SPE

3736
Art Unit

COFC

OIPE JC182
JUL 0 1 2005
PATENT & TRADEMARK OFFICE

Attorney's Docket No.: 13533-002001 / F/USP81213

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Laurence Cervi
Patent No. : 6,875,183
Issue Date : April 5, 2005
Serial No. : 09/955,790
Filed : September 19, 2001
Title : BIOPSY NEEDLE

Art Unit : 3736
Examiner : Brian Scott Szmal

Certificate
JUL 0 8 2005
of Correction

Attn.: Certificate of Corrections Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REQUEST FOR CERTIFICATE OF CORRECTION

Applicant hereby requests that a certificate of correction be issued for the above patent in accordance with the attached request.

All errors sought to be corrected were made in printing by the Patent and Trademark Office, and no fee is believed to be due.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 29, 2005

Timothy A. French
Reg. No. 30,175

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21117864.doc

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

June 29, 2005
Date of Deposit

Signature

Timothy A. French
Typed or Printed Name of Person Signing Certificate

JUL 0 8 2005

Staple
Here
Only

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,875,183

DATED : APRIL 5, 2005

INVENTOR(S) : PAUL LAURENCE CERVI

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page, please include the following foreign priority information:

--GB 9926427.7 11/08/1999
GB 9906257.2 03/19/1999 --

MAILING ADDRESS OF SENDER:

Timothy A. French
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110

PATENT NO. 6,875,183

No. of add'l copies

number

JUL 08 2005

Staple
Here
Only

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,875,183

DATED : APRIL 5, 2005

INVENTOR(S) : PAUL LAURENCE CERVI

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page, please include the following foreign priority information:

--GB 9926427.7 11/08/1999
GB 9906257.2 03/19/1999 --

MAILING ADDRESS OF SENDER:

Timothy A. French
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110

PATENT NO. 6,875,183

No. of add'l copies

number

FEB 08 2005

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4-29-05

TO SPE OF : ART UNIT 1753

SUBJECT : Request for Certificate of Correction on Patent No.: 6,773,577

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-915
Palm location **7580** - Tel. No. 305-8309

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

Magdalene Talley

Thank You For Your Assistance — **Certificates of Correction Branch**

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

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

Comments:

This Certificate of Correction corrects typographical errors. GN

NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

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, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

COPY MAILED

SEP 1 8 2002

OFFICE OF PETITIONS

In re Application of :
Schlotzhauer et al. :
Application No. 09/955,796 :
Filed: September 18, 2001 :
Attorney Docket No. 10010804-1 :

DECISION ON PETITION

This is a decision on the Petition, filed July 29, 2002, to revive an unavoidably abandoned application Under 37 CFR §1.137(a), which is being treated under 37 CFR §1.181(a), as a petition to withdraw the holding of abandonment.

The petition is **granted**.

Petitioner avers non-receipt of the Notice to File Missing Parts of Nonprovisional Application ("Notice"), mailed on October 18, 2001. In support, Petitioner has provided the necessary statements and copies of the docket record where the non-received Notice would have been entered had it been received and docketed. Petitioner has demonstrated by a preponderance of the evidence that the Notice was not received.

The Abandonment of this application is hereby withdrawn. The executed oath/declaration has been entered and made of record.

No petition fee is due; however, as the oath/declaration filed with the application was unexecuted, the fee for the late filing of the oath or declaration, $130.00, has been charged to deposit account 50-1078, as authorized in the general authorization filed with the application.

The application is being returned to the Office of Initial Patent Examination for further processing in due course..

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

Derek L. Woods
Petitions Attorney
Office of Petitions
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

ROBERT DEBERARDINE
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

COPY MAILED

JAN 3 1 2006

OFFICE OF PETITIONS

In re Application of Taneja et al. :
Application No. 09/955,801 : Decision on Petition
Filing Date: September 19, 2001 :
Attorney Docket No. 6842.US.O1 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 16, 2005, 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 December 14, 2004. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, this application became abandoned on March 15, 2005. A Notice of Abandonment was mailed on July 14, 2005.

The instant petition requests revival of the application.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

The petition is signed by attorney Martin Katz. The record indicates Katz may not have first hand knowledge concerning the facts surrounding the abandonment of the application. Nevertheless, the statement by Katz that the entire delay was unintentional is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.[1] In the event that such an inquiry has not been made, petitioner must make such an

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

inquiry. If such inquiry results in the discovery that a portion of the delay from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Technology Center Art Unit 1615 will be informed of the instant decision so that the application may be further examined in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

cc: Martin L. Katz
Wood, Phillips, Katz, Clark & Mortimer
Citigroup Center, Suite 3800
West Madison Street
Chicago, Illinois 60661-2511

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WILLIAMS MULLEN
FOUNTAIN PLAZA THREE, SUITE 200
721 LAKEFRONT COMMONS
NEWPORT NEWS VA 23606

COPY MAILED

FEB 16 2005

OFFICE OF PETITIONS

In re Application of	:	
Lewis et al.	:	DECISION ON
Application No.09/955,816	:	PETITION
Filed: September 19, 2001	:	
Attorney Docket No. 035146.2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 13, 2005, which is being treated as a request to withdraw the holding of abandonment for the above-identified application.

This application was held abandoned for failure to timely respond to the nonfinal Office Action mailed on May 5, 2004, which set a three-month shortened statutory period for reply. In the apparent absence of a timely filed response, the application was held abandoned and a Notice of Abandonment was mailed on December 14, 2004.

In the present petition, petitioner states that on September 29, 2004, petitioner submitted a reply in the form of an amendment and a petition for a two-month extension of time to respond with an authorization to charge the requisite fees. Accompanying the petition is a copy of the amendment and a petition for extension of time under 37 CFR 1.136(a) with a certificate of mailing dated September 29, 2004.

> 37 CFR 1.8(b) states that in the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received by the United States Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and,

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

After reviewing the papers submitted on petition, the response is considered timely filed on September 29, 2004. Accordingly, the petition is **granted**. The Notice of Abandonment is hereby vacated. The application is restored to pending status in view of the fact that a response was timely submitted on September 29, 2004.

In view of the above, the $750.00 petition fee is unnecessary and will be refunded to Deposit Account No. 50-0766. Additionally, the $210.00 fee for the two-month extension of time submitted on September 29, 2004, will be charged to the Deposit Account.

The matter is being referred to the Technology Center Art Unit 1744 for a review of the amendment submitted with the present petition.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAYER BROWN ROWE & MAW LLP
P O BOX 2828
CHICAGO, IL 60690-2828

COPY MAILED

NOV 23 2005

OFFICE OF PETITIONS

In re Application of	:
Kenneth John Laurence et al	:
Application No. 09/955,822	: DECISION GRANTING PETITION
Filed: September 18, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 01831049	:

This is a decision on the petition, filed November 16, 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 15, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1771 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).*

10779

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 19

DATE : 5/10/05

TO SPE OF : ART UNIT 2832

SUBJECT : Request for Certificate of Correction on Patent No.: 6,563,415

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

please return

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:

No change in scope, filing date or on due to PTO

KARL D. EASTHOM
PRIMARY EXAMINER

SPE

2832
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#15
KS

Dillis V. Allen, Esq.
105 S. Roselle Road
Suite 101
Schaumburg IL 60193

In re Application of	MAY - 6 2010
ALLEN, DILLIS V.	
Application No.: 09/955,899	DECISION ON
Filing or 371(c) Date: September 19, 2001	PETITION
Attorney Docket Number:	

This is a decision on the Petition To Withdraw Holding Of Abandonment Based On Failure To Receive Office Action, received in the United States Patent and Trademark Office (USPTO) on November 15, 2004.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply to the Notice of Allowance and Issue Fee Due mailed on June 27, 2003, which set a three (3) months from it mailing date. No response was received within the allowable period, and the application became abandoned. A Notice of Abandonment was sent on December 12, 2003.

When, as in this case petitioner is arguing that an Office communication was not received, petitioner must establish non-receipt of the Office communication in accordance with section 711.03 (c) of the *Manual Patent Examining Procedure* that requires the following:

This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the practitioner did not receive the Office action, and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Action Are Not Received" MPEP 711.03(c) II of the MPEP.

Petitioner has met the above-stated conditions. Accordingly, the holding of abandonment is hereby withdrawn. The application will be forwarded to Technology Center 3700 for further processing that will include remailing the Notice of Allowance and Issue Fee Due and resetting of the period for reply.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 756-1547.

Kay D. Pinkney
Application Assistance Unit
Office of Data Management

UNITED STATES 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 10 2006
OFFICE OF PETITIONS

HARRITY SNYDER, LLP
11350 Random Hills Road
SUITE 600
FAIRFAX, VA 22030

In re Application of :
Hirofumi Yamagiwa :
Application No. 09/955,955 : ON PETITION
Filed: September 20, 2001 :
Attorney Docket No. Q66339

This is a decision on the petition under 37 CFR 1.137(a), filed June 9, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to respond to the non-final Office action mailed April 19, 2005, which set a shortened statutory period for reply of three-months from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). No response was received within the allowable period, and the application became abandoned on July 20, 2005. A Notice of Abandonment was mailed on May 3, 2006.

The amendment filed June 9, 2006, is noted and made of record.

The file is now being forwarded to Technology Center 2600, GAU 2616 for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria VA 22313-1404

COPY MAILED
MAY 24 2006
OFFICE OF PETITIONS

In re Application of	:	
Hiroshi Sumiyama et al.	:	
Application No. 09/955,963	:	DECISION ON PETITION
Filed: September 20, 2001	:	
Attorney Docket Number:	:	
018775-842	:	
Title: IMAGE FORMING	:	
APPARATUS INCORPORATING NO	:	
IMAGE MEMORY WITH MEMORY	:	
RECALL FUNCTION	:	

This is a decision on the "petition to reset response date to office action based on failure to receive office action," which is properly treated as a petition under 37 C.F.R. §1.181, filed on March 21, 2006.

BACKGROUND

A non-final Office action was mailed October 4, 2005, which set a shortened statutory period for reply of three (3) months. With this petition, Petitioner has asserted that the non-final Office action was not received. Petitioner has included an amendment and a three-month extension of time, but has requested that the extension of time not be charged to his account due to the failure to receive the Office action.

A discussion follows.

RELEVANT PORTION OF THE MPEP

MPEP 711.03(c) sets forth, in part:

> PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION
>
> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).
>
> Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.
>
> See also 1156 O.G. 53 (October 25, 1993), which may be viewed at http://www.uspto.gov/web/offices/com/sol/og/con/files/cons074.htm.

Petitioner has not established non-receipt of Office action. Petitioner has included a statement that the Office

communication was not received by the Practitioner and he has attested to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. However, Petitioner has not provided a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

CONCLUSION

In view of the above, this petition must be **DISMISSED**.

Any request for reconsideration of this decision under 37 C.F.R. §1.181 must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. 181," and should only address the deficiencies noted in this decision.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. Any renewed petition may be submitted by mail[1], hand-delivery[2], or facsimile[3].

The request to enter the amendment and charge the three-month extension of time to Petitioner's Deposit Account will be held in abeyance so as to afford Petitioner the opportunity to file a renewed petition. If Petitioner would prefer to have the extension of time charged to his Deposit Account, a response to this decision should be submitted with words to this effect.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
3 (571) 273-8300 - please note this is a central facsimile number.

UNITED STATES 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
JUL 17 2006
OFFICE OF PETITIONS

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria VA 22313-1404

In re Application of	:	
Hiroshi Sumiyama et al.	:	
Application No. 09/955,963	:	DECISION ON
Filed: September 20, 2001	:	RENEWED PETITION
Attorney Docket Number:	:	UNDER 37 C.F.R. §1.181
018775-842	:	
Title: IMAGE FORMING	:	
APPARATUS INCORPORATING NO	:	
IMAGE MEMORY WITH MEMORY	:	
RECALL FUNCTION	:	

This is a decision on the renewed petition under 37 C.F.R. §1.181, filed on June 22, 2006.

A non-final Office action was mailed October 4, 2005, which set a shortened statutory period for reply of three (3) months. With the original petition, Petitioner asserted that the non-final Office action was not received. Petitioner included an amendment and a three-month extension of time, but requested that the extension of time not be charged to his account due to the failure to receive the Office action.

The original petition was submitted on March 21, 2006, and was dismissed via the mailing of a decision on May 24, 2006.

With this renewed petition, Petitioner has submitted an argument which has been deemed to be persuasive.

Accordingly, the petition under 37 C.F.R. §1.181(a) is **GRANTED**. The holding of abandonment is WITHDRAWN.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment which was received with the original petition on March 21, 2006 can be processed.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

OIPE JC177
JUN 2 1 2004
PATENT & TRADEMARK OFFICE

BEST AVAILABLE COPY

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

Docket No.: 213857US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/956,014
Applicants: Tatsuya MATSUMURA, et al.
Filing Date: September 20, 2001
For: A DISPLAY APPARATUS AND DRIVING METHOD THEREFOR
Group Art Unit: 2673
Examiner: Lao, Lun Yi

SIR:

Attached hereto for filing are the following papers:

PETITION UNDER 37 C.F.R. § 1.181
COPIES OF AN INFORMATION DISCLOSURE STATEMENT, PTO-1449, & FILING RECEIPT (ALL FILED ON JANUARY 23, 2004)

Our check in the amount of -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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

Gregory J. Maier
Registration No. 25,599

Raymond F. Cardillo
Registration No. 40,440

Customer Number
22850
(703) 413-3000 (phone)
(703) 413-2220 (fax)

I:\ATTY\STD\21'S\213857US\213857US.SHT PTO CVR.DOC

COPY

BEST AVAILABLE COPY

OIPE JC177 JUN 2 1 2004 PATENT & TRADEMARK OFFICE

DOCKET NO: 213857US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
TATSUYA MATSUMURA, ET AL.	: EXAMINER: LAO, LUN YI
SERIAL NO: 09/956,014	:
FILED: SEPTEMBER 20, 2001	: GROUP ART UNIT: 2673
FOR: A DISPLAY APPARATUS AND DRIVING METHOD THEREFOR	:

PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Petition pursuant to 37 CFR §1.181(a)(3) requesting that the examiner be provided the Application file in order to supply Applicants a copy of the below noted Form PTO-1449 that indicates consideration of the references listed thereon.

STATEMENT OF FACTS

On January 23, 2004, Information Disclosure Statement (IDS) papers were filed that included a Form PTO-1449 listing three references for consideration as documented by the attached copy of these IDS papers including Form PTO-1449 and the associated date-stamped mail room filing receipt.

Upon review of this Application after the allowance thereof, it was noted that there was no indication of receipt or consideration of the Form PTO-1449 listed three references.

COPY

BEST AVAILABLE COPY

ACTION REQUESTED

It is respectfully requested that the Examiner be supplied with the application file so that he can provide Applicants a copy of the above-noted Form PTO-1449 indicating proper consideration of the listed three references.

As the above-identified application has already been allowed, an early response to this Petition is hereby respectfully requested.

Respectfully submitted,

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

Gregory J. Maier
Attorney of Record
Registration No. 25,599

Raymond F. Cardillo
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

GJM/RFC/STD/kke

I:\ATTY\STD\21'S\213857US\213857.AM1.181_REVISED051004.DOC

COPY

BEST AVAILABLE COPY

OIPE JC177
JUN 2 1 2004
PATENT & TRADEMARK OFFICE

[redacted]

Dept.: E/M

OSMM&N File No. 213857US2

By: GJM/RFC/STD/mac

Serial No. 09/956,014

In the matter of the Application of: Tatsuya MATSUMURA, et al.

For: A DISPLAY APPARATUS AND DRIVING METHOD THEREFOR

Due Date: January 23, 2004

The following has been received in the U.S. Patent Office on the date stamped hereon:

- ■ Check for $770.00
- ■ Dep. Acct. Order Form
- ■ Information Disclosure Statement
- ■ PTO-1449
- ■ Request for Continued Examination (RCE) Transmittal
- ■ Japanese Office Action dated November 4, 2003 (with Partial Translation)
- ■ Cited References 3

OIPE JC177
JAN 2 3 2004
PATENT & TRADEMARK OFFICE

I:\ATTY\STD\21'S\213857US\213857US.FR.DOC

COPY

BEST AVAILABLE COPY

OIPE JC177
JUN 2 1 2004
PATENT & TRADEMARK OFFICE

Docket No. 213857US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Tatsuya MATSUMURA, et al.

SERIAL NO: 09/956,014 GAU: 2673

RCE FILED: Herewith EXAMINER: L. Y. LAO

FOR: A DISPLAY APPARATUS AND DRIVING METHOD THEREFOR

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Linked to OPTMS
1/26/04 DATE
213857US CASE ID

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

REFERENCES

■ The applicant(s) wish to make of record the references cited in the attached Japanese Office Action, listed on the attached form PTO-1449. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.

☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

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

☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

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

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

DEPOSIT ACCOUNT

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

Respectfully submitted,

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

Gregory J. Maier
Registration No. 25,599

Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

COPY

I:\ATTY\STD\21'S\213857US\213857US.IDS.DOC

BEST AVAILABLE COPY

OIPE JC177
JUN 2 1 2004
PATENT & TRADEMARK OFFICE

Form PTO 1449 (Modified)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF REFERENCES CITED BY APPLICANT

ATTY DOCKET NO.	SERIAL NO.
213857US2	09/956,014
APPLICANT	
Tatsuya MATSUMURA, et al.	
RCE FILING DATE	GROUP
Herewith	2673

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION YES	TRANSLATION NO
	AO	64-10299	1-13-1989	Japan (w/ Partial Translation)		
	AP	3-174186	7-29-1991	Japan (w/ Partial Translation)		
	AQ	11-271710	10-8-1999	Japan (Corresponds to U.S. Pat. No. 6,219,017)		
	AR					
	AS					
	AT					
	AU					
	AV					

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

	AW	
	AX	
	AY	
	AZ	

☐ Additional References sheet(s) attached

Examiner | Date Considered

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

I:\ATTY\STD\21'S\213857US\213857US.1449.DOC

COPY

Linked to OPTMS
1/26/04 — DATE
213857US — CASE ID

PETD

OIPE JC177
JUN 2 1 2004
PATENT & TRADEMARK OFFICE

BEST AVAILABLE COPY

Dept.: E/M

OSMM&N File No. 213857US2 By: GJM/RFC/STD/kke

Serial No. 09/956,014

In the matter of the Application of: Tatsuya MATSUMURA, et al.

For: A DISPLAY APPARATUS AND DRIVING METHOD THEREFOR

Due Date: N/A

The following has been received in the U.S. Patent Office on the date stamped hereon:

- Dep. Acct. Order Form
- Petition Under 37 C.F.R. § 1.181
- PTO Cover Letter
- Copies of an Information Disclosure Statement, PTO-1449, & Filing Receipt (All filed on January 23, 2004)

I:\ATTY\STD\21'S\213857US\213857US.FR2.DOC

OIPE JC26
MAY 1 2 2004
PATENT & TRADEMARK OFFICE

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

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

COPY MAILED

AUG 2 3 2005

OFFICE OF PETITIONS

In re Patent of :
Akutsu et al. :
Patent No. 6,797,769 :
Issued: September 28, 2004 : ON PETITION
For: ELECTRODEPOSITING SOLUTION :
FOR LOW-POTENTIAL :
ELECTRODEPOSITION AND :
ELECTRODEPOSITION METHOD USING :
THE SAME :

This is a decision on the Petition, filed January 28, 2005, under 37 CFR 1.183, for waiver of 37 CFR 3.81(a), to correct the name of the assignee in the above-identified patent. The petition is properly treated as a request under 37 CFR 3.81(b)[1].

The Petition is **granted**.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

The application is being referred to the Certificate of Corrections Branch for issuance of the requested Certificate of Correction, filed November 29, 2004.

Derek L. Woods
Petitions Attorney
Office of Petitions

[1] See, 1283 OG 148 22 June 2004, 69 Fed. Reg. 29865 26 May 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

COPY MAILED

MAR 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Raymond Kwong :
Application No. 09/956,032 : NOTICE
Filed: September 20, 2001 :
Attorney Docket No. 10052/1901 :

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 1774.

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. 8

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON DC 20005

COPY MAILED

FEB 13 2003

OFFICE OF PETITIONS

In re Application of
Stephen R. Forrest et al
Application No. 09/956,085
Filed: September 20, 2001
Attorney Docket No. 10020/18902

NOTICE

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

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

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

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney and change in correspondence address documentation must be submitted. A courtesy copy of this notice is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 2876.

Wan Laymon

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

cc: KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

UNITED STATES 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

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

COPY MAILED

OCT 3 1 2003

OFFICE OF PETITIONS

In re Application of
Kalun Choi
Application No. 09/956,114
Filed: September 20, 2001
Attorney Docket No. 1875.1060001

ON PETITION

This is a decision on the petition, filed by facsimile transmission on October 30, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 9, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2816 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 18

Date : October 31, 2003

TO : Director, Office of Publication and Dissemination

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Kalun Choi
Application No. : 09/956,114
Filed : September 20, 2001

The above-identified application has been assigned Patent No. 6,642,753 and an issue date of November 4, 2003.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of November 4, 2003:

"All reference to Patent No. 6,642,753 to Kalun Choi of California for HIGH-SWING TRANSCONDUCTANCE AMPLIFIER appearing in the Official Gazette of November 4, 2003 should be deleted since no patent was granted."

Karen Creasy

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

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis, P/OCS, CM1-6A07
Tamara Greene, Crystal Park 3-908

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

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209

MAILED

AUG 0 5 2003

Technology Center 2100

In re Application of: Heung-For CHENG, et al.)
Application No. 09/956,115)
Filed: September 20, 2001) **DECISION ON REQUEST FOR**
For: SYSTEM AND METHOD FOR) **WITHDRAWAL AS ATTORNEY**
INTERFACING TO DIFFERENT)
IMPLEMENTATIONS OF THE)
INTELLIGENT PLATFORM)
MANAGEMENT INTERFACE)

This is a decision on the Request To Withdraw from Representation filed July 21, 2003.

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

The request is **GRANTED**.

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

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

cc: Kenyon & Kenyon
1500 K Street, N.W.
Suite 700
Washington, DC 20005-1257

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 4

NOV - 3 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

SMART & BIGGAR
P.O. Box 2999, Station D
55 Metcalfe Street, Suite 900
Ottawa, Canada K1P5Y-6

In re Application of
Thomas M.W. BOTTOMLEY
Application No. 09/956,130
Filed: September 20, 2001
For: METHOD OF BYTE CODE QUICKENING: QUICK INSTRUCTIONS FOR METHOD INVOCATION

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Reprsentation filed October 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.**

There is no indication that Applicant has been notified of the request for withdrawal. Accordingly, the request is **DENIED**.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

MAIL

MAR 2 9 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

SMART & BIGGAR
P.O. Box 2999, Station D
55 Metcalfe Street, Suite 900
Ottawa, Canada K1P5Y-6

In re Application of:
Thomas M. W. BOTTOMLEY
Application No. 09/956,130
Filed: September 20, 2001
For: METHOD OF BYTE CODE QUICKENING: QUICK INSTRUCTIONS FOR METHOD INVOCATION

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed March 17, 2004.

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

The request 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: ZUCOTTO WIRELESS INC.
16644 West Bernardo Drive
Suite 301
San Diego, CA 92127

#10
DW

UNITED STATES 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 23 2004

MAILED

JUN 23 2004

OFFICE OF THE DIRECTOR
TC 3600

Antonelli, Terry, Stout & Kraus, LLP
1300 North Seventeenth street
Suite 1800
Arlington, VA 22209-9889

In re Application of :
Minoru Soraoka et al. :
Application No. 09/956,137 :
Filed: September 20, 2001 :
For: VACUUM PROCESSING APPARATUS :
AND SEMICONDUCTOR MANUFACTURING
LINE USING THE SAME

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the petition to withdrawal the holding of abandonment filed on February 20, 2004 in the United States Patent and Trademark Office.

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

☐ Postcard receipt being dated_____.

☒ USPTO return facsimile receipt dated December 3, 2003 which identifies the application by serial number and the type of Response that was filed on that date.

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

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

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

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

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Response filed with the petition, then to the examiner for prompt action on the response.

KJD/vdb: 6/22/04

KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

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)
6,632,125	2003-10-14	09/956,150	2001-09-20	4443/0456PUS1

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	/Joe McKinney Muncy/	Date (YYYY-MM-DD)	2009-02-19
Name	Joe McKinney Muncy	Registration Number	32334

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. 6632125
Issue Date: October 14,2003
Application No. 09956150
Filed: September 20,2001
Attorney Docket No. BHT-3167-16

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

This is a decision on the electronic petition, filed February 19,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 19,2009 . 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

COPY MAILED

APR 2 2 2009

OFFICE OF PETITIONS

DOUGHERTY & TROXELL
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH VA 22041

In re Patent No. 6,632,125	:
Issue Date: October 14, 2003	:
Application No. 09/956,150	: DECISION ON REQUEST FOR REFUND
Filed: September 20, 2001	: AND STATUS UNDER 37 CFR 1.27
Attorney Docket No. BHT-3167-16	:

This is a decision on the request for refund and the claim of small entity status under 37 CFR 1.27, filed March 19, 2009.

The request is **GRANTED**.

As authorized, the $490.00 large entity portion of the maintenance fee has been credited to petitioner's credit card account as requested.

Additionally, small entity status has been accorded.

There is no indication that the person signing the request was ever given a power of attorney in the above application. If the person signing the request desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the request, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

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

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

MUNCY, GEISSLER, OLDS & LOWE, PLLC
PO BOX 1364
FAIRFAX, VA 22038-1364

#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

MAILED

MAY 13 2004

TECHNOLOGY CENTER 2100

Paper No. 5

Gray Cary Ware & Freidenrich LLP
1221 South MoPac Expressway
Suite 400
Austin, TX 78746-6875

In re Application of:
George W. HINDMAN
Application No. 09/956,182
Filed: September 19, 2001
For: APPARATUS AND METHOD FOR A MOBILE NAVIGATION COMPUTER

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition, filed 26 March 2004, under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The petition is **GRANTED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

> A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:
>
> (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);
>
> (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
>
> (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
>
> (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
>
> (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

> In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submissions of 26 March 2004 meet all the criteria set out above. Accordingly, the petition is **GRANTED**. The application file is being forwarded to the Examiner for accelerated examination in accordance with M.P.E.P. § 708.02. If the application is subsequently allowed, it will be given priority for printing. See M.P.E.P. § 1309.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

COPY MAILED

APR 28 2005

OFFICE OF PETITIONS

In re Application of :
Lesker L. Bertrand :
Application No. 09/956,195 :
Filed: September 19, 2001 :
Attorney Docket No. 005849.000002 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 11, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Receipt is acknowledged of the Request for Continued Examination (RCE) and Amendment filed August 11, 2004, with the instant petition.

The Change of Correspondence Address has been accepted and recorded.

In view of the submission of the petition fee in the small entity amount of $665, 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 3700, Art Unit 3711 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

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

In re Application of SO-YOUNG IM	:
	: DECISION GRANTING PETITION
Application No. 09/956,239	: TO REMAIL AN OFFICE
Filed: September 20, 2001	: COMMUNICATION AND RESTART
Attorney Docket No. P56565	: PERIOD FOR REPLY

This is a decision on the petition filed on January 16, 2002, requesting that the Office communication mailed on October 19, 2001 be remailed and the shortened statutory period for reply set forth in the Office communication be restarted on the new mail date.

The petition is granted.

Petitioner provided a statement that the Office communication in question was received at the correspondence address of record on January 14, 2002. The petition was filed within two weeks of receipt of the Office communication. A substantial portion of the reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed.

Accordingly, the Office communication in question will be remailed and the period for reply that was originally set forth in the Office communication will be restarted to run from the new mail date of the Office communication.

Kevin Little

Kevin Little
Office of Initial Patent Examination
(703) 308-1863

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED
AUG 3 0 2004
OFFICE OF PETITIONS

In re Application of	:	
Geoffrey Ryding	:	
Application No. 09/956,247	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. 003373	:	

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the nonfinal Office action mailed August 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 above-identified application became abandoned on November 20, 2003.

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 $950 extension of time submitted with the petition on May 17, 2004 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

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

The application file is being referred to Technology Center AU 1475.

Karen Creasy

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

cc:

BIRCH, STEWART, KOLASCH & BIRCH, LLP
MICHAEL K. MUTTER
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATRICK G. BURNS
GREER, BURNS & CRAIN
300 SOUTH WACKER DR
SUITE 2500
CHICAGO, IL 60606

COPY MAILED

SEP 2 2 2005

OFFICE OF PETITIONS

In re Patent No. 6,940,579	:	
Issue Date: September 6, 2005	:	
Application No. 09/956,267	:	ON PETITION
Filed: September 19, 2001	:	
Attorney Docket No. 1324.65845	:	

This is a decision on the petition under 37 CFR 1.183, filed August 24, 2005, which is being treated as a petition under 37 CFR 3.81(b)[1] to correct the assignees on the front page of the above-identified patent.

The petition is **dismissed**.

Applicants request that the patent issue to **Sharp Kabushiki Kaisha, Osaka, Japan** should be listed on the front page of this patent.

37 CFR 3.81(b), effective June 25, 2004, reads:

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

A review of the official file indicates that the instant request was not accompanied by a request for a certificate of correction as required by 3.81(b). Accordingly, the petition cannot be granted.

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 Sharp Kabushiki Kaisha, Osaka, Japan was the assignee of record at the time of issuance of the instant application into a patent. *Note also* 35 U.S.C. § 152.

In view of the above, **the Certificates of Correction Branch is instructed to issue a certificate of correction upon submission by petitioner of a request for a certificate of correction which sets forth Sharp Kabushiki Kaisha as the assignee**. No certificate of correction will be issued which sets forth an assignee other than the assignees set forth in the instant request. A copy of this decision ***must*** accompany the request for a Certificate of Correction.

---

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

This matter is being referred to Files Repository.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3220. After the submission of the request for a certificate of correction to correct the assignee data on the front page of the Letters Patent, any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Wan Laymon

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE, 46TH FLOOR
PHILADELPHIA, PA 19103

COPY MAILED
MAY 0 5 2006
OFFICE OF PETITIONS

In re Application of	:	
Contractor, Sunil H.	:	DECISION ON PETITION
Application No. 09/956,289	:	TO WITHDRAW
Filed: September 19, 2001	:	FROM RECORD
Attorney Docket No. BELL-0108/01063	:	

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 9, 2005.

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

A review of the file record indicates that the power of attorney to the attorneys associated with Customer Number 38952 has been revoked by the assignee of the entire interest of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at 571-272- 3206.

David Bucci
Petitions Examiner
Office of Petitions

cc: LEE & HAYES, PLLC
421 W. RIVERSIDE AVE.
SUITE 500
SPOKANE WA 99201

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5-4-05

TO SPE OF : ART UNIT 1744

SUBJECT : Request for Certificate of Correction on Patent No.: 6832409

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.

Check claims

BEST AVAILABLE COPY

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:

Change to claim 1 denied. Squeeze on line 6 not 5
Claims 2 + 3 should be left as is. See MPEP 608.01(n)
no line # given in claim 3 to add "an" ~~before~~ after "including"
Change to claim 3, line 3 does not match w patent
Change to claim 14, line 3 OK

SPE

1744
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

PTO/SB/44 (04-04)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,832,409

DATED : December 21, 2004

INVENTOR(S) : Morgan et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In claim 1, line ~~5~~ 6 "squeeze" should read "squeegee".

Claim 2 should be renumbered as claim 3.

Claim 3 should be renumbered as claim 2.

no MPEP 608.01(h)

In claim 3, line ~~"an"~~ 7 "an" should be inserted after "including".

In claim 3, line 3, "and said nozzle assembly off of said surface or lowers said nozzle assembly" should be inserted after "said brush assembly". D.N. match

In claim 14, line 3, "whe l" should read "wheel". OK

MAILING ADDRESS OF SENDER:

The Hoover Company
101 E. Maple Street
N. Canton, OH 44720

PATENT NO. 6,832,409

No. of additional copies

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

M. Corrigan
330 499-9200 x 2930

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN TX 78729

COPY MAILED

APR 07 2009

OFFICE OF PETITIONS

In re Application of :
John Vaglica :
Application No. 09/956,300 : ON PETITION
Filed: September 19, 2001 :
Attorney Docket No. **SC11372TH** :

This is a decision on the petition filed March 18, 2009 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned March 5, 2009 for failure to timely pay the issue fee on or before March 4, 2009. The instant petition was filed prior to the mailing of the Notice of Abandonment was mailed March 24, 2009.

The issue fee in the amount of $1510.00, petition fee in the amount of $1620.00 and publication fee in the amount of $300 have been charged to petitioner's deposit account no. 50-3079, as authorized. All other requirements of 37 CFR 1.137(b) having now been met, this matter is being referred to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20091118

DATE : November 18, 2009

TO SPE OF : ART UNIT 2617

SUBJECT : Request for Certificate of Correction on Patent No.: 6,975,288

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:

Applicant's request for certificate of correction due to Office mistakes is not entirely accurate. Applicant's appear to request to replace the entire specification and drawings without indication of what the errors are or an indication of what is being altered.

/LunYi Lao/
Supervisory Patent Examiner.Art Unit 2617

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02-25-10

TO SPE OF : ART UNIT 2617

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/956305 Patent No.: 6975288

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: _____

RICHARD HUERPE
SUPERVISORY PATENT EXAMINER

SPE **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

Date Mailed : December 5, 2009

Patent No. :6975288
Inventor : Michiyo Nishimura et al.
Patent Issued :Decemgber 13, 2005
Title :METHOD OF DRIVING IMAGE-FORMING APPARATUS AND APPARATUS THEREOF

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 37 CFR 1.322 and 1.323.

Accordingly, applicants request is denied due to non-compliance with filing requirements in regard to formatting procedures for requesting corrections to the Letters Patent. To have proposed changes further considered, applicant may resubmit a request under 37 CFR 1.322 and/or 1.323 which clearly identifies on the PTO-1050 form the point of reference as presented in the printed patent by use of column and line numbers as well as directives e.g. add, delete. For more detailed instructions concerning formatting and procedures for requesting corrections under 37 CFR 1.322/1.323 see MPEP 1485.

Further correspondence concerning this matter should be filed and directed to Decisions & Certificate of Correction Branch. Any telephone inquiry concerning this communication should be directed to Ms. A. Green at (703) 756-1541

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756- 1544

Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, New York 10112-3801

/arg

UNITED STATES 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 8 - 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

Jacques M. Dulin ESQ
INNOVATION LAW GROUP LTD
271 S. 7TH AVENUE STE 24
SEQUIM WA 98382

In re Application of
RON VAN OSI

Application No. 09956373
Filed: September 17, 2001
For: FAST, AUTO-CROPPING, BI-DIRECTIONAL MULT-RESOLUTION SCANNER APPARATUS, SYSTEM AND SOFTWARE THEREFOR

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on March 31, 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 met all of the above. Accordingly, the request is **GRANTED**.

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
(571) 272-2986

CC: DIANE VAN OS
PATENT ADMINISTRATOR, VISIONEER INC.
8016 SOUTH DEERCREEK CANYON ROAD
MORRISON CO ~~80465~~-9530
80465

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DORSEY & WHITNEY LLP
555 CALIFORNIA STREET, SUITE 1000
SUITE 1000
SAN FRANCISCO CA 94104

COPY MAILED
NOV 17 2006
OFFICE OF PETITIONS

In re Application of :
Os et al. :
Application No. 09/956,373 : ON PETITION
Filed: September 17, 2001 :
Attorney Docket Number: 7106-002 REG US

This is a decision on the petition under 37 CFR 1.137(b), filed September 18, 2006, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply to the non-final Office Action of March 22, 2005. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on June 23, 2005. A Notice of Abandonment was mailed on August 9, 2006.

This petition is hereby **Granted**.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of Continuation Application No. 11/532,022.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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

JOHN L. DEANGELIS, JR.
HOLLAND & KNIGHT, LLP
SUITE 201
1499 S. HARBOR CITY BLVD.
MELBOURNE, FL 32901

COPY MAILED

AUG 0 5 2002

OFFICE OF PETITIONS

In re Application of :
Chaudhry, et al. :
Application No. 09/956,382 :
Filed: September 18, 2001 :
Attorney Docket No. Chaudhry 12-6-4-3-3 :

ON PETITION

This is a decision on the papers styled, "Petition And Response To Notice Of Omitted Item(s) In A Nonprovisional Application," filed on April 1, 2002, which is being treated as a petition under 37 CFR 1.53, requesting that the above-identified application be accorded a filing date of September 18, 2002, including Figures 1I and 1J as described in the specification.

The application was filed on September 18, 2001. On October 19, 2001, the Office of Initial Patent Examination (OIPE) mailed a "Notice To File Corrected Application Papers," requesting substitute drawings in compliance with 37 CFR 1.84. In response, on February 1, 2002, Petitioner filed formal drawings. However, on March 6, 2002, OIPE mailed a "Notice Of Omitted Item(s) In A Nonprovisional Application" that stated the application had been accorded a filing date, but Figures 1I and 1J as described in the specification appear to have been omitted.

In response, on April 1, 2002, the instant petition and a copy of Figures 1I and 1J as described in the specification were submitted. The papers were accompanied by a copy of applicant's postcard receipt that acknowledges receipt of eight (8) sheets of formal drawings on February 1, 2002. The eight (8) sheets of formal drawings contain Figures 1-2, with the fourth sheet of formal drawings containing Figures 1I and 1J. A review of the application file indicates the presence of only seven (7) sheets

of formal drawings with the fourth sheet containing Figures 1I and 1J missing. It is assumed that the fourth sheet of formal drawings containing Figures 1I and 1J was misplaced by the Office.

In view of the above, the petition is granted.

The $130.00 petition fee submitted on April 1, 2002 will be refunded to deposit account no. 50-1790.

This application will be returned to OIPE for further processing with a filing date of September 18, 2001, using the copy of Figures 1I and 1J as described in the specification, supplied on April 1, 2002.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Edward Tannouse at (703) 306-9200.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FENWICK & WEST LLP
TWO PALO ALTO SQUARE
PALO ALTO CA 94306

Paper No. 5

MAIL

MAY 2 8 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:)
Pankaj Parekh, et al)
Application No.: 09/956,394)
Filed: September 18, 2001)
For: UNIVERSAL APPLICATION DECODE ENGINE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw As Attorneys filed April 22, 2002.

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

The request is **GRANTED**.

The following attorneys have been withdrawn from the record: Greg T. Sueoka and Laura Majerus, leaving no attorneys remaining in the application.

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

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

cc: Pankaj Parekh
Ipolicy Networks, Inc.
47467 Fremont Boulevard
Fremont, California 94538

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DAVID P. RITCHIE
THELEN REID & PRIEST LLP
P O BOX 640640
SAN JOSE, CA 95164-0640

COPY MAILED

AUG 2 2 2006

OFFICE OF PETITIONS

In re Application of	:	
Pankaj Parekh et al	:	
Application No. 09/956,394	:	DECISION GRANTING PETITION
Filed: September 18, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. IPOL-0014	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 30, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely pay the issue fee on or before August 3, 2005, as required by the Notice of Allowance and Fee(s) Due mailed May 3, 2005. The Notice of Allowability mailed also on May 3, 2005 required the submission of a substitute oath or decision since there was no indication that the oath or declaration required by the Notice to File Missing Parts of Nonprovisional Application, mailed on October 19, 2001 was ever received. In view thereof, it appears that this application became abandoned at an earlier time for failure to timely submit an executed oath or declaration as required by the Notice of October 19, 2001. Therefore, the actual date of abandonment of this application is December 20, 2001.

All of the outstanding requirements for a grantable petition under 37 CFR 1.137(b) have now been satisfied; that is, the reply required by the Notice of October 19, 2001, the issue fee payment of $1,400, the petition fee of $1,500, and the required statement of unintentional delay. Accordingly, the replies to the Notices of October 19, 2001 and May 3, 2005 are 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 or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to

Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

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

The application file is being referred to Publishing Division.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

WILSON & HAM
PMB: 348
2530 BERRYESSA ROAD
SAN JOSE, CA 95132

COPY MAILED

OCT 0 1 2004

OFFICE OF PETITIONS

In re Application of :
In Kwon Jeong :
Application No. 09/956,451 : ON PETITION
Filed: September 18, 2001 :
Attorney Docket No. ORL-008 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 6, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 28, 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 July 29, 2003.

The Revocation of Power of Attorney filed with the present petition is not accepted since it is from an assignee and the Certificate required by 37 CFR 3.73(b) has not been received. 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. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of record until such time as appropriate Power of Attorney documentations are received to the contrary. A blank 37 CFR 3.73(b) accompanies this decision.

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

The application is being forwarded to Technology Center AU 1765 for further processing.

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

cc:

Song K. Jung
McKenna Long & Aldridge LLP
1900 K Street
Washington, DC 20006

Attachment: Statement Under 37 CFR 3.73(b)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

DEC - 9 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

PILLSBURY WINTHROP LLP
11682 El Camino Real
Suite 200
San Diego, CA 92130-2092

In re Application of:
Bryce NAKATANI
Application No. 09/956,452
Filed: September 18, 2001
For: INTERNET BROADCAST AND LOCATION TRACKING METHOD AND APPARATUS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed October 13, 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**.

Because there was no request for a correspondence address change, all future communications from the U.S. Patent and Trademark Office (Office) ***will continue to be addressed*** to the above-mentioned address until further notice. Applicant is reminded of the obligation to provide the Office with any change of correspondence address to ensure receipt of all correspondence.

For Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

MAIL

FEB 02 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re application of:
Carlos Avendano, et al.
Application No. 09/956,476
Filed: September 17, 2001
For: SYSTEM FOR SUPPRESSING ACOUSTIC ECHOES AND INTERFERENCES IN MULTI-CHANNEL AUDIO SYSTEMS

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 October 04, 2004

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

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

All of the attorneys/agents listed in the Request 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: Schwegman, Lundberg, Woessner & Kluth, P.A.
121 South Eighth Street
Suite 1600
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

Paper No.

Alan S. Hodes
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

MAILED

DEC 0 6 2004

Technology Center 2100

In re Application of:
Iraklis Kourtidis
Application No. 09/956,511
Filed: September 17, 2001
For: ON-DEMAND RESOURCE EDITOR FOR DYNAMICALLY GENERATED WEB PAGE DOCUMENTS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed July 16, 2002.

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

The request filed July 16, 2002 meets all the requirements. Accordingly the request is **GRANTED**.

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

James R. Matthews

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

cc: CMA Business Credit Services
40 E. Verdugo Avenue
Burbank, CA 91510-7740

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#12

MAILED

FEB 04 2004

Office of the Director
Group 3600

RIGDON PATENTS & ENGINEERING
1306 GLOUCESTER STREET
BRUNSWICK, GA 31520-7056

Paper No. 12

In re Application of
Lewis D. Rubin
Application No. 09/956,526
Filed: September 19, 2001
For: FLOOD WATER CONTAINMENT BAG

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office on July 2, 2003. The delay in deciding this petition is regretted.

The petition is **DENIED**.

A review of the file record indicates that the application was held abandoned for failure to timely respond to the Office communication dated September 18, 2002, and a notice to that effect was mailed on June 27, 2003.

A proper reply under 37 CFR 1.113 to a final rejection consists of: (1) a timely filed amendment which places the application in a condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

The request to reconsider filed on March 18, 2003 was timely filed; however, the response did not place the case in a condition for allowance. The Notice of Appeal filed on April 18, 2003 was not timely filed since the statutory response period had expired on March 18, 2003 and the case held abandoned. The telephone conversation with the examiner on April 15, 2003 regarding the filing of a Notice of Appeal is a moot point since the statutory response period had already expired.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $110. The fee for a petition under the unintentional standard is $1,330. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Deputy Commissioner of Patent Examination Policy
Box DAC
Washington, D.C. 20231

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

By Hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

DJD/mjz 1/30/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

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

COPY MAILED

JUL 0 8 2004

OFFICE OF PETITIONS

In re Application of
Wesley D. Sterman et al
Application No. 09/956,547
Filed: September 19, 2001
Attorney Docket No. HRT-272

: 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 December 17, 2003, 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.

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 for Application Nos. 09/482,306, 08/933,634 and 08/281,891, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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

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

---

[1] *Note* 37 CFR 1.121

By hand: Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

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

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.16

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

COPY MAILED

AUG 0 4 2004

OFFICE OF PETITIONS

In re Application of
Wesley D. Sterman et al
Application No. 09/956,547
Filed: September 19, 2001
Attorney Docket No. HRT-272

: 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 July 15, 2004 and supplemented on July 26, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant pending application was filed on September 19, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisionals 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 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.

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

This application is being referred to Technology Center Art Unit 3738 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

Karen Creasy

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

MORRISON & FOERSTER LLP
2000 Pennsylvania Ave, NW
Suite 5500
Washington, DC 20006-1888

JUL 12 2002

In re Application of	)	
NAKATANI et al.	)	
Application No. 09/956,551	)	DECISION ON PETITION
Filed: September 20, 2001	)	TO MAKE SPECIAL
For: Printed Circuit Board and Method	)	
Manufacturing the Same	)	

This is a decision on the petition under 37 C.F.R. § 1.102, filed September 20, 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, Item VIII: Accelerated Examination.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Item VIII, must include (A) the fee set forth in 37 CFR 1.17(i), (B) claims limited to a single invention, (C) a statement that a pre-examination search was made, (D) one copy each of the references deemed most closely related to the subject matter encompassed by the claims, and (E) a detailed discussion of the references pointing out how the claimed subject matter is patentable over the references.

The petition includes items (A), (C), (D) and (E) above, along with a statement by the petitioner that (B) the claims are directed to a single invention.

Accordingly, the petition is **GRANTED**.

The petition being granted, prosecution will proceed in accordance with the special examining procedure specified in M.P.E.P. § 708.02, Item VIII. After allowance, this application will be given priority for printing. See M.P.E.P. § 1309.

Henry Phan

Hien H. Phan, 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
WASHINGTON, DC 20231
www.uspto.gov

OPPENHEIMER WOLFF & DONNELLY LLP
9663 SANTA MONICA BOULEVARD, SUITE 276
BEVERLY HILLS, CA 90210

MAILED Paper No. 7

FEB 13 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Stephanie Ebrami
Application No. 09/956,569
Filed: September 18, 2001
For: **SYSTEM AND METHOD FOR ACQUIRING AND TRANSMITTING ENVIRONMENTAL INFORMATION**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the Petition filed December 16, 2002, under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111(b) and (c), how the claimed subject matter is patentable over the references.

The petition 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. After mailing, the application will be forwarded to the examiner for immediate handling.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(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

Melissa A. Shaw
Senior Patent Counsel
Bayer Corporation
800 Dwight Way
Berkeley, CA 94710

COPY MAILED

APR 29 2005

OFFICE OF PETITIONS

In re Application of :
Myung-Sam Cho, et al. :
Application No. 09/956,576 : ON PETITION
Filed: September 18, 2001 :
Attorney Docket No. MSB-7270 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 8, 2005, to revive the above-identified application.

The petition is **GRANTED**.

A Notice of Non-Responsive Amendment was mailed to applicant on August 23, 2004, which set a one (1) month or thirty-days, whichever is longer, period for reply. As no reply was received and no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on September 24, 2004.

Since the application became abandoned, applicant filed the instant petition and a proposed reply, namely, an amendment. Receipt of the amendment is acknowledged.

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

The application file is being referred to Technology Center 1600.

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

Paper 7

MUNSCH, HARDT, KOPF & HARR, P.C.
INTELLECTUAL PROPERTY DOCKET CLERK
1445 ROSS AVENUE, SUITE 4000
DALLAS TX 75202-2790

COPY MAILED

OCT 07 2004

OFFICE OF PETITIONS

In re Application of
James H. Sturges et al.
Application No. 09/956,602
Filed: September 19, 2001
Attorney Docket No. 5456.2-3

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This decision is in response to the petition filed April 23, 2002, under 37 CFR 1.47(a), in response to the Notice to File Missing Parts "Notice" mailed October 23, 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 September 19, 2001, naming James H. Sturges and Owen J. Palmer but without a signed declaration. Accordingly, on October 23, 2001, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

In response, on April 23, 2002, the present petition was filed with a request for a four month extension and the oath and declaration signed by inventor James H. Sturges only. Petitioners seek status under 37 CFR 1.47(a) based on the fact that telephone conversations were had with joint inventor Palmer and that he expressly refused to execute the oath or declaration. Petitioner claims that they have put forth diligent efforts to have the oath or declaration executed and that Mr. Palmer has refued 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 statements made by Shelley Sturgis and James H. Sturges reveal that the declaration was sent to Mr. Palmer electronically and via FedEx, but don't indicate that the complete application was ever sent to Mr. Palmer. Thus, there is no evidence to show that Mr. Palmer 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 (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. 15

GEAM – SILICONES – 60SI
IP LEGAL
ONE PLASTICS AVENUE
PITTSFIELD, MA 01201-3697

COPY MAILED

MAR 29 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Richard Cruse et al	:	
Application No. 09/956,650	:	
Filed: September 19, 2001	:	
Attorney Docket No. 0093-OS	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 21, 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 April 18, 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 July 19, 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 (571) 272-3210.

This file is being forwarded to Technology Center AU 1713 for further processing.

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

cc:

Adrian T. Calderone
Dilworth & Barrese, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MOMENTIVE PERFORMANCE MATERIALS INC.
IP LEGAL
ONE PLASTICS AVENUE, BLDG. 51
PITTSFIELD, MA 01201-3697

COPY MAILED

OCT 01 2007

OFFICE OF PETITIONS

In re Application of	:	
Richard W. Cruse et al	:	
Application No. 09/956,650	:	ON PETITION
Filed: September 19, 2001	:	
Attorney Docket No. 0093-OS	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 11, 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 Office action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), mailed November 30, 2006, 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 January 31, 2007.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

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

This matter is being referred to Technology Center AU 1713 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Adrian T. Calderone
Dilworth & Barrese, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

UNITED STATES 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 10 2005

OFFICE OF PETITIONS

TREXLER BUSHNELL GIANGIORGI
BLACKSTONE & MARR, LTD
105 W. ADAMS STREET, SUITE 3600
CHICAGO, IL 60603

In re Application of	:	
Daniel John Smith et al	:	
Application No. 09/956,723	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. 1171/39624/92-CIP		

This is a decision on the petition, filed February 9, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on June 3, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter will be forwarded to Technology Center AU 3761 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

Todd M. Becker
BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

MAILED

AUG 0 7 2006

Technology Center 2100

In re Application of:
Chun et al.
Application No. 09/956,730
Filed: September 19, 2001
For: INTELLIGENT SECURE DATA MANIPULATION APPARATUS AND METHOD

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed May 30, 2006.

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.

Michelle R. Eason

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
The Chase Building
700 Lavaca, Suite 800
Austin, Texas 78701-3102

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Meyertons, Hood, Kivlin, Kowert, Goetzel/Symantec
P.O. Box 398
Austin TX 78767-0398

COPY MAILED

DEC 2 2 2009

OFFICE OF PETITIONS

In re Application of	:	
Jon Andre Chun, et al.	:	
Application No. 09/956,730	:	DECISION GRANTING PETITION
Filed: September 19, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 6002-03405	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, December 15, 2009 to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on June 19, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 2432 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Terri Johnson
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

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE WA 98101-2347

COPY MAILED

NOV 25 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Jeffrey A. Hermanson :
Application No. 09/956,745 :
Filed: September 17, 2001 :
Attorney Docket No. ACDT117528 :

This is a decision on the petition filed December 10, 2004 to withdraw the holding of abandonment under 37 CFR 1.181.

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

This application became abandoned March 20, 2004 for failure to timely pay the issue fee in response to the Notice of Allowance mailed December 19, 2003. Accordingly, a Notice of Abandonment was mailed May 6, 2004.

Petitioner claims that the Notice of Allowance mailed December 19, 2003 and the Notice of Abandonment mailed May 6, 2004 were never received. Petitioners provide proof that a power of attorney, with a request for an address change, was filed by the Assignee on July 25, 2003, prior to the mailing of the Notice of Allowance on November 4, 2003 and argue therefore that the USPTO records were not updated to reflect the address change.

The file record discloses that the Notices were mailed to the address of record which is the same address used on all correspondences from the USPTO. Petitioner has provided a copy of the docket report and file jacket, wherein receipt of the Notices mailed December 19, 2003 and May 6, 2004 would have been filed, had it been received.

In that the statement from the petitioner and the exhibit from the docket record and file jacket for the instant matter show no entry indicating receipt of the Notices mailed December 19, 2003 and May 6, 2004 , it is apparent that they were not received.

The evidence submitted corroborates non-receipt of the Notice of Allowance and the Notice of Abandonment. Accordingly, the holding of abandonment is withdrawn.

Please note however, that the filing of a continuation application, specifically, application no. 11/009,356 on December 10, 2004 cannot serve as a response to the Notice of Allowance. Only the payment of the issue fee due can serve as the response to a Notice of Allowance.

This matter is being referred to the Office of Publications for a re-mailing of the Notice of Allowance after which time the issue fee must be paid.

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

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.
09/956,747	09/17/2001	Dragan Grubisic	IMET0064	2080

22862 7590 09/23/2004

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER
PUNNOOSE, ROY M

ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 09/23/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 092004

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of:	:	
Grubisic	:	PETITION FOR CORRECTION OF
Serial No.: 09/956,747	:	INVENTORSHIP
Filed: September 17, 2001	:	UNDER 37 CFR § 1.48(a)
Attorney Docket No.: IMET0064	:	

This is a decision on the petition filed July 7, 2004 to correct inventorship under 37 CFR 1.324.

The petition is granted.

In view of the papers filed May 10, 2004 it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48 (a). The inventorship of this application has been changed by adding the names:

Kevin Hazen
Timothy L. Ruchti
George Acosta

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Gregory J. Toatley, Jr.
Supervisory Patent Examiner,
Art Unit 2877

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

IBM CORPORATION
INTELLECTUAL PROPERTY LAW
11501 BURNET ROAD
AUSTIN, TX 78758

Mail Date: 04/20/2010

Applicant	: Rabindranath Dutta	: DECISION ON REQUEST FOR
Patent Number	: 7668724	: RECALCULATION of PATENT
Issue Date	: 02/23/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/956,773	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/20/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1784** 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

THE SMALL PATENT LAW GROUP, LLP
611 OLIVE STREET, SUITE1611
ST. LOUIS, MO 63101

COPY MAILED

NOV 14 2007

OFFICE OF PETITIONS

In re Application of
John A. Moon, et. al.
Application No. 10/956,791
Filed: October 1, 2004
Attorney Docket No. IP-0042-US (SPLG 42US1)

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.182 filed by facsimile transmission on December 21, 2006, which is being treated as a petition under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional Application No. 60/508,038. It is noted that the Office mistakenly overlooked the claim for priority to the non-provisional applications listed in the specification. However, petitioner failed to include the correct claim for benefit to provisional Application No. 60/508,038; therefore, this petition is properly treated as a petition under 37 CFR 1.78(a)(6).

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.

The petition lacks items (2) and (3) above.

Effective September 30, 2007, a petition under 37 CFR 1.78(a)(6) requires a petition fee of $1,410. Accordingly, this fee must be submitted for consideration of the instant petition.

Further, 37 CFR § 1.78(a)(6) requires 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.

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(6), the petition fee of $1,410, the statement of unintentional delay and either a supplemental Application Data Sheet executed pursuant to 37 CFR 1.33(b) or an amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) are 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) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Andrea Smith at (571) 272-3226.

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

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

COPY MAILED

JAN 17 2007

OFFICE OF PETITIONS

In re Patent of Gondouin	:	
Patent No. RE39,141	:	
Issue Date: June 27, 2006	:	Decision on Petition
Application No. 09/956,806	:	
Filing Date: September 21, 2001	:	
Attorney Docket No. 02376.0006-03000	:	

This is a decision in response to the petition under 37 CFR 1.377 filed December 19, 2006, requesting the Office determine the instant patent is not expired.

The petition is **GRANTED.**

Facts:

Application No. 07/814,585 issued as Patent No. 5,462,120 on October 31, 1995.

Petitioner filed Reissue Application No. 08/861,457 on May 22, 1997.

The 3.5 year maintenance fee was timely paid for Patent No. 5,462,120 on April 16, 1999.

Petitioner filed four continuation applications based on Application No. 08/861,457:
(1) 09/824,738 filed April 4, 2001,
(2) 09/871,813 filed June 4, 2001,
(3) 09/944,115 filed September 4, 2001, and
(4) 09/956,806 filed September 21, 2001.

Reissue Application No. 08/861,457 issued as Reissue Patent No. RE37,867 on October 8, 2002.

The 7.5 year maintenance fee and surcharge were paid on June 6, 2003, for RE37,867.

Reissue Application No. 09/824,738 issued as Reissue Patent No. RE38,636 on October 26, 2004.

Reissue Application No. 09/871,813 issued as Reissue Patent No. RE38,642 on November 2, 2004.

Reissue Application No. 09/944,115 issued as Reissue Patent No. RE38,616 on October 12, 2004.

Reissue Application No. 11/038,005 was filed as a continuation of Reissue Application No. 09/956,806 on April 8, 2005. The application is currently pending.

Reissue Application No. 09/956,806 issued as Reissue Patent No. RE39,141 on June 27, 2006.

Discussion:

A review of the facts demonstrates the instant patent is not, and has never been, expired. To the extent any Office records have indicated the patent is expired, the records are hereby vacated.

The Office will schedule a refund of the $200 petition fee.

PTO records will be updated to indicate the patent has not expired.

As a courtesy, the Office will now discuss the payment of the 11.5 year maintenance fee.

Per the MPEP, when a reissue patent issues based on an original patent, maintenance fee payments should be made for the reissue patent based on the schedule established for the original patent. The MPEP states a maintenance fee does not have to be paid for subsequent reissue patents. MPEP 501 states, "No payment of additional maintenance fees is required for second or subsequent reissue patents, i.e., continuation or divisional reissues (see MPEP 1451), which are derived from a first reissue patent which has issued."

Unfortunately, the Office finance system, RAM, currently updates multiple reissue patents only if the payment is made in the most recent reissue patent to be issued. If petitioner complies with the MPEP, and the Office employee who process the fee fails to recognize the need to move the fee to the newest reissue patent in RAM, problems may arise. Therefore, the Office of Petitions strongly suggests petitioner pay the 11.5 year fee for Reissue Patent No. RE39,141. However, if a reissue patent based on Reissue Application No. 11/038,005 issues prior to payment of the 11.5 year maintenance fee, then the 11.5 year fee should be applied towards the new reissue patent.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10-13-06

TO SPE OF : ART UNIT 3672

SUBJECT : Request for Certificate of Correction on Patent No.: RE 39,141 (09/956806

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

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

Should filing date be change?

Eva James

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

DAVID BAGNELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

SPE

3672
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

DAFFER MCDANIEL, LLP
P.O. BOX 684908
AUSTIN, TX 78768-4908

COPY MAILED
AUG 2 1 2006
OFFICE OF PETITIONS

In re Application of	:	
Dan Wack et al	:	
Application No. 09/956,850	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. 5589-02310	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 26, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee in a timely manner in reply to the Notice of Allowance mailed March 23, 2006, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on June 24, 2006.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Publishing Division 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

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

COPY MAILED

FEB 0 7 2006

OFFICE OF PETITIONS

In re Application of	:	
Heather Laudan Clark et al	:	
Application No. 09/956,873	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. 2001-0159.02	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 9, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee/publication fee in a timely manner in reply to the Notice of Allowance And Fee(S) Due mailed August 9, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on November 10, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee/publication fee; (2) the petition fee; and (3) the required statement of unintentionally delay have been received. Accordingly, the issue fee/publication fee are accepted as having been unintentional delayed.

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

This matter is being referred to Publishing Division.

Wan Laymon
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

MAILED

MAY 0 2 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

JAMES C. WRAY
SUITE 300
1493 CHAIN BRIDGE ROAD
MCLEAN VA 22101

In re Application of :
Nathan J. Hays :
Application No. 09/956,877 :
Filed: September 21, 2001 :
For: POLLED TONE SYNCHRONIZATION OF :
RECEIVER/TRANSMITTER UNITS :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on April 8, 2003.

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

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All 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: ROBERT E. KREBS, ESQ.
THELEN REID & PRIEST LLP
SUITE 1200
225 WEST SANTA CLARA STREET
SAN JOSE, CA 95115-1723

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650TH
ALEXANDRIA, VA 22314

In re Application of: Dey, Jayanta K.
Application No. 09/956,889
Filed: September 21, 2001
For: TOOL FOR AUTOMATICALLY MAPPING MULTIMEDIA ANNOTATIONS TO ONTOLOGIES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed October 4, 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.

Verlene Green
Head SLIE
Technology Center 2100
571-272-3585

cc: HOUGHTON MIFFIN COMPANY
PAUL MILLHOUSER
222 BERKERLEY STREET
BOSTON, MA 02116

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON DC 20005

COPY MAILED

NOV 20 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Thomas D. Fletcher et al. :
Application No. 09/956,903 :
Filed: September 21, 2001 :
Attorney Docket No. 2207/11270 :

This is a decision on the petition filed October 25, 2006 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**.

In response to the Final Office Action mailed May 19, 2005, an amendment and a Notice of Appeal were filed on November 21, 2005 with a three month extension of time. By Advisory Action mailed December 15, 2005, petitioners were advised that the amendment filed November 21, 2005 did not place the application in condition for allowance. An Appeal Brief was therefore due not later than January 21, 2006. No response having been filed, this application became abandoned January 24, 2006. Accordingly, a Notice of Abandonment was mailed October 6, 2006.

Petitioner asserts that an Appeal Brief was filed via facsimile transmission on March 21, 2006 with a two month extension of time request. 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 Appeal Brief and extension of time request have not been matched with the file but the evidence submitted corroborates a timely response. 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 application is being forwarded to Technology Center 2193 for review of the Appeal Brief filed originally filed March 21, 2006, a copy of which was submitted 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

JAMES R RIEGEL
IMMERSION CORPORATION
801 FOX LANE
SAN JOSE, CA 95131

COPY MAILED

FEB 2 8 2002

OFFICE OF PETITIONS

In re Application of	:	
Kollin Tierling	:	
Application No. 09/957,004	:	NOTICE
Filed: September 19, 2001	:	
Attorney Docket No. IMM135	:	

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 2635.

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

PATENT DEPARTMENT (51851)
KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM, NC 27101

COPY MAILED

DEC 01 2005

OFFICE OF PETITIONS

In re Application of	:
Kollin Tierling	:
Application No. 09/957,004	: DECISION GRANTING PETITION
Filed: September 19, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. IMM135	:

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 29, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2635 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

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.
09/957,014	09/20/2001	Richard Francis Russell	2001-0158.02	3768

21972 7590 11/09/2007
LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

EXAMINER
MAUNG, ZARNI

ART UNIT	PAPER NUMBER
2151	

MAIL DATE	DELIVERY MODE
11/09/2007	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

November 2, 2007

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

In re Application of: Russell et al. Application No. 09/957,014 Attorney Docket No. **2001-0158.02** Filed: September 20, 2001 For: **AUTOMATIC REMOTE ASSIGNMENT OF INTERNET PROTOCOL ADDRESS INFORMATION TO A NETWORK DEVICE**	)))))	**DECISION ON PETITION TO CONTEST THE HOLDING OF NONCOMPLIANCE OF APPLICANT'S APPEAL BRIEF 37 CFR §1.181**

This is a decision on the petition filed May 23, 2007 under 37 C.F.R. §1.181 to contest the holding of noncompliance of Applicant's Appeal Brief.

The petition is **GRANTED**.

In the Non-compliant Appeal Brief dated April 23, 2007, the examiner stated that the Appeal Brief is non-compliant because "(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and--'step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The filed replacement Appeal Brief noted above has been considered. The replacement Appeal Brief includes a summary of claimed subject matter for independent claims 1, 11 and 17. However, at least dependent claim 8 has been argued separately according to pages 42-44 of the replacement brief. Under the provision of theabove-mentioned section each dependent claim argued separately must contain a concise explanation of the cubject matter defined in the claim referencing to the specificaton by page and line number, and to the drawings, if any, by reference characters. Appellant is urged to address this discrepancy to avoid any further delays upon submission of the Appeal Brief to the Board of Patents Appeals and Interferences."

Applicant argued, in their petition, that "However, Appellants respectfully submit that their claims, including their dependent claims, are not in means plus function or step plus function form, as permitted by 35 U.S.C. 112, sixth paragraph, and hence, the second sentence of 37 C.F.R. 41.37(c)(1)(v) does not apply to Appellants claims. For example, MPEP 2181 (I) sets forth that a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets a 3-prong analysis, which includes the

requirement that (A) the claim limitations must use the phrase "means for" or "step for." However, none of Appellants' claims employ the phrase "means for" or "step for." Rather, Appellants' claims employ the phrases "steps of" and "step of." The phrase "steps of" colloquially signals the introduction of specific acts, rather than functions, and should therefore not presumptively invoke application of Section 112, Para. 6. Unlike "of," the preposition "for" colloquially signals the recitation of a function. Accordingly, the phrase "step for" generally introduces functional claim language falling under Section 112, Para. 6. Seal-Flex inc. v. Athletic Track and Court Construction, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999). On the other hand, the term "step" alone and the phrase "steps of' tend to show that Section 112, Paral 6 does not govern that limitation, and accordingly, step-plus-function treatment has been denied for method claims which use the conventional "steps of" language. Seal-Flex Inc. v. Athletic Track and Court Construction, 50 USPQ2d 1225, 1235 (Fed. Cir. 1999)."

Rule 41.37 (c)1(v) in its entirety states :

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Based on Rule 41.37 (c)(1)(v), the examiners non-compliant Appeal Brief is incorrect. The petitioner's arguments with respect of the holding of noncompliance of Applicant's Appeal Brief are persuasive.

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

The application will be forwarded to the examiner for consideration on the merits.

John Follansbee
WQAS
Technology Center 2100
571-272-3964

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.
09/957,014	09/20/2001	Richard Francis Russell	2001-0158.02	3768

21972 7590 11/09/2007
LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

EXAMINER
MAUNG, ZARNI

ART UNIT	PAPER NUMBER
2151	

MAIL DATE	DELIVERY MODE
11/09/2007	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

November 2, 2007

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

In re Application of: Russell et al. Application No. 09/957,014 Attorney Docket No. **2001-0158.02** Filed: September 20, 2001 For: **AUTOMATIC REMOTE ASSIGNMENT OF INTERNET PROTOCOL ADDRESS INFORMATION TO A NETWORK DEVICE**	)))))	**DECISION ON PETITION TO CONTEST THE HOLDING OF NONCOMPLIANCE OF APPLICANT'S APPEAL BRIEF 37 CFR §1.181**

This is a decision on the petition filed May 23, 2007 under 37 C.F.R. §1.181 to contest the holding of noncompliance of Applicant's Appeal Brief.

The petition is **GRANTED**.

In the Non-compliant Appeal Brief dated April 23, 2007, the examiner stated that the Appeal Brief is non-compliant because "(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and--'step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The filed replacement Appeal Brief noted above has been considered. The replacement Appeal Brief includes a summary of claimed subject matter for independent claims 1, 11 and 17. However, at least dependent claim 8 has been argued separately according to pages 42-44 of the replacement brief. Under the provision of theabove-mentioned section each dependent claim argued separately must contain a concise explanation of the cubject matter defined in the claim referencing to the specificaton by page and line number, and to the drawings, if any, by reference characters. Appellant is urged to address this discrepancy to avoid any further delays upon submission of the Appeal Brief to the Board of Patents Appeals and Interferences."

Applicant argued, in their petition, that "However, Appellants respectfully submit that their claims, including their dependent claims, are not in means plus function or step plus function form, as permitted by 35 U.S.C. 112, sixth paragraph, and hence, the second sentence of 37 C.F.R. 41.37(c)(1)(v) does not apply to Appellants claims. For example, MPEP 2181 (I) sets forth that a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets a 3-prong analysis, which includes the

requirement that (A) the claim limitations must use the phrase "means for" or "step for." However, none of Appellants' claims employ the phrase "means for" or "step for." Rather, Appellants' claims employ the phrases "steps of" and "step of." The phrase "steps of" colloquially signals the introduction of specific acts, rather than functions, and should therefore not presumptively invoke application of Section 112, Para. 6. Unlike "of," the preposition "for" colloquially signals the recitation of a function. Accordingly, the phrase "step for" generally introduces functional claim language falling under Section 112, Para. 6. Seal-Flex inc. v. Athletic Track and Court Construction, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999). On the other hand, the term "step" alone and the phrase "steps of' tend to show that Section 112, Paral 6 does not govern that limitation, and accordingly, step-plus-function treatment has been denied for method claims which use the conventional "steps of" language. Seal-Flex Inc. v. Athletic Track and Court Construction, 50 USPQ2d 1225, 1235 (Fed. Cir. 1999)."

Rule 41.37 (c)1(v) in its entirety states :

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Based on Rule 41.37 (c)(1)(v), the examiners non-compliant Appeal Brief is incorrect. The petitioner's arguments with respect of the holding of noncompliance of Applicant's Appeal Brief are persuasive.

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

The application will be forwarded to the examiner for consideration on the merits.

John Follansbee
WQAS
Technology Center 2100
571-272-3964

UNITED STATES 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. 111504

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

DEC - 1 2004

In re Application of:	:	
EVELYN BOETTCHER et al.	:	
Serial No.: 09/957,022	:	DECISION ON REQUEST TO WITHDRAW
Filed: September 21, 2001	:	FROM RECORD
Attorney Docket No.: **082134-0271811**	:	

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed October 26, 2004.

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

The request meets all the above stated requirements. The request was signed by Henry J. Daley, on behalf of himself and all the attorneys/agents of record. There is no outstanding Office action at this time.

The request is **APPROVED**.

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

All future communications from the Office will be directed to the assignee, Optinel Systems Inc., at the below address, until otherwise notified by applicant.

Inquiries related to this decision should be directed to Lissi Marquis at (571) 272-1596.

Lissi Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: OPTINEL SYSTEMS INC.
6835 DEERPATH ROAD
ELKRIDGE, MD 21075

UNITED STATES 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 25 2005

OFFICE OF PETITIONS

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON MA 02109

In re Application of
David Margolis, et al.
Application No. 09/957,031
Filed: September 21, 2001
Docket No.: BSZ-008DVCN

ON PETITION

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**.

The application became abandoned for a failure to respond to a non-final Office action mailed July 22, 2004. This decision precedes the mailing of a Notice of Abandonment.

The application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing Application No. 11/042,598 filed January 24, 2005.

Extensions of time under 37 CFR 1.136 are available only if asked for "prior to or with the response." In no case, however, may an applicant respond later than the maximum time period set by statute. Accordingly, if the question of abandonment arises when the provisions of 37 CFR 1.136 can no longer be used, then the application is abandoned when the unextended time for response has expired. Therefore, no extension of time fees are due on a petition for revival. In view thereof, the $1020 extension of time fee submitted with the present petition is unnecessary and will be credited to counsel's deposit account.

Telephone inquiries concerning this decision should 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

Paper No. 6

BAKER BOTTS, LLP
910 LOUISIANA
HOUSTON, TX 77002-4995

COPY MAILED

FEB 1 9 2004

OFFICE OF PETITIONS

In re Application of
Bartling, James E.
Application No. 09/957,062
Filed: September 20, 2001
Attorney Docket No. 068354.1109

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 5, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 17, 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 December 18, 2001. A Notice of Abandonment was mailed on January 30, 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 Office of Initial Patent Examination for further processing.

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

FENWICK AND WEST LLC
801 CALIFORNIA ST
SILICON VALLEY CTR
MOUNTAIN VIEW, CA 94041

COPY MAILED

JUN 0 5 2006

OFFICE OF PETITIONS

In re Application of	:	
Schultz et al.	:	DECISION ON PETITION
Application No. 09/957,099	:	TO WITHDRAW
Filed: September 19, 2001	:	FROM RECORD
Attorney Docket No. 21540-05696	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 14, 2005.

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

A review of the file record indicates that the power of attorney to Greg T. Sueoka and the other attorneys of record has been revoked by the assignee of the entire interest of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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:

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
530 B STREET
SUITE 2100
SAN DIEGO CA 92101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 4 2003

Paper No. 06

Antoinette F. Konski
Bingham McCutchen LLP
(formerly McCutchen, Doyle, Brown & Enersen LLP)
Three Embarcadero Center
Suite 1800
San Francisco, CA 94111-4067

In re Application of:	:	
Rocke, *et al.*	:	
Application No. 09/957,100	:	DECISION ON REQUEST TO
Filed: September 19, 2001	:	WITHDRAW FROM RECORD
Attorney Docket No. 19629-7005	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed December 26, 2002.

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

The request meets all the above requirements. The request was signed by Antoinette F. Konski, an attorney of record in the above identified application and there is no outstanding Office action requiring a response by the applicant.

The request is approved.

The application currently has no attorney of record.

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

Inquiries related to this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.

Lissi Mojica Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Mr. Michael Shuster
FENWICK & WEST LLP
Embarcadero Center West
275 Battery Street
San Francisco, CA 94111

UNITED STATES 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

ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

COPY MAILED

MAY 21 2004

OFFICE OF PETITIONS

In re Application of :
Handiono Santosa et al :
Application No. 09/957,144 :
Filed: September 19, 2001 :
Attorney Docket No. 50R4784 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 20, 2004, to revive the above-identified application.

The petition is **GRANTED**.

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

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $1480 extension of time submitted with the petition on April 20, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's Credit Card.

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

The application file is being forwarded to Technology Center AU 2816 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

NOV 2 8 2008

OFFICE OF PETITIONS

KATTEN MUCHIN
ROSENMAN LLP
575 MADISON AVENUE
NEW YORK NY 10022-2585

In re Application of	:	
Kurose, et al.	:	
Application No. 09/957,148	:	DECISION
Filed: 20 Septmber, 2001	:	
Attorney Docket No. 100794-11765(FUJG19.002)	:	

This is a decision on the petition filed on 10 October, 2008, and properly considered as a petition requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The petition to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

Petitioners are directed to the Commentary at MPEP §711.03(c) for guidance as to the proper showing and timeliness and showing requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to non-final Office action (copy enclosed) mailed on 13 February, 2008, with reply due absent extension of time on or before 13 May, 2008.

The application went abandoned by operation of law after midnight 13 May, 2008.

The Office mailed the Notice of Abandonment on 26 August, 2008.

On 10 October, 2008, Petitioner filed the instant petition, asserting, *inter alia*, that the Notice was not received, and averred a search of the file and non-discovery, and provided description of her practice and her firm practice as to receipt/docketing an a copy of the docket record for the instant application and of the due-date docket for the firms in the effort to satisfy the showing requirements set forth in the Commentary at MPEP §711.03(c)(I),

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.[2],[3]

More particularly, the Office has set forth in the Commentary at MPEP §711.03(c) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

---

[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). See specifically, the regulations at 37 C.F.R. §10.18.

[2] 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).

[3] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The record evidences a satisfactory showing of the requirements under the Rule.

CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **granted**, and the 26 August, 2008, Notice of Abandonment is **vacated**.

The instant application is released to the Technology Center/AU (TC/AU) 2153 for further processing (including re-mailing of the Office action in question) in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

[4] The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
09/957,148	09/20/2001	Yoshitoshi Kurose	100794-11765(FUJG19.002)	3476

26304 7590 02/13/2008
KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER
SCUDERI, PHILIP S

ART UNIT	PAPER NUMBER
2153	

MAIL DATE	DELIVERY MODE
02/13/2008	PAPER

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

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

AK

Office Action Summary	Application No.	Applicant(s)
	09/957,148	KUROSE ET AL.
	Examiner	Art Unit
	Philip S. Scuderi	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *6 and 8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7 and 9-11* is/are rejected.

7)☒ Claim(s) *9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Arguments

Applicant's arguments filed 10/31/2007 (herein "Remarks") have been fully considered but they are not persuasive.

Applicant states that "as best understood, Taniguchi teaches that the QoS parameter determined for each node includes a delay, jitter, packet loss factors, transfer band, and the like." (Remarks at pp. 6, with emphasis added). The examiner agrees with this analysis of the Taniguchi reference. For example, Taniguchi states that "a delay, jitter, a packet loss factor, a transfer band, and the like are considered as a QoS parameter." (Taniguchi at col. 9, ll. 27-29, with emphasis added).

Applicant then argues that "Taniguchi does not teach the use of delay time being used as a QoS parameter." (Remarks at pp. 6, with emphasis added). Applicant concludes that Taniguchi does not teach "a setting generation device for setting a delay time permissible for said communication device so that total delay time permissible for said communication device is lower

than a maximum delay time corresponding to a whole communication path intended for said communication." (Remarks at pp. 6).

This argument is unpersuasive on its face because applicant's own analysis of the Taniguchi reference (which the examiner agrees with, see above) directly contradicts it. For example, applicant states that "that the QoS parameter determined for each node includes a delay" (Taniguchi at col. 9, ll. 27-29, with emphasis added).

As to the setting generation device "setting a delay time permissible for said communication device so that total delay time permissible for said communication device is lower than a maximum delay time corresponding to a whole communication path intended for said communication" is clearly inherent as follows.

Taniguchi teaches that QoS controller 25 determines optimal QoS parameters for the nodes involved in the stream transfer shown in figure 3 (Taniguchi at col. 7, ll. 42-50, col. 9, ll. 18-30). The QoS parameters include delay time at the nodes (Taniguchi at col. 9, ll. 18-30, col. 17, ll. 14-30). The delay time at each node is inherently lower than the aggregate delay time for all the nodes in the communication path shown in figure 3.

Claim Objections

Claim 9 is objected to because of a minor informality. The word "while" in line 5 should presumably be "whole." Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi (U.S. Patent No. 6,445,679) in view of Seki (U.S. Patent No. 6,330,603).

As to claim 1, Taniguchi teaches a network service setting system, comprising:

a communication device (relay node 12) having a network resource (stream transfer device 20) for providing a predetermined network service in making a communication (providing stream data) via a network (network 14) [see fig. 3; col. 7, ll. 42-50]; and

a setting generation device (QoS controller 25) for setting a delay time permissible (delay) for said communication device (relay node 12) so that total delay time permissible (delay) for said communication device (relay node 12) is lower than a maximum delay time corresponding to a whole communication path (aggregate of all the nodes' delays) intended for said communication [see fig. 3; col. 9, ll. 38-46 (centralized QoS controller 25 collects information regarding load state of the nodes and determines respective optimal QoS parameters for the nodes); col. 9, ll. 18-30 (the QoS parameters include delay or transmission rate); col. 13, ll. 36 to col. 14, ll. 10 (manager and controller within QoS controller 25 sets QoS parameters according to user specified transmission rates)].

Taniguchi does not appear to expressly state that the delay is set in accordance with a packet discard rate.

Taniguchi teaches that QoS controller 25 determines optimal QoS parameters for the nodes involved in the stream transfer shown in figure 3 [col. 7, ll. 42-50; col. 9, ll. 18-30]. The QoS parameters include delay time at the nodes [col. 9, ll. 18-30; col. 17, ll. 14-30].

Discarding packets that exceed a permissible delay time was well known in the art, as evidenced by Seki (U.S. Patent No. 6,330,603) [col. 18, ll. 30-39]. It would have been obvious to discard packets that exceed the permissible delay time here because doing so would not waste resources on packets that would not meet the specified QoS requirements.

The combination of Taniguchi and Seki meets the claims because setting the delay time clearly creates an associated packet discard rate.

As to claim 2, Taniguchi teaches the network service setting system according to claim 1, in which said communication device is a routing apparatus (relay node 12) connecting between terminal devices (transmission node 11 and reception node 13) for transmitting or receiving the data in said communication [figure 3; column 9, line 18 – column 10],

wherein said routing apparatus (relay node 12) comprises:

an information transfer section for notifying its own resource delay assurance information to said setting generation device (QoS controller 25) [figure 3; column 9, line 18 – column 10]; and

a network service providing section for providing a network service of the delay time based on setting information passed from said setting generation device (QoS controller 25) [figure 3; column 9, line 18 – column 10].

As to claim 3, Taniguchi teaches the network service setting system according to claim 2, wherein said setting generation device (QoS controller 25) comprises:

an information collection section for collecting said resource information passed from said routing apparatus (relay nodes 12) [figures 3, 4];

a setting information generation section for generating said setting information on the basis of said resource information corresponding to a plurality of routing apparatuses (relay nodes 12) which said information collection section collects [figures 3, 4]; and

a setting information transmission section for transmitting said setting information generated by said setting information generation section to said routing apparatuses (relay nodes 12) [figures 3, 4].

As to claim 4, Taniguchi teaches the network service setting system according to claim 3, wherein said setting generation device (QoS controller 25) further comprises a contention judgment section for judging the contention of a request that occurs in a case where a plurality of communication requests that are different from each other request the identical resource in accordance with a predetermined rule [column 29, line 62 - column 30, line 27].

As to claim 5, Taniguchi teaches the network service setting system according to claim 3, wherein said setting generation device further comprises a load management section for managing the load state of said routing apparatus, and said setting information generation section generates said setting information in consideration of said load state managed by said load management section [figures 3, 4].

As to claim 7, Taniguchi teaches the network service setting system according to claim 2, wherein said information transfer section is a signaling processing section for transmitting and receiving a signaling packet in accordance with a resource reservation protocol, and the notification of said resource information is made employing a path message (a message that traverses the path between, for example, relay node 12 and the QoS controller at reception node 13) [figures 3, 4; column 9, line 60 – column 10, line 4].

As to claim 9, Taniguchi teaches a network service providing method for providing a predetermined network service in making a communication via a network, comprising:

a first step of enabling a setting generation device (QoS controller 25) to set up a delay time permissible (delay) for an individual communication device (relay node 12) so that total delay time permissible (delay) for said individual communication device (relay node 12) is lower than a maximum delay time corresponding to a whole communication path (aggregate of all the nodes' delays) intended for said communication [see fig. 3; col. 9, ll. 38-46 (centralized QoS controller 25 collects information regarding load state of the nodes and determines respective optimal QoS parameters for the nodes); col. 9, ll. 18-30 (the QoS parameters include delay or transmission rate); col. 13, ll. 36 to col. 14, ll. 10 (manager and controller within QoS controller 25 sets QoS parameters according to user specified transmission rates)]; and

a second step of providing said predetermined network service (providing stream data) in said individual communication device (relay node 12) with the delay time (delay) set up at said first step [see fig. 3; col. 7, ll. 42-50].

Taniguchi does not appear to expressly state that the delay is set in accordance with a packet discard rate.

Taniguchi teaches that QoS controller 25 determines optimal QoS parameters for the nodes involved in the stream transfer shown in figure 3 [col. 7, ll. 42-50; col. 9, ll. 18-30]. The QoS parameters include delay time at the nodes [col. 9, ll. 18-30; col. 17, ll. 14-30].

Discarding packets that exceed a permissible delay time was well known in the art, as evidenced by Seki (U.S. Patent No. 6,330,603) [col. 18, ll. 30-39]. It would have been obvious to discard packets that exceed the permissible delay time here because doing so would not waste resources on packets that would not meet the specified QoS requirements.

The combination of Taniguchi and Seki meets the claims because setting the delay time clearly creates an associated packet discard rate.

As to claim 10, Taniguchi teaches the network service providing method according to claim 9, further comprising a third step of enabling said individual communication device to notify its own resource information to said setting generation device, before said first step [figure 3; column 9, line 18 – column 10].

As to claim 11, Taniguchi teaches the network service providing method according to claim 9, wherein the delay time at the first step is set up in consideration of the load state of said individual communication device [figures 3, 4].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Philip S Scuderi/

KRISNA LIM
PRIMARY EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PORTER WRIGHT MORRIS & ARTHUR, LLP
INTELLECTUAL PROPERTY GROUP
41 SOUTH HIGH STREET
28TH FLOOR
COLUMBUS, OH 43215

COPY MAILED
OCT 16 2006
OFFICE OF PETITIONS

In re Application of He et al. :
Application No. 09/957,209 : Decision on Petition
Filing Date: September 20, 2001 :
Attorney Docket No. 3994994-131915-3 :

This is a decision on the petition under 37 CFR 1.181, filed July 7, 2006, to withdraw the holding of abandonment.

The petition is **granted.**

A Notice of Abandonment was mailed June 12, 2006. The Notice states the application is abandoned for failure to respond to an Office letter mailed November 7, 2005.

Petitioner has established non-receipt of the November 7, 2005 Office action. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

A new copy of the Office action will be mailed and the period for reply will be re-started.

Technology Center Art Unit 1754 will be informed of the instant decision. Thereafter, the Technology Center's technical support staff will mail a new copy of the November 7, 2005 Office action. The time period for responding to the new Office action will be set to run from the mailing date of the new Office action.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Handley Law Firm, PLLC
Roger N. Chauza, PC
PO Box 140036
Irving, TX 75014

COPY MAILED

MAR 0 9 2007

OFFICE OF PETITIONS

In re Application of Duhon :
Application No. 09/957,214 : Decision on Petitions Under
Filing Date: September 19, 2001 : 37 CFR 1.78(a)(3) and (a)(6)
Attorney Docket No. CBCC-25,840 :

This is a decision on the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed December 22, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) 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 Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

In reviewing the chain of applications to which applicant is seeking a claim for priority, it is noted that at Application No. 09/095,779, does not make a reference to the earlier-filed provisional application. When an application claims benefit to a chain of applications, every intermediate application must make claim benefit of priority to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d).

MPEP 201.11(III)(C) states,

> If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

Application No. 09/095,779 did not claim priority to provisional application no. 60/049,750. Therefore, the amendment as filed is unacceptable.

An Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) with a priority claim only to application no. 09/095,779 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) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Handley Law Firm, PLLC
Roger N. Chauza, PC
PO Box 140036
Irving, TX 75014

COPY MAILED
SEP 21 2007
OFFICE OF PETITIONS

In re Application of Duhon :
Application No. 09/957,214 : Decision on Petitions Under
Filing Date: September 19, 2001 : 37 CFR 1.78(a)(3)
Attorney Docket No. CBCC-25,840 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed September 10, 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late proper 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.

This application is being forwarded to Technology Center Art Unit 3691 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application and for consideration of the RCE and other papers filed September 10, 2007.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

Charles Steven Brantley
Senior Petitions Attorney
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
09/957,214	09/19/2001	3691	710	CBCC-25,840	2	1

CONFIRMATION NO. 2707

CORRECTED FILING RECEIPT

OC000000025941035

31782
Handley Law Firm, PLLC
Roger N. Chauza, PC
PO BOX 140036
IRVING, TX 75014

Date Mailed: 09/21/2007

Receipt is acknowledged of this nonprovisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Eric M. Duhon, Katy, TX;

Power of Attorney: The patent practitioners associated with Customer Number **31782**.

Domestic Priority data as claimed by applicant

This application is a CON of 09/095,779 06/11/1998 PAT 6,311,169

Foreign Applications

If Required, Foreign Filing License Granted: 11/02/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/957,214

Projected Publication Date: Request for Non-Publication Acknowledged

Non-Publication Request: Yes

Early Publication Request: No

Title

Consumer credit data storage system

Preliminary Class

705

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

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

GRANTED

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

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

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

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

NOT GRANTED

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

MAR 18 2002 JC54

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
09/957,215	09/19/2001	Howard B. Urnovitz	018651-000211US

CONFIRMATION NO. 3651

FORMALITIES LETTER

OC000000007288803

20350
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY OF PAPERS ORIGINALLY FILED

Date Mailed: 01/10/2002

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given **TWO MONTHS** from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a)

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

- A substitute specification in compliance with 37 CFR 1.52 because:
  - Papers contain improper margins. *Each sheet must have a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (3/4")*

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

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

EDWARDS & ANGELL, LLP
Dike, Bronstein, Roberts & Cushman, IP Group
P.O. Box 9169
Boston, MA 02209

COPY MAILED

SEP 0 5 2002

OFFICE OF PETITIONS

In re Application of Robert Schetty, Michael Toben, James Martin, Neil Brown, Jeffrey Crosby and Keith Whitlaw Application No. 09/957,218 Filed: September 20, 2001 Attorney Docket No. 50589-2 Title: ALLOY COMPOSITION AND PLATING METHOD	DECISION REFUSING STATUS UNDER 37 C.F.R. §1.47(a)

This is a decision on the "Petition under 37 CFR §1.47(a)" filed May 28, 2002 (certificate of mailing May 10, 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 September 20, 2001, without an executed oath or declaration. Robert Schetty, Michael Toben, James Martin, Neil Brown, Jeffrey Crosby and Keith Whitlaw were named as joint inventors. In response to a "Notice to File Missing Parts of Nonprovisional Application," mailed October 12, 2001, applicants filed the instant petition under §1.47(a)(and fee) and late surcharge under §1.16(e). This reply was made timely by an accompanying petition for extension of time for response within the fifth month (and fee). Also filed with the petition were declarations executed in combination by inventors Toben, Martin, Brown, Crosby and Whitlaw; and a declaration executed by inventor Toben on behalf of non-signing inventor Schetty. Rule 47 applicants assert that status under §1.47(a) is proper because inventor Schetty refuses to execute the declaration. In support thereof, applicants submit a declaration of facts of patent attorney S. Matthew Cairns.

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 petition includes payment of the petition fee. In addition, by statement of attorney Cairns with supporting documentary evidence, rule 47 applicants have provided adequate proof that non-signing inventor Schetty has refused to join in the application after having been presented with the application papers. However, the petition is not grantable because requirements (2) and (4) have not been met.

As to requirement (4), the petition does not include a statement of the last known address of inventor Schetty. Applicants should include such a statement on renewed petition.

More importantly, as to requirement (2), the declarations as submitted are not acceptable. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

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

Here, applicants have indicated, by having inventor Toben sign on behalf of non-signing inventor Schetty, that the declaration as submitted is not signed by all the available joint inventors on behalf of themselves and on behalf of joint inventor Schetty. A declaration properly executed by all available joint inventors on behalf of non-signing inventor Schetty is required.

In addition, as to inventor Crosby, his signature block includes non-dated/non-initialed alterations. Such alterations render the declaration unacceptable. The new declaration, executed by all available joint inventors on behalf of themselves and on behalf of non-signing inventor Schetty, should incorporate these changes or be properly dated and initialed by inventor Crosby. It is further noted that the deficiencies as to inventor Crosby are separate and distinct from the deficiency in execution discussed above. Accordingly, if applicants obtain a declaration executed by inventor Schetty, a new declaration executed by inventor Crosby is still 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

EDWARDS & ANGELL, LLP
Dike, Bronstein, Roberts & Cushman, IP Group
P.O. Box 9169
Boston, MA 02209

COPY MAILED

NOV 14 2002

OFFICE OF PETITIONS

In re Application of Robert Schetty, Michael Toben, James Martin, Neil Brown, Jeffrey Crosby and Keith Whitlaw Application No. 09/957,218 Filed: September 20, 2001 Attorney Docket No. 50589-2 Title: ALLOY COMPOSITION AND PLATING METHOD	DECISION ACCORDING STATUS UNDER 37 C.F.R. §1.47(a)

This is a decision on the "Request for Reconsideration of Petition under 37 CFR § 1.47(a)" filed November 6, 2002 (certificate of mailing November 1, 2002).

The petition is **GRANTED**.

The above-identified application was filed on September 20, 2001, without an executed oath or declaration. Robert Schetty, Michael Toben, James Martin, Neil Brown, Jeffrey Crosby and Keith Whitlaw were named as joint inventors. In response to a "Notice to File Missing Parts of Nonprovisional Application," mailed October 12, 2001, applicants filed the initial petition under §1.47(a)(and fee) and late surcharge under §1.16(e). Also filed with the petition were declarations executed in combination by inventors Toben, Martin, Brown, Crosby and Whitlaw; and a declaration executed by inventor Toben on behalf of non-signing inventor Schetty.

However, the petition was dismissed for failure to include a statement of the last known address of inventor Schetty in the petition and failure to submit an acceptable oath or declaration. The declaration submitted was not acceptable because it was not executed by all of the available joint inventors on behalf of the themselves and on behalf of the nonsigning inventor Schetty; and as to inventor Crosby, the declaration included non-dated/non-initialed alterations (Decision mailed September 5, 2002).

On instant renewed petition, timely filed, petitioners included the last known address of the nonsigning inventor, a declaration executed by all of the available joint inventors on behalf of nonsigning joint inventor Schetty, and a new declaration executed by inventor Crosby encompassing the previous alterations.

The declaration and the petition have been reviewed and found in compliance with 37 C.F.R. § 1.47(a).

This application is hereby accorded Rule 1.47(a) status.

As provided in new Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing 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 1712 for examination in due course.

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

ROBERT A. SCHETTY, III
23 PADDOCK DRIVE
FORT SALONGA, NY 11768

In re Application of :
Robert Schetty, Michael Toben, :
James Martin, Neil Brown, : LETTER
Jeffrey Crosby and Keith Whitlaw :
Application No. 09/957,218 :
Filed: September 20, 2001 :
Attorney Docket No. 50589-2 :
Title: ALLOY COMPOSITION AND :
PLATING METHOD :

COPY MAILED
NOV 14 2002
OFFICE OF PETITIONS

Dear Mr. Schetty:

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 Nancy Johnson at (703) 305-0309. 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).

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

S. Matthew Cairns, Ph.D.
c/o EDWARDS & ANGELL, LLP
Dike, Bronstein, Roberts & Cushman, IP Group
P.O. Box 9169
Boston, MA 02209
(508) 229-7545

UNITED STATES 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

EMAGIN CORPORATION
2070 ROUTE 52
HOPEWELL JUNCTION, NY 12533

COPY MAILED
MAY 0 7 2004
OFFICE OF PETITIONS

In re Application of	:	
Howard, Webster E.	:	
Application No. 09/957,221	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. EMA-01-104	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 28, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed October 3, 2002. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on January 4, 2003. A Notice of Abandonment was mailed on June 18, 2003.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

The file is now being forwarded to Technology Center 2800 for further examination on the merits.

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

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

cc: JOSEPH F. MURPHY
EPSTEIN, DRANGEL, BAZERMAN & JAMES, LLP
60 EAST 42ND STREET, SUITE 820
NEW YORK, NY 10165

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

----------x

RECEIVED

MAY 18 2004

OFFICE OF PETITIONS

In re: GRANTED petition to revive
Inventor: HOWARD, Webster E.
Serial No.: 09/957,221
Filed: September 20, 2001
Title: METHOD AND SYSTEM FOR STABILIZING THIN FILM TRANSISTORS IN AMOLED DISPLAYS
Examiner: TRAN, Chuc
Art Unit: 2821

----------x

Ms. Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for Patent Examination Policy
US Patent Office
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

Wednesday, May 12, 2004

Dear Ms. Chase:

Thank you for sending me a courtesy copy of your decision (copy enclosed) in the above-captioned matter. Thank you also for highlighting the need for a new power of attorney; one is being obtained and will be filed shortly.

For the record, please know that I made the statement of unintentional delay only after making inquiry and ascertaining that the entire delay was unintentional.

Thank you again for your prompt and just decision in this matter.

Sincerely,

Joseph F. Murphy

Joseph F. Murphy
Reg. No. 36,617

1494-014.

UNITED STATES 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

MAY 10 2004

Epstein Drangel
Bazerman & James, LLP

Paper No. 11

EMAGIN CORPORATION
2070 ROUTE 52
HOPEWELL JUNCTION, NY 12533

COPY MAILED

MAY 07 2004

OFFICE OF PETITIONS

In re Application of
Howard, Webster E.
Application No. 09/957,221
Filed: September 20, 2001
Attorney Docket No. EMA-01-104

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 28, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed October 3, 2002. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on January 4, 2003. A Notice of Abandonment was mailed on June 18, 2003.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

The file is now being forwarded to Technology Center 2800 for further examination on the merits.

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

Liana Chase

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

cc: JOSEPH F. MURPHY
EPSTEIN, DRANGEL, BAZERMAN & JAMES, LLP
60 EAST 42ND STREET, SUITE 820
NEW YORK, NY 10165

Epstein Drangel
Bazerman&James LLP
60 East 42nd Street, Suite 820, New York, NY 10165

RECEIVED
MAY 18 2004
OFFICE OF PETITIONS

NEW YORK NY 100
PM
13 MAY
2004

FROM
NEW YORK NY 10165
$0.370 $0.370 $0.370
$0.370 W METER
MAY 12 04 5925763

RECEIVED
MAY 17 2004
USPTO MAIL CENTER

Ms. Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for Patent Examination Policy
U.S. Patent Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

Brian R. Reyve Esquire
Law Office of Brian Reyve
161 Maple Drive
Park City, UT 84098

COPY MAILED
MAY 12 2006
OFFICE OF PETITIONS

In re Patent of	:	
Mike R. Rodney	:	
Application No. 09/957,251	:	DECISION
Filed: September 21, 2001	:	ON PETITION
Attorney Docket Number:	:	
07103-11	:	

This is a decision in response to the petition under 37 CFR 1.137(b), filed February 2, 2006, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Final Office Action mailed March 25, 2005, which set a shortened statutory period of reply of three (3) months.

Applicant filed a Notice of Appeal on October 6, 2005 (Certificate of Mailing dated September 25, 2005); however, applicant failed to include the proper extension of time request/fee.

Accordingly, the above-identified application became abandoned on June 26, 2005.

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 is being referred to Technology Center 1761 to await submission of the Appeal Brief.

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

EMC Corporation
Office of the General Counsel
176 South Street
Hopkinton, MA 01748

COPY MAILED

FEB 09 2005

OFFICE OF PETITIONS

In re Application of	:	
Yao Wang, et al.	:	
Application No. 09/957,278	:	ON PETITION
Filed: September 20, 2001	:	
Attorney Docket No. EMC-01-183	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 14, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being referred to Technology Center 2100 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

Paper No. 6

BAKER BOTTS, LLP
910 LOUISIANA
HOUSTON, TX 77002-4995

COPY MAILED

FEB 19 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Bartling et al.
Application No. 09/957,283
Filed: September 20, 2001
Attorney Docket No. 068354.1106

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 5, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 22, 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 December 23, 2001. A Notice of Abandonment was mailed on November 6, 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 Office of Initial Patent Examination for further processing.

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

Date : May 29, 2007

Patent No. :6,961,036
Inventor(s) :Kristen L. Bhatti
Issued :November 1, 2005
Title :APPARATUS AND METHOD FOR CONTROLLING STORED JOBS
Doc./File No.:

Consideration has been given your request for the issuance of a certificate of correction for the above identified patent.

Accordingly, applicants' proposed request to change data in claim 11, column 6, line 20 and 21 from that which is presented in the printed patent has been reviewed and considered unwarranted. The change was the result of an examiners amendment made in accordance with permissible amendments as defined in MPEP 1302.04.

In view of the forgoing your request in this matter is hereby denied.

Any telephone inquiries concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

Angela Green

Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308-9380 ext. 123

Hewlett-Packard Co.
P.O. Box 272400 MS35
Ft. Colins, CO 802528-9599

CBN/arg

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.
09/975,338	10/10/2001	Craig Nemecek	CD00186M	9777

60909 7590 01/19/2010
CYPRESS SEMICONDUCTOR CORPORATION
198 CHAMPION COURT
SAN JOSE, CA 95134-1709

EXAMINER
PROCTOR, JASON SCOTT

ART UNIT	PAPER NUMBER
2123	

MAIL DATE	DELIVERY MODE
01/19/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CYPRESS SEMICONDUCTOR CORPORATION
198 CHAMPION COURT
SAN JOSE CA 95134-1709

In re Application of:
Craig Nemecek et al.
Application No. 09/975,338
Filed: October 12, 2001
For: METHOD FOR BREAKING EXECUTION OF (TEST) CODE IN A DUT AND EMULATOR CHIP ESSENTIALLY SIMULTANEOUSLY AND HANDLING COMPLEX BREAKPOINT EVENTS

DECISION ON PETITION UNDER 37 CFR 1.181 TO INVOKE SUPERVISORY REVIEW

This is a decision on the petition, filed December 15, 2008 under 37 CFR 1.181 to request designation of a new ground of rejection in the Examiner's Answer of October 14, 2008. Although not specifically stated in the petition, the petition is treated as a petition under 1.181(a) to invoke Supervisory Authority and designate the ground of rejection set forth in the answer to be designated as a new ground of rejection

RECENT PROSECUTION BACKGROUND

January 31, 2008	- Final Action mailed. Examiner entered the following rejections: (1) Claim 1 rejected under 35 USC 102 as being anticipated by Beck (2) Claims 1-4, 6, 8, 10-11, and 27-28 rejected under 35 USC 103 as being unpatentable over Beck in view of Johnson. (3) Claims 13-16, 18, 20-23, 29-31, and 33-34 rejected under 35 USC 103 as being unpatentable over Beck, Johnson, and Barnett
October 14, 2008	-Examiner's Answer mailed. The following rejections were maintained: (1) Claims 6 and 18 rejected under 35 USC 112, second paragraph (2) Claims 1-4, 6, 8, 10-11, and 27-28 rejected under 35 USC 103 as being unpatentable over Beck in view of Johnson (3) Claims 13-16, 18, 20-23, 29-31, and 33-34 rejected under 35 USC 103 as being unpatentable over Beck, Johnson, and Barnett
December 15, 2008	- Petition filed under 37 C.F. R. 1.181(a).

RELIEF REQUESTED

Petitioner filed the instant petition on December 15, 2008 contending that the Examiner's Answer issued on October 14, 2008 contained a new ground of rejection.

Petitioner argues the Examiner introduced a new argument under the "Response to Arguments" section which was not previously presented. Petitioner argues that the ground of rejection presented in the "Response to Arguments" in the Examiner's Answer constitutes a new ground of rejection because the "multi-threaded" argument was not presented in any previous Office Actions.

Specifically, the Petitioner argues the following outstanding issues:

(1) Examiner did not previously argue "multi-threaded" in any of the previous Office Actions. The argument concerning "multi-threaded" changes the basic thrust of the rejection and Appellant has not been given fair opportunity to react to the rejection.

(2) A new prior art reference, Microsoft Windows Operating System, is applied for the first time in the Examiner's Answer.

Petitioner requests the allegation in the Examiner's Answer in the Response to Argument section be designated as a new ground of rejection.

ANALYSIS

The relevant section of the MPEP concerning New Grounds of Rejection in Examiner's Answer is MPEP §1207.03.

MPEP 1207.03 states in part:

1207.03 < New Ground of Rejection in Examiner's Answer [R-3]

....

....

II. SITUATIONS WHERE NEW GROUNDS OF REJECTION ARE NOT PERMISSIBLE

A new ground of rejection would not be permitted to reject a previously allowed or objected to claim even if the new ground of rejection would rely upon evidence already of record. In this instance, rather than making a new ground of rejection in an examiner's answer, if the basis for the new ground of rejection was approved by a supervisory patent examiner as currently set forth in MPEP § 1207.04, the examiner would reopen prosecution. In addition, if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate. New grounds of rejection cannot

be made in a supplemental examiner's answer unless it is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a).

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION<

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). ***Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection.*** *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

.....

.....

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)<. See also MPEP § 2144.03.

(emphasis added)

The question to be addressed is whether the Examiner presented a new ground of rejection in the Examiner's Answer.

A review of the record reveals that in the final rejection dated January 31, 2008, claims 1-4, 6, 8, 10-11, and 27-28 were rejected under 35 USC 103 as being unpatentable over Beck in view of Johnson and claims 13-16, 18, 20-23, 29-31, and 33-34 were rejected under 35 USC 103 as being unpatentable over Beck, Johnson, and Barnett. These rejections were maintained in the Examiner's Answer of October 14, 2008, under the subheading "Grounds of Rejection".

Claim 1 recites, "executing instructions on a programmable logic device in lockstep synchronization with the execution of the set of instructions on the DUT" and "determining, at the programmable logic device and not at the DUT, a breakpoint event" among other limitations. In the Final rejection and Examiner's answer, Examiner cites Beck for teaching "executing instructions on a programmable logic device .." and relies on Johnson for teaching the limitation "determining, at the programmable logic device.....a breakpoint event" and provides rationale for how the teachings of Beck would be modified by the teachings of Johnson to arrive at the claimed invention, in support of the conclusion of obviousness. Thus all of the limitations recited in claim 1 are asserted by the examiner as met by the combination of Beck and Johnson. Thus, this ground of rejection under Appeal does not rely on any references other than Beck and Johnson.

In addition, in the "Response to Arguments" section of the Answer, Examiner includes a statement that "multi-threaded computer systems were well known" and refers to Microsoft Windows Operating System, apparently in an effort to address Appellant's assertion that the teachings of Beck and Johnson are "mutually exclusive" (Appeal Brief filed July 30, 2008). However, the Examiner has not included this statement under the Grounds of Rejection, and attempts to merely supplement his reasons for combining references with this additional information. In other words, Examiner is not relying on "multithreading" features of Windows OS for teaching any of the claim limitations or for the motivation used under the subheading "Grounds of Rejection" in the Examiner's answer.

Moreover, it is noted that the "multi-threading" feature is neither recited nor implied in any of the claims under appeal. Therefore, any reference by the Examiner to "multithreading" has no bearing on teaching any of the claim limitations, nor is it relevant to the rejection under Appeal.

Thus, designating the Examiner's arguments in the Response to Arguments section as a "new ground of rejection" would not be proper as (1) the statement regarding the new reference is not relevant to any claim limitation and (2) the rejection is based only on a combination of Beck and Johnson, and the new reference is not essential to support the grounds of rejection in the Examiner's Answer.

Accordingly the petition to designate a new ground of rejection in the Examiner's Answer is **DISMISSED.**

Wendy Garber, Director
Technology Center 2100

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OIPE IAP68
JUL 07 2006
PATENT & TRADEMARK OFFICE

RECEIVED
OCT 09 ENT'D
BY:

Paper No. 7

COPY MAILED
OCT 02 2002
OFFICE OF PETITIONS

STATTLER JOHANSEN & ADELI
P O BOX 51860
PALO ALTO CA 94303

In re Application of
Brehmer, et al.
Application No. 09/957,343
Filed: September 19, 2001
Attorney Docket No. PIXL.P0001C2

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 24, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 20, 2001, which set a shortened statutory period for reply of three (3) months. No extension of time pursuant to 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on March 21, 2002. A Notice of Abandonment was mailed on July 2, 2002.

The application is being forwarded to Technology Center 2800 for review of the amendment filed on September 24, 2002.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES 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 0 2006
OFFICE OF PETITIONS

LOWRIE, LANDO & ANASTASI
RIVERFRONT OFFICE
ONE MAIN STREET, ELEVENTH FLOOR
CAMBRIDGE, MA 02142

In re Application of	:	
Brehmer, et al.	:	
Application No.: 09/957,343	:	ON PETITION
Filed: September 19, 2001	:	
Attorney Docket No: Z2002-9000	:	

This is in response to the petition under 37 CFR 1.137(b) filed August 7, 2006.

The petition is **dismissed as moot.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition" under 37 CFR 1.137(b)."

This application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 20, 2001, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time was obtained pursuant to 37 CFR 1.136. Accordingly, the application became abandoned on March 21, 2002. A Notice of Abandonment was mailed on July 2, 2002. A petition under 37 CFR 1.137(b) was filed on September 24, 2002, and granted by a decision mailed October 2, 2002. The record does not reflect that the application became abandoned at any point after it was revived on October 2, 2002.

The instant petition under 37 CFR 1.137(b) must be dismissed as moot because there is no relief that can be provided under 37 CFR 1.137(b).

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

By mail:

Mail Stop Petitions
Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

The application file will be directed to the Office of Patent Publications to await applicant's response to the Notice of Allowability and Notice of Allowance and Issue Fee Due, mailed September 13, 2006.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON DC 20006

COPY MAILED

JUN 03 2005

OFFICE OF PETITIONS

In re Patent No. 6,857,502	:	
Issued: 22 February, 2005	:	
Application No. 09/957,400	:	ON PETITION
Filed: 21 September, 2001	:	
Atty Docket No. 011157	:	

This is a decision on the petition filed on 27 April, 2005, which is being treated as a request 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 inquires concerning this matter may be directed to the undersigned at 571.272.3231. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at 703.305.8309.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

COPY MAILED

JAN 22 2002

OFFICE OF PETITIONS

Merchant & Gould, P.C.
P. O. Box 2903
Minneapolis, MN 55402-0903

In re Application of
Yiv, *et al.*
Application No. 09/957,434
Filed: September 19, 2001
Attorney Docket Number: 12152.48USI1

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

This is in response to the December 27, 2001 petition Under 37 C.F.R. §1.47(a).

HISTORY

Applicant filed the above-identified application on September 19, 2001, naming Seang Yiv, Mingshu Li, Osmond D'Cruz, and Faith M. Uckun as joint inventors. However, the application as filed did not include the declaration executed as required by 37 C.F.R. §1.53. Specifically, the declaration lacked the signature of co-inventor Yiv.

On October 29, 2001, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record. A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on December 27, 2001, which was timely.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

> (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner has failed to demonstrate that the nonsigning inventor has been provided with a complete copy of the application. In fact, Petitioner has nowhere even alleged that such a step was taken. Rather, Petitioner has simply alleged that a declaration and power of attorney were sent to the nonsignor.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.[1] Under the provisions of 37 C.F.R. §1.63(b)(2), a valid declaration must "state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration." Thus, an inventor cannot make a valid declaration without having had the opportunity to review the application papers. This is why the Office requires that a copy of the papers be sent or delivered to the nonsignor before rule 47 status will be granted. Simply put, an inventor must be given the opportunity to review the entire application before a valid declaration can be made. Until such time as the application has been sent or delivered to the nonsignor, it cannot be said that the inventor has been given a *bona fide* opportunity to make the required declaration.

Petitioner is advised to consult the M.P.E.P. §409.03(d) for further information on what kind of showing is required to prove that the nonsigning inventor has refused to sign the declaration.

Because of the foregoing, this petition is *dismissed.*

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

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

By mail:	Assistant Commissioner for Patents Box DAC Washington, D.C. 20231
By FAX:	(703) 308-6916 Attn: Special Program Law Office
By hand:	Crystal Plaza Four, Suite 3C23 2201 S. Clark Place Arlington, VA

[1] M.P.E.P. §409.03(d)

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.

Scott M. Ledford
Petitions Attorney
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

MERCHANT & GOULD
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

COPY MAILED

JUN 2 6 2002

OFFICE OF PETITIONS

In re Application of
Yiv, et al
Application No. 09/957,434
Filed: September 19, 2001
Attorney Docket No. 12152.48USI1

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

This is in response to the renewed petition under 37 CFR 1.47(a), filed April 29, 2002.

The petition is granted.

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

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

Telephone inquiries regarding this decision should be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Office of Initial Patent Examination Unit for further processing.

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

SCANI **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/5/07

TO SPE OF : ART UNIT 3617

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/957447 Patent No.: 6857919

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

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

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

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

SPE

3617
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
AUG 25 2006
OFFICE OF PETITIONS

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

In re Application of	:	
Inoue, et al.	:	
Application No. 09/957,449	:	DECISION ON PETITION
Filed: September 21, 2001	:	TO WITHDRAW
Attorney Docket No. KYO004-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 February 21, 2006.

The request is **NOT APPROVED**.

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

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

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

There is an outstanding Office action mailed July 27, 2006 that requires a response by the applicant.

Telephone inquiries concerning this decision should be directed to April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: Mr. Kenji Suzuki
Patent Attorney
2-1-10-206, Sasazuka, Shibuya-ku
Tokyo 151-0073
Japan

UNITED STATES 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
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

MAILED

NOV 0 9 2009

OFFICE OF PETITIONS

In re Application of	:	
Leif Gustafson	:	
Application No. 09/957,457	:	DECISION GRANTING PETITION
Filed: September 21, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. JRL-4010-9	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, November 6, 2009 to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 27, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 3694 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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

Paper No. 2

In re Application of
Una CHEN
Application No. 09/957,458
Filed: 09/21/01
Attorney Docket No. P66567US0

: DECISION GRANTING PETITION
: TO RESET PERIOD FOR REPLY

This is a decision on the petition filed on January 18, 2002 requesting that the shortened statutory period for reply set forth in the Office communication mailed on October 18, 2001 be reset to run from the date on which the Office communication was actually received at the correspondence address of record. The Statutory period for reply set forth in the Office communication will be restarted on the new mail date.

The petition is granted.

Petitioner provided a statement that the Office communication in question was received at the correspondence address of record on _____. The petition was filed within two weeks of receipt of the Office communication. A substantial portion of the set reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed.

Accordingly, the shortened statutory period that was originally set forth in the Office communication originally mailed on _____ is hereby reset to run FROM THE RECEIPT DATE OF _____.

Kevin Little

Kevin Little, Management Analyst
Office of Initial Patent Examination
703-308-1202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Chain & Samuels LLP
1100 17th Street, N.W.
Suite 401
Washington, D.C. 20036

COPY MAILED

FEB 1 8 2009

OFFICE OF PETITIONS

In re Application of	:	
Warren Roach et al.	:	
Application No. 09/957,459	:	ON PETITION
Filed: September 21, 2001	:	
Attorney Docket No. 166.0001	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 2, 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 as a result of the petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20 (b) within the time period provided in 37 CFR 41.37 (a) (1). As an appeal brief (and appeal brief fee) was not filed two (2) months of the notice of appeal, filed March 11, 2008, and no extension of time under the provisions of 37 CFR 1.136 (a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197 (b). As no claim was allowed, the application became abandoned on May 12, 2008. See MPEP 1215.04.

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

The application became abandoned for failure to timely file an Appeal Brief in accordance with 37 CFR 41.37. The proposed reply required for consideration of a petition to revive must be an Appeal Brief (an 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). The Notice of Appeal submitted with instant petition is not a proper response, because a Notice of Appeal (and the required fee) had been previously 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 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 Zohreh Fay at (571) 272-6051 or in her absence to the undersigned at (571) 272-7099.

David Bucci
Petition Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FREDERICK SAMUELS
CAHN & SAMUELS LLP
1100 17TH STREET NW
SUITE 401
WASHINTION DC 20036

COPY MAILED

JUN 2 9 2009

OFFICE OF PETITIONS

In re Application of	:	
Warren Roach et al.	:	
Application No. 09/957,459	:	DECISION ON PETITION
Filed: September 21, 2001	:	
Attorney Docket No. 166.0001	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed April 17, 2009 to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned as a result of the petitioner's failure to file an appeal brief and fee required by 37 CFR 41.20 (b) within the time period provided in 37 CFR 41.37 (a)(1). As an appeal brief (and appeal brief fee) was not filed two (2) months form the Notice of Appeal, filed March 11, 2008, and no extension of time under the provisions of 37 CFR 1.136 (a) were obtained. The appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.1979b). As no claim was allowed, the application became abandoned on May 12, 2008. See MPEP1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief, (2) the petition fee of $810, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Newton Edwards at (571) 272-6052 or in his absence to the undersigned at (571) 272-7099.

This application is being referred to Technology Center AU 2162 for appropriate action by the Examiner in the normal course of business on the reply received.

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

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET NW, SUITE 1200
WASHINGTON, DC 20006-1109

COPY MAILED
OCT 11 2006
OFFICE OF PETITIONS

In re Application of	:
Ty Bordner et al	:
Application No. 09/957,465	: DECISION GRANTING PETITION
Filed: September 21, 2001	: UNDER 37 CFR 1.137(b)
Attorney Docket No. 72167.000594	:

This is a decision on the petition under 37 CFR 1.137(b), filed March 20, 2006, to revive the above-identified application.

The petition 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, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 7, 2005 (September 3, 2005, the due date, was a Saturday, and Monday, September 5, 2005, was a Federal holiday).

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply (amendment), (2) the $1,500 petition fee, and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of June 3, 2005 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 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 the delay was intentional, petitioner must notify the Office.

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

This matter is being referred to Technology Center AU 2161 for appropriate action in the normal course of business on the reply received March 20, 2006.

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

BARNES & THORNBURG LLP
750-17TH STREET NW
SUITE 900
WASHINGTON DC 20006-4675

COPY MAILED
DEC 22 2008

In re Patent No. 7,386,525	:	
Issue Date: June 10, 2008	:	
Application No. 09/957,516	:	ON PETITION
Filed: September 21, 2001	:	
Attorney Docket No. P 283740	:	
2011269US/A/KOP	:	

This is a decision on the REQUEST UNDER 37 C.F.R. § 3.81(b) AND SUPPLEMENTAL REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.323 filed July 23, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the omission of the city of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **DISMISSED** without prejudice to reconsideration upon the submission of a Certificate of Correction.

This decision is made in light of the REQUEST FOR CERTIFICATE OF CORRECTION filed June 26, 2008. By decision mailed July 17, 2008, the Certificate of Corrections Branch dismissed the request for failure to submit a request meeting the requirements of 37 CFR 3.81(b) and directed to the Office of Petitions for decision.

Petitioner requests that the patent be corrected to reflect the city of the assignee Stonesoft Corporation, to Helsinki (FI). Petitioner provides a copy of the assignment as recorded September 21, 2001 at Reel/Frame 012195/0676.

---

[1] *See* MPEP 1309, subsection II, Official Gazette at 1283 OG 148 (June 22, 2004) or Final Register at 69 FR 29865 (May 26, 2004).

Both petitioner's evidence and Office records show that the assignment of the above-identified application to Stonesoft Corporation, Helsinki, Finland was submitted for recording in the Office on September 21, 2001 before issuance of the patent on June 10, 2008. This was also prior to payment of the Issue Fee on May 1, 2008. Receipt of the required $130 processing fee is acknowledged. The required $100 certificate of correction fee was previously submitted. Accordingly, the relief requested can be granted.

Unfortunately, the request includes the processing fee and the Certificate of Correction fee, but does not include a Certificate of Correction. As petitioner has failed to fully comply with the provisions of 37 CFR 3.81(b), the request cannot be granted at this time.

The Certificates of Correction Branch is instructed to issue a certificate of correction upon submission by petitioner of a request for a certificate of correction which sets forth Stonesoft Corporation, Helsinki (FI) 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[2].

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3219. Any questions concerning issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

[2] However, to facilitate issuance of the Certificate of Correction, patentee may contact the undersigned upon the filing of the Certificate of Correction.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATRICK G. BURNS, ESQ.
GREER, BURNS & CRAIN, LTD.
300 SOUTH WACKER DRIVE, SUITE 2500
CHICAGO, IL 60606

COPY MAILED
MAY 0 8 2006
OFFICE OF PETITIONS

In re Application of	:
Hiroshi Ashikaga et al	:
Application No. 09/957,598	: DECISION ON PETITION
Filed: September 20, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 0941.65838	:

This is a decision on the petition, filed July 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,** *nunc pro tunc*.

It is noted that, although the petition to withdraw from issue had not been acted upon by the appropriate deciding official of the U.S. Patent and Trademark Office, the Technology Center processed the request for continued examination (RCE) under 37 CFR 1.114 and subsequently issued a new Notice of Allowance and Fee(s) Due and Notice of Allowability on September 22, 2005. Where an issue fee has been paid and an RCE is subsequently filed, the RCE is not a proper filing unless a petition to withdraw from issue has been granted. Therefore, the examiner was without authority to act further in the case absent a grantable petition withdrawing the application from issue. Nevertheless, in view of this decision on petition, the RCE is now considered a proper filing and the actions of the examiner taken thereafter are hereby ratified.

The issue fee in reply to the second Notice of Allowance and Fee(s) Due mailed September 22, 2005 was received on October 21, 2005. Accordingly, this matter is being referred to Publishing Division for taking such further action as the nature of the case requires.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\may9\957598.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

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

4/7/08

Patent No. :7155157
Ser. No. :09957656
Inventor(s) :Craig A. Kaplan
Issued : 12/26/06
Title : METHOD AND SYSTEM FOR ASYNCHRONOUS ONLINE DISTRIBUTED PROBLEM SOLVING INCLUDING PROBLEMS IN EDUCATION, BUSINESS, FINANCE, AND TECHNOLGY
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

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

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

A certificate of correction will be issued to correct the remaining errors noted in your request.

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

Perkins Colie LLP
P.O Box 2168
Menlo Park, CA 94026

HR

UNITED STATES 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 1208
SEATTLE, WA 98111-1208

COPY MAILED
JUL 23 2008

In re Patent No. 7,155,157 :
Issue Date: December 26, 2006 :
Application No. 09/957,656 : ON PETITION
Filed: September 20, 2001 :
Attorney Docket No. 61117-8001.US01 :

This is a decision on the petition filed April 25, 2008, which is being treated as a petition under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction.

The petition is **DISMISSED.**

Petitioner requests issuance of a certificate of correction in the name of "IQ CONSULTING COMPANY, INC."

37 CFR 3.81(b), effective June 25, 2004, reads:

> After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter. See also MPEP 1481.01.

U.S. Patent and Trademark Office assignment records disclose that an assignment from IQ COMPANY to IQ CONSULTING COMPANY, INC. was recorded on February 6, 2007, after the date of issuance of this patent. Accordingly, since the assignment was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 19, 2007

TO SPE OF : ART UNIT 3766 09/957657

SUBJECT : Request for Certificate of Correction on Patent No.: 7171265 B2

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

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

Elisha Evans

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 EXT 110

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

☒ **Approved** — **All** changes apply.

☐ **Approved in Part** — Specify below which changes **do not** apply.

☐ **Denied** — State the reasons for denial below.

Comments:

Carl H. Layno — **SPE**

3766 — **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

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

COPY MAILED

JUL 20 2007

OFFICE OF PETITIONS

In re Patent No. 7,171,265	: DECISION GRANTING PETITION
Issue Date: January 30, 2007	: UNDER 37 CFR 1.78(a)(3) AND
Application No. 09/957,657	: REQUEST FOR CERTIFICATE OF
Filed: September 20, 2001	: CORRECTION
Attorney Docket No. 1831.14US02	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed April 2, 2007, seeking to add a claim for benefit of priority under 35 U.S.C. § 120 to nonprovisional Application No. 09/487,557, filed January 19, 2000, by way of a certificate of correction.

The petition is **granted**.

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

The instant application was filed September 20, 2001. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP 1481.

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) and (iii) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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

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

It is noted that, upon approval by the Technology Center, a Certificate of Correction was issued on June 12, 2007, prior to the granting of this decision on petition. Accordingly, no further action is deemed necessary in this case.

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

Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
09/957,657	09/20/2001	3766	1235	1831.14US02	20	3

CONFIRMATION NO. 2804

CORRECTED FILING RECEIPT

OC000000024916531

24113
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

Date Mailed: 07/19/2007

Receipt is acknowledged of this nonprovisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Harold H. Hoium, Eden Prairie, MN;
Stephen J. Ryan, Chaska, MN;

Assignment For Published Patent Application

Harbinger Medical, Inc.

Power of Attorney:

John Thuente--29595
James Patterson--30673
Bradley Pedersen--32432
Douglas Christensen--35480
William Alexander--37269
Michael Bondi--39616
Peter Dardi--39650
Kimberly Baxter--40504
Eric Chadwick--41664
Randall Skaar--42151

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/234,054 09/20/2000
and is a CIP of 09/487,557 01/19/2000 PAT 6,445,947
which is a CIP of 09/126,864 07/31/1998 PAT 6,129,678
and claims benefit of 60/116,396 01/19/1999
and claims benefit of 60/133,983 05/13/1999

Foreign Applications

If Required, Foreign Filing License Granted: 10/29/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/957,657

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

APPARATUS AND METHOD FOR DETECTING LEAD ADEQUACY AND QUALITY

Preliminary Class

607

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.:20070108

DATE : January 8, 2007

TO SPE OF : ART UNIT 1638

SUBJECT : Request for Certificate of Correction on Patent No.: 7,122,715

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:

Proposed changes to claims 41-42 are approved. Proposed changes to claims 10 and 13 are denied because they result in the following phrase: "wherein the transgenic is cell derived". Claims 10 and 13 should be amended to merely delete "is" in the first line of each claim, and to insert ---is--- before "derived" in the second line of each claim.

ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARK A. LITMAN & ASSOCIATES
YORK BUSINESS CENTER, SUITE 205
3209 WEST 76TH STREET
EDINA MN 55402

COPY MAILED

OCT 1 3 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
John G. Breeding et al	:	
Application No. 09/957,665	:	
Filed: September 20, 2001	:	
Attorney Docket No. PA0600.AP.US	:	

This is a decision on the petition, filed October 8, 2004, 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**.

The above-identified application is withdrawn from issue for express abandonment. See 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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

The application is being referred to Files Repository.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#7

Paper No. 7

COPY MAILED

JAN 09 2002

OFFICE OF PETITIONS

GENIE L. OGILVIE
COMPUTER LAW ++
1211 EAST YALE AVENUE
SALT LAKE CITY, UT 84105

In re Application of Moshir, et al. Application No. 09/957,673 Filed: September 20, 2001 Attorney Docket No. 5029.2.1A For: NON-INVASIVE AUTOMATIC OFFSITE PATCH FINGERPRINTING AND UPDATING SYSTEM AND METHOD	DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a) filed November 26, 2001 and supplemented December 12, 2001.

The petition is **GRANTED**.

Petitioner has shown that the inventors James J. Horton and Dan Ferguson have 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.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for issuance of a corrected filing receipt.

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

E. Shirene Willis for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DAN FERGUSON
5001 EAST HILTON AVENUE
MESA, AZ 85206

COPY MAILED

JAN 0 9 2002

OFFICE OF PETITIONS

In re Application of :
Moshir, et al. :
Application No. 09/957,673 : LETTER
Filed: September 20, 2001 :
Attorney Docket No. 5029.2.1A :
For: NON-INVASIVE AUTOMATIC OFFSITE:
PATCH FINGERPRINTING AND UPDATING :
SYSTEM AND METHOD :

Dear Sir:

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

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost 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 Alesia M. Brown at (703) 305-0310. 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).

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

CC: GENIE L. OGILVIE
COMPUTER LAW ++
1211 EAST YALE AVENUE
SALT LAKE CITY, UT 84105

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAMES J. HORTON
136 NORTH BRETT STREET
GILBERT, AZ 85234

COPY MAILED

JAN 0 9 2002

OFFICE OF PETITIONS

In re Application of :
Moshir, et al. :
Application No. 09/957,673 : LETTER
Filed: September 20, 2001 :
Attorney Docket No. 5029.2.1A :
For: NON-INVASIVE AUTOMATIC OFFSITE:
PATCH FINGERPRINTING AND UPDATING :
SYSTEM AND METHOD :

Dear Sir:

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

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost 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 Alesia M. Brown at (703) 305-0310. 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).

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

CC: GENIE L. OGILVIE
COMPUTER LAW ++
1211 EAST YALE AVENUE
SALT LAKE CITY, UT 84105

UNITED STATES 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

Genie L. Ogilvie
COMPUTER LAW++
1211 East Yale Avenue
Salt Lake City, Utah 84105

MAIL

OCT 3 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Sean Moshir et al. Application No. 09/957,673 Filed: September 21, 2001 For: NON-INVASIVE AUTOMATIC OFFSITE PATCH FINGERPRINTING AND UPDATING SYSTEM AND METHOD	)))))))	**DECISION ON PETITION UNDER M.P.E.P. §708.02(II): INFRINGEMENT**

This is a decision on the petition, refiled October 13, 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. The original submission of May 12, 2003 has not been matched to the file.

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(h) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed: and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. A fee under 37 C.F.R. for such a petition is required.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**. The application file is being forwarded to the Examiner of Record for expedited examination.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 21

MAIL

JUN 2 9 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Genie Ogilvie
Computer Law
1211 East Yale Avenue
Salt Lake City, UT 84105

In re Application of:
Sean MOSHIR, et al.
Application No. 09/957,673
Filed: September 20, 2001
For: NON-INVASIVE AUTOMATIC OFFSITE PATCH FINGERPRINTING AND UPDATING SYSTEM AND METHOD

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed June 15, 2004.

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

There is no indication that Applicant has been notified of the request for withdrawal. Accordingly, the request is **DENIED.**

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

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

UNITED STATES 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 : November 23, 2009

Patent No. :6990660
Inventor(s) :Sean Moshir et al.
Issued :January 24, 2006
Title :NON-INVASIVE AUTOMATIC OFFSITE PATCH FINGERPRINTING AND :UPDATING SYSTEM AND METHOD

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 Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	571-273-8300 ATTN: Office of Petitions
EFS web	uspto.gov/ebc/index.html (must be registered as an e-filer to submit responses) Technical Support 1-866-217-9197

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 756-1541.

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756-1541

HEATH J. BRIGGS
GREENBERG TRAURIG
1200 17th Street,
Suite 2400
Denver, CO 80202

/arg

UNITED STATES 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

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

COPY MAILED

JUL 1 8 2003

OFFICE OF PETITIONS

In re Application of :
Gary Bridger, et al. :
Application No. 09/957,682 :
Filed: September 17, 2001 :
Attorney Docket No. 391442004400 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 9, 2003, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed November 20, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 21, 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 $465 extension of time submitted with the petition on July 9, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account number 03-1952.

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

The application file is being forwarded to Technology Center 1600, Art Unit 1625 for further processing.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GREENLEE WINNER AND SULLIVAN P C
5370 MANHATTAN CIRCLE
SUITE 201
BOULDER, CO 80303

COPY MAILED

JUL 2 2 2004

OFFICE OF PETITIONS

In re Application of :
Curt H. Hagedorn :
Application No. 09/957,689 :
Filed: September 19, 2001 :
Attorney Docket No. 96-01 :

ON PETITION

This is a decision on the petition, filed July 20, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 7, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 1639 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

AUG 3 1 2005

OFFICE OF PETITIONS

Foley & Lardner LLP
1530 Page mill Road
Palo Alto, Ca 94304

In re Application of
Bolton et al
Application No. 09/957,698
Filed: September 18, 2001
Attorney Docket No. *

: DECISION GRANTING PETITION

This decision is in response to Applicants' "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" timely[1] filed on January 19, 2005 requesting that the Office adjust the Patent Term Adjustment to a determination of 52 days of patent term adjustment.

Applicants' application for PTA is GRANTED TO THE EXTENT HEREIN INDICATED. The Office will adjust the PAIR calculation to reflect this decision by removing the 13 days of PTA reduction and inserting the 2 day reduction.

Applicants assert that the Office made (2) errors in the calculation of the Patent Term Adjustment. Specifically, applicants assert that the Office erred in asserting a thirteen day delay in responding to the notice to file missing parts. In addition, the Office erred in not calculating the amount of time over three years in issuance of the patent.

Applicants arguments as to the error in assessing a delay for an overdue response to the missing parts are persuasive. The file history reflects that applicants filed a complete response on January 28, 2002, not February 8, 2002 as asserted by the Office. Accordingly, applicants are entitled to removal of eleven days of applicant delay.

As for the applicants request that the patent will issue 227 days beyond three years, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee if such request is the sole basis for seeking an adjustment under 1.705(d).

---

[1]Issue fee was paid on January 19, 2005

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

Accordingly, at the time of the mailing of the notice of allowance, the Office had delayed by a period of 28 days and applicant had delayed by a period of 175 (59 + 61 +53 + 2 = 175). Any time earned for the Office's failure to issue the application within three years of the filing of the application under 37 CFR 1.702(b) and the failure to issue the application within four months of the payment of the issue fee and other requirements being satisfied under 37 CFR 1.702(a)(4) will be reflected in the issue notification letter that will be mailed to applicants approximately three week prior to issuance.

After the mailing of this decision, the application will be forwarded to the Office of Patent Publication for a prompt issuance of the application.

The Office has assessed the $200.00 fee. No additional fees are required for this decision.

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.

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

cc: Adjusted PAIR calculation

#7

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

NOV 14 2002

Office of the Director
Group 3600

Knoble & Yoshida
Eight Penn Center
Suite 1350,
1628 John F. Kennedy Blvd.
Philadelphia, PA 19103

In re application of
Masaki Nishino, et.al.
Application No. 09/957,722 : DECISION ON REQUEST
Filed: September 21, 2001 : FOR WITHDRAWAL OF
For: VEHICLE SEAT : ATTORNEY

This is a decision on the request filed on September 17, 2002, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

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

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

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

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

09/957,722

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks conditions (A) above.

As to condition (A). The Customer Number 50-0462 supplied does not exist. Therefore, it is not clear who Ken Yoshida is signing on behalf of.

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

Rjb:11/6/02

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

#12

MAILED

APR 25 2003

Office of the Director
Group 3600

Steinberg & Raskin, P.C.
1140 Avenue of the Americas, 15th Floor
New York, NY 10036-5803

In re application of
Masaki Nishino et al.
Application No. 09/957,722
Filed: September 21, 2001
For: VEHICLE SEAT

DECISION ON RENEWED REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the renewed request filed on November 27, 2002, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application. The delay in treating this request is sincerely regretted.

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).

A request to withdraw as attorney in the above-identified application was filed September 17, 2002. The request was not approved in a decision mailed November 14, 2002 wherein it was held that the request lacked condition A) above. The Customer Number 50-0462 supplied does not exist. Therefore, it was not clear who Ken Yoshida was signing on behalf of.

The request to withdraw as attorney filed November 27, 2002 is not approved as moot because the power of attorney has already been withdrawn as per the Notice to that effect of April 1, 2003.

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(703) 308-2121
(703) 605-0586 (facsimile)

RAR/tpl: 4/3/03

Cc: Knoble & Yoshida
Eight Penn Center
Suite 1350, 1628 John F. Kennedy Blvd.
Philadelphia, PA 19103

UNITED STATES 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 18 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

STEINBERG & RASKIN, P.C.
1140 AVENUE OF THE AMERICAS, 15th FLOOR
NEW YORK, NY 10036-5803

Paper No. 15

In re Application of
Masaki Nishino, et al.
Application No. 09/957,722
Filed: September 21, 2001
For: VEHICLE SEAT

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition to withdrawal the holding of abandonment filed on July 21, 2003. The delay in deciding this petition is sincerely regretted.

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

☒ Postcard receipt being dated December 23, 2002.

☐ USPTO return facsimile receipt dated _____, which references the application by serial number and the amendment that was filed on that date.

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

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

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

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

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/2/15/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

McCormick, Paulding & Huber LLP
City Place II
185 Asylum Street
Hartford, CT 06103-3402

COPY MAILED

MAR 07 2005

OFFICE OF PETITIONS

In re Application of
Mark Gaydos, et al.
Application No. 09/957,726
Filed: September 20, 2001
Attorney Docket No. 6016-48

ON PETITION

This is a decision on the petition, filed December 8, 2004, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed December 23, 2003. A Notice of Abandonment was mailed on October 15, 2004.

The petition is found to comply with the requirements of 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center AU 3727 for consideration of the amendment filed December 8, 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.

Bryan D. Wright
Woods, Rogers & Hazlegrove, PLC
Suite 300
250 W. Main St.
Charlottesville, VA 22902

COPY MAILED

NOV 0 5 2004

OFFICE OF PETITIONS

In re Application of Mike Neighbors Application No. 09/957,748 Filed: September 21, 2001 Atty Docket No. 104100-01-03	: : : : :	DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed October 5, 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. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under § 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely file a proper reply to the final Office action mailed October 6, 2003. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). On April 5, 2004, applicant replied with an Amendment, made timely by an accompanying petition for a three month extension of time. However, the amendment was determined by the examiner not to place the application in condition for allowance (Advisory Action mailed May 4, 2004). No proper reply having been received and no further extensions of time being obtainable, the application became abandoned effective April 6, 2004. A Notice of Abandonment was mailed on September 30, 2004.

Petitioner maintains that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unavoidable. Petitioner asserts the abandonment was unavoidable because applicant could not have responded to the Advisory Action within the regulatory time frame.

STATUTES, RULES AND REGULATIONS

35 U.S.C. 133 provides that the Director may revive an application if the delay in replying to the outstanding Office

action is shown to the satisfaction of the Director to have been unavoidable. A grantable petition to revive an unavoidably abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee 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 this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

The burden of showing the cause of the delay is on the person seeking to revive the application. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). This burden includes establishing that the entire delay from the due date for the reply until the filing of a grantable petition was unavoidable. Haines v. Quigg, 673 F.Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable:

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

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 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). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

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

Petitioner has not met his burdening of establishing unavoidable delay within the meaning of § 1.137(a). It was petitioner's responsibility to timely file a proper response to the final Office action. The response filed after the shortened statutory period for reply was not proper. As stated in § 1.135(b), filing such a response will not operate to save the application from abandonment. Moreover, it is well-established that letting the time period for response expire without having filed a proper response to a final Office action is not unavoidable within the meaning of § 1.137(a).

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under § 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR §1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

The time period set in this dismissal of two months for reply with extensions of time obtainable under § 1.136(a) applies to requests for reconsideration filed under either § 1.137(a) or § 1.137(b). Regardless, petitioner should not delay filing a request for reconsideration as petitioner continues to bear the burden of establishing that the entire delay, including the delay from the due date for the reply until the filing of a grantable petition, was unavoidable or unintentional.

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: (703) 872-9306
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

By hand: Effective June 5, 2004, patent correspondence delivered by hand or delivery services, other than the USPS, to the Customer Window must be addressed as follows:

U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop
Crystal Plaza Two, Lobby, Room IB03
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Bryan D. Wright
Williams Mullen
401 E. Market Street
Suite 101
Charlottesville, VA 22902

COPY MAILED

MAR 29 2005

OFFICE OF PETITIONS

In re Application of
Mike Neighbors
Application No. 09/957,748
Filed: September 21, 2001
Atty Docket No. 104100-01-03

CORRECTED
DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed October 5, 2004, to revive the above-identified application.

This corrected decision is being mailed to correct an error in sending the original decision to an old correspondence address, and to reset the period for responding to the dismissal. A change of correspondence address accompanied the original petition but was not acknowledged and made of record.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under § 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely file a proper reply to the final Office action mailed October 6, 2003. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). On April 5, 2004, applicant replied with an Amendment, made timely by an accompanying petition for a three month extension of time. However, the amendment was determined by the examiner not to place the application in condition for allowance (Advisory Action mailed May 4, 2004). No proper reply having been received and no further extensions of time being obtainable, the application became abandoned effective April 6, 2004. A Notice of Abandonment was mailed on September 30, 2004.

Petitioner maintains that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unavoidable. Petitioner asserts the abandonment was unavoidable because applicant could not have

responded to the Advisory Action within the regulatory time frame.

STATUTES, RULES AND REGULATIONS

35 U.S.C. 133 provides that the Director may revive an application if the delay in replying to the outstanding Office action is shown to the satisfaction of the Director to have been unavoidable. A grantable petition to revive an unavoidably abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee 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 this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

The burden of showing the cause of the delay is on the person seeking to revive the application. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). This burden includes establishing that the entire delay from the due date for the reply until the filing of a grantable petition was unavoidable. Haines v. Quigg, 673 F.Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable:

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

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 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). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from

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

Petitioner has not met his burdening of establishing unavoidable delay within the meaning of § 1.137(a). It was petitioner's responsibility to timely file a proper response to the final Office action. The response filed after the shortened statutory period for reply was not proper. As stated in § 1.135(b), filing such a response will not operate to save the application from abandonment. Moreover, it is well-established that letting the time period for response expire without having filed a proper response to a final Office action is not unavoidable within the meaning of § 1.137(a).

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under § 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR §1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

The time period set in this dismissal of two months for reply with extensions of time obtainable under § 1.136(a) applies to requests for reconsideration filed under either § 1.137(a) or § 1.137(b). Regardless, petitioner should not delay filing a request for reconsideration as petitioner continues to bear the burden of establishing that the entire delay, including the delay from the due date for the reply until the filing of a grantable petition, was unavoidable or unintentional.

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: (703) 872-9306
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

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

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Bryan D. Wright
Williams Mullen
401 E. Market Street
Suite 101
Charlottesville, VA 22902

COPY MAILED

JUN 16 2005

OFFICE OF PETITIONS

In re Application of Mike Neighbors Application No. 09/957,748 Filed: September 21, 2001 Atty Docket No. 104100-01-03	: : : : :	DECISION ON PETITION

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) filed May 9, 2005.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file a proper reply to the final Office action mailed October 6, 2003. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). On April 5, 2004, applicant replied with an Amendment, made timely by an accompanying petition for a three month extension of time. However, the amendment was determined by the examiner not to place the application in condition for allowance (Advisory Action mailed May 4, 2004). No proper reply having been received and no further extensions of time being obtainable, the application became abandoned effective April 6, 2004. A Notice of Abandonment was mailed on September 30, 2004.

By decision mailed March 29, 2005, the initial petition filed under 37 CFR 1.137(a) on October 5, 2004, was dismissed for failure to make an adequate showing of unavoidable delay.

On instant petition, petitioner now seeks to meet the lesser burden of showing that the delay was unintentional. The petition includes payment of the petition fee, a proposed response to the final Office action, and the required statement of unintentional delay pursuant to § 1.137(b). Petitioner has now met all requirements for granting of petition under § 1.137(b).

The application file is being forwarded to Technology Center AU 3727 for further action.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

ALTERA LAW GROUP, LLC
6500 CITY WEST PARKWAY
SUITE 100
MINNEAPOLIS MN 55344-7704

MAILED

FEB 1 9 2003

Technology Center 2600

In re Application of :
Scott Sarkinen et al :
Application No. 09/957,750 :
Filed: September 21, 2001 :
For: **PROGRAMMABLE MULTI-SERVICE QUEUE SCHEDULER** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on December 10, 2002.

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

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application are removed from record.

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

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

cc: Scott Sarkinen
7580 Knollwood Drive
Mounds View, MN. 55112

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

ALTERA LAW GROUP, LLC
6500 CITY WEST PARKWAY
SUITE 100
MINNEAPOLIS MN 55344-7704

MAILED

FEB 1 9 2003

Technology Center 2600

In re Application of :
Scott Sarkinen et al :
Application No. 09/957,751 :
Filed: September 21, 2001 :
For: **MULTI-SERVICE QUEUING METHOD AND APPARATUS THAT PROVIDES EXHAUSTIVE ARBITRATION, LOAD BALANCING, AND SUPPORT FOR RAPID PORT FAILOVER** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on December 10, 2002.

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

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application are removed from record.

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

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

cc: Scott Sarkinen
7580 Knollwood Drive
Mounds View, MN. 55112

UNITED STATES 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.

Scott Sarkinen
7580 Knollwood Drive
Mounds View MN 55112

COPY MAILED
JUL 10 2006
OFFICE OF PETITIONS

In re Application of	:	
Sarkinen et al.	:	DECISION ON
Application No. 09/957,751	:	PETITION
Filed: September 21, 2001	:	
Atty Docket No. 1305.20US01	:	

This is a decision on the "PETITION FOR ISSUANCE OF A NEW NOTICE OF ALLOWANCE AND WITHDRAWAL OF THE NOTICE OF ABANDONMENT" filed May 19, 2006. This paper is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

The above-identified application became abandoned for failure to timely pay the issue fee and publication fee within the three-month statutory period set in the Notice of Allowance and Fee(s) Due mailed November 3, 2005. This period is not extendable. No reply having been received, the above-identified application became abandoned on February 4, 2006. A courtesy Notice of Abandonment was mailed on March 31, 2006.

The instant petition was filed on the basis that the attorney of record never received the Notice of Allowance. In support thereof, petitioner submits the declaration of patent attorney Brad Pedersen.

Petitioner's arguments and evidence have been considered, but not found persuasive that withdrawal of the holding of abandonment is warranted. A review of the record reveals that the Notice of Allowance was mailed to the correspondence address of record properly in effect on the day of mailing. By decision mailed February 19, 2003, a request to withdraw, made by the attorney named on the original declaration for patent, was granted. Consequently, the address of record was changed to that of the first named inventor. See 37 CFR § 1.33(a). On May

25, 2004, a substitute power of attorney, including a change of address, was filed by Michael Weingarten as managing director of SLT LOGIC, LLC as assignee. The request was not accompanied by a 3.73(b) statement. At least for the reason of a managing director not being presumed to have the authority to sign on behalf of a company and this submission lacking an express statement that Mr. Weingarten was empowered to sign on behalf of the assignee (and no such statement being of record), by letter mailed November 1, 2004, the Office advised the filer of the paper that the substitute power of attorney was not accepted. See 37 CFR § 3.73(b)(2).

Furthermore, petitioner acknowledges that on November 12, 2004, the firm received this Notice Regarding Power of Attorney from the USPTO stating that the power of attorney filed May 25, 2004 had not been accepted. Petitioner now sets forth arguments as to why the conclusion that the power of attorney would not be accepted was in error. (It is noted that these arguments are not only untimely, but also unpersuasive). However, petitioner does not show that at the time they took any action in response to the Notice. Absent entry of a power of attorney or of an assignee establishing their right to take action in an application pursuant to 37 CFR 3.73, an attorney may act in a representative capacity, but may not change the correspondence address of record. See 37 CFR 1.33(a)(1). Accordingly, the Office continued to mail correspondence to the address of the first named inventor.

Further, petitioner acknowledges that the non-final Office action mailed June 15, 2005 was received on September 14, 2005 as addressed to the first named inventor. Yet, despite the delay in receipt and the apparent continued addressing of Office communications to the first named inventor, petitioner does not indicate that any action was taken to then respond to the Notice Regarding Power of Attorney or otherwise change the correspondence address of record. Instead, acting in a representative capacity pursuant to § 1.34, the attorney filed a response to the Office action.

In this context, on November 4, 2005, the Notice of Allowance was mailed to the uncorrected correspondence address of record, but was not received by petitioner at the address he had intended to, but never did, make of record in the application.

In view thereof, abandonment for failure to timely respond to the Notice of Allowance mailed to the correspondence address of record was proper. Non-receipt of the Notice of Allowance is properly attributed to the failure to file a proper power of attorney and change of correspondence address. Under the circumstances, withdrawal of the holding of abandonment is not warranted.

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

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are not permitted. See 1.181(f).

Alternatively, applicants may seek revival under the provisions of 37 CFR 1.137. Such a request should include a cover letter entitled "Petition under 37 C.F.R. § 1.137(a)" or "Petition under 37 C.F.R. § 1.137(b)," as appropriate.

A courtesy copy of this decision is being mailed to the address set forth on the petition. All future correspondence will be mailed to the correspondence address of record (which continues to be that of the first named inventor) until such time as a proper change of correspondence address is filed.

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

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

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

cc: Brad Pedersen
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

UNITED STATES 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.

Scott Sarkinen
7580 Knollwood Drive
Mounds View MN 55112

COPY MAILED

NOV 0 2 2006

OFFICE OF PETITIONS

In re Application of	:	
Sarkinen et al.	:	DECISION ON
Application No. 09/957,751	:	PETITION
Filed: September 21, 2001	:	and
Atty Docket No. 1305.20US01	:	NOTICE OF NONACCEPTANCE
	:	OF
	:	CHANGE OF CORRESPONDENCE ADDRESS

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b) filed September 14, 2006 (certificate of mailing Monday September 11, 2006).

The petition is **GRANTED**.

The above-identified application became abandoned effective February 4, 2006 for failure to timely pay the issue fee and publication fee within the three-month statutory period set in the Notice of Allowance and Fee(s) Due mailed November 3, 2005. By decision mailed July 10, 2006, a prior petition for ISSUANCE OF A NEW NOTICE OF ALLOWANCE AND WITHDRAWAL OF THE NOTICE OF ABANDONMENT" filed May 19, 2006 was dismissed.

In response, applicants timely filed the instant petition. Petitioner now states that the delay in responding was unintentional. On prior petition, applicants submitted the required reply in the form of payment of the Issue Fee. With the instant petition, applicants complete the required reply with payment of the Publication Fee[1]. Further, the petition includes the petition fee of $750 and the required statement of unintentional delay. In view thereof, it is concluded that

[1] There was no separate but concurrent requirement for new drawings.

petitioner has met all requirements for a grantable petition under 37 C.F.R. 1.137(b).

A courtesy copy of this decision is being mailed to the address set forth on the petition. All future correspondence will be mailed to the correspondence address of record (which continues to be that of the first named inventor) until such time as a proper change of correspondence address is filed.

It is noted that accompanying the petition was a change of address signed by attorney Pedersen. However, for the reasons previously stated, such a change of correspondence address continues to be improper. Attorney Pedersen continues to only be acting in a representative capacity. Although some evidence was submitted as an exhibit to the earlier petition to show that SLT Logic LLC is an assignee of record, the actions necessary to enable attorney Pedersen to change the correspondence address still have not occurred[2]. The record does not include a 3.73(b) statement. Even if a 3.73(b) statement could be construed from the exhibit on petition, the record does not include a power of attorney to attorney Pedersen. As such, attorney Pedersen is not an attorney of record. So attorney Pedersen can only continue to file papers in a representative capacity. He cannot take actions that are limited to those allowable for an attorney of record, such as filing a change of correspondence address.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

cc: Brad Pedersen
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

---

[2] Two attempts were made to call attorney Pedersen at the number listed on the petition to discuss this matter. Unfortunately, this number led to the voice mailbox of another attorney without the option of being connected to a receptionist for redirection.

UNITED STATES 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 11 2006
OFFICE OF PETITIONS

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA PA 19103

In re Application of	:	
Roberts et al.	:	DECISION ON PETITION
Application No. 09/957,760	:	TO WITHDRAW
Filed: September 21, 2001	:	FROM RECORD
Attorney Docket No. BELL-0132/01185	:	

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 2, 2005.

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

A review of the file record indicates that the power of attorney to Steven J. Rocci and all other attorneys of record has been revoked by the assignee of the entire interest of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.136(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 Petitions Examiner Liana Chase at 571-272- 3206.

Denise Pothier for

David Bucci
Petitions Examiner
Office of Petitions

cc:

WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA GA 30007-1355

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : January 17, 2007

TO SPE OF : ART UNIT 2814

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/957784 Patent No.: 7105463 B2

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

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

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

Elisha Evans

Certificates of Correction Branch

703-308-9390 ext. 110

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

SPE

2814

Art Unit

OIPE IAP 39
DEC 1 1 2006
PATENT & TRADEMARK OFFICE

C of C

PATENT
Atty. Dkt. No. APPM/004946.Y1/DISPLAY/AHRDWR/RKK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kurita et al.	§	
	§	Group Art Unit: 2812
Patent No.: 7,105,463	§	
	§	Examiner: Wai-Sing Louie
Issued: September 12, 2006	§	
Serial No.: 09/957,784	§	**Certificate**
Filed: September 21, 2001	§	DEC 1 4 2006
For: LOAD LOCK CHAMBER HAVING TWO DUAL SLOT REGIONS	§	**of Correction**

Please enter! Wai Sing Louie

CERTIFICATE OF MAILING
37 CFR 1.8
I hereby certify that this correspondence is being deposited on 12/7, 2006 with the United States Postal Service as First Class Mail in an envelope addressed to: Certificate of Correction Branch, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.
12/7/06 Date — Signature

Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR CERTIFICATE OF CORRECTION

Attached is a Certificate of Correction for correcting several errors throughout the printed patent.

Applicants submit that at least one of the errors mentioned above was made by the applicants. Therefore, please charge the fee of $100.00 to deposit account no. 20-0782/APPM/4946.Y1 (KMT).

Respectfully submitted,

Keith M. Tackett
Registration No. 32,008
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Agent for Applicant(s)

DEC 1 5 2006

12/12/2006 SLUANG1 00000042 200782 7105463
01 FC:1811 100.00 DA

DEC 1 5 2006

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. : 7,105,463

APPLICATION NO. : 09/957,784

DATED : September 12, 2006

INVENTOR(S) : Kurita et al.

It is certified that error appears in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

Column 1, Line 37: Change "throughout" to --throughput--

Column 3, Line 20: Delete the comma after "which"

Column 3, Line 22: Change "over view" to --overview--

Column 7, Claim 15, Line 51: Change "load lock chamber" to --cassette load station--

Column 7, Claim 15, Line 52: Change "transfer" to --load lock--

Column 8, Claim 18, Lines 8-9: Change "movably device" to --device movably--

Please enter!
Wai Sing Lane

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Keith M. Tackett
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd., Suite 1500
Houston, TX 77056-6582

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.

DEC 1 5 2006

525048-1

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

RANBAXY INC.
600 COLLEGE ROAD EAST
SUITE 2100
PRINCETON, NJ 08540

COPY MAILED

AUG 0 1 2005

OFFICE OF PETITIONS

In re Application of :
Narayanan Badri Vishwanathan, et al. :
Application No. 09/957,799 : ON PETITION
Filed: September 21, 2001 :
Attorney Docket No. RLL-171US :

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 final Office action mailed March 5, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 7, 2004.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1020 extension of time fee submitted with the petition on March 2, 2005, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment and a Request for Continued Examination (RCE); (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

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

The application matter is being forwarded to Technology Center 1600, Art Unit 1615 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

JAMES K. BRANNON, M.D.
5729 CANTEBURY DRIVE
CULVER CITY, CA 90230

COPY MAILED

MAR 1 1 2004

OFFICE OF PETITIONS

In re Application of :
James Kevin Brannon :
Application No. 09/957,817 :
Filed: September 19, 2001 :
Attorney Docket No. N/A :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 1, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 9, 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 July 10, 2003.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

The application file is being forwarded to Technology Center 3700, Art Unit 3739 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

cc: Michael Fedrick
Sheldon & Mak
225 South Lake Avenue, Suite 900
Pasadena, CA 91101

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Mailed: AUG 2 6 2004

rvk
Paper Number: ____

In re application of
Grant Olewiler, III
Serial No. 09/957,824
Filed: September 20, 2001
For: METHOD OF AND APPARATUS FOR DAMPENING THE NOISE OF A VACUUM CLEANER:

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.81(a), filed June 18, 2004. The petition requests withdrawal of any holding of abandonment which may be issued for failure to timely pay the issue fee as indicated in Notice of Allowability and Notice of Allowance and Issue Fee Due mailed February 12, 2004, be withdrawn. The petitioner asserts that the Notice of Allowability and Notice of Allowance and Issue Fee Due mailed February 12, 2004 were not received by applicant. No actual Notice of Abandonment has as yet been mailed.

DECISION

The instant request is accepted as a 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 Notice of Allowability and Notice of Allowance and Issue Fee Due were not received by the petitioner. The evidence provided includes a statement by the petitioner that the Notice of Allowability and Notice of Allowance and Issue Fee Due were not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Notice of Allowability and Notice of Allowance and Issue Fee Due mailed February 12, 2004 were not received. Also provided is a Declaration of Thomas I. Rozsa along with a printout (Exhibit 1) of the attorney's

calendaring docket for February and March of 2004 where the Notice of Allowability and Notice of Allowance and Issue Fee Due of February 12, 2004 would have been posted had it been timely received.

Therefore, the application shall be forwarded to the examiner for prompt remailing of the above noted Notice of Allowability and Notice of Allowance and Issue Fee Due to the correspondence address and restarting of the statutory period of response from the remail date thereof.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

ROZSA & CHEN
15910 VENTURA BOULEVARD
SUITE 1601
ENCINO, CA 91436

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

APR 9 2004
Mailed:_____

rvk
Paper Number: 10

In re application of
Masaji Nishikawa et al
Serial No. 09/957,848
Filed: September 21,2001
For: HEAT-TRANSFER LAMINATING UNIT

DECISION ON PETITION

This is a response to the PETITION FOR THE WITHDRAWAL OF THE HOLDING OF ABANDONMENT BECAUSE OF NON-RECEIPT OF OFFICE ACTION, filed November 12, 2003. The petition requests that the abandonment, as set forth in the Notice of Abandonment of November 05, 2003, for failure to timely file a proper response to the Office letter dated April 23, 2003 be withdrawn. The petitioner asserts that the Office letter of April 23, 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 April 23, 2003 was not received by petitioner. The evidence provided includes a statement by the petitioner that the Office letter of April 23, 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 April 23, 2003 was not received. Also provided are copies of the attorney's USPTO mail log for the period from April 23, 2003 to June 23, 2003 where the Office letter of April 23, 2003 would have been posted had it been timely received.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the 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**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALAN H. THOMPSON
ASSISTANT LABORATORY COUNSEL
LAWRENCE LIVERMORE NATIONAL LABORATORY
P.O. BOX 808, L-703
LIVERMORE, CA 94551

COPY MAILED

NOV 1 0 2004

OFFICE OF PETITIONS

In re Application of	:	
Paul R. Coronado et al	:	
Application No. 09/957,853	:	ON PETITION
Filed: September 21, 2001	:	
Attorney Docket No. IL-10751	:	

This is a decision on the petition under 37 CFR 1.137(b), filed September 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 non-final Office action mailed June 19, 2003, which set a shortened statutory period for reply of three (3) months. One month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on October 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, since the $55 extension of time submitted with the petition on September 10, 2004 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 Irvin Dingle at (571) 272-3210.

The application is being forwarded to Technology Center AU 1712 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

ALAN H. THOMPSON
ASSISTANT LABORATORY COUNSEL
LAWRENCE LIVERMORE NATIONAL LABORATORY
P.O. BOX 808, L-703
LIVERMORE, CA 94551

COPY MAILED

JAN 1 1 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Paul Coronado et al	:	
Application No. 09/957,853	:	
Filed: September 21, 2001	:	
Attorney Docket No. IL-10751	:	

CORRECTED DECISION

This is a decision on the petition under 37 CFR 1.137(b), filed September 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 January 15, 2004, 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 February 16, 2004.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $55 extension of time submitted with the petition on September 10, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application number 10/794,847.

The decision mailed November 10, 2004 is hereby vacated as of the mail date of this decision.

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

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. 7

Jack Klumpp
Prestige Printing Products
3298 Sanatoga Road
Pottstown, PA 19464

COPY MAILED

FEB 0 4 2004

OFFICE OF PETITIONS

In re Application of	:	
Jack Klumpp	:	
Application No. 09/957,872	:	ON PETITION
Filed: September 21, 2001	:	
Attorney Docket No. N/A	:	

This is a decision on the petition under 37 CFR 1.137(a), filed January 27, 2004, to revive the above-identified application.

The petition is **DISMISSED.**

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

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;[1] (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

---

[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.

A Restriction Requirement was mailed to applicant on April 21, 2003, setting a one-month shortened statutory period within which to submit a reply. Since no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on May 22, 2003.

Petitioner asserts that he did not receive the Office action because he was involved in divorce proceedings and was forced to move from his home by April 30, 2003. His wife continued to reside at the home but failed to give the Office action to him. Several months later, she unfortunately died in a fatal car accident. Petitioner has provided a copy of a "Praecipe to Transmit Record," and an "Agreement" to confirm his order to move from his residence as well as a copy of a newspaper article to confirm his wife's death.

A reply to the outstanding Office action did not accompany the instant petition. Since petitioner did not receive the Office action, it can be reasonably assumed that petitioner did not have anything upon which to base a response. Therefore, a copy of the Office action mailed April 21, 2003, is enclosed herewith.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

While petitioner's situation is indeed unfortunate and the Office is sympathetic to such, these circumstances do not meet the standard of unavoidable delay. It is noted that the Agreement is dated March 5, 2003. This date precedes the date the Office action was mailed. In view thereof, when did petitioner actually vacate the home? Did petitioner submit a forwarding order with the U. S. Postal Service to have his mail forwarded to him? It appears that petitioner did receive the Notice of Abandonment; how did he obtain the Notice of Abandonment since it was mailed to the same address? Additionally, why didn't petitioner file a change of correspondence address with the USPTO when he moved? MPEP 711.03(c) in pertinent part states:

> "For an example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of 'unavoidable' delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of

> address. The following do not constitute proper notification of a change in correspondence address:
>
> ...(C) the lack of notification, or belated notification, to the U. S. Patent and Trademark Office of the change in correspondence address."

MPEP 601.03 in pertinent part states:

> "Where an attorney or agent of record (or applicant if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for notifying the U. S. Patent and Trademark Office of the new correspondence address (including ZIP Code)."

A review of the file record shows that petitioner did not file a change of correspondence address in accordance with MPEP 601.03. As such, the failure to do so does not constitute unavoidable delay within the meaning of 37 CFR 1.137(a).

Petitioner is urged to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of 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 $665 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
Post Office Box 1450
Alexandria, VA 22313-1450

Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

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

Enclosure: Copy of Restriction Requirement mailed April 21, 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

Paper No. 10

Jack Klumpp
Prestige Printing Products
3298 Sanatoga Road
Pottstown, PA 19464

COPY MAILED
APR 1 9 2004
OFFICE OF PETITIONS

In re Application of	:	
Jack Klumpp	:	
Application No. 09/957,872	:	ON PETITION
Filed: September 21, 2002	:	
Attorney Docket No. N/A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed April 2, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to Technology Center 2800.

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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

COPY MAILED

JAN 2 3 2004

OFFICE OF PETITIONS

In re Application of
Katz et al.
Application No. 09/957,876
Filed: September 20, 2001
Attorney Docket No. AMBIINC.007A

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 6, 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 final Office action mailed March 19, 2003. A one-month extension of time under the provisions of 37 CFR 1.136(a) was obtained on June 26, 2003. Accordingly, this application became abandoned on July 20, 2003.

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

The Notice of Appeal filed October 6, 2003, has been entered and made of record. Accordingly, the 2-month period for filing the appeal brief, in triplicate, accompanied by the fee required by law, runs from the date of this decision.

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 $420.00 extension of time fee submitted with the petition on October 6, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/16/09

TO SPE OF : ART UNIT 2121 Decady, Albert (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/957878 Patent No.: 6947919

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

H. Riley
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: Ok to Enter.

P Cady 2121
SPE

2121 9/24/09
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

ALAN H. THOMPSON
ASSISTANT LABORATORY COUNSEL
LAWRENCE LIVERMORE NATIONAL LABORATORY
P.O. BOX 808, L-703
LIVERMORE, CA 94551

COPY MAILED

JAN 17 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Peter A. Krulevitch, et al. :
Application No. 09/957,894 :
Filed: September 21, 2001 :
Attorney Docket No. IL-10630 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed August 24, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on November 25, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition and publication fees; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This application matter is being forwarded to the Publishing Division for further processing.

Retta Williams

Retta Williams
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
AUG 14 2006
OFFICE OF PETITIONS

INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

In re Application of :
Chang, et al. : DECISION ON PETITION
Application No. 09/957,903 :
For: September 21, 2001 :
Atty. Dkt. No.: 4080-119 :

This is a decision on the petition under 37 CFR 1.137(a), July 24, 2006, to revive the above-identified application.

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

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

This application became abandoned September 17, 2005 for failure to timely reply to the final Office action mailed June 16, 2005. The final Office action set a three (3) month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed February 22, 2006.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition fails to satisfy requirements (1) and (3) set forth above.

As to item (1), petitioners have failed to submit a reply to the outstanding Office communication. Although a request for continued examination (RCE) was submitted July 24, 2006, the RCE

lacks the required submission. See 37 CFR 1.114(c). Any renewed petition must include a proper response to the outstanding Office action.

As to item (3), petitioners have failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioners attribute the abandonment of the instant application to applicants' miscommunication with prior counsel.

The United States Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. See, Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, applicants' delay caused by mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Douglas v. Manbeck, 21 USPQ2d (BNA)(1697)(E.D. PA Nov. 7, 1991). Consequently, the

delay allegedly caused by prior counsel does not constitute unavoidable delay. Moreover, that delay is imputed to applicant. Petitioner is further reminded the Patent and Trademark Office is not the proper forum for resolving a dispute between petitioners and petitioners' prior representative. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

ALTERNATE VENUE

Petitioner is strongly urged to consider filing a petition stating that the entire delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Petitioners are lastly advised that an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. *See*,37 CFR 1.136. Accordingly, since the request for extension of time submitted herewith was filed subsequent to the maximum period obtainable for reply, this fee is unnecessary. Petitioners may request a refund of the previously submitted $225.00 extension of time fee by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

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

By mail: Mail Stop Petition
Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

COPY MAILED

SEP 25 2006

OFFICE OF PETITIONS

In re Application of :
Chang, et al. : DECISION ON PETITION
Application No. 09/957,903 :
For: September 21, 2001 :
Atty. Dkt. No.: 4080-119 :

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

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

This application became abandoned September 17, 2005 for failure to timely reply to the final Office action mailed June 16, 2005. The final Office action set a three (3) month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed February 22, 2006. A petition under 37 CFR 1.137(a) was filed July 24, 2006 and dismissed August 14, 2006.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit a proper reply to the final rejection is accepted as having been unintentionally delayed.

There is no indication in the official application file wrapper that petitioner was ever empowered to represent the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate documentation must be submitted to the Office. **Petitioners are advised that all future correspondence will be directed to the**

address currently of record until such time as appropriate instructions are received to the contrary.

In view thereof, the requested change of correspondence address has not been entered.

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. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

This application file is being forwarded to Technology Center 1600 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

MOORE & VAN ALLEN, PLLC
PO BOX 13706
RESEARCH TRIANGLE PARK, NC 27709

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 08-07

Paper No: __

DAVID W. LYNCH
CHAMBLISS, BAHNER & STOPHEL
1000 TALLAN BUILDING-T
TWO UNION SQUARE
CHATTANOOGA TN 37402

COPY MAILED

SEP 0 4 2007

OFFICE OF PETITIONS

In re Application of	:	
Chamberlain	:	DECISION
Application No.: 09/957,948	:	
Filing Date: 20 September, 2001	:	
Attorney Docket No. TUC920010051US1	:	

This is a decision on the petition filed on 21 November, 2006, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

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

NOTES:

(1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision.

---

[1] **NOTE: Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.**

Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(If Petitioner is unable to present even a satisfactory showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

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

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the 20 September, 2004, non-final Office action, reply due absent an extension of time on or before 20 December, 2004;
- the application went abandoned by operation of law after midnight on 20 December, 2004;
- after communications regarding change of address in 2005, the Office mailed the Notice of Abandonment on 3 May, 2006;
- on 21 November, 2006, Petitioner filed the instant petition, and averred therein, *inter alia*, that he did not receive the Notice of Abandonment (see: MPEP §711.03(c)(I)(C),[3]

---

[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] The Commentary at MPEP §711.03 (c) (I) (C) provides:

I.Design Applications, Utility Applications Filed Before June 8, 1995, and Plant Applications Filed Before June 8, 1995

a)Applicant Receives Notice of Abandonment

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, if applicant receives a notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within two months of the mail date of the notice of abandonment will **not** (absent extraordinary circumstances) be treated on its merits **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted on the application, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c), equivalent to the period between:

had filed a timely and proper reply to the Office action in question, and provided a copy of the reply averred to have been filed over a 20 December, 2004, Certificate of Mailing, which Petitioner avers he obtained from the online Office records through Private PAIR;[4]

- Petitioner appears to be unaware even at this writing that the papers to which Petitioner refers and the instant petition and its supporting documentation all were filed of record by Petitioner into Application No. 09/957,048–not into the instant application, which is, of course, Application No. 09/957,948.

Contrary to Petitioner's assertion that he is "entitled to the filing date of December 20, 2004," as one long registered to practice before the Office, Petitioner is aware that, while Petitioner may aver that he executed on 20 December, 2004, a Certificate of Mailing (under 37 C.F.R. §1.8), this is but Petitioner's statement, accepted as true by the Office under Petitioner's duty of candor to the Office that Petitioner had on that date sent the paper to be mailed–i.e., submitted the paper for filing. Submission in the fashion described above, of course, is not filing because in the absence of a transmission under the provisions of 37 C.F.R. §1.10 there is no filing of papers via the U.S. Postal Service (USPS) until they are physically received at the Office.

The actions or inactions that triggered the abandonment of the instant application were not that of the Office in failing to make of record the papers provided by Petitioner–rather, the Office placed the papers of record where Petitioner directed them to be placed.

Thus, Petitioner failed to file a timely and proper reply into the instant application.

(A)the date that is two months after the mail date of the notice of abandonment; and

(B)the filing date of a grantable petition to withdraw the holding of abandonment.

***

(b)Applicant Does Not Receive Notice of Abandonment

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, if applicant never receives the notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within twelve months from the date of applicant's filing (or date of submission, if the correspondence was never received by the Office) of correspondence with the Office for which further action by the Office can reasonably be expected, will **not** (absent extraordinary circumstances) be treated on its merit **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted thereon, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c), equivalent to the period between:

(A)the date that is twelve months from the date of applicant's filing or submission of correspondence with the Office, for which further action by the Office can reasonably be expected; and

(B)the filing date of a grantable petition to withdraw the holding of abandonment. (Emphasis the original.)

***

[4] Petitioner incorrectly marks the date of that paper as "showing the stamped entry on Appellants' (sic) Request for Reconsideration received on December 24, 2003"–this is an apparent typographical error because the record reflects the date on the document to which Petitioner refers as "DEC 27, 2004."

Further, Petitioner's apparent inability and/or failure to satisfy the requirements of MPEP §711.03(c)(I)(C)(1)(B), as set out in footnote above, bars relief under the provisions of 37 C.F.R. §1.181.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[5]

---

[5] 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).[6]

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.[7]

Delays in responding properly raise the question whether delays are unavoidable.[8] 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).[9]

And the Petitioner must be diligent in attending to the matter.[10] 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.[11]))

---

[6] 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.

[7] 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.

[8] 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).

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

[10] 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.

[11] 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.

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[12]

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.

---

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

> As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).
>
> 37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.
>
> * * *

Moreover, the regulation places upon Petitioner a diligence requirement to seek relief within two (2) months of the act complained of.

It does not appear that Petitioner has satisfied the showing as discussed above.

CONCLUSION

Because it appears that Petitioner has not satisfied in part the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **is dismissed**.

ALTERNATIVE VENUE

Petitioner may wish to file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:[13]

By mail: Commissioner for Patents[14]
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

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

---

[13] On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf .)

[14] To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[15]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

[15] The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.
All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DAVID W. LYNCH
CHAMBLISS, BAHNER & STOPHEL
1000 TALLAN BUILDING-T
TWO UNION SQUARE
CHATTANOOGA TN 37402

COPY MAILED

MAY 1 9 2008

OFFICE OF PETITIONS

In re Application of :
Chamberlain :
Application No.: 09/957,948 : DECISION
Filing Date: 20 September, 2001 :
Attorney Docket No.: TUC920010051US1 :

This is a decision on the petition filed on 31 October, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

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

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that Petitioner has satisfied the requirements of the regulation, as set forth below:

BACKGROUND

The record reflects that:

Petitioner failed to reply timely and properly to the 20 September, 2004, non-final Office action, reply due absent an extension of time on or before 20 December, 2004.

The application went abandoned by operation of law after midnight on 20 December, 2004;

After communications regarding change of address in 2005, the Office mailed the Notice of Abandonment on 3 May, 2006;

On 21 November, 2006, Petitioner filed a petition (under 37 C.F.R. §1.181), and averred therein, *inter alia*, that he did not receive the Notice of Abandonment (see: MPEP §711.03(c)(I)(C), had filed a timely and proper reply to the Office action in question, and provided a copy of the reply averred to have been filed over a 20 December, 2004, Certificate of Mailing, which Petitioner avers he obtained from the online Office records through Private PAIR—Petitioner was unaware that the papers to which Petitioner referred and the petition all were filed of record by Petitioner into Application No. 09/957,048–not into the instant application—and the petition was dismissed on 4 September, 2007, for failing to make the showing set forth in MPEP §711.03(c).

On 31 October, 2007, Petitioner filed the instant petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an amendment, and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

STATUTES, REGULATIONS

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

---

[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). See specifically, the regulations at 37 C.F.R. §10.18.

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.[2],[3]

CONCLUSION

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

The instant application is released to Technology Center/AU 2624 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center/AU OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

[2] 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).

[3] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

[4] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DANIEL P. MAGUIRE
423 E STREET
DAVIS, CA 95616

COPY MAILED

DEC 0 1 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of	:
David Roy Springett	:
Application No. 09/957,949	:
Filed: September 14, 2001	:
Attorney Docket No. CCF – Satellite Stn.	:

This is a decision on the petition under 37 CFR 1.137(b), filed August 2, 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 December 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 3, 2004.

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

The application is being forwarded to Technology Center AU 3632 for further processing.

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

24 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DINSMORE & SHOHL
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202

In re Application of: YAGUCHI, Shigeyuki, et al.	:	
U.S. Application No.: 09/958,004	:	
PCT No.: PCT/JP00/00568	:	DECISION
International Filing Date: 02 February 2000	:	
Priority Date: None	:	
Attorney's Docket No.: 10936-63	:	
For: STRING TYPE SEALING MATERIAL	:	

This decision is issued in response to applicants' "Request For Corrected Filing Receipt" filed 15 November 2001. No petition fee is required.

BACKGROUND

On 02 February 2002, applicants filed international application PCT/JP00/00568. On 09 August 2001, the international application was published and a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). A review of the published international application reveals that the United States was designated and no priority claims were present.

A Demand was not filed with the International Preliminary Examining Authority electing the United States prior to the expiration of 19 months from the international filing date. As a result, the deadline for submission of the basic national fee was twenty months from the international filing date, i.e., 02 October 2001.

On 01 October 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, a translation of the international application into English, and a declaration in compliance with 37 CFR 1.497. It is noted that the Transmittal Letter did not reference a priority claim, and, while the declaration did identify two Japanese national applications, it expressly stated that priority was not claimed to either of these applications.

On 06 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Acceptance indicating that the 35 U.S.C. 371 requirements had been received on 01 October 2001. Subsequently, a filing receipt was issued.

On 15 November 2001, applicant's filed the "Request For Corrected Filing Receipt" considered herein. This submission seeks correction of the filing receipt so as to add priority claims to two Japanese applications.

DISCUSSION

The current submission seeks to correct the filing receipt so as to add priority claims to Japanese Patent Application Nos. 231224/1998 (filed 03 August 1998) and 2000-25338 (filed 02 February 2000). Applicants state that the present application "claims priority" to these applications; however, as noted above, the published international application does not indicate that applicants made any priority claims during the international stage, and the declaration filed by applicants in the national stage, while identifying these two Japanese applications, expressly states that priority is not claimed to these applications.

Moreover, even if properly made, under the terms of the PCT, neither of the two identified Japanese applications could serve as proper priority claims. Application No. 231224/1998 was filed on 03 August 1998, significantly more than twelve months prior to the international filing date. As for Application No. 2000-25338, such was filed on 02 February 2000, the same date as the present international application (priority claims are only permitted to previously filed applications, not to applications filed on the same date as the international application).

CONCLUSION

Based on the above, applicants' request for a corrected filing receipt is **DISMISSED** without prejudice.

If applicants' seek reconsideration of the above decision, they must submit a request for such reconsideration within **TWO (2) MONTHS** of the mail date of the present decision.

Any further correspondence with respect to the request for a corrected filing receipt 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.

This application is being returned to Group Art Unit 1734 for examination

Leonard Smith
for 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

2 0 NOV 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

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

Roger T. Frost
Kilpatrick Stockton
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530

In re Application of SCKERL Application No.: 09/958,007 PCT No.: PCT/DK00/00150 Int. Filing Date: 29 March 2000 Priority Date: 31 March 1999 Attorney Docket No.: 44125-264018 (12083) For: METHOD FOR CONTROLLING THE POLARISATION OF AN OPTICAL SIGNAL AND AN OPTICAL COMPONENT FOR POLARISATION CONTROL OF LIGHT IN PLANAR WAVEGUIDES	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicant's "Request For Withdrawal of Notice of Abandonment" filed in the United States Patent and Trademark Office (USPTO) on 13 August 2002. The request is being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 29 March 2000, applicant filed international application PCT/DK00/00150, which claimed priority of an earlier application filed 31 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 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 30 September 2001.

On 01 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. A signed oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed; however, applicant did pay the $130.00 surcharge for providing an oath or declaration later than thirty months from the priority date. As 30 September 2001 was a Sunday, applicant's papers filed 01 October 2001 were considered timely filed.

On 26 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 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. 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 02 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 (Form PCT/DO/EO/905) mailed 26 October 2001 within the time period set therein and that above-identified application was abandoned as to the United States.

On 13 August 2002, applicant responded with the present petition accompanied by a an executed combined declaration and power of attorney; copy of petition for extension of time and a return postcard receipt with a 13 February 2002 USPTO date stamp which lists the attorney docket number, serial number and applicant and identifies the items to be filed as a "Transmittal of Missing Requirements; copy of Notification; executed Declaration and Power of Attorney; Petition for Extension of Time; $110 check."

DISCUSSION

A review of the application file reveals that the NOTIFICATION OF MISSING REQUIREMENTS was mailed by the USPTO on 26 October 2001, addressed to the mailing address provided in the transmittal letter for entry into the national stage in the United States submitted 01 October 2001. In addition, applicant's 13 February 2002 response is contained therein; however the purportedly filed declaration and power of attorney is not in the file. Regardless, the evidence filed with the present petition, namely the date stamped postcard receipt and information contained therein is convincing that a combined declaration and power of attorney was filed on 13 February 2002. Thus, it is appropriate to withdraw the holding of abandonment.

As noted in applicant's petition, a two-month extension of time was due on 13 February 2002 in order for the papers to be considered timely filed. As authorized, the $280.00 difference in fees will be charged to Deposit Account No.: 11-0855.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED.**

The NOTIFICATION OF ABANDONMENT mailed on 02 July 2002 is hereby **VACATED**.

The application has an international filing date of **29 March 2000** under 35 U.S.C. 363 and will be given a date of **13 February 2002** under 35 U.S.C. 371(c).

As detailed above, $280.00 will be charged to Deposit Account No.: 11-0855.

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
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

09 AUG 2002

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Conrad J. Clark
CLARK & BRODY
1750 K Street, NW, Suite 600
Washington, D.C. 20006

In re Application of
McPHAIL, Neil *et al*
U.S. Application No.: 09/958,035
PCT No.: PCT/CA00/00377
Int. Filing Date: 06 April 2000
Priority Date: 06 April 1999
Attorney Docket No.: 70566-0006
For: STERILIZER WITH VACUUM-ASSISTED AIR REMOVAL

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Response to Notice of Missing Requirements and Petition under 37 C.F.R. § 1.47(a)" ("Pet.") filed on 17 June 2002.

BACKGROUND

On 15 November 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 an oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. Applicants were given two months to respond.

On 17 June 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, a declaration signed by one of the seven co-inventors and authorization to charge all required fees to Deposit Account No. 50-1088.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

With regard to item (3), applicants state that the last known addresses of the nonsigning co-inventors are listed on the declaration "with the exception of Neil McPhail, whose last know [*sic*] address is MDS Nordion, 4004 Westbrook Mall, Vancouver B.C. V6T 2A3. Pet. at ¶ 2.

This information satisfies item (3).

Regarding item (4), applicants included a declaration signed by one of the seven co-inventors, Dorin Cioraca. All of the nonsigning co-inventor's names and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b).

Thus, item (4) is also satisfied.

However, applicants have not met the requirements of items (2).

Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the MPEP (8th Ed.) which 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, a statement of facts **should** be submitted that **fully describes the exact facts which are relied** on to establish that a diligent effort was made . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** (Emphasis added).

In the instant petition, applicants have <u>not</u> submitted the requisite statement of facts or provided <u>any</u> credible evidence that a diligent effort was made to contact six of the seven listed co-inventors. Merely stating that a "diligent effort" was made to locate the nonsigning inventors' in the petition is <u>not</u> sufficient.

For these reasons, Item (2) is not satisfied.

Therefore, all of the requirements of 37 CFR 1.47(a) are not yet complete.

<u>CONCLUSION</u>

For the reasons discussed above, the petition under 37 CFR 1.47(a) is <u>**DISMISSED**</u> 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)." Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Boris Milef
for

Richard Cole
PCT Legal Examiner
PCT Legal Office

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

0 6 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#6

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

Conrad J. Clark
CLARK & BRODY
1750 K Street, NW, Suite 600
Washington, D.C. 20006

In re Application of
McPHAIL, Neil *et al*
U.S. Application No.: 09/958,035
PCT No.: PCT/CA00/00377
Int. Filing Date: 06 April 2000
Priority Date: 06 April 1999
Attorney Docket No.: 70566-0006
For: STERILIZER WITH VACUUM-ASSISTED AIR REMOVAL

DECISION ON REQUEST FOR REFUND

This is a decision on applicants' "Request for Refund" filed on 18 September 2002.

On 17 June 2002, applicants filed a "Response to Notice of Missing Requirements and Petition under 37 C.F.R. § 1.47(a)" requiring a five-month extension of time. Applicants included authorization to charge all required fees to Deposit Account No. 50-1088.

A fee of $1,960.00 (Fee Code 128) was charged to counsel's Deposit Account. This charge was erroneous. Applicants previously claimed small entity status.

The proper charge for a five-month extension of time for a small entity should have been $980.00 (Fee Code 228).

Accordingly, Deposit Account No. 50-1088 will be credited the $980.00 difference.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

28 MAR 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Conrad J. Clark
CLARK & BRODY
1750 K Street, NW, Suite 600
Washington, D.C. 20006

In re Application of
McPHAIL, Neil *et al*
U.S. Application No.: 09/958,035
PCT No.: PCT/CA00/00377
Int. Filing Date: 06 April 2000
Priority Date: 06 April 1999
Attorney Docket No.: 70566-0006
For: STERILIZER WITH VACUUM-ASSISTED AIR REMOVAL

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition under 37 C.F.R. § 1.47(a)" ("Ren.Pet.") filed on 10 February 2003.

BACKGROUND

On 09 August 2002, a decision dismissing applicants' petition was mailed because applicants failed to meet the requirements of item (2) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 10 February 2003, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a declaration executed by four of the co-inventors and authorization to charge any required extensions to Deposit Account No. 50-1088.

04/01/2003 SNAJARRO 00000031 501088 09958035
01 FC:2254 725.00 CH

DISCUSSION

In the original petition, the 37 CFR 1.47(a) applicant failed to provide the necessary details or documentary evidence required by section 409.03(d) of the MPEP to show that a diligent effort was made to contact six of the seven co-inventors.

In the renewed petition, applicants were able to locate four of the remaining six nonsigning co-inventors and obtained signed declarations from each. Applicants also contacted co-inventor, Eduardo C. Ghelman and spoke to him personally. The 37 CFR 1.47(a) applicant learned then that Mr. Ghelman had moved to a new address. This occurred after the letter submitted with the renewed petition and accompanying documents were sent to Mr. Ghelman on 31 January 2003 at his old address. Nonetheless, the 37 CFR 1.47(a) applicant claims that "Federal Express confirmed that the package was delivered to [the new] address, but Mr. Ghelman has not yet returned the executed Declaration and Power of Attorney." Ren.Pet. at ¶ 3.

The letter dated 31 January 2003 which was submitted with the instant renewed petition stated that a copy of the application was enclosed and requested that the documents be returned by 08 February 2003. Since the documents had not been received by 10 February 2003, the 37 CFR 1.47(a) applicant is presumably treating the lack of receipt of a response by Mr. Ghelman as a refusal to sign.

The deadline given by the 37 CFR 1.47(a) applicant was not long enough to conclude that Mr. Ghelman's lack of timely response was a refusal. The letter and documents sent by Federal Express were mailed 31 January to the wrong address for Mr. Ghelman. The 37 CFR 1.47(a) applicant has not indicated when the package arrived at the correct address. A reply was requested by 08 February 2003. The instant renewed petition was mailed on 10 February 2003. This time period is not sufficient to conclude that the co-inventor refuses to sign. For this reason, item (2) of 37 CFR 1.47(a) has not been satisfied.

The 37 CFR 1.47(a) applicant still has been unable to reach co-inventor, Edward House. Id. at ¶ 4. The 37 CFR 1.47(a) applicant submitted a letter via Federal Express at his last known address but that was returned stamped "RECIPIENT MOVED." A copy of this was included with the instant renewed petition. The 37 CFR 1.47(a) applicant also attempted to contact Mr. House using an internet search but was unsuccessful. However, only one of the seven listed numbers returned calls during business hours and that person was not the co-inventor. Id.

This does not meet the requirements of a diligent effort. There is no mention whether the 37 CFR 1.47(a) applicant left a message with any of the other persons on the list. The 37 CFR 1.47(a) applicant should attempt at least to contact the remaining six people to ensure that the co-inventor cannot be located. There is also no indication whether the 37 CFR 1.47(a) applicant attempted to contact anyone at his former company whether they knew where Mr. House had moved to.

Therefore, all of the requirements of 37 CFR 1.47(a) are not yet complete.

A four-month extension of time fee of $725.00 has been charged to Deposit Account No. 50-1088 as authorized.

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. Extensions of time may be obtained under 37 CFR 1.136(a).

Applicants are 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.

James Thomson

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

#10

15 JUL 2003

Conrad J. Clark
CLARK & BRODY
1750 K Street, NW, Suite 600
Washington, D.C. 20006

In re Application of
McPHAIL, Neil *et al*
U.S. Application No.: 09/958,035
PCT No.: PCT/CA00/00377
Int. Filing Date: 06 April 2000
Priority Date: 06 April 1999
Attorney Docket No.: 70566-0006
For: STERILIZER WITH VACUUM-ASSISTED AIR REMOVAL

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Response to Decision on Renewed Petition Under 37 C.F.R. §1.47(a)" filed on 18 June 2003.

BACKGROUND

On 28 March 2003, a decision dismissing applicants' renewed petition was mailed because they failed to satisfy item (2) of 37 CFR 1.47(a).

On 18 June 2003, applicants submitted the instant request which was accompanied by, *inter alia*, a one-month extension and $55.00 fee and a declaration signed by co-inventors, Eduardo C. Ghelman and Edward House.

DISCUSSION

In the renewed request, applicants filed a declaration signed by the remaining nonsigning co-inventors, Eduardo C. Ghelman and Edward House.

CONCLUSION

For the reasons above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** as moot.

A review of the declaration filed with the instant petition reveals that it is in compliance with 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 06 April 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **18 June 2003**.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

IVOR R. ELFRIFI
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

COPY MAILED

AUG 1 6 2004

OFFICE OF PETITIONS

In re Application of	:
Tao Weng et al	:
Application No. 09/958,040	: DECISION ON PETITION
Filed: January 22, 2002	: UNDER 37 CFR 1.78(a)(3) AND
Attorney Docket No. 19141-542	: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition filed February 4, 2004, 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 amendment filed concurrently with the instant petition.

The petition is **DISMISSED** as moot for the reasons stated below.

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; or (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. § 365 before November 29, 2000.

Since the instant nonprovisional application is the national stage entry of an international application filed prior to November 29, 2000, the provisions of 37 CFR 1.78(a)(3) for acceptance of a later claim for priority do not apply to the subject nonprovisional application. Accordingly, the petition is dismissed as involving a moot issue.

In view of the above, the $1,330 fee submitted for the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) is unnecessary and will be credited to deposit account no. 50-0311 as authorized.

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

---

[1]37 CFR 1.78(a)(2) was amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(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).

The application is being referred to Technology Center Art Unit 1636.

Karen Creasy

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

2 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Michael S. Huppert
WENDEROTH, LIND & PONACK, L.L.P.
2033 K Street, N.W., Suite 800
Washington, D.C. 20006-1021

In re Application of KOICHI KOBAYASHI ET AL. U.S. Appl. No.: 09/958,075 PCT No.: PCT/JP01/01711 Int. Filing Date: 06 March 2001 Priority Date: 28 March 2000 Agent's File Reference: 2001_1242A For: VIBRATION GENERATOR AND A PORTABLE TELEPHONE USING THE VIBRATION GENERATOR	DECISION UNDER 37 CFR 1.182

This decision is in response to applicants' "Petition Under 37 CFR 1.182 To Enter The Reply To The Notification Of Missing Requirements" requesting that the "Reply To Notification Of Missing Requirements Under 35 USC 371" directed to U.S. application 09/058,075 be accepted as having been filed for U.S. application 09/958,075. The $130 petition has been charged to counsel's Deposit Account No. 23-0975. The petition is **GRANTED**.

BACKGROUND

On 06 March 2001, applicants filed international application PCT/JP01/01711, which claimed priority to an earlier Japanese application filed on 28 March 2000. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 10 April 2001. Accordingly, the twenty-two month period for entering the U.S. national stage expired on 28 January 2002.

On 04 October 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 purported English translation of the international application and a declaration as required by 35 U.S.C. 371(c)(4).

On 09 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)" inviting applicants to provide a correct English translation of the application with processing fee.

On 08 January 2002, applicants filed a "Reply To Notification Of Missing Requirements Under 35 USC 371" forwarding, inter alia, a corrected English translation of the application.

However, applicants directed the 08 January 2002 communication to U.S. application 09/058,075 instead of the present application.

On 22 February 2002, applicants filed, inter alia, a copy of the return receipt postcard indicating that the 08 January 2002 communication was intended for U.S. application 09/958,075.

On 10 June 2002, applicant filed the present petition requesting that the 08 January 2002 communication be treated as having been filed for U.S. application 09/958,075.

DISCUSSION

37 CFR 1.5(a) requires in part that:

> *"When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and the filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application."*

The papers filed on 08 January 2002 are not in compliance with requirements of 37 CFR 1.5(a) in that they do not properly identify the U.S. national application to which they pertain. However, the papers filed on 08 January 2002 show sufficient evidence that they were intended for filing in U.S. application 09/958,075 because they properly identify the Docket No. as 2001_1242A and the applicants. Therefore, on petition, the papers filed on 08 January 2002 directed to U.S. application 09/058,075 may be accepted as having been intended for the present application. It is noted that the copy of the postcard receipt filed 22 February 2002 indicated that U.S. application number 09/058,075 is incorrect.

CONCLUSION

Accordingly, the papers filed on 08 January 2002 are accepted for entry into the present application. This application is being forwarded to the DO/EO/US for further processing in accordance with this decision.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Jeremy Fleming
Paralegal Specialist
PCT Legal Office

JSF/LS:jf

(703) 308-6154

12 JAN 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

ADELMAN FRAYNE & SCHWAB
150 East 42nd Street
New York, NY 10017

In re Application of	:	DECISION ON
Bela NAGY	:	
Application No.: 09/958,081	:	
PCT No.: PCT/HU00/00026	:	
Int. Filing Date: 29 March 2000	:	PETITION UNDER
Priority Date: 31 March 1999	:	
Attorney's Docket No.: 205,311	:	
For: A STRAIN SUITABLE ...	:	
FOR PRODUCING THAT STRAIN	:	37 CFR 1.181

This Decision is in response to applicant's "PETITION UNDER 37 C.F.R. 1.181" filed on 29 March 2004 indicating that the Article 34 amendments were with the application filed on October 01, 2001 but were not considered by the examiner in the examiner's office action dated February 12, 2004.

BACKGROUND

On 29 March 2000, this international application was filed, claiming an earliest priority date of 31 March 1999.

On 01 October 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371 (c)(1); U.S.C. 371(c)(2); and a declaration as required by 35 U.S.C. 371(c)(4).

On 07 November 2001, the DO/EO/US mailed a "NOTIFICATION OF ACCEPTENCE OF APPLICATION UNDER 35 U.S.C. 371" (Form PCT/DO/EO/909), which indicated a 01 October 2001 date of receipt of 35 USC 371(c)(1), (c)(2), and (c)(4) requirements. The communication also indicated, inter alia, that a copy of the international preliminary examination report (IPER) had been received.

On 12 February 2004, examiner mailed an office action that did not consider the Article 34 amendments filed during the international stage.

DISCUSSION

A review of the file shows that the International Bureau (IB) timely submitted the IPER with its annexes and that it had been received on 01 October 2001 with the rest of the items submitted by applicant.

In view of the above, applicant's 409 annex to the IPER was timely communicated to the US designated Office. Accordingly, the instant application has been improperly examined since the examiner did not consideration the Article 34 amendments. Therefore, the office action mailed on 12 February 2004 is **Vacated.** A new decision will be issued considering the Article 34 amendments.

DECISION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED**.

The Office Decision mailed on 12 February 2004 has been **Vacated**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

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)
6949879	2005-09-27	09958102	2002-02-15	JYG155USA

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	/William Bak/	Date (YYYY-MM-DD)	2009-10-20
Name	William Bak	Registration Number	37277

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. 6949879
Issue Date: September 27,2005
Application No. 09958102
Filed: February 15,2002
Attorney Docket No. JYG 155 USA

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

This is a decision on the electronic petition, filed October 20,2009 ,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 20,2009 . 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

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

COPY MAILED
NOV 07 2006
OFFICE OF PETITIONS

In re Application of Baatz :
Application No. 09/958,108 : Decision on Petition
Filing Date: January 18, 2002 :
Attorney Docket No. 003400.P011 :

This is a decision on the petition under 37 CFR 1.181, filed July 17, 2006, to withdraw the holding of abandonment.

The petition is **granted.**

The above-identified application was deemed abandoned for failure to reply in a timely manner to the non-final Office action mailed September 29, 2005, which set a shortened statutory period for reply of three (3) months. The above-identified application was deemed abandoned as of December 30, 2005. A Notice of Abandonment was mailed on June 28, 2006.

Petitioner contends a reply and request for a three-month extension of time were timely mailed March 22, 2006.

Petitioner has supplied a copy of the papers mailed March 22, 2006, The papers bear a proper certificate of mailing in compliance with the requirements of 37 C.F.R. 1.8(a) and the petition complies with the requirements set forth in 37 CFR 1.8(b). In view thereof the reply is considered timely filed.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Technology Center Art Unit 2161 will be informed of the instant decision and the application, including the copy of the March 22, 2006 reply, will be further examined in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

JAN 03 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEVEN J. GROSSMAN
HAYES, SOLOWAY, HENNESSEY, GROSSMAN & HAGE, P.C.
175 CANAL STREET
MANCHESTER, NEW HAMPSHIRE 03101

In re Application of	:	
David A. GATTUSO, et al.	:	
Application No.: 09/958,119	:	
PCT No.: PCT/US00/05125	:	DECISION ON PETITION
International Filing Date: 29 February 2000	:	
Priority Date: 01 March 1999	:	
Attorney Docket No. MWT M4022	:	
For: HEADLAMP WASHER SYSTEM	:	

This is a decision on the petition under §1.137(b), filed 03 October 2001, to revive the above-identified application.

BACKGROUND

On 29 February 2000, applicants filed international application PCT/US00/05125, which claims a priority date of 01 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 September 2000. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 02 October 2000. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 September 2001.

On 02 September 2001, the above-identified application became abandoned as to the United States for failure to meet the requirements of 35 U.S.C. 371(c)(1) and 37 CFR 1.495. This decision precedes the mailing of a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) by the United States Designated/Elected Office.

On 03 October 2001, applicant submitted the instant petition. Accompanying the petition was a TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371, included therewith was the basic national fee as required by 35 U.S.C. 371(c)(1)

and a copy of the international application as filed as required by 35 U.S.C. 371(c)(2). However, no oath or declaration of the inventors as required by 35 U.S.C. 371(c)(4) was enclosed.

DISCUSSION

Applicants have met all requirements for a grantable petition under §1.137(b). The petition included the required fee ($1280), the required statement of unintentional delay, and the required reply (payment of the basic national fee).

CONCLUSION

For the reasons set forth above, the petition is **GRANTED**.

The application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further review and processing in accordance with this communication, including issuing a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office" (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date is required.

Nancy Johnson
Petitions Attorney
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0309
Facsimile: (703) 308-6459

20 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Steven J. Grossman
Grossman, Tucker, Perreault & Pfleger, PLLC
795 Elm Street, Suite 604
Manchester, NH 03101

In re Application of	:	
GATTUSO, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/958,119	:	
PCT No.: PCT/US00/05125	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 29 February 2000	:	
Priority Date: 01 March 1999	:	
Attorney Docket No.: MWT M4022	:	
For: HEADLAMP WASHER SYSTEM	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.47(a) With Statement of Facts as to Inventor's Refusal to Sign" filed 28 May 2002.

BACKGROUND

On 03 January 2002, applicant was mailed a decision granting applicant's petition under 37 CFR 1.137(b) to revive the present application in the United States of America.

On 27 March 2002, 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 as well as payment of the $130.00 surcharge for providing an executed oath or declaration later than thirty 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 28 May 2002, applicant responded with the present petition to accept the filed declaration without the signature of joint inventor David A. Gattuso. The petition was accompanied by a check in the amount of $260.00 ($130.00 as payment of the petition fee for a petition under 37 CFR 1.47(a) and $130.00 as payment for the surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date.) and a combined declaration and power of attorney executed by joint inventors: Martyn Jenkins and Malcolm Claydon. As 27 May 2002 was a federal holiday, applicant's response is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1) and (3), applicants have enclosed a check which includes the required petition fee of $130.00 and the petition states the last known address of the non-signing inventor, David A. Gattuso.

Regarding Item (4), accompanying the petition is a declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor. Accordingly, Items (1), (3) and (4) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." In the present petition, applicant claims that inventor Gattuso has been provided with a complete set of the application papers and subsequently refused to execute the declaration. However, applicant has failed to provide documentation regarding the purported mailing of 24 December 2001. It is unclear from the petition whether the non-signing inventor actually received the papers prior to his express refusal of 02 May 2002.

In light of the above, applicants' petition can not be granted at this time. Applicant must provide copies of the receipt of mailing be it a certified mail receipt or an Express Mail receipt which show Mr. Gattuso's address and date of delivery. It must be shown that inventor Gattuso was provided a complete set of the application papers and refused to sign the declaration.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

23 JUN 2003

#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

Steven J. Grossman
Grossman, Tucker, Perreault & Pfleger, PLLC
795 Elm Street, Suite 604
Manchester, NH 03101

In re Application of	:	
GATTUSO, et al.	:	DECISION ON RENEWED
U.S. Application No.: 09/958,119	:	
PCT No.: PCT/US00/05125	:	PETITION UNDER
Int. Filing Date: 29 February 2000	:	
Priority Date: 01 March 1999	:	37 CFR 1.47(a)
Attorney Docket No.: MWT M4022	:	
For: HEADLAMP WASHER SYSTEM	:	

This decision is in response to applicant's "Second Renewed Petition Under 37 CFR 1.47(a)" filed 15 April 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 20 September 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a) to accept the present application without the signature of joint inventor David A. Gattuso. Applicant was afforded two months to file any request for reconsideration.

On 15 April 2003, applicant responded with the present renewed petition accompanied by a combined declaration and power of attorney executed by the previously non-signing joint inventor, David A. Gattuso.

06/26/2003 HKAYPAGH 00000001 502121 09958119
01 FC:1255 1040.00 DA 930.00 OP

DISCUSSION

It is noted that applicant's purported filing of 20 February 2003 is not in the application file. While a review of the USPTO fee record for the present application finds that applicant provided a check in the amount of $930.00 on 20 February 2003 and that the fee code is for a petition for a three-month extension of time, the present second renewed petition does not contain any evidence that applicant filed a proper response on 20 February 2003. As such, applicant's present second renewed petition filed 15 April 2003 is considered to contain a petition for a five-month extension of time and the additional $1040.00 will be charged to Deposit Account No.: 50-2121. In order to obtain a refund of this charge applicant must provide evidence, such as a USPTO stamped return postcard, that a proper response to the decision mailed 20 September 2002 was filed on 20 February 2003.

The second renewed petition under 37 CFR 1.47(a) is moot since the declaration filed 15

April 2003 has been executed by the previous non-signing inventor, David A. Gattuso. The declaration filed 15 April 2003 is acceptable under 37 CFR 1.497.

CONCLUSION

For the reasons above, the second renewed petition under 37 CFR 1.47(a) is **DISMISSED as moot**.

As discussed above, $1040.00 will be charged to Deposit Account No.: 50-2121 in order to consider the present renewed petition timely filed.

The application has an international filing date of **29 February 2000** and will be given a date of **15 April 2003** under 35 U.S.C 371(c).

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Richard Cole
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

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

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

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/398,943	Kenichi Shiraishi	0670-7023

INTERNATIONAL APPLICATION NO.
PCT/JP01/08307

I.A. FILING DATE	PRIORITY DATE
09/25/2001	10/13/2000

Robinson Intellectual Property Law Office
PMB 955
21010 Southbank Street
Potomac Falls, VA 20165

CONFIRMATION NO. 2982

371 FORMALITIES LETTER

OC000000010289251

Date Mailed: 06/19/2003

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 a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 04/11/2003
- English Translation of the IA filed on 04/11/2003
- Copy of the International Search Report filed on 04/11/2003
- Copy of IPE Report filed on 04/11/2003
- Preliminary Amendments filed on 04/11/2003
- Information Disclosure Statements filed on 04/11/2003
- Request for Immediate Examination filed on 04/11/2003
- Copy of references cited in ISR filed on 04/11/2003
- U.S. Basic National Fees filed on 04/11/2003

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.

- **$130** Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

SUMMARY OF FEES DUE:

Total additional fees required for this application is **$130** for a Large Entity:

- **$130** Late oath or declaration Surcharge.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS 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).

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)

*A copy of this notice **MUST** be returned with the response.*

BARBARA A CAMPBELL

Telephone: (703) 305-3631

PART 2 - OFFICE COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/398,943	PCT/JP01/08307	0670-7023

FORM PCT/DO/EO/905 (371 Formalities Notice)

8 1 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#5

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

Michael J. Stricker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of	:	
ZELENY, et al.	:	
U.S. Application No.: 09/958,127	:	DECISION ON PETITION
PCT No.: PCT/DE01/00432	:	
Date of Receipt: 02 February 2001	:	UNDER 37 CFR 1.181
Priority Date: 04 February 2000	:	
Attorney's Docket No.: 1827	:	
For: CONNECTING DEVICE	:	

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment" filed 10 February 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 02 February 2001, applicant filed international application PCT/DE01/00432, which claimed priority of an earlier application filed 04 February 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 August 2001. A Demand for international preliminary examination, in which the United States was elected, was not filed prior to the expiration of nineteen months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 04 October 2001.

On 04 October 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 Information Disclosure Statement; an unsigned combined declaration and power of attorney and a First Preliminary Amendment.

On 07 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 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 and a translation of the International Application into English. Applicant was provided two months to file the proper response and advised that this time could be extended pursuant to 37 CFR 1.136(a). In addition, applicant was advised of the need to provide payment of the $130.00 processing fee for providing an English translation of the International Application later than thirty months from the priority date and the $130.00 surcharge for providing an oath or declaration of the inventors later than thirty months from the priority date.

On 15 January 2003, applicant was mailed a Notification of Abandonment (Form PCT/DO/EO/909) for having failed to respond to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 07 November 2001.

On 10 February 2003, applicant filed the present petition to withdraw the holding of abandonment.

DISCUSSION

The Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant's petition and accompanying papers filed 10 February 2003 satisfy items (1) and (3).

As to item (2), while applicant has provided a statement from counsel indicating that he has examined the application file and did not find any notation indicating that the Notification of Missing Requirements was received, applicant must attests that a search of the file jacket indicates that the Office action was not received.

Regarding item (4), it is not clear from the docket records provided that the enclosed pages reflect where the purported non-received Office action would have been entered. It appears that the pages show what would have been the two month due date. In order to satisfy item (4) with the current exhibit, applicant is required to provide a statement from an individual with firsthand knowledge that these pages accurately reflect the docket system for the entire firm and a "Notice of Missing Requirements" mailed 07 November 2001 would have been entered in the docket on either 06 or 07 January 2002.

For the reason indicated above, it is not proper to grant applicant's petition at this time.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 has been considered, however, for the reasons indicated above, the petition stands **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration of 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." No additional fee is required.

Any renewed petition filed must include a proper reply. A proper reply must include a statement that a search of the file jacket indicates the Notification of Missing Requirements mailed 07 November 2001 was not received, as well as, a statement regarding the docket records as detailed above.

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.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#7

01 JUL 2003

Michael J. Stricker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of	:	
ZELENY, et al.	:	
U.S. Application No.: 09/958,127	:	DECISION ON RENEWED
PCT No.: PCT/DE01/00432	:	
Date of Receipt: 02 February 2001	:	PETITION UNDER
Priority Date: 04 February 2000	:	
Attorney's Docket No.: 1827	:	37 CFR 1.181
For: CONNECTING DEVICE	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.181" filed 16 May 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 31 March 2003, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment in the present application. Applicant was afforded two months to file any request for reconsideration.

On 16 May 2003, applicant filed the present renewed petition under 37 CFR 1.181.

DISCUSSION

As detailed in the decision mailed 31 March 2003, the Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant previously satisfied items (1) and (3).

As to item (2), applicant has presently provided a statement from counsel that a search of the file jacket indicates the Office action was not received.

Regarding item (4), applicant's current filing includes a statement from an individual with firsthand knowledge that the pages filed 10 February 2003 accurately reflect the docket system

for the entire firm and that a "Notice of Missing Requirements" mailed 07 November 2001 would have been entered in the docket on either 06 or 07 January 2002.

As applicant has now satisfied all items detailed above, it is proper to grant applicant's petition at this time.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 15 January 2003 is hereby **VACATED**.

Enclosed is a copy of the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 07 November 2001. Applicant is afforded **TWO (2) MONTHS** from the mail date of this decision to file a proper response to the Form PCT/DO/EO/905. Extensions of time are available under 37 CFR 1.136(a).

Richard Cole
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
08 OCT 2002

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

Sandor Breiner
H-1035 Budapest
Szentendrei ut. 12, I.2
HUNGARY

In re Application of Breiner Application No.: 09/958,146 PCT No.: PCT/HU99/00033 Int. Filing Date: 29 April 1999 Priority Date: 29 April 1999 Attorney's Docket No.: None For: Firearm Barrel With Bar Coding Means	:	DECISION

This is in response to applicants' communication filed on 09 June 2002.

BACKGROUND

Applicant filed this international application on 29 April 1999, and did not claim an earlier priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 09 November 2000. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month time period to pay the basic national fee in the United States expired as of midnight on 29 October 2001.

On 27 September 2001, applicant filed *inter alia* the required basic national fee.

On 06 December 2001, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the filing of an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

On 10 January 2002, applicant filed a letter in response to the Notification of Missing Requirements, requesting a copy of a declaration form.

On 15 May 2002, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicant, indicating that the response filed on 10 January 2002 was defective and again requiring the filing of an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

On 09 June 2002, applicant filed the instant communication.

DISCUSSION

Review of the declaration included with the communication filed on 09 June 2002 reveals that it is in compliance with 37 CFR 1.497(a) and (b). Therefore, the requirement of the Notification of Defective Response has been satisfied.

As the acceptable declaration was filed later than 30 months from the effective priority date, applicant is required to pay a $65.00 surcharge under 37 CFR 1.492(e).

DECISION

The declaration filed on 09 June 2002 is **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the filing of a surcharge under 37 CFR 1.492(e).

Leonard Smith
for Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

17 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Steven L. Oberholtzer
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610

In re Application of:	:	
DICKE, Robert	:	DECISION ON PETITION TO
U.S. Application No.: 09/958,164	:	REVIVE ABANDONED
PCT No.: PCT/EP00/01568	:	APPLICATION UNDER 37
International Filing Date: 25 February 2000	:	CFR 1.137(b)
Priority Date: 07 April 1999	:	
Attorney's Docket No.: 11256-003	:	
For: RECESSED HEAD SCREW	:	

The petition to revive under 37 CFR 1.137(b), originally filed 24 February 2003[1] and resubmitted by facsimile 05 September 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the required response, that is, a declaration in compliance with 37 CFR 1.497 and the $130 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.

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 24 February 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

---

[1] Based on applicant's statements and the return postcard that itemizes the petition and bears a USPTO receipt stamp dated 24 February 2003, it is concluded that the petition, surcharge fee, and declaration were originally filed on 24 February 2003.

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

WILLIAM H. DIPPERT
REED SMITH LLP
375 PARK AVENUE
NEW YORK, NY 10152

MAIL

MAY 2 8 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Rajwan
Application No. 09/958,165
Filed: October 4, 2001
For: DATA STREAMING

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the letter filed under 37 C.F.R. §1.181 and §1.182 on November 1, 2001, supplemented on May 21, 2002, and treated as a petition to make special the above-identified National Application, which Petitioner avers is companion to Application No. PCT/IL01/00106.

The petition requests that the above-identified application be made special but does not specify the grounds under which the application should be made special as set forth in the Manual of Patent Examining Procedure §708.02.

The petition does address, however, the standing of the application under 37 C.F.R. §1.492(a)(4) and § 1.496(b) (and, thus, M.P.E.P. §1893.03).

A review of the International Preliminary Examination Report (IPER) indicates that the requirements for an application to be taken out of turn under 37 C.F.R. §1.496(b) (and, thus, M.P.E.P. §1893.03) have been satisfied.

For the above stated reason, the petition is **GRANTED**.

The application will retain its special status throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

The application file will be forwarded to the examiner for expedited prosecution.

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

MAILED
FROM DIRECTOR'S OFFICE

AUG 2 4 2007

TECHNOLOGY CENTER 3600

Mark S. Bicks
Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, DC 20036

In re Application of Werner Wilkendorf Application No. 09/958,180 Filed: December 7, 2001 Attorney Docket No.: 42124 For: COUPLING DEVICE FOR THE QUICK-RELEASE COUPLING OF HOSE-LIKE OR TUBULAR PIPES TO A CONNECTING PART	DECISION ON PETITION TO INVOKE SUPERVISORY AUTHORITY UNDER 37 CFR 1.181

This is in response to applicant's petition to invoke supervisory authority under 37 CFR 1.181 filed December 30, 2005 requesting that acceptance of the drawings filed December 13, 2004 and the amendment to the specification filed August 8, 2005 be required. A second copy of this petition was filed June 23, 2006. The delay in responding to this petition is regretted.

The petition is **DENIED**.

A review of the record reveals that the examiner has objected to the drawings under 37 CFR 1.83(a) for not showing clamping screws directly engaging a rear surface of the end flange as set forth in claim 8, lines 9-10. The examiner requires that this feature be shown or canceled from the claim. Further, applicant's amendment to the specification filed August 8, 2005 is also objected to under 35 U.S.C. 132(a) for introducing new matter into the disclosure because there is no support in the original disclosure of the clamping screws directly engaging the rear surface of the end flange.

Applicant alleges that the drawings are acceptable as filed since they adequately illustrate the claimed invention. It is also alleged that the amendment to the specification does not introduce new matter because such amendment finds support in the original disclosure.

With respect to the drawings, applicant alleges:

"Figs. 3 and 5 show the clamping screws directly engaging rear surface 2 (sic, 21) of end flange 7 through their spring washers 23, as described in the last three lines of page 7 of the original specification and on page 5, lines 8-11 of the substitute specification".

However, what this passage actually describes is that the "clamping screws 15 can be screwed into the threaded bores, and the screw heads work *directly through spring washers 23* on the rear surface 21 of flange 7, which rests in recess 31" (emphasis added). There is no disclosure of the clamping screws "directly engaging" the rear surface of the end flange. Rather, the original disclosure explicitly discloses that the clamping screws (15) act "directly through" the spring washers (23) on to the rear surface (21) of the end flange (7). As described, there are spring washers (23) between the clamping screws and the rear surface of the end flange and the clamping screws act "directly through" these washers on to the rear surface of the end flange.

According to the original disclosure, there are washers between the clamping springs and the rear surface. This is also shown by the original drawings. See Figs. 3 and 5. Note also that the recitation "directly engaging" clearly means that there is no element between the clamping screws and the rear surface of the end flange. Thus, there can be no direct engagement of the clamping spring to the rear surface when, as shown and described, there is a spring washer interposed therebetween. Accordingly, it is evident that the original specification does not support the amended claim language of clamping screws "directly engaging" the rear surface of the end flange and the original drawings do not show the clamping screws directly engaging the rear surface of the end flange.

In an attempt to account for the presence of spring washers interposed between the clamping screws and the rear surface of the end flange, applicant further alleges that the spring washers are a part of the clamping screws because there is no statement in the description portion of the specification or in the Remarks of any amendment that exclude the presence of such. This is not persuasive. The original specification has clearly and explicitly identified the clamping screws by reference numeral "15" and the spring washers by reference numeral "23". There is nothing in the original disclosure that would lead one of ordinary skill in the art to interpret that these two separately identified elements are actually inclusive of being one and the same element. The mere fact that "clamping screw" has been identified by one reference numeral and "spring washer" by another, different, reference numeral and that each of these elements have been separately referred to throughout the original specification would lead one to believe that the spring washer is not a part of the clamping screw, but rather is a distinct element from what constitutes the "clamping screw".

Moreover, while some clamping screws may utilize a spring washer, not all clamping screws have a spring washer. As evidence of this, one need only note the various references already of record. For example, USP 1,258,166 discloses "clamping screws" (g) that do not include spring washers. Note also USP 1,468,187 and USP 2,464,744, both of which disclose clamping screws that lack a spring washer. USP 3,600,012 even discloses embodiments with spring washers (Figs. 1 and 2) and without spring washers (Fig. 3). Thus, it cannot even be said that a "spring washer" is inherently, i.e., the only possibility, part of the clamping screw. Rather, spring washers are separate elements that are usually provided for use in conjunction with clamping screws and employed under the screw heads.

Applicant alleges that the change to the specification is adequately supported therein because of various passages on pages 3 and 7. See the paragraph bridging pages 3 and 4 of the petition. With respect to these passages being referred to by applicant, it should be noted that page 3 of the specification filed on October 5, 2001 has only ten lines. There is also a page 3a that has eleven lines. Accordingly, it is initially pointed out that the locations identified by applicant do not correspond to the lines of these original pages.

On the original page 3, lines 7-8, it is described that the "clamping screws cooperate directly with the surface of the flange of the pipe facing the end surface". On the original page 3a, lines 8-9, it is described that "bearing pressure can be exerted through the clamping screws directly over the end flange of the pipe". On the original page 7, lines 15-17, it is described that "clamping screws 15 can be screwed into the threaded bores, and the screw heads work directly through spring washers 23 on the rear surface 21 of flange 7". It is presumed that these are the passages being referred to by applicant.

Turning to the passage on page 7 first, the recitation of "directly through" is in reference to the screw heads and the spring washers, not the clamping screw and the rear flange surface. Thus, this passage states that the screw head (a part of the clamping screw) will work on the rear surface of the flange in a manner that is "directly through" the spring washer. This passage in no way states or conveys that the screw head *directly engages* the rear surface of the flange nor does it convey that the spring washer is a constituent part of the clamping screw. Disclosing that a first element (the screw head) acts through a second element (the spring washer) on to a third element (the rear surface of the flange) is not the same as, and does not provide support for, the first element directly engaging the third element. Further, this passage does not disclose that the "clamping screw" is defined and constituted in part by the spring washer.

The passage on page 3, lines 7-8, discloses that the clamping screws "cooperate directly" with the surface of the flange. This passage does not disclose the more specific relationship of directly *engaging* the surface of the flange. Much like disclosure of "metal" would not support a later change to a specific metal such as "aluminum", applicant's disclosure of "cooperates directly" does not support the later change to "directly engage". Further, this passage does not disclose that the "clamping screw" is defined and constituted in part by the spring washer.

The passage on page 3a, lines 8-9, discloses that bearing pressure is exerted through the clamping screws "directly over" the end flange. As with the passage noted above, the disclosure of bearing pressure being exerted through clamping screws directly "over" the end flange does not constitute disclosure of the clamping screws directly *engaging* the rear surface of the flange. Further, this passage does not disclose that the "clamping screw" is defined and constituted in part by the spring washer.

In view of the above, applicant's amendment to now define that the spring washer elements are a constituent part of the clamping screws and recite that the clamping screws directly engage the rear surface of the flange is not merely added clarifying language as alleged. Rather, such added subject matter seeks to include a structural relationship that was not previously shown or

disclosed and is not supported by the original disclosure. Accordingly, the examiner's drawing objection and objection to the specification is proper and will not be withdrawn. The application is being forwarded to the examiner for consideration of the response filed on December 14, 2006.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Daniel P. Stodola at (571) 272-7087.

Donald T. Hajec, Director
Technology Center 3600
(571) 272-5150
Facsimile No.: (571) 273-8300

SNM/DS: 8/7/07

SM

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)
6,651,664	2003-11-25	09/958,190	2001-10-03	COVC:0143

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 G. Fletcher/	Date (YYYY-MM-DD)	2009-06-01
Name	Michael G. Fletcher	Registration Number	32777

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. 6651664
Issue Date: November 25,2003
Application No. 09958190
Filed: October 3,2001
Attorney Docket No. 9663.56USWO

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

This is a decision on the electronic petition, filed June 1,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 1,2009 .
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.

0 2 AUG 2002

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Timothy M. Kelley
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of Jordan K. Weisman Application No.: 09/958,201 PCT No.: PCT/US01/01369 Int. Filing Date: 16 January 2001 Priority Date: 11 February 2000 Attorney's Docket No.: 096573-9002 For: GAME PIECE AND METHOD PLAYING A GAME AND SUPPLYING THE GAME PIECE	DECISION ON PETITION UNDER 37 CFR 1.182

This is in response to applicant's petition under 37 CFR 1.182, "PETITION 37 C.F.R. 1.182 TO CONVERT FILED PATENT APPLICATION TO 35 U.S.C. 111(a) APPLICATION," filed to the United States Patent and Trademark Office (USPTO) on 28 January 2002, requesting the above referenced application be converted from a national stage application filed under 35 U.S.C. 371 to a national application filed under U.S.C. 111(a). A $130.00 petition fee has been paid.

BACKGROUND

On 16 January 2001, applicant filed international application PCT/US01/01369, which claimed priority of an earlier U.S. provisional application filed 11 February 2000. No Demand was filed and accordingly, the twenty-month period for paying the basic national fee in the United States would expire at midnight on 11 October 2001.

On 05 October 2001, applicant filed a transmittal letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and an English translation of the international application

On 28 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating the that 371 date for the above application is 05 October 2001.

BEST AVAILABLE COPY

On 28 January 2002, applicant filed the instant petition under 37 CFR 1.182 requesting that the national stage application, filed under 35 U.S.C. 371, be converted to an application filed under 35 U.S.C. 111(a) and be accorded a filing date of 05 October 2001.

DISCUSSION

PETITION TO CONVERT TO AN APPLICATION UNDER 35 U.S.C. 111(a)

The application papers filed on 05 October 2001 clearly and unambiguously indicated that the application was being filed under 35 U.S.C. 371 as the national stage application of international application No. PCT/US01/01369 by use of the "TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE... 35 U.S.C. 371" (Form PTO-1390) as the transmittal letter. Since applicant's transmittal letter did request treatment under 35 U.S.C. 371, included the basic national fee and no conflicting instructions were provided, the application was properly processed under 35 U.S.C. 371 and 37 CFR 1.494 rather than 35 U.S.C. 111(a) and 37 CFR 1.53.

The present application has been properly processed by the Office as a national stage application under 35 U.S.C. 371, as requested and pursuant to 37 CFR 1.494. Accordingly, it would not be appropriate to consider the conversion of the application to an application under 35 U.S.C. 111(a) at this time.

Furthermore, U.S. statutes and regulations do not make specific provision for the requested action and as such, the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (i.e., the loss of patent rights) where no other remedy is available. In the present case, applicant requested that the application be converted but has not demonstrated that the applicant will suffer a loss of any right if the petition to convert is not granted.

In sum, the application filed on 05 October 2001 was properly treated as an application under 35 U.S.C. 371 (37 CFR 1.494). Applicant's petition to convert the application from a filing under 35 U.S.C. 371 to an application under 35 U.S.C. 111(a), cannot be granted.

National stage processing will proceed using a copy of the international application as provided by the International Bureau. .

CONCLUSION

As construed above, the petition under 37 CFR 1.182 is **DISMISSED**.

BEST AVAILABLE COPY

Any further correspondence with respect to this matter should be addressed to the Commissioner of Patents, Office of PCT Legal Administration, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Richard R. Cole
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

BEST AVAILABLE COPY

12 AUG 2002

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Timothy M. Kelley
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of Jordan K. Weisman Application No.: 09/958,201 PCT No.: PCT/US01/01369 Int. Filing Date: 16 January 2001 Priority Date: 11 February 2000 Attorney's Docket No.: 096573-9002 For: GAME PIECE AND METHOD PLAYING A GAME AND SUPPLYING THE GAME PIECE	DECISION ON RENEWED PETITION UNDER 37 CFR 1.182

This is in response to applicant's petition under 37 CFR 1.182, "RENEWED PETITION 37 C.F.R. 1.182 TO CONVERT FILED PATENT APPLICATION TO 35 U.S.C. 111(a) APPLICATION," faxed to the United States Patent and Trademark Office (USPTO) on 08 August 2002, requesting the above referenced application be converted from a national stage application filed under 35 U.S.C. 371 to a national application filed under U.S.C. 111(a).

BACKGROUND

On 12 August 2002, this Office dismiss the petition submitted on 28 January 2002. The decision indicated that the application filed on 05 October 2001 was properly treated as an application under 35 U.S.C. 371 (37 CFR 1.494).

On 08 August 2002, applicants filed a renewed petition, which indicates that the filing was improper because the United States was not designated in the original filed PCT application.

DISCUSSION

A review of the international publication does show that the U.S. was not designated in the in the PCT application, and that the filing under 35 U.S.C. 371 was improper for this application.

Application No.: 09/958,201

The present application was not properly processed by the Office since this application should have not been treated as a national stage application under 35 U.S.C. 371. Accordingly, it would be appropriate to consider the conversion of the application to an application under 35 U.S.C. 111(a) at this time.

Applicant's petition to convert the application from a filing under 35 U.S.C. 371 to an application under 35 U.S.C. 111(a), can be granted. A certified copy of any priority document must be filed in order to obtain priority benefit under 35 U.S.C. 119.

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b) (May 29, 2000) may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111 and ending on the mailing date of this decision. See 37 CFR 1.704(a).

CONCLUSION

As construed above, the petition under 37 CFR 1.182 is **GRANTED**. The 35 U.S.C. 111(a) filing date is **05 October 2001**

Accordingly, the Notification of Acceptance (Form PCT/DO/EO/903) mailed on 28 March 2002 is **VACATED** with the mailing of this decision.

This application is being forward to Office Initial Patent Examination(OIPE) for continued processing.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

20 JUN 20

#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

Timpthy M. Kelly
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of	:	DECISION ON
Jordan K. Weisman	:	
Application No.: 09/958,201	:	
Filing Date: 05 October 2001	:	PETITION
Attorney's Docket No.: 096573-9002	:	
For: GAME PIECE AND METHOD PLAYING	:	
A GAME AND SUPPYING THE GAME PIECE	:	

This is response to applicant's communication "PETITION UNDER 37 CFR §1.182 AND §1.183" filed 12 December 2002 requesting to have the US treated as a designated state in PCT application no.: PCT/US01/01369 and to convert the above captioned- application to a national phase application filed under 35 U.S.C. 371. The appropriate fee of $130.00 set forth in §1.17(h) has been charged to Deposit Account No. 13-3080 as authorized.

BACKGROUND

In a decision from this Office on 12 August 2002, the petition to convert the application from a 35 U.S.C. 371 to 35 U.S.C. 111(a) was granted. The decision indicated that the above application was improperly processed as filed under 35 U.S.C. 371 since the U.S. was not designated in the PCT application.

DISCUSSION

Only international applications that designates the U.S. may enter the national phase. Note 35 USC 363, 371; PCT Article 22, Article 39. It is undisputed that the U.S. was not designated during the international phase.

During the internatinal phase a remedy is available to correct the failure to indicate a specific designation on filing. Specifically, the precautionary designation procedure under PCT Rule 4.9(b) enables applicants to correct omissions and mistakes in the original list of specific designations by initially providing an indication that designations other than those specifically designated in the request being made, and then later confirming such designations, but any designation which is not so confirmed

before the expiration of 15 months from the priority date is regarded as withdrawn by the applicant at the expiration of the time limit.

Pursuant to 35 USC 366, if there is a withdrawal of the U.S. designation prior to compliance with the applicable requirements of 35 USC 371 (c), the designation of the US after the withdrawal shall have no effect and shall be considered as not having been made.

To grant the relief sought in the present case would require waiver of both U.S. statutes and PCT Rule 4.9. The USPTO has no authority to waive either. 37 CFR 1.183 permits waiver of only U.S. regulations not U.S. statutes or PCT regulations.

The facts of this case are distinguishable from Helfgott. The court in Helfgott did not waive any PCT Rule. In that case, relief was granted on the basis of the rectification of an obvious error under PCT Rule 91.

CONCLUSION

The petition for the reasons noted above is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition is desired, applicant must file a request for reconsideration within a **TWO (2) MONTH** non-extendable time period from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition."

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
Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
Legal Examiner
PCT Legal Office

16 MAR 2004

#18

UNITED STATES PATENT and TRADEMARK OFFICE

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

Timpthy M. Kelly
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of	:	DECISION ON
Jordan K. Weisman	:	
Application No.: 09/958,201	:	
Filing Date: 05 October 2001	:	RENEWED PETITION
Attorney's Docket No.: 096573-9002	:	
For: GAME PIECE AND METHOD PLAYING	:	
A GAME AND SUPPYING THE GAME PIECE	:	37 CFR §1.183

This is in response to applicant's communication "SECOND RENEWED PETITION UNDER 37 CFR §1.183" filed 08 August 2003 requesting to have the United States treated as a designated state in PCT application no.: PCT/US01/01369 (the "PCT Application") and to convert U.S. Application No. 09/958,201 (the U.S. application) back to a national-phase application filed under 35 U.S.C. §371.

BACKGROUND

In a decision from this Office on 20 June 2003, the petition under 37 CFR 1.182 and 1.183 was dismissed because to grant relief would have required waiver of both U.S. statutes and PCT Rule 4.9 and the USPTO has no authority to waive either.

On 20 August 2003, petitioner filed a second renewed petition under 37 CFR 1.182.

DISCUSSION

As indicated in the previous decision only international applications that designates the U.S. may enter the national phase. It is undisputed that the U.S. was not designated during the international phase since no confirmation of the U.S. was made under 4.9(c) during the permitted time period. Accordingly, any designation, in this the U.S., which is not confirmed before the expiration of 15 months from the priority date is regarded withdrawn by the applicant at the expiration of the time limit. That is, the international application designating the U.S. is considered withdrawn as to the United States.

Contrary to applicant's analysis on page 5-6 of his petition, the scope of §366 does address unconfirmed precautionary designations in that if a designation is not confirmed, the international application as to that designated State is considered withdrawn. In this case, the U.S. was designated under the general statement of the request pursuant PCT Rule 4.9(b) but was not confirmed before the expiration of the time period. As a result of this, the international application designating the U.S. is considered withdrawn. Also applicant's argument that there was no "nonpayment of the designation fee" with respect to the US because the application paid the full designation fee upon filing the the PCT Request is incorrect. There was nonpayment of the designation fee as to the U.S. since the U.S. designation was subject to confirmation by applicant and applicant did not file a written notice to the receiving Office and did not pay the designation fee and the confirmation fee for the U.S. as required under PCT Rule 4.9(c). Therefore §366 does apply in this present situation.

Pursuant to 35 USC 366, if there is a withdrawal of the U.S. designation prior to compliance with the applicable requirements of 35 USC 371 (c), the designation of the US after the withdrawal shall have no effect and shall be considered as not having been made. Therefore, §366 is applicable and the requested relief would require waiver of both U.S. statute §366 and PCT Rule 4.9. The USPTO has no authority to waive either..

With respect to applicant's arguments about PCT Rule 29, this rule is not applicable in this situation since the international application is withdrawn by operation of law only with respect to the U.S. since it was not confirmed timely. Therefore, the receiving Office is neither declaring that the international application is considered withdrawn under Rule 29.1(a) since the international application is not withdrawn nor is the receiving Office declaring that the designation of any given State is considered withdrawn because it was applicant's failure to confirm the designation within the time period set forth.

CONCLUSION

The second renewed petition for the reasons noted above is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition is desired, applicant must file a request for reconsideration within a **TWO (2) MONTH** non-extendable time period from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition."

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
Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
Legal Examiner
PCT Legal Office

04 JAN 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

Timothy M. Kelley
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of	:
WEISMAN, Jordan K.	: DECISION ON
Application No.: 09/958,201	: RENEWED
Attorney's File Reference: 96573-9002	: PETITION
For: GAME PIECE AND METHOD OF	: UNDER
PLAYING A GAME AND SUPPLYING	: 37 CFR § 1.183
THE GAME PIECE	:

This decision is in response to applicant's "Third Renewed Petition Under 37 CFR § 1.183" filed 17 May 2004 requesting to have the United States treated as a designated state in PCT Application No. PCT/US01/01369 and to convert US application number 09/958,201 back to a national-phase application under 35 USC § 371.

BACKGROUND

On 16 March 2004, this Office mailed a decision dismissing applicant's petition under 37 CFR § 1.183 because the requested relief would require waiver of a US statute, 35 USC § 366, and PCT Rule 4.9 and the USPTO has no authority to waive either provision.

On 17 May 2004, applicant filed the present "Third Renewed Petition Under 37 CFR § 1.183".

DISCUSSION

PCT Rule 4.9(b) (as in effect at the time of filing the international application) states:

> The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:
>
> (i) at least one Contracting State is designated under paragraph (a), and
>
> (ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.

Further, 35 USC § 366 entitled "Withdrawn international application." states, in part:

> Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal.
>
> * * * * * * * * * *

Applicant asserts that 35 USC § 366 does not apply to the present set of facts. Specifically, applicant asserts that 35 USC § 366 applies only to withdrawn applications, not withdrawn designations, and that as such 35 USC § 366 is not presently applicable since the applicant merely failed to confirm the precautionary designation of the US but never withdrew the international application. The applicant also asserts that the PCT Rules clearly make a distinction between withdrawn designations and withdrawn applications. The applicant cites PCT Rule 29 as an example of this.

There is a distinction between the withdrawal of an international application in general and the withdrawal of a single designation as to one contacting state. The withdrawal of an international application in general functions to withdraw the application as to all of the designated contracting states. The withdrawal of a single designation functions to withdraw the application as to the particular state or region indicated in the withdrawal such that the application only remains viable for purposes of any designations that remain. However, there is a direct relationship between the withdrawal of designations and the withdrawal of the international application generally. As indicated in PCT Rule 90bis.2(c), the withdrawal of the designations of all designated states shall be treated as the withdrawal of the international application. If all of the designations are withdrawn, the application is no longer viable with regard to any states in which the application has not already entered the national or regional phase and thus the application is, in effect, withdrawn in general.

The applicant's interpretation of 35 USC § 366 is not in keeping with the wording of the statute. The language of the statute indicates that 35 USC § 366 is applicable if an international application designating the United States is withdrawn "either generally or as to the United States". Thus it is clear from the wording of the statute that 35 USC § 366 is applicable whether the international application is withdrawn generally with regard to all of the designated states including the United States or whether the international application is withdrawn particularly as to the United States by withdrawing the designation of the United States and keeping any or all of the rest of any other designations that were made.

The applicant also argues that 35 USC § 366 does not apply because the US was not designated but was merely a precautionary designation that could only rise to the level of a designation upon confirmation. However, the PCT makes no provision for a "precautionary designation". If the request contains a statement in accordance with PCT Rule 4.9(b)(ii), then all

designations which would be permitted, other than those made under PCT Rule 4.9(a), are also made provided that any designation that is not confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn at that time. Thus for applications including a statement in accordance with PCT Rule 4.9(b)(ii), all designations other than those made under PCT Rule 4.9(a) are also made and are not considered withdrawn under PCT Rule 4.9(b) until 15 months from the priority date unless the applicant confirms the designation prior to the expiration of that time limit.

In applicant's prior international application number PCT/US01/01369 filed 16 January 2001, upon filing the international application the applicant did not check the box for the US in the Designation of States Box No. V of the PCT/RO/101 Request form. However, the end of the Designation of States Box did include the standard precautionary designation statement indicating that in addition to the designations checked, the applicant also makes under Rule 4.9(b) all other designations which would be permitted under the PCT. The statement further indicated that the applicant declares that those additional designations are subject to confirmation and that any designation which is not confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit. Since the applicant did not confirm the designation of the US, the US designation came to be regarded as withdrawn as of midnight on 11 May 2001, the expiration of 15 months from the priority date, in accordance with PCT Rule 4.9(b). Accordingly, the US was designated and that designation was withdrawn through applicant's failure to timely confirm the US designation, and thus 35 USC § 366 is applicable to the present set of facts.

Applicant also asserts that 35 USC § 366 does not apply to the present facts because 35 USC § 366 indicates that it only applies to withdrawals that took place "under the conditions of the treaty and the Regulations". In support of this assertion the applicant points out that the International Bureau (IB) did not follow the "conditions of the treaty and Regulations" when it incorrectly listed the US as a designated state on the Notification of Receipt of Record Copy (Form PCT/IB/301).

The IB clearly erred when it incorrectly listed the US as a designated state on the Form PCT/IB/301. However, the error has no effect on the fact that the withdrawal of the US designation took place under the conditions of the treaty and Regulations when at the expiration of 15 months from the priority date the applicant had not confirmed the precautionary designation of the US in accordance with PCT Rule 4.9(b). Thus, 35 USC § 366 is applicable in spite of the error made by the IB.

The applicant entitles the present petition "Third Renewed Petition Under 37 CFR § 1.183" thus implying that he is requesting the waiver of § 366. However, 37 CFR § 1.183 only provides the Director with the authority to suspend or waive a regulation "which is not a requirement of the statutes". Since 35 USC § 366 is a statute, the USPTO has no authority to suspend or waive § 366.

The applicant alternatively asserts that the US should be treated as a designated state because the IB indicated that the US was a designated state in the Form PCT/IB/301. However, as pointed out by the Head of the PCT Legal Affairs Section of the PCT Legal Service at the IB, Matthias Reischle, in his letter to the applicant dated 22 July 2003,

> while the erroneous inclusion of "US" on Form PCT/IB/301 might have led the applicant to assume that "US" had been designated in the request form, this does not change the fact that "US" was not explicitly designated in the request form, and the responsibility for identifying and addressing such omissions (for example, by confirming the precautionary designation) is that of the applicant. The International Bureau consistently recommends that when PCT users receive Form PCT/IB/301 they compare its contents (in particular the designations) to the indications that were made by the applicant in the request form.

Since the US designation is considered not to have been made, neither PCT Article 22 nor 39 are applicable with regard to the US. Thus the applicant's request for US national stage commencement under 35 USC § 371 is not appropriate.

CONCLUSION

For the above reasons, the applicant's petition under 37 CFR 1.183 to treat the US as a designated state in PCT Application No. PCT/US01/01369 and to convert US application number 09/958,201 back to a national-phase application under 35 USC § 371 is **DENIED**.

This decision may be viewed as a final agency action. See MPEP 1002.02.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Charles A. Pearson
Director
PCT Legal Administration
Telephone: 571-272-3224
Facsimile: 571-273-0459

25 OCT 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

Timothy M. Kelley
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202

In re Application of	DECISION ON
WEISMAN, Jordan K.	
Application No.: 09/958,201	PETITION
Filing Date: October 05, 2001	
Attorney's Docket No.: 96573-9002	UNDER 37 CFR 1.182
For: GAME PIECE AND METHOD OF PLAYING A GAME AND SUPPLYING THE GAME PIECE	

This decision is in response to applicant's "Petition under 37 C.F.R. 1.468 to Excuse the Delay in Meeting the Time Limit to Act to Confirm a Precautionary Designation Under PCT Rule 4.9(b)" filed March 03, 2005 to accept the above identified international application as the national stage of the international application PCT/US01/01369. The present application issued as United States Patent No. 6,899,332 on May 31, 2005. Because the decision dated January 4, 2005 was a final agency decision and the application has issued as a patent no action will be taken on this petition. The petition is DISMISSED as moot.

BACKGROUND

On January 04, 2005, the USPTO issued a final office agency decision dismissing applicant's petition to accept the above identified international application as the national stage of the international application PCT/US01/01369. The decision stated that the requested relief would require the waiver of a US statute, 35 U.S.C. 366 and that the USPTO has no authority to waive the provisions of a statute.

The precautionary designation of the United States of America in the international application PCT/US01/01369 was not confirmed within the time limit set in PCT Rule 4.9(b) thus causing the precautionary designation of the United States of America to be withdrawn. 35 U.S.C. 366 states in part, "[I]f an international application designating the United States is withdrawn or considered to be withdrawn, either generally or as to the United States, under the conditions of the treaty and Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, **the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made....**" (Bold added).

DISCUSSION

Applicant has argued that the final agency action dated January 04, 2005 does not apply to the instant petition because applicant is now not seeking the USPTO to suspend certain regulations but is seeking relief under 37 CFR 1.468. Applicant's arguments are not compelling. Applicant has not presented any new facts in the case. The arguments applicants are now making could have been presented in an earlier petition.

Applicant seeks relief under 37 CFR 1.468 and 35 U.S.C. 364(b) which states:

> An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Director of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

The key phrase in the statute is "a pending international application." When the applicant failed to confirm the precautionary designation of the United States of America, the international application was considered withdrawn as to the United States per PCT Rule 4.9(b)(ii)[1] and 35 U.S.C. 366. Furthermore, when the applicant requested on January 28, 2002 that the application be converted from a national stage application to an application filed under 35 U.S.C. 111(a), applicant no longer sought to continue prosecution of the international application in the United States through a national stage application. Applicant elected the relief that he desired and cannot now request contrary action. Thus for the above reasons, the international application was not pending and therefore relief is not available under 35 U.S.C. 364(b) and 37 CFR 1.468.

APPLICANT'S FIRST ALTERNATIVE

Applicant argues that "because: (1) a copy of the Notification of Receipt of Record Copy in the International Application, which listed the United States as a specifically designated office, was sent to the United States Receiving Office before the expiration of the 15 months from the priority date (and was therefore effectively a written notice in compliance with PCT Rule 4.9(c)(i)) and (2) the PCT Fee Calculation Sheet in the International Application included an indication of Deposit Account Authorization so that the United States Receiving Office was authorized to charge any deficiency to the deposit account... confirmation of the United States as a designated state in the International Application *was made* before the expiration of 15 months from the priority date." First, the IB discovered their error indicating that the U.S. was designated in the Notification of Receipt of Record Copy and they corrected the error before publication of the international application. Secondly, the deposit account authorization on the PCT Fee Calculation Sheet only permits the Offices "to charge any deficiency or credit any overpayment in the total fees indicated above to my deposit account." Thus this authorization is only for fees listed on the fee calculation sheet and not for fees (such as confirmation fees) not listed on the fee calculation sheet.

APPLICANT'S SECOND ALTERNATIVE

Alternatively, applicant argues "because the PCT Request in the International Application included that the Petitioner was an applicant for the purposes of all designated states, this indication met the requirement for a designation of all Contracting States under PCT Rule 4.9(a). Therefore, the United States was a specifically designated state and no confirmation of a precautionary designation is needed." This clause on the request form means that the applicant, Jordan K. Weisman, was an applicant for all designated states. The Notes to the Request form makes it clear that states are designated by checking the appropriate boxes in Box No. V. The notes to Box No. V states, in part:

---

[1] [A]ny designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.

Designation of States (Rules 4.1(a)(iv) and 4.9(a)): The Contracting States in which protection is desired must be designated under Rule 4.9(a) in the request by marking the applicable check-boxes. At least one check-box effecting a specific designations must be marked.

A review of the request form shows that all the possible specific designations in Box No. V were checked, except for the United States of America. Thus it is clear that the United States of America was not specifically designated and that while Jordan K. Weisman is an applicant for all states that were designated, he is not an applicant for the United States of America.

CONCLUSION

The present application issued as United States Patent No. 6,899,332 on May 31, 2005. Because the decision dated January 4, 2005 was a final agency decision and the application has issued as a patent no action will be taken on this petition. Applicant could have filed a Request for Continued Examination to prevent issuance of the patent and given the USPTO time to considered the present petition. Accordingly, the petition is dismissed as moot.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Charles A. Pearson
Director
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3224

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Bradford G. Addison
Barnes & Thornburg
11 South Meridian Street
Indianapolis, Indiana 46204-7253

(Petitioner)

COPY MAILED

OCT 06 2004

OFFICE OF PETITIONS

In re Application of
Koji Sode
Application No. 09/958,231
Filed: January 18, 2000
For: GLUCOSE DEHYDROGENASE

: Decision
: On Petition
: Granting
: Access

A petition for access to entire contents of the above referenced application was filed by Bradford G. Addison on July 30, 2004, without proof of service on applicant. Accordingly, a copy of the petition is included with this decision.

The petition is **DISMISSED**.

The petition requests access to the above referenced application under 37 CFR 1.14(h) because it is the national stage application of PCT/JP00/02322 which was published as WO 00/61730. Petitioner states that 35 USC § 122 requires publication of the above referenced application based upon its origin from an application filed pursuant to a multilateral international agreement. Petitioner states that if the application had been published, the contents of the application file would be accessible to him. This apparently would constitute special circumstances to carry out an act of Congress as provided in 37 CFR 1.14(h).

Section 4502 of the American Inventors Protection Act of 1999 (P.L. 106-113) which amended 35 USC § 122 to provide for publication of patent applications limited its scope in § 4508, to applications filed on or after November 29, 2000. The above referenced application was filed (the international filing date) January 18, 2000. The date of entry into the national stage is not a filing date. Hence the filing date is prior to the effective date of the AIPA changes to § 122 and the above referenced application is not subject to publication.

Since the above referenced application is a pending application, access cannot be obtained under 37 CFR 1.14(a)(1)(iv). Access under 37 CFR 1.14(a)(1)(vi) is limited to the application as filed, not the entire contents of the application as requested in the petition.

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

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

Attachment: Petition

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

(Applicant)

19 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BEST AVAILABLE COPY

William R. Evans
Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of SUNDHOLM	:	
U.S. Application No.: 09/958,238	:	
Int. Application No.: PCT/FI00/00298	:	DECISION
Int. Filing Date: 07 April 2000	:	
Priority Date: 07 April 1999	:	
Attorney Docket No.: U 013656-8	:	
For: A BARRIER APPARATUS FOR RESISTING	:	
PASSAGE OF HARMFUL GASES	:	
THROUGH AN OPENING	:	

This is in response to applicant's "Petition Under 37 CFR 1.181 to Withdraw Holding of Abandonment" filed 06 August 2002. No petition fee is due.

BACKGROUND

On 07 April 2000, applicant filed international application PCT/FI00/00298, which claimed priority of an earlier Finland application filed 07 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 23 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 09 October 2001 (07 October 2001 was a Sunday preceding a Monday holiday).

On 05 October 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 19 July 2002, the DO/EO/US mailed a Notice of Abandonment, which indicated that the application is abandoned for failure to respond to the 07 November 2001 communication.

On 06 August 2002, applicant filed the present petition to withdraw the holding of abandonment.

DISCUSSION

According to the Official Gazette at 1156 OG 53 and MPEP 711.03(c), a petition to withdraw a holding of abandonment based on failure to receive an Office communication must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

With regard to item (1) above, applicant's representative has provided the required statement.

With regard to item (2) above, applicant's representative has provided the required statement.

With regard to item (3) above, the submitted docket listing for the present application is insufficient. Applicants' representative should supply a docket record which lists responses due to the USPTO on 07 January 2002 for all cases handled by the representative's firm, or if such a docket record is unavailable, for all cases handled by applicants' representative. This docket record must illustrate the absence of any listing of a response due to a Notification of Missing Requirements.

CONCLUSION

Because applicant has failed to satisfy item (3) above, the petition is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No petition fee is due. Extensions of time are available under 37 CFR 1.136(a).

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 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William R. Evans
Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of SUNDHOLM	:	
U.S. Application No.: 09/958,238	:	
Int. Application No.: PCT/FI00/00298	:	DECISION
Int. Filing Date: 07 April 2000	:	
Priority Date: 07 April 1999	:	
Attorney Docket No.: U 013656-8	:	
For: A BARRIER APPARATUS FOR RESISTING	:	
PASSAGE OF HARMFUL GASES	:	
THROUGH AN OPENING	:	

This is in response to applicant's "Response to Decision and Renewed Petition to Withdraw Abandonment" filed 27 September 2002.

BACKGROUND

On 07 April 2000, applicant filed international application PCT/FI00/00298, which claimed priority of an earlier Finland application filed 07 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 23 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 09 October 2001 (07 October 2001 was a Sunday preceding a Monday holiday).

On 05 October 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 07 June 2002, applicant filed an executed declaration.

On 19 July 2002, the DO/EO/US mailed a Notice of Abandonment, which indicated that the application is abandoned for failure to respond to the 07 November 2001 communication.

On 06 August 2002, applicant filed a petition to withdraw the holding of abandonment.

On 13 September 2002, this Office mailed a decision dismissing the 06 August 2002 petition.

On 27 September 2002, applicant filed the present renewed petition to withdraw the holding of abandonment.

DISCUSSION

According to the Official Gazette at 1156 OG 53 and MPEP 711.03(c), a petition to withdraw a holding of abandonment based on failure to receive an Office communication must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

Applicant has previously satisfied items (1) and (2) above.

With regard to item (3) above, applicant's representative has furnished a docket record which lists responses due to the USPTO on 07 January 2002 for all cases handled by the representative's firm. This docket record sufficiently illustrates the absence of any listing of a response due to a Notification of Missing Requirements.

CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment is GRANTED.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 19 July 2002 is hereby VACATED.

The application has an International Filing Date of 07 April 2000 and a date under 35 U.S.C. 371 of 07 June 2002.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

ELI LILLY AND COMPANY
PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS IN 46206-6288

COPY MAILED

SEP 27 2005

OFFICE OF PETITIONS

In re Application of	:	
Bender et al.	:	
Application No. 09/958,262	:	DECISION ON APPLICATION
International Filing	:	FOR
Date: April 17, 2000	:	PATENT TERM ADJUSTMENT
Attorney Docket No. X-12964	:	

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 June 24, 2005. Applicants, in effect, 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 two hundred fifty-six (256) days.

The petition is **DISMISSED**.

On March 22, 2005, 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 two hundred fifty-six (256) 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 applications 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, April 17, 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.

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

Kery A. Fries

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

Michael J. Striker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

MAR 26 2004

In re Application of:
Andreas Jennerjahn
Serial No.: 09/958,283
Filed: April 29, 2002
Attorney Docket No.: 1781

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181 filed on December 22, 2003. There is no fee for this petition.

The petition is GRANTED.

A review of the application file reveals that a Notice of Abandonment was mailed on November 25, 2003 holding the application to be abandoned for failure to timely file a proper reply to the Office letter mailed on July 9, 2003.

Petitioner asserts that the Office letter of July 9, 2003 was never received. Although petitioner provides evidence as to the non-receipt of the Office letter, it is not necessary to review the evidence since the Office letter was in fact returned to the U.S. Patent and Trademark Office by the U.S. Postal Service. It apparently was returned because the complete address was not visible through the window of the envelope.

The Notice of Abandonment of November 25, 2003 is hereby vacated and the holding of abandonment is withdrawn. The Office letter of July 9, 2003 (actually mailed on July 10, 2003) will be remailed restarting the time period for response.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components

MAY 0 1 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robert G. Mukai
BURNS, DOANE, SWECKER & MATHIS LLP
P.O. Box 1404
Alexandria, Virginia 22313-1404

In re Application of
KOMATSU, Hironori *et al*
U.S. Application No.: 09/958,305
PCT No.: PCT/JP01/00968
Int. Filing Date: 13 February 2001
Priority Date: 10 February 2000
Attorney Docket No.: 029430-490
For: SELECTIVE PROCESS FOR PRODUCING AN ANOMER . . .

DECISION

This is a decision on the petition filed on 07 March 2001, requesting that the shortened statutory period for reply set forth in the Office communication mailed on 09 November 2001 be reset to run from the date on which the Office communication was actually received at the correspondence address of record.

The petition is **GRANTED**.

Petitioner provided a statement that the Office communication in question was received at the correspondence address of record on 21 February 2001. The petition was filed within two weeks of receipt of the Office communication. A substantial portion of the set reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed.

Accordingly, the shortened statutory period that was originally set forth in the Office communication originally mailed on 09 November 2001 is hereby reset to run FROM THE RECEIPT DATE OF **21 February 2001**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

DEC 1 9 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Walter Ottesen
Patent Attorney
P.O. Box 4026
Gaithersburg, MD 20885-4026

In re Application of BLICKWEDEL, Holger, et al. Application No.: 09/958,306 PCT Application No.: PCT/EP99/04895 International Filing Date: 13 July 1999 Priority Date: 15 July 1998 Attorney Docket No.: 98-060 For: METHOD FOR PRODUCING A TIRE	DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office on 09 October 2001 is **GRANTED**.

BACKGROUND

On 13 July 1999, applicants filed an international application, No. PCT/EP99/04895. A copy of the application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 January 2000.

On 27 January 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. The deadline for entry into the United States National Stage was thirty months from the priority date, that is 16 January 2001 (15 January 2001 was a holiday).

On 09 October 2001, applicants filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, a petition to revive, the requisite petition fee and the basic national fee.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicants' statement that "the entire delay in entering the application into the National Stage from the due date for the entry until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as application was filed on 13 July 1999. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The $130.00 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. 15-0773 as authorized in the transmittal letter filed 09 October 2001.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

The application has an international filing date of 13 July 1999 under 35 U.S.C. §363 and a date of 09 October 2001 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Erin M. Pender
Attorney Advisor
PCT Legal Office

Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

SEP 11 2007

OFFICE OF PETITIONS

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

In re Application of	:
Rodgers, et al.	: DECISION ON APPLICATION
Application No. 09/658,315	: FOR PATENT TERM ADJUSTMENT
Filed: September 8, 2000	:
Atty. Dkt. No: 98.009-B1	:

This is a decision on the "Request for Patent Term Adjustment Determination," filed March 7, 2007. This matter is being treated under 37 CFR 1.705(b) as an application for patent term adjustment.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **GRANTED TO THE EXTENT INDICATED HEREIN**.

Applicants request that the Determination of Patent Term Adjustment be corrected from 765 days, as indicated on the Determination of Patent Term Adjustment mailed January 10, 2007, to an adjustment of 1188 days. Specifically, applicants argue that the reduction 208 days was improperly accorded and that the adjustment of 929 days is less than should be accorded.

The correct patent term adjustment (PTA) at the time of the allowance is 1178 days. The Office will adjust the PAIR screen to reflect that the PTA determination at the time of mailing of the instant letter reflects an adjustment of 1178 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

As uncontested by applicants, an adjustment of 126 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1).

As argued by applicants, the application is entitled to an adjustment of 1144 days, rather than 929 days as reflected in the Determination of Patent Term Adjustment mailed January 10, 2007, in accordance with 37 CFR 1.702(a)(2). The adjustment began June 11, 2003, the day after the date that is four months after the date that a reply to the non-final Office action was

filed, and ended July 28, 2006, the date that the second non-final Office action was mailed.

The adjustment totaling 1270 days is properly reduced 70 days, as uncontested by applicants, in accordance with 37 CFR 1.704(b) in connection with the reply submitted August 23, 2002.

The adjustment totaling 1270 days is further properly reduced 10 days in accordance with 37 CFR 1.704(c)(4) in connection with the petition to withdraw holding of abandonment filed September 11, 2003. The reduction began September 2, 2003, the day after the date that is two months after the date that the Notice of Abandonment was mailed, and ended September 11, 2003, the date the petition was filed.

The adjustment totaling 1270 days is further properly reduced 12 days, as uncontested by applicants, in accordance with 37 CFR 1.704(c)(8) in connection with the information disclosure statement field November 8, 2006.

Accordingly, at the time of allowance, the application is entitled to an adjustment of 1178 days.

As authorized, applicants' deposit account has been charged the required $200.00 application fee.

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

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

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

Kery A. Fries

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

Enclosure: Copy of Adjustment PAIR Calculation

Day : Monday
Date: 9/10/2007

PALM INTRANET

Time: 10:18:44

PTA Calculations for Application: 09/658315			
Application Filing Date:	09/08/2000	PTO Delay (PTO):	1055
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	290
Post-Issue Petitions:	0	Total PTA (days):	1178
PTO Delay Adjustment:	413		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
50	09/10/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		2	
49	09/10/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	415		
41	01/10/2007	MAIL NOTICE OF ALLOWANCE			
40	01/08/2007	ISSUE REVISION COMPLETED			
39	01/08/2007	DOCUMENT VERIFICATION			
38	01/08/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
37	01/06/2007	NOTICE OF ALLOWABILITY			
36	11/08/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
35	11/08/2006	REFERENCE CAPTURE ON IDS			
34	11/08/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		12	31
33	11/13/2006	PARALEGAL TD ACCEPTED			
32	11/06/2006	DATE FORWARDED TO EXAMINER			
31	10/27/2006	RESPONSE AFTER NON-FINAL ACTION			
30	07/28/2006	MAIL NON-FINAL REJECTION	929		27
29	07/24/2006	NON-FINAL REJECTION			
28	07/24/2006	DATE FORWARDED TO EXAMINER			
27	09/11/2003	RESPONSE AFTER NON-FINAL ACTION		208	16
26	07/25/2006	MAIL NOTICE OF RESCINDED ABANDONMENT			
25	01/23/2006	MISCELLANEOUS INCOMING LETTER			
24	11/22/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
23	04/08/2005	PETITION TO REVIVE APPLICATION - GRANTED			
22	09/11/2003	PETITION ENTERED			

21	01/29/2004	NOTICE OF RESCINDED ABANDONMENT IN TCS			
20	01/21/2004	PETITION TO REVIVE APPLICATION - GRANTED			
19	09/11/2003	PETITION ENTERED			
18	07/01/2003	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
17	06/30/2003	ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
16	11/15/2002	MAIL NON-FINAL REJECTION			
15	11/15/2002	NON-FINAL REJECTION			
14	10/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
13	09/03/2002	DATE FORWARDED TO EXAMINER			
12	08/23/2002	RESPONSE AFTER NON-FINAL ACTION		70	10
11	08/23/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
10	03/14/2002	MAIL NON-FINAL REJECTION	126		-1
9	03/11/2002	NON-FINAL REJECTION			
8	09/08/2000	PRELIMINARY AMENDMENT			
7	10/23/2000	CASE DOCKETED TO EXAMINER IN GAU			
6	10/19/2000	APPLICATION DISPATCHED FROM OIPE			
5	10/19/2000	CORRESPONDENCE ADDRESS CHANGE			
4	09/28/2000	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	09/26/2000	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	09/08/2000	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	09/08/2000	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

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

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

0 8 SEP 2003

SHERIDAN ROSS P.C.
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141

In re Application of	:	DECISION ON
PARK et al	:	
Application No.: 09/958,321	:	
PCT No.: PCT/IB00/02058	:	PETITION UNDER
Int. Filing Date: 29 December 2000	:	
Priority Date: 03 February 2000	:	37 CFR 1.137(b)
Attorney's Docket No.: 4409KRI-1	:	
For: A PROTEASE, A GENE THEREFOR AND	:	
THE USE THEREOF	:	

This decision is in response to applicants' "Petition For Revival Of Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 13 November 2002.

BACKGROUND

On 29 December 2000, this international application was filed, claiming an earliest priority date of 03 February 2000.

No Demand electing the United States was filed in this international application. Accordingly, the deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.494 was 03 October 2001.

On 03 October 2001, applicants filed a Transmittal letter (Form PTO-1390) for entry into the national stage in the United States, which was accompanied by, basic national fee and an executed declaration.

On 19 November 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 a copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). The notification set two (2) months time limit or 32 months from the priority date for the application, whichever is later to respond.

On 05 December 2001, petitioners filed a paper and computer readable form of the Sequence Listing for this application.

On 05 February 2002, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the nucleotide and/or amino acid sequence disclosure contained in the application did not comply with the requirements for such disclosure as set forth in 37 CFR .1821-1.825 because the computer readable form that has been filled with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. It further indicated that applicant must provide a substitute computer readable form (CRF) of the "Sequence Listing."

The decision gave petitioner one (1) MONTH from the mail date of the Notification of Defective Response, or the time period set for the related Notification of Missing Requirements which was mailed on November 19, 2001. The notification further stated that the time period for response set in the Notification of Missing Requirements may be extended under the provisions of 37 CFR 1.136(a).

On 16 October 2002, the United States Designated/Elected Office mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that applicant has failed to respond to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 05 February within the time period set therein.

On 13 November 2002, petitioners submitted the instant petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a substitute paper and computer readable form the Sequence Listing.

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.

The petition is not deemed to satisfy the requirements under 37 CFR 1.137(b).

Petitioners have provided: (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. However, Petitioners have not met requirement (1) because the reply is not proper since the computer readable form the Sequence Listing was damaged.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Enclosed: CRF Problem Report

12 MAR 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

SHERIDAN ROSS P.C.
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141

In re Application of	:	DECISION ON RENEWED
PARK et al	:	
Application No.: 09/958,321	:	
PCT No.: PCT/IB00/02058	:	
Int. Filing Date: 29 December 2000	:	PETITION UNDER
Priority Date: 03 February 2000	:	
Attorney's Docket No.: 4409KRI-1	:	
For: A PROTEASE, A GENE THEREFOR AND	:	
THE USE THEREOF	:	37 CFR 1.137(b)

This decision is in response to applicants' "Request for reconsideration of decision refusing to revive an abandoned application," which is being treated a renewed petition under 37 CFR 1.137(b) filed on 16 October 2003.

BACKGROUND

In a decision from this Office on 08 September 2003, the petition filed on 13 November 2002 was dismissed because the reply was not proper since the computer readable form the Sequence Listing was damaged.

On 05 December 2001, petitioners filed a paper and another computer readable form of the Sequence Listing for this application.

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 a substitute paper and computer readable form the Sequence Listing, (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).

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. The 35 USC 371(c)(1), (c)(2) and (c)(4) date of this application is **03 October 2001**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

31 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

YOUNG & THOMPSON
745 South 23rd Street
2nd Floor
Arlington, VA 22202

In re Application of BREMNER, Douglas *et al* U.S. Application No.: 09/958,325 PCT No.: PCT/EP00/03202 Int. Filing Date: 10 April 2000 Priority Date: 09 April 1999 Attorney Docket No.: BO 42188 SMO For: ANCHOR LINE PRETENSIONING METHOD	**DECISION ON PETITION UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Petition under 37 C.F.R. § 1.47(a)" filed on 19 April 2002.

BACKGROUND

On 19 November 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 an oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. Applicants were given two months to respond.

On 19 April 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, the $130.00 petition fee; a three-month extension and $920 fee; a letter dated 20 March 2002 signed by Mr. Wille; and a declaration signed by one of the two co-inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

With regard to item (3), applicants state that the last known address of the nonsigning co-inventor, Doug Bremner is:

Palais Armida

8 Rue Rossini
Nice, France

This information satisfies item (3).

Regarding item (4), applicants included a Declaration signed by one of the two co-inventors, Jean-Claude Gramet. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has also been satisfied.

However, applicants have not sufficiently met the requirements of item (2).

Applicants submitted a declaration by Mr. Hein Wille, Patent Manager of the assignee, Single Buoy Moorings, Inc. explaining his efforts to obtain the signature of Mr. Bremner. However, this declaration does not contain the necessary details to determine whether a diligent effort was made to contact Mr. Bremner and is not accompanied by any documentary evidence supporting Mr. Wille's claims.

Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the MPEP (8th Ed.) which 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, a statement of facts should be submitted that **fully describes the exact facts which are relied** on to establish that a diligent effort was made . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** (Emphasis added).

In paragraph two of his declaration, Mr. Wille states that "from 1 August we undertake several actions to trace and locate Mr. Doug Bremner, for example we tried to contact him via his old address. The result of our actions is that it is still not possible for us to trace and to contact Mr. Bremner, as we do not know his new address or telephone number. His latest known address is Palais Armida, 8 Rue Rossini in Nice, France, but he changed his address at least one year ago. As a result of that he could not sign the relevant documents for this case like the power of attorney." This is

insufficient.

Mr. Wille does not specifically indicate what constituted the "several actions to trace and locate Mr. Doug Bremner", and did not explain how he tried to contact Mr. Bremner at his first address. Did he send a letter and it was returned, or did an employee tell them? Neither did Mr. Wille explain how he determined that Mr. Bremner moved from his address in Nice, France. Did postal authorities inform him? As stated above, a statement of facts must be submitted that fully describes the steps taken to determine the whereabouts of Mr. Bremner. In addition, no documentary evidence was provided such as returned mail receipts, etc. as required above. Finally, Mr. Wille does not explain how he knows Mr. Bremner moved out of the address in Nice, France more than one year ago. Again no documentary evidence was provided that may shed some light on this matter. For these reasons, Item (2) is not yet satisfied.

Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

02 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

02 JAN 2003

YOUNG & THOMPSON
745 South 23rd Street
2nd Floor
Arlington, VA 22202

In re Application of BREMNER, Douglas *et al* U.S. Application No.: 09/958,325 PCT No.: PCT/EP00/03202 Int. Filing Date: 10 April 2000 Priority Date: 09 April 1999 Attorney Docket No.: BO 42188 SMO For: ANCHOR LINE PRETENSIONING METHOD	**DECISION ON PETITION UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(a)" filed on 02 December 2002.

BACKGROUND

On 28 December 2001, a decision dismissing applicants' petition was mailed because they failed to satisfy item (2) of 37 CFR 1.47(a).

On 02 December 2002, applicants submitted the instant request which was accompanied by, *inter alia*, a two-month extension and authorization to charge the $400.00 fee to Deposit Account No. 25-0120 and a declaration signed by co-inventor, Douglas Bremnar.

DISCUSSION

In the renewed request, applicants filed a declaration signed by the nonsigning co-inventor, Douglas Bremnar.

Accordingly, applicants petition under 37 CFR 1.47(a) is moot.

CONCLUSION

For the reasons above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** as moot.

A review of the declaration filed with the instant petition reveals that it is in compliance with 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 10 April 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **02 December 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

MAILED

MAR 3 1 2009

OFFICE OF PETITIONS

In re Application of
Marina Marie Pierre Nicolas, et al.
Application No. 09/958,330
Filed: October 9, 2001
Attorney Docket No. NL 000052

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed September 2, 2008.

The petition is GRANTED.

The above-identified application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision on April 3, 2008 by the Board of Patent Appeals and Interferences. A Notice of Abandonment was mailed on June 16, 2008. On September 2, 2008, the present petition was filed.

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

The application is being referred to Technology Center AU 2622 for appropriate action by the Examiner in the normal course of business on the amendment received September 2, 2008.

Telephone inquiries concerning this matter may 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

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE NW
WASHINGTON, DC 20036

COPY MAILED

APR 1 5 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Dorit Baucke, et al. :
Application No. 09/958,349 :
Filed: March 28, 2002 :
Attorney Docket No. 50511 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Restriction Requirement mailed May 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 June 30, 2003.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34, the signature of Martin L. Katz appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. If Martin L. Katz desires to receive future correspondence regarding this application, an appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence will be directed solely to the address of record until otherwise instructed.

The application file is being forwarded to Technology Center 1600, Art Unit 1626 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

cc: Martin L. Katz
Wood, Phillips, Katz, Clark & Mortimer
Citicorp Center, Suite 3800
500 West Madison Street
Chicago, IL 60661-2511

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

01 JUL 2003

Beth A. Burrous
Foley & Lardner
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109

In re Application of	:	DECISION
Huan PHAN et al.	:	
U.S. Application No.: 09/958,359	:	ON
PCT No.: PCT/US00/09277	:	
International Filing Date: 06 April 2000	:	PETITION
Priority Date: 09 April 1999	:	
Attorney's Docket No.: 038602-1255	:	UNDER
For: TYROSINE KINASE SUBSTRATE (Tks)	:	
PROTEINS	:	37 CFR 1.181

This decision is in response to applicants' "PETITION UNDER RULE § 1.181" filed 14 April 2003 requesting that the copy of the Declaration and Power of Attorney filed with the present petition be accepted in lieu of the original Declaration and Power of Attorney filed on 05 February 2002. No petition fee is required. The petition is **GRANTED**.

BACKGROUND

On 06 April 2000, applicants filed an International Application PCT/US00/09277, which claimed a priority date of 09 April 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 09 November 2000, which was within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 09 October 2001.

On 09 October 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 05 December 2001, the USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than the applicable time limit from the priority date were required.

On 05 February 2002, applicants filed a response to the Notification of Missing Requirements which included, *inter alia*, a transmittal letter (form PTO-1390) with an indication

of a submission of oath/declaration (checked box 9) and a check for $130 for the late submission of the oath/declaration. Further, the transmittal letter included an incorrect U.S. Application Number of 09/958,1255 listed thereon.

On 14 April 2003, applicants filed the present petition, which included, *inter alia*, (1) a copy of the USPTO stamped postcard receipt with a listing of contents including 4 pages of Declaration and Power of Attorney and the receipt date of 05 February 2002 stamped thereon and; (2) a copy the Declaration and Power of Attorney filed 05 February 2002.

DISCUSSION

A review of the papers filed on 14 April 2003 reveals that applicants have provided sufficient evidence to establish that applicants filed the Declaration and Power of Attorney in response to the Notification of Missing Requirements on 05 February 2002. The proof is the received date of FEB 05 2002 stamped by the USPTO on the postcard receipt. Moreover, the USPTO's accounting database also indicates 05 February 2002 as the mailroom date of $130 for the late submission of the oath/declaration.

As regards to the transmittal letter filed on 05 February 2002, although the heading on the transmittal letter includes the incorrect U.S. Application Number 09/958,1255, other identifying information in the heading, i.e. International Application No., International Filing Date, Priority Date Claimed, Applicants' name, Title and Attorney's Docket Number, clearly establishes that the response is directed to U.S. Application Number 09/958,359. Consequently, the applicants' response to the Notification of Missing Requirements is being considered as being timely submitted.

Further, as a matter of information, the transmittal letter filed with the instant petition also bears the incorrect U.S. Application Number 09/958,1255. The counsel should check that this is corrected on future submissions to ensure proper matching with the file.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing including mailing of a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) and FILING RECEIPT.

Harry C. Kim
PCT Special Program Examiner
Office of PCT Legal Administration
Telephone: (703) 308-2248
Facsimile: (703) 308-6459

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE
02 OCT 2002
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877

In re Application of	:	
Schneider	:	
Application No. 09/958,366	:	DECISION ON
PCT No.: PCT/EP00/03247	:	
Int. Filing Date: 12 April 2000	:	PAPERS UNDER
Priority Date: 17 April 1999	:	
Atty. Docket No.: 1/1085	:	37 CFR 1.42
For: Method For Nitrating	:	
Aniline Derivatives	:	

This is in response to the declaration and "Submission of Missing Parts of Application..." filed on 04 April 2002, which are being treated under 37 CFR 1.42.

BACKGROUND

This international application was filed on 12 April 2000, and claimed a priority date of 17 April 1999. The International Bureau transmitted a copy of the published international application to the USPTO on 26 October 2000. A Demand electing the United States was filed before the expiration of 19 months from the priority date. Accordingly, the 30 month time period to file the basic national fee in the U.S. expired as of midnight on 17 October 2001.

On 05 October 2001, applicants filed *inter alia* the basic national fee.

On 26 November 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b).

The instant papers were filed on 04 April 2002.

DISCUSSION

Inspection of the declaration reveals that it has been signed by Margarete Schneider "as Legal Representative for Heinrich SCHNEIDER, deceased inventor." 37 CFR 1.42 provides in part that

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) Of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

> If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Former § 1.44 required that proof of the authority of the legal representative be submitted. Effective 08 September 2000, § 1.44 was removed and reserved. The requirement to submit proof of legal authority was thereby eliminated. Thus, the signature and accompanying identification of the legal representative is sufficient to establish that the legal representative may make application on behalf of the deceased inventor.

Review of the copy of the declaration filed on 04 April 2002 reveals that it was executed by Margarete Schneider, acting as the legal representative of deceased sole inventor Heinrich Schneider. The declaration includes citizenship, residence and post office address information for Margarete Schneider, but does not include the citizenship, residence and mailing address of Heinrich Schneider. As such, the declaration is not in compliance with 37 CFR 1.497(b)(2). Accordingly, it would not be appropriate to accord the application status pursuant to 37 CFR 1.42 on the basis of the present record.

DECISION

The papers under 37 CFR 1.42 are **DISMISSED**, without prejudice.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, 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: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

22 JUL 2003

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

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877

In re Application of Schneider Application No. 09/958,366 PCT No.: PCT/EP00/03247 Int. Filing Date: 12 April 2000 Priority Date: 17 April 1999 Atty. Docket No.: 1/1085 For: Method For Nitrating Aniline Derivatives	DECISION ON PAPERS UNDER 37 CFR 1.42

This is in response to the "Request For Reconsideration Of Decision" filed on 18 March 2003.

DISCUSSION

In a decision mailed on 02 October 2002, the declaration filed on 04 April 2002 was found not to be in compliance with 37 CFR 1.497(b)(2) because, while it was executed by Margarete Schneider, acting as the legal representative of deceased sole inventor Heinrich Schneider (and includes citizenship, residence and post office address information for Margarete Schneider), it does not include the citizenship, residence and mailing address of Heinrich Schneider.

Petitioner argues that 37 CFR 1.497(b)(2) should not be interpreted to require citizenship, residence and mailing address information for the deceased inventor. The essence of petitioner's arguments is that such a requirement would be "absurd" and "pointless." However, petitioner overlooks the identification function performed by requiring such information - that is, the (former) citizenship, residence and post office address of the deceased inventor serve to more specifically identify him. Moreover, regardless of the merits of requiring such information, the plain language of the regulation in fact does require the statement of the "facts which the inventor would have been required to state." Consequently, since the declaration filed on 04 April 2002 did not state these facts, it would not be appropriate to accept it.

DECISION

The papers under 37 CFR 1.42 are **DISMISSED**, without prejudice.

Applicant is advised that, effective May 1, 2003, the Office has changed 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.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

28 OCT 2003

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877

In re Application of	:	
Schneider	:	
Application No. 09/958,366	:	DECISION ON
PCT No.: PCT/EP00/03247	:	
Int. Filing Date: 12 April 2000	:	PAPERS UNDER
Priority Date: 17 April 1999	:	
Atty. Docket No.: 1/1085	:	37 CFR 1.42
For: Method For Nitrating	:	
Aniline Derivatives	:	

This is in response to the "Response To Decision Dated July 22, 2003 Dismissing Papers Under 37 CFR 1.142" filed on 29 September 2003.

DISCUSSION

In a decision mailed on 22 July 2003, the declaration filed on 04 April 2002 was found not to be in compliance with 37 CFR 1.497(b)(2) because, while it was executed by Margarete Schneider, acting as the legal representative of deceased sole inventor Heinrich Schneider (and includes citizenship, residence and post office address information for Margarete Schneider), it does not include the citizenship, residence and mailing address of Heinrich Schneider. Counsel has now submitted a new declaration signed by the legal representative and providing the required information. As such, it would now be appropriate to grant the requested relief.

DECISION

The request for status under 37 CFR 1.42 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **29 September 2003**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 04 2001

James P. Demers
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154-0053

In re Application of	:	
Hiroto MIYAKE, et al.	:	
Application No.: 09/958,405	:	DECISION ON
PCT No.: PCT/JP01/00459	:	PETITION
Int. Filing Date: 24 January 2001	:	UNDER 37 CFR 1.137(b)
Priority Date: 25 January 2000	:	
Attorney Docket No.: 1776-4068	:	
For: A PHOTOCURABLE RESIN	:	
COMPOSITION	:	

The petition to revive under 37 CFR 1.137(b) filed 09 October 2001 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. 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" meets the requirements under 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the application papers reveals that an oath or declaration of the inventors has not been filed.

Applicants' claim for priority is acknowledged. The application has an international filing date of **24 January 2001** under 35 U.S.C. 363.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing including the issuance of a Notification of Missing Requirements under 35 U.S.C. 371(c) and 37 CFR 1.494 (Form PCT/DO/ EO/905) to inform applicants that a

declaration of the inventors must be filed along with the surcharge for filing an oath or declaration after 20 months in order for avoid abandonment of the application as to the national stage in the United States.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/BM:hn

Tel: (703) 308-6508

UNITED STATES 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 17 2004

Paper No. 8

In re Application of
Klas Kriström *et al*
Application No. 09/958,418
Filed: October 9, 2001
Attorney Docket No. SUNDS-125

: DECISION ON PETITION

This is a decision on the petition filed on April 26, 2004 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated August 27, 2003. The petition is being considered pursuant to 37 CFR 1.181, and no fee is required for the petition.

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. Petitioners have supported this allegation by furnishing a copy of the reply and a copy of a post card receipt showing that the reply was in fact filed on November 26, 2003, a date within the time set for replying to the Office letter dated August 27, 2003. Based upon this evidence, it is clear that the application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for entry of the reply filed on November 26, 2003, and will thereafter be forwarded to the examiner for appropriate action.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Lerner David Littenberg
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

rvk

Mailed: 1-3-06 Paper No. _____

In re application of:
Turid Ellingsen et al
Serial No.: 09/958,431
Filed: October 09, 2001
For: PROCESS FOR THE PREPARATION OF MONODISPERSE POLYMER PARTICLES

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181(a), filed July 26, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of June 27, 2005, for failure to timely file a proper response to the Office letter dated December 15, 2004 be withdrawn. The petitioner asserts that applicants timely filed a proper response on June 15, 2005.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee).

A review of the instant application file indicates that the error status of the instant application was administratively corrected via the Notice of Rescinded Abandonment dated October 19, 2005. Subsequently, a non-Final rejection was mailed out on October 20, 2005. Therefore, no further action is required.

The Petition is **DISMISSED.**

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

WENDEROTH, LIND & PONACK, L.L.P
2033 K STREET,N.W.
SUITE 800
WASHINGTON, DC 20006-1021

UNITED STATES 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 DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA CA 95050

COPY MAILED

APR 2 0 2006

OFFICE OF PETITIONS

In re Application of	:	
Richard Heylen et al	:	
Application No. 09/958,445	:	ON PETITION
Filed: October 5, 2001	:	
Attorney Docket No. 194	:	

This is a decision on the petition under 37 CFR 1.182, filed January 19, 2006, requesting that a previously filed terminal disclaimer be withdrawn.

Petitioner asserts that the terminal disclaimer filed on July 25, 2005, is no longer required. As the examiner has concurred, the requested relief can be favorably considered.

Accordingly, the petition is granted.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

This matter is being referred to Technology Center Art Unit 2132 for correction of PALM and file records consistent with this decision.

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

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

cc:
MORRISON & FOERSTER LLP
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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

COPY MAILED

DEC 15 2004

OFFICE OF PETITIONS

In re Application of :
Hiroshi Okamoto :
Application No. 09/958,447 :
Filed: October 5, 2001 :
Attorney Docket No. TOYAM78.001APC

ON PETITION

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

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 29, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter will be forwarded to Technology Center AU 1641 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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

DEC 2 3 2004

OFFICE OF PETITIONS

In re Application of :
Hiroshi Okamoto :
Application No. 09/958,447 :
Filed: October 5, 2001 :
Attorney Docket No. TOYAM78.001APC :

NOTICE

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

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

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

This application no longer qualifies for small entity status. Accordingly, all future fees must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

Karen Creasy

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

16 JUN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard R Michaud
McCormick Paulding & Huber
City Place II 185 Asylum Street
Hartford CT 06103-3402

In re Application of	:	
MONTANO et al.	:	
Application No.: 09/958,449	:	DECISION
PCT No.: PCT/SE00/00552	:	
Int. Filing Date: 21 March 2000	:	
Priority Date: 07 April 1999	:	
Attorney Docket No.: 6485-21WOUS	:	
For: A SEPARATION DEVICE	:	

This decision is in response to applicants' "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" filed in the United States Patent and Trademark Office (USPTO) on 02 April 2004, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 21 March 2000, applicants filed international application PCT/SE00/00552, which claimed a priority date of 07 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 September 2000, prior to 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 09 October 2001 (07 October 2001 being a Sunday and 08 October 2001 being a Federal holiday).

On 05 October 2001, applicants filed, *inter alia*, 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 02 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The Notification set a two-month extendable period for reply.

On 27 February 2004, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT

(Form PCT/DO/EO/909) indicating that the application was abandoned for failure to reply to the NOTIFICATION OF MISSING REQUIREMENTS mailed 02 November 2001.

On 02 April 2004, applicants filed the instant "PETITION TO WITHDRAW HOLDING OF ABANDONMENT", which has been treated as a petition under 37 CFR 1.181. The petition was accompanied by, *inter alia*, a date-stamped postcard receipt and a copy of a declaration of inventors.

DISCUSSION

Applicants have provided sufficient evidence to establish that on 29 January 2002 (the response includes a certificate of mailing stating that the response was mailed 29 November 2001, however, as indicated by the date-stamped postcard receipt, the response was not received until 29 January 2002) applicants filed a declaration of inventors. 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 29 January 2002 and which itemizes the declaration and identifies the above-captioned docket number and application number. Further, practitioner states that the copy of the declaration filed 02 April 2004 is a copy of the declaration originally filed 29 January 2002. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 02 April 2004 may properly be accepted as originally received in the USPTO on 29 January 2002. The NOTIFICATION OF ABANDONMENT mailed 27 February 2004 is hereby vacated.

The surcharge under 37 CFR 1.492(e) has been paid.

The international application lists Klaus Stroucken as an applicant/inventor while the declaration of inventors filed 29 January 2002 lists Klaus Hans Dieter Stroucken as an applicant. This difference in names is presumed not to be a name change or a change of inventors or a typographical error. The name Klaus Stroucken is presumed to be a shortened version of the name Klaus Hans Dieter Stroucken and these names are construed to designate the same person. (If this interpretation is incorrect, applicants are required to provide a written notification of this fact to the Office of PCT Legal Administration *immediately*.) The declaration filed 29 January 2002 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED** for the reasons set forth above.

The NOTIFICATION OF ABANDONMENT mailed 27 February 2004 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office

of PCT Operations to continue national stage processing of the application including the accordation of a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **29 January 2002**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON
SUITE 3300
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

COPY MAILED

FEB 07 2007

OFFICE OF PETITIONS

In re Patent No. 7,011,968 :
Issue Date: March 14, 2006 :
Application No. 09/958,451 : ON PETITION
Filed: March 28, 2002 :
Attorney Docket No. 10848-015001 :

This is a decision on the petition filed August 18, 2006, which is being treated as a petition under 37 CFR 3.81(b)[1] to correct assignee's name on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **granted.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3210. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] See Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

MURAMATSU & ASSOCIATES
114 PACIFICA, SUITE 310
IRVINE, CA 92618

COPY MAILED

FEB 06 2008

OFFICE OF PETITIONS

In re Application of
Yoshikazu Nakayama et al
Application No. 09/958,454
Filed: December 26, 2001
Attorney Docket No. ADVA218.001AUS

DECISION ON PETITION

This is a decision on the petition requesting withdrawal of the holding of abandonment under 37 CFR 1.181 (no fee), and a petition under 37 CFR 1.137(b) to revive the above-identified application filed July 2, 2007.

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

This application was held abandoned for failure to pay the issue fee within the statutory period of three (3) months from the mailing date of the May 16, 2002 Notice of Allowance.

Petitioner asserts that the Applicants did timely pay the issue fee within the statutory period. However, the transmittal letter dated August 16, 2002, certificate of mailing, states "A check in the amount of $1295 to cover the issue fee is enclosed." The Office record does not show any evidence that the payment of the issue fee was timely filed. The Office record show the issue fee was paid on September 30, 2002, which is after the three (3) months statutory period for reply. Therefore, the petition requesting withdrawal of the holding of abandonment cannot be granted.

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

The above-identified application became abandoned for failure to submit the Issue fee in a timely manner in reply to the Notice of Allowance mailed May 16, 2002, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on August 17, 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 payment of the Issue fee, which was previously paid on September 30, 2002; (2) the petition fee; and (3) the required statement of unintentional delay

have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Publishing Division for further processing.

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 Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petition Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 03 2002

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

Horst M. Kasper
13 Forest Drive
Warren, NJ 07059

#3

In re Application of WELCKER, Friedrich Application No.: 09/958,456 PCT Application No.: PCT/EP00/01692 International Filing Date: 29 February 2000 Priority Date: 09 March 1999 Attorney Docket No.: BEC207 For: SAFETY DEVICE FOR SYSTEM USING GAS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office on 08 August 2001 is **GRANTED**.

BACKGROUND

On 29 February 2000, applicant filed an international application, No. PCT/EP00/01692. A copy of the application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 September 2000.

The deadline for entry into the United States National Stage was twenty months from the priority date, that is 09 November 2000. The application became abandoned on 10 November 2000, after applicant failed to timely pay the basic national fee.

On 05 October 2001, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, a petition to revive, the requisite petition fee and the basic national fee.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant states "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as application was filed on 29 February 2000. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

The Office cannot accept the declaration at this time. It is partially in German and the requirements of 37 CFR 1.69 have not been met. A USPTO approved German Language Declaration (Form PTO/SB/103) is enclosed. Alternatively, if applicable, applicant may certify that the English language portions are accurate translations of the German language portions immediately preceding the English.

A proper response, i.e. an oath or declaration in compliance with 37 CFR 1.497(a)-(b), or perfection of the requirements under 37 CFR 1.69 for acceptance of the previously submitted foreign language declaration, must be filed within TWO (2) MONTHS from the mail date of this decision. This time period is extendable under 37 CFR 1.136(a). Failure to timely file the proper response will result in **ABANDONMENT OF** this application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Erin M. Pender
Attorney Advisor
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

Enclosure: German Language Declaration (Form PTO/SB/103)

14 APR 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

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

Lawrence J. McClure
Hogan & Hartson
500 South Grand Avenue, Suite 1900
Los Angeles, California 90071

In re Application of	:	
KOBAYASHI et al.	:	
Application No.: 09/958,472	:	DECISION ON PETITION
PCT No.: PCT/JP01/00943	:	UNDER 37 CFR 1.181
Int. Filing Date: 09 February 2001	:	
Priority Date: 10 February 2000	:	
Attorney Docket No.: 81839.0103	:	
For: SILICON BOAT HAVING PROTECTIVE FILM, METHOD FOR PRODUCING THE SAME AND SILICON WAFER HEAT-TREATED BY USING THE SAME	:	

This is a decision on applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)" which is being treated as a Petition to Withdraw a Holding of Abandonment under 37 CFR 1.181, filed in the Patent and Trademark Office (PTO) on 21 January 2003. No petition fee is due.

BACKGROUND

On 09 February 2001, applicants filed international application PCT/JP01/00943 which claimed a priority date of 10 February 2000. No Demand was filed with the International Preliminary Examination Authority. As a result, the deadline for payment of the basic national fee was to expire 20 months from the priority date, or at midnight on 10 October 2001.

On 09 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; a translation of the international application; an executed declaration; and an information disclosure statement.

On 08 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENT UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the current translation was defective because the number of claims in the international application and the number of claims in the translation of the international application were not the same. The notification set a TWO(2) MONTH period for response.

On 21 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 08 November 2001 within the time period set therein.

On 21 January 2003, applicants filed a translation of the international application and the present petition. Applicants state in the present petition, "[s]uch application was unavoidably abandoned as a result of the Applicants' failure to reply to a Notification of Missing Requirements, which was never received." Petitioner's statements will be treated as a petition to withdraw a holding of abandonment under 37 CFR 1.181.

DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 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 record must also be referenced in practitioner's statement). Applicants' have satisfied items (1) and (2).

With regard to item (3) above, applicants have not provided copies of the docket record where the notification mailed 08 November 2001 would have been entered had it been received or referenced such copies in the statement by practitioner. Specifically, applicant must provide a copy of counsel's docket records for 08 January 2002 (ie, the date on which the response was due) showing all applications for which a response was due on that date.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision 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." Extensions of time may be obtained under 37 CFR 1.136(a).

The $110 petition fee filed with the present papers has been refunded to Deposit Account no. 50-1314.

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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#8

29 MAY 2003

Hogan & Hartson
500 South Grand Avenue, Suite 1900
Los Angeles, California 90071

In re Application of	:	
KOBAYASHI et al.	:	
Application No.: 09/958,472	:	DECISION ON PETITION
PCT No.: PCT/JP01/00943	:	UNDER 37 CFR 1.181
Int. Filing Date: 09 February 2001	:	
Priority Date: 10 February 2000	:	
Attorney Docket No.: 81839.0103	:	
For: SILICON BOAT HAVING PROTECTIVE FILM, METHOD FOR PRODUCING THE SAME AND SILICON WAFER HEAT-TREATED BY USING THE SAME	:	

This is a decision on applicants' "RENEWED PETITION UNDER 37 CFR 1.181" filed in the United States Patent and Trademark Office on 19 May 2003, in response to a decision mailed 14 April 2003.

DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 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 record must also be referenced in practitioner's statement). The 14 April 2003 decision indicated that applicants satisfied requirements (1) and (2) above.

As to Item (3), applicants have submitted a copy of the docket records for 08 January 2002 indicating all applications for which a response was due on said date. The above-identified application is not among the patent applications listed on the attached docket record. Therefore, since applicants have satisfied Items (1), (2), and (3) above, the request may be properly granted.

CONCLUSION

For the reasons above, the request is **GRANTED**. The holding of Abandonment is withdrawn.

The application has an international filing date of 09 February 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **21 January 2003**.

This application is being returned to the United States/Designated Elected Office for processing in accordance with this decision.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

21 JUL 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

Hogan and Hartson
1901 S. Grand Avenue
Los Angeles, California 90071

In re Application of	:	
KOBAYASHI et al.	:	
Application No.: 09/958,472	:	
PCT No.: PCT/JP01/00943	:	DECISION
Int. Filing Date: 09 February 2001	:	
Priority Date: 10 February 2000	:	
Attorney Docket No.: 81839.0103	:	
For: SILICON BOAT HAVING PROTECTIVE FILM, METHOD FOR PRODUCING THE SAME AND SILICON WAFER HEAT-TREATED BY USING THE SAME.	:	

This is a decision on applicants' unsigned facsimile communication dated 19 June 2003, which is being treated as a request for corrected filing receipt.

BACKGROUND

On 09 October 2001, applicants filed a request to enter into the national stage under 35 U.S.C. 371 along with the appropriate basic national filing fee; translation of the international application; and an executed declaration.

On 08 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirement under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the translation, filed 09 October 2001, was defective because the number of claims in the international application and the number of claims in the translation of the international application were not the same.

On 21 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 08 November 2001 within the time period set therein.

On 21 January 2003, applicants filed a translation of the international application and a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The holding of abandonment was withdrawn in a "Decision on Petition" dated 29 May 2003.

On 05 June 2003, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 21 January 2003. Subsequently, an Official Filing Receipt was issued indicating a "FILING DATE" of 21 January 2003.

On 19 June 2003, applicants filed a request for a corrected filing receipt.

DISCUSSION

Applicants request that the Filing Receipt be corrected to indicate a filing date of 09 October 2001, rather than 21 January 2003. The actual filing date of the present application is the international filing date, i.e., 09 February 2001. (See 35 U.S.C. 363) The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. (See MPEP §1895.01) A review of the application file reveals that the translation of the international application was filed with the United States Patent and Trademark Office on 21 January 2003, the date which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. Therefore, the correction of the "FILING DATE" on the filing receipt to indicate a date of 09 October 2001 is not proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on 21 January 2003. (Note MPEP section 1893.03(b)).

CONCLUSION

Applicants' request for the issuance of a corrected filing receipt indicating a "Filing Date" of 09 October 2001, is **DISMISSED** without prejudice.

The application will be returned to Art Unit 2812 for further prosecution.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

18 AUG 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

Hogan and Hartson
500 South Grand Avenue
Suite 1900
Los Angeles, California 90071-2611

In re Application of	:	
KOBAYASHI et al.	:	
Application No.: 09/958,472	:	
PCT No.: PCT/JP01/00943	:	DECISION
Int. Filing Date: 09 February 2001	:	
Priority Date: 10 February 2000	:	
Attorney Docket No.: 81839.0103	:	
For: SILICON BOAT HAVING PROTECTIVE FILM, METHOD FOR PRODUCING THE SAME AND SILICON WAFER HEAT-TREATED BY USING THE SAME.	:	

This is a decision on applicants' unsigned facsimile communication dated 19 June 2003, which is being treated as a request for corrected filing receipt.

BACKGROUND

On 09 October 2001, applicants filed a request to enter into the national stage under 35 U.S.C. 371 along with the appropriate basic national filing fee; translation of the international application; and an executed declaration.

On 08 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirement under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the translation, filed 09 October 2001, was defective because the number of claims in the international application and the number of claims in the translation of the international application were not the same.

On 21 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 08 November 2001 within the time period set therein.

On 21 January 2003, applicants filed a translation of the international application and a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The holding of abandonment was withdrawn in a "Decision on Petition" dated 29 May 2003.

On 05 June 2003, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 21 January 2003. Subsequently, an Official Filing Receipt was issued

indicating a "FILING DATE" of 21 January 2003.

On 19 June 2003, applicants filed a request for a corrected filing receipt.

DISCUSSION

Applicants request that the Filing Receipt be corrected to indicate a filing date of 09 October 2001, rather than 21 January 2003. The actual filing date of the present application is the international filing date, i.e., 09 February 2001. (See 35 U.S.C. 363) The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. (See MPEP §1895.01) A review of the application file reveals that the translation of the international application was filed with the United States Patent and Trademark Office on 21 January 2003, the date which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. Therefore, the correction of the "FILING DATE" on the filing receipt to indicate a date of 09 October 2001 is not proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on 21 January 2003. (Note MPEP section 1893.03(b)).

CONCLUSION

Applicants' request for the issuance of a corrected filing receipt indicating a "Filing Date" of 09 October 2001, is **DISMISSED** without prejudice.

The application will be returned to Art Unit 2812 for further prosecution.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Wenderoth, Lind & Ponack, L.L.P.
2033 K Street, N. W.
Suite 800
Washington, DC 20006-1021

COPY MAILED
AUG 2 6 2004
OFFICE OF PETITIONS

In re Patent No. 6,755,075 :
Issue Date: June 29, 2004 :
Application No. 09/958,477 : ON PETITION
Filed: November 21, 2001 :
Attorney Docket No. 2001-1526A :

This is a decision on the petition filed July 26, 2004, to waive the rules and accept the correction of the assignee on the front page of the above-identified patent.

The petition is granted.

In view of the granting of the instant petition, petitioner may request a Certificate of Correction pursuant to the provisions of 37 CFR 1.323 and submit the required fee of $100.

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

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 306-3475. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

17 SEP 2003

Robert F. Clark
Osram Sylvania
100 Endicoff Street
Danver, MA 01923

RECEIVED
SEP 19 2003
Patent Department

In re Application of :
SEIBOLD et al. :
Application No.: 09/958,486 :
PCT No.: PCT/DE01/00043 :
Int. Filing Date: 09 January 2001 :
Priority Date: 15 February 2000 :
Attorney Docket No.: 00P5509 :
For: PROCESS FOR PRODUCING A FLAT GAS DISCHARGE LAMP :

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on applicants' "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" which is being treated as a Petition to Withdraw a Holding of Abandonment under 37 CFR 1.181, filed in the Patent and Trademark Office (PTO) on 19 February 2003. The $110 petition fee filed with the present papers will be refunded to Deposit Account no. 25-0120.

BACKGROUND

On 09 January 2001, applicants filed international application PCT/DE01/00043 which claimed a priority date of 15 February 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 August 2001. No Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 20 months from the priority date, or at midnight on 15 October 2001.

On 11 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; a translation of the international application; and a preliminary amendment.

On 15 November 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 an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. The notification set a two-month period to respond.

On 15 January 2003, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 15 November 2001 within the time period set therein.

On 19 February 2003, applicants filed "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)." Applicants state in the present petition, "[t]he applicants did not receive the Notification of Missing Requirements which was mailed 11/15/01." Petitioner's statements will be treated as a petition to withdraw a holding of abandonment under 37 CFR 1.181.

DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 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 record must also be referenced in practitioner's statement). Applicants have satisfied items (1).

As to item (2), applicants have not provided a statement attesting that a search of the file jacket and docket records indicates that the papers were not received.

With regard to item (3) above, applicants have not provided copy of the docket record where the notification mailed 15 November 2001 would have been entered had it been received or referenced such copies in the statement by practitioner. Specifically, applicants must provide a copy of counsel's docket records for 08 January 2002 (ie, the date on which the response was due) showing all applications for which a response was due on that date.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision 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." Extensions of time may be obtained under 37 CFR 1.136(a).

The $110 petition fee filed with the present papers will be refunded to Deposit Account no. 25-0120.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

25 NOV 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#7

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

Robert F. Clark
Osram Sylvania
100 Endicott Street
Danvers, MA 01923

In re Application of	:	
SEIBOLD et al.	:	
Application No. 09/958,486	:	
PCT No.: PCT/DE01/00043	:	
Int. Filing Date: 09 January 2001	:	DECISION
Priority Date: 15 February 2000	:	
Atty. Docket No.: 00P5509	:	
For: Process For Producing A	:	
Flat Gas Discharge Lamp	:	

This is in response to the "Renewed Petition Under 37 CFR § 1.181" filed on 30 September 2003.

DISCUSSION

In a decision mailed on 17 September 2003, the previous petition filed on 19 February 2003 was dismissed without prejudice because petitioner had not provided a statement attesting that a search of the file jacket and docket records indicates that the papers at issue were not received, and because petitioner had not provided relevant docket records. The instant renewed petition is accompanied by appropriate docket records. The renewed petition includes a statement that "searches of the file jacket of the instant application and the docketing records where the Notification would have been recorded indicate that the Notification was never received." Therefore, it would now be appropriate to grant the requested relief. Accordingly, the Notification of Abandonment mailed on 15 January 2003 is hereby **VACATED**.

DECISION

The petition is **GRANTED**.

This application is being returned to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371(c)(1), (2) and (4) is **19 February 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

COPY MAILED

FEB 18 2005

OFFICE OF PETITIONS

In re Application of	:	
Johann-Christian Zechel, et. al.	:	
Application No. 09/958,491	:	ON PETITION
Filed: June 18, 2002	:	
Attorney Docket No. ABB10010P0550US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 20, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment under 37 CFR 1.121 mailed February 2, 2004.

In response, petitioner submitted with the instant petition $1,500 for the petition to revive fee, and an amendment.

The petition is **GRANTED**.

The application file is being referred to Technology Center Art Unit 1624, for review of the amendment filed with the instant petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions
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

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

COPY MAILED

AUG 24 2005

OFFICE OF PETITIONS

In re Patent No. 6,757,454 :
Issue Date: June 29, 2004 :
Application No. 09/958,496 : ON PETITION
Filed: January 29, 2002 :
Attorney Docket No. P/3241-19 :

This is a decision on the petition filed on February 3, 2005, to waive the rules and accept the correction of the assignee on the front page of the above-identified patent.

The petition is **DISMISSED**.

Petitioner states that the second assignee "NTT Advanced Technology Corporation." printed on the patent is incorrect in that the correct second assignee is "NTT Electronics Corporation". However, the spelling of the assignee's name on the patent agrees with the Office PALM computer database assignment records at the time of the issuance of the patent. Petitioner submitted a new recordation form to correct the assignee's name on November 1, 2004. However this correction was not recorded until **after** the patent issued. Therefore, issuance of a certificate of correction herein is not in order.

As issuance of a Certificate of Correction is not appropriate, the $100.00 fee paid for issuance of the Certificate of Correction will be refunded to petitioner's deposit account, No. 15-0700, in accordance with the petition filed on February 3, 2005.

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

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

By facsimile: (571) 273-8300

By delivery service: U.S. Patent and Trademark Office

(FedEx, UPS, DHL, etc.)

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

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

19 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

In re Application of	:	
ENGBERT, Wilmink et al.	:: :	
U.S. Application No.: 09/958,510	:	DECISION ON
PCT No.: PCT/NL00/00223	:	
International Filing Date: 05 April 2000	:	PETITION
Priority Date: 06 April 1999	:	
Attorney's Docket No.: 47161-00028USPT	:	UNDER 37 CFR 1.181
For: ELECTROACOUSTIC	:	
TRANSDUCER ... IN SUCH	:	
TRANSDUCER	:	

Applicants filed "Request For Corrected Official Filing Receipt," on 03 November 2004 and a second request on 15 September 2005. The Request has been treated as a petition under 37 CFR 1.181.

As set forth in MPEP 1893.03(b), the filing date of a national phase of a PCT is the international filing date. The date that appears in the "filing date" field of the filing receipt is the date of completion of the 35 U.S.C. §371 (c) requirements. This is more clearly indicated in the current filing receipt forms. Applicants supplied a declaration of the inventors and completed the 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) requirements on 23 January 2002, as indicated. MPEP 1893.03(b).

For the above reasons, the Petition Under 37 CFR 1.181 is **DISMISSED** without prejudice. Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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

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

COPY MAILED

SEP 1 2 2005

OFFICE OF PETITIONS

In re Application of :
Matsuzawa et al :
Application Number: 09/958,561 :
Patent: 6,844, 163
Attorney Docket Number: 2185-0574P :
Filing Date: October 10, 2001 :
Issue Date: January 18, 2005 : DECISION ON PETITION
Title of Invention: Method For Analyzing :
the Amount of Intraabdominal Adipose
Tissue

This is a decision on the petition to correct the assignee under 37 CFR 1.183 filed on April 7, 2005. The petition is properly treated 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**.

Petitioner has submitted a $400.00 petition fee. The processing fee pursuant to 37 CFR 1.17(l) is $130.00. A petition fee is no longer required. Pursuant to petitioner's request deposit account 02-2448 is being refunded $270.00.

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

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

Charlema R. Grant
Petitions Attorney
Office of Petitions

---

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

MAY 22 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#7

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

AMSTER, ROTHSTEIN & EBENSTEIN
90 Park Avenue
New York, New York 10016

In re Application of
TRACEY, Kevin J. *et al*
U.S. Application No.: 09/958,585
PCT No.: PCT/US00/10002
Int. Filing Date: 13 April 2000
Priority Date: 13 April 1999
Attorney Docket No.: 50425/129
For: PREVENTION OF BRAIN DAMAGE IN STROKE

DECISION

This is a decision on the petition filed on 27 March 2002, requesting that the shortened statutory period for reply set forth in the Office communication mailed on 09 November 2001 be reset to run from the date on which the Office communication was actually received at the correspondence address of record.

The petition is **DISMISSED** without prejudice.

Petitioners provided a statement that the Office communication in question was received at the correspondence address of record on 28 January 2002. A substantial portion of the set reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed. However, the petition was not filed within two weeks of receipt of the Office communication. The petition was filed almost two months after receipt.

Accordingly, the statutory period that was originally set forth in the Office communication mailed on 09 November 2001 is still operative. Consequently, the three-month extension fee of $460.00 included with the instant response is appropriate.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 April 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **27 March 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

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

19 AUG 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

Michael I. Stewart
SIM & McBURNEY
6th Floor, 330 University Avenue
Toronto, Ontario
Canada M5G 1R7

In re Application of :
PAI, Emil F. *et al* :
U.S. Application No.: 09/958,605 :
PCT No.: PCT/CA00/00318 :
Int. Filing Date: 05 April 2000 :
Priority Date: 13 April 1999 : **DECISION**
Attorney Docket No.: 1038-1209 MIS :
For: Fab-EPITOPE COMPLEX FROM THE :
HIV-1 CROSS-NEUTRALIZING :
MONOCLONAL ANTIBODY 2F5 :

This is a decision in response to the "Petition to Revive Abandoned Application Under 37 CFR 1.137(a)" and other papers filed 24 May 2004.

BACKGROUND

On 24 March 2004, a decision was mailed indicating that the above-captioned application was abandoned for failing to provide a timely response to 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) mailed 15 November 2001.

On 24 May 2004, applicants filed the instant petition which was accompanied by, *inter alia*, a renewed petition under 37 CFR 1.47(a); a "Declaration" of Michael I. Stewart ("Decl."); and authorization to charge the petition fee to Deposit Account No. 19-2253.

DISCUSSION

A petition to revive an abandoned application pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4) the petition fee.

Applicants request that the application be revived pursuant to 37 CFR 1.137(a) because the abandonment was unavoidable. The $110.00 petition fee has been charged to Deposit Account No. 19-2253 as authorized. A terminal disclaimer is not

required.

Applicants argue that the abandonment in the above-captioned application was unavoidable because "[a] Notification of Acceptance of Application was received dated June 26, 2002, indicating to me that the application was in order. A petition under 37 CFR 1.47(a) had been submitted June 20, 2002. The receipt of the Notification gave the impression that the Petition had been accepted although no Decision on Petition was received until March 24, 2004." Decl. at ¶ 2.

This argument has been considered and dismissed. The above-captioned application was abandoned by operation of law on 15 June 2004. Any events occurring after that date have no relevance to whether the abandonment was unavoidable. The petitioner must demonstrate how any action of the Office caused applicants to miss the deadline of 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) mailed 15 November 2001. *See* MPEP § 711.03(c).

CONCLUSION

For the reason discussed above, applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice. The application remains **ABANDONED**.

Any renewed petition under 37 CFR 1.137(a) or petition to revive under 37 CFR 1.137(b) 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). Applicants may also wish to consider filing a petition under 37 CFR 1.137(b) requesting that the application be revived under the unintentional standard. The petition under 37 CFR 1.47(a) will not be considered until the application is revived or the holding of abandonment is withdrawn.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

24 MAR 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

Michael I. Stewart
SIM & McBURNEY
6th Floor, 330 University Avenue
Toronto, Ontario
Canada M5G 1R7

In re Application of :
PAI, Emil F. *et al* :
U.S. Application No.: 09/958,605 :
PCT No.: PCT/CA00/00318 :
Int. Filing Date: 05 April 2000 :
Priority Date: 13 April 1999 : **DECISION**
Attorney Docket No.: 1038-1209 MIS :
For: Fab-EPITOPE COMPLEX FROM THE :
HIV-1 CROSS-NEUTRALIZING :
MONOCLONAL ANTIBODY 2F5 :

This is a decision on matters relating to 35 U.S.C. 371.

BACKGROUND

On 15 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) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b), a surcharge fee of $130.00 and a copy of a computer readable sequence listing was required. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 01 May 2002, applicants filed a response to the Notification of Missing Requirements which was accompanied by, *inter alia*, a four-month extension and $1,440.00 extension fee, the $130.00 surcharge fee, a declaration executed by three of the four named inventors and a statement that a petition under 37 CFR 1.47(a) would be forthcoming.

On 20 June 2002, applicants submitted a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, the petition fee of $130.00 and a "Declaration Under 37 CFR 1.471a1" by Reza Yacoob.

On 26 June 2002, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 indicating that the application has a 35 U.S.C. 371 date of 01 May 2002.

On 23 March 2004, after a request by James Thomson of the Office of PCT

Legal Administration, applicants filed via facsimile a copy of the "Declaration Under 37 CFR 1.471a1" and a copy of a "Confidentiality Agreement" signed by Pele Chong.

DISCUSSION

The declaration filed 01 May 2002 was not in compliance with 37 CFR 1.497(a) and (b) since it was not executed by all of the joint inventors. Thus, the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 mailed 26 June 2002, was sent in error, and is hereby **VACATED**.

The response filed 01 May 2002 containing a declaration signed by three of the four named inventors and a statement that the "[t]he applicants will be submitting a petition under 37 C.F.R. 1.47(a) with respect to Pele Chong." However, this statement does not affect the time period to properly reply to the Form PCT/DO/EO/905.

Applicants' petition under 37 CFR 1.47(a) was filed on 20 June 2002, which is after the expiration of any time remaining to respond to the Form PCT/DO/EO/905 mailed 15 November 2001.

CONCLUSION

Since the petition under 37 CFR 1.47(a) filed 20 June 2002 was untimely, the above-captioned application is hereby **ABANDONED**.

If reconsideration on the merits of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants may also wish to revive the above-captioned application under 37 CFR 1.137(a) or (b). The petition under 37 CFR 1.47(a) will not be considered until the application is revived or the holding of abandonment is withdrawn.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

24 MAR 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

Michael I. Stewart
SIM & McBURNEY
6th Floor, 330 University Avenue
Toronto, Ontario
Canada M5G 1R7

In re Application of :
PAI, Emil F. *et al* :
U.S. Application No.: 09/958,605 :
PCT No.: PCT/CA00/00318 :
Int. Filing Date: 05 April 2000 :
Priority Date: 13 April 1999 : **DECISION**
Attorney Docket No.: 1038-1209 MIS :
For: Fab-EPITOPE COMPLEX FROM THE :
HIV-1 CROSS-NEUTRALIZING :
MONOCLONAL ANTIBODY 2F5 :

This is a decision on matters relating to 35 U.S.C. 371.

BACKGROUND

On 15 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) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b), a surcharge fee of $130.00 and a copy of a computer readable sequence listing was required. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 01 May 2002, applicants filed a response to the Notification of Missing Requirements which was accompanied by, *inter alia*, a four-month extension and $1,440.00 extension fee, the $130.00 surcharge fee, a declaration executed by three of the four named inventors and a statement that a petition under 37 CFR 1.47(a) would be forthcoming.

On 20 June 2002, applicants submitted a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, the petition fee of $130.00 and a "Declaration Under 37 CFR 1.471a1" by Reza Yacoob.

On 26 June 2002, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 indicating that the application has a 35 U.S.C. 371 date of 01 May 2002.

On 23 March 2004, after a request by James Thomson of the Office of PCT

Legal Administration, applicants filed via facsimile a copy of the "Declaration Under 37 CFR 1.471a1" and a copy of a "Confidentiality Agreement" signed by Pele Chong.

DISCUSSION

The declaration filed 01 May 2002 was not in compliance with 37 CFR 1.497(a) and (b) since it was not executed by all of the joint inventors. Thus, the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 mailed 26 June 2002, was sent in error, and is hereby **VACATED**.

The response filed 01 May 2002 containing a declaration signed by three of the four named inventors and a statement that the "[t]he applicants will be submitting a petition under 37 C.F.R. 1.47(a) with respect to Pele Chong." However, this statement does not affect the time period to properly reply to the Form PCT/DO/EO/905.

Applicants' petition under 37 CFR 1.47(a) was filed on 20 June 2002, which is after the expiration of any time remaining to respond to the Form PCT/DO/EO/905 mailed 15 November 2001.

CONCLUSION

Since the petition under 37 CFR 1.47(a) filed 20 June 2002 was untimely, the above-captioned application is hereby **ABANDONED**.

If reconsideration on the merits of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants may also wish to revive the above-captioned application under 37 CFR 1.137(a) or (b). The petition under 37 CFR 1.47(a) will not be considered until the application is revived or the holding of abandonment is withdrawn.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

0 9 NOV 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

Michael I. Stewart
SIM & McBURNEY
6th Floor, 330 University Avenue
Toronto, Ontario
Canada M5G 1R7

In re Application of :
PAI, Emil F. *et al* :
U.S. Application No.: 09/958,605 :
PCT No.: PCT/CA00/00358 :
Int. Filing Date: 05 April 2000 :
Priority Date: 13 April 1999 : **DECISION**
Attorney Docket No.: 1038-1209 MIS :
For: Fab-EPITOPE COMPLEX FROM THE :
HIV-1 CROSS-NEUTRALIZING :
MONOCLONAL ANTIBODY 2F5 :

This is a decision in response to the "Petition to Revive Abandoned Application Under 37 CFR 1.137(b)" filed 07 October 2004.

BACKGROUND

On 19 August 2004, a decision dismissing applicants' petition under 37 CFR 1.137(a) was mailed.

On 07 October 2004, applicants filed the instant petition to revive pursuant to 37 CFR 1.137(b).

DISCUSSION

A petition to revive pursuant to 37 CFR 1.137(b) requires: (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Petitioners submitted the correct petition fee of $1,370.00. Applicants' statement that "the abandonment was unintentional and that the entire delay in filing the required reply from the due date for the reply until the filing of this Petition was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Therefore, items (2), (3) and (4) of 37 CFR 1.137(b) are satisfied.

With regards to item (1), the proper reply in the above-captioned application is to satisfy 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) mailed 15 November 2001 which requires either a declaration in compliance with 37 CFR 1.497(a) and (b), or a grantable petition under 37 CFR 1.47(a). In this case, applicant submitted a petition under 37 CFR 1.47(a) on 20 June 2002.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application or cannot be located; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the nonsigning joint inventor.

The petition fee of $130.00 was previously submitted on 20 June 2002. The last known address of Pele Chong is listed on the declaration as:

32 Estoril Street
Richmond Hill, Ontario
Canada L4C 0B6

Thus, items (1) and (3) of 37 CFR 1.47(a) are complete.

The 37 CFR 1.47(a) applicant submitted a declaration on 01 May 2002 signed by three of the four listed co-inventors Emil F. Pai, Michel H. Klein and Arthur Pedyczak on behalf of joint inventor Pele Chong. The nonsigning inventor's name, residence, post office address and citizenship are typed on this declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) of 37 CFR 1.47(a) is satisfied.

However, petitioners failed to satisfy item (2) of 37 CFR 1.47(a). Petitioners submitted a declaration by Reza Yacoob ('Decl.") of the Patents Department of Aventis Pasteur Limited on 20 June 2002 explaining her efforts to obtain the signature of the nonsigning inventor, Mr. Chong. Ms. Yacoob claims to have personal knowledge of the facts in her declaration.

Ms. Yacoob states that "[o]n February 27, 2002, I arranged for a complete copy of the specification for this application including drawings to be mailed to Pele Chong at his last known work address . . . along with a Declaration and Power of Attorney document, with a request that he execute and return the paper. The requested executed Declaration and Power of Attorney had not been received by Pele Chong." Decl. at ¶ 2. Ms. Yacoob also asserts that "[t]he invention . . . was made during the period of time that Pele Chong was employed by Aventis Pasteur Limited." Id. at ¶ 4.

The 37 CFR 1.47(a) applicant included a copy of a "Confidentiality Agreement" between the nonsigning co-inventor and Connaught Laboratories Limited signed by Mr. Chong with the instant petition.

Section 409.03(d) of the MPEP discusses the proof required to show that an inventor cannot be reached and 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, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** The steps taken to locate the whereabouts of the nonsigning inventor should be included [in a] statement of facts. It is important that the statement contain facts as opposed to conclusions. (Emphasis added)

Petitioners must provide the requisite documentary evidence such as copies of the letters sent to Mr. Chong along with the mailing documents. There is also no evidence that the 37 CFR 1.47(a) applicant has attempted to locate Mr. Chong using the telephone or internet. An attempt to contact Mr. Chong should be made by petitioners and the documentary evidence should be made of record. It is also noted that Ms. Yacoob states in her declaration that "a complete copy of the specification for this application, including drawings" were mailed to the nonsigning co-inventor at his last known address which was listed as:

United Biomedical Inc.
25 Davids Drive
Hauppauge, New York 11788

Section 409.03(e) of the MPEP discusses the last known address of a nonsigning inventor and states, in part:

> That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

The 37 CFR 1.47(a) applicant must explain why the address of a company was used to send the above-captioned application to the nonsigning co-inventor instead of his residence which is listed on the declaration filed 01 May 2002.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Applicants petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice. Thus, item (1) of 37 CFR 1.137(b) is also not satisfied.

CONCLUSION

For the reason discussed above, applicants' petition for revival pursuant to 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

14 FEB 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

Michael I. Stewart
SIM & McBURNEY
6th Floor, 330 University Avenue
Toronto, Ontario
Canada M5G 1R7

In re Application of	:	
PAI, Emil F. *et al*	:	
U.S. Application No.: 09/958,605	:	
PCT No.: PCT/CA00/00358	:	
Int. Filing Date: 05 April 2000	:	
Priority Date: 13 April 1999	:	**DECISION**
Attorney Docket No.: 1038-1209 MIS	:	
For: Fab-EPITOPE COMPLEX FROM THE	:	
HIV-1 CROSS-NEUTRALIZING	:	
MONOCLONAL ANTIBODY 2F5	:	

This decision in response to the papers filed via facsimile on 14 February 2005.

BACKGROUND

On 09 November 2004, a decision dismissing applicants' petition under 37 CFR 1.137(b) was mailed. Applicants failed to satisfy item (1) of 37 CFR 1.137(b) because a grantable petition under 37 CFR 1.47(a) was not provided. Applicants were given two months to respond with extensions of time available.

On 09 February 2005, applicants filed via facsimile a response. However, the electronic transmission was not completed as only seven pages were received.

On 14 February 2005, after a telephone call from the undersigned, applicants resubmitted the response originally filed 09 February 2005 via facsimile. All ten pages were received.

DISCUSSION

Facsimile Response Not Completely Received

The response filed 09 February 2005 filed via facsimile was not transmitted successfully. Only seven of the ten pages were received. The "RX Report" Result was listed as "NG" and the number of pages received was also listed as seven pages. This failed transmission resulted in the USPTO receiving only a one-page declaration which was not in compliance with 37 CFR 1.497.

The papers submitted via facsimile on 14 February 2005 were all received.

Accordingly, a two-month extension fee of $450.00 has been charged to Deposit Account No. 19-2253 as authorized.

Item (1) of 37 CFR 1.137(b)

Applicants failed to satisfy item (1) of 37 CFR 1.137(b) in the prior petition because applicants did not provide sufficient evidence for a grantable petition under 37 CFR 1.47. In the instant response, applicants located the nonsigning joint inventor and submitted an executed declaration. A review of the declaration filed 14 February 2004 shows that it is in compliance with 37 CFR 1.497(a) and (b). Applicants had previously submitted a declaration signed by the three other joint inventors on 01 May 2002. This satisfies item (1) of 37 CFR 1.137(b).

All requirements of 37 CFR 1.137(b) are satisfied.

CONCLUSION

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

Since the nonsigning joint inventor has executed a declaration, applicants' petition under 37 CFR 1.47(a) is **MOOT**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 05 April 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 14 February 2005.

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.: (571) 272-3302

04 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KNOBBE, MARTENS, OLSON & BEAR
620 Newport Center Drive, Sixteenth Floor
Newport Beach, CA 92660

In re Application of	:	
NAJI, Basil, Taha, et al.	:	
U.S. Application No.: 09/958,614	:	DECISION ON PETITION
PCT No.: PCT/AU00/00301	:	
International Filing Date: 10 April 2000	:	
Priority Date: 09 April 1999	:	
Attorney's Docket No.: BALDS2.019APC	:	
For: CONCRETE FORMULATION	:	

This decision is issued in response to the "Petition To Correct Inventorship Under 37 CFR 1.497(d)" filed 02 July 2002. No petition fee is required.

BACKGROUND

On 10 April 2000, applicants filed international application PCT/AU00/00301 which claimed a priority date of 09 April 1999 and which designated the United States. On 19 October 2000, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 18 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., 09 October 2001.

On 09 October 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 31 December 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 02 July 2002, applicants filed the "Petition To Correct Inventorship Under 37 CFR 1.497(d)" considered herein, with accompanying materials including an executed declaration, the required surcharge, and a fee for a three month extension of time (based on this extension and the 37 CFR 1.8 certification contained on the filed transmittal letter, the 02 July 2002 filing is considered a timely response to the Notification Of Missing Requirements).

DISCUSSION

The inventors identified on this international application are Basil Taha NAJI, Ihor HINCZAK, Valentin IOWA, and David Malcolm STITT. The declaration filed by applicants on 02 July 2002 identifies only three of these inventors, omitting Valentin IOWA.

Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d).

37 CFR 1.497(d) states:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:
>
> > (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
> >
> > (2) The processing fee set forth in § 1.17(I); and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

Applicants' 02 July 2002 submission includes all the requirements for a grantable request under 37 CFR 1.497(d). Regarding item (1), applicants have submitted a statement from the removed inventor, Valentin IOWA, stating that the error occurred without deceptive intent. Regarding item (2), applicants have authorized a charge to Deposit Account 11-1410 for the required processing fee. Regarding item (3), applicants have submitted a statement of consent by the assignee, accompanied by a copy of the assignment.

The inventorship is therefore corrected so as to remove Valentin IOWA. Based on this correction, the declaration filed on 02 July 2002 is acceptable under 37 CFR 1.497.

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**.

The inventorship is corrected so as to remove Valentin IOWA. The remaining inventors are Basil Taha NAJI, Ihor HINCZAK, and David Malcolm STITT.

Based on the correction in inventorship, the declaration filed on 02 July 2002 is acceptable under 37 CFR 1.497(d).

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is **02 July 2002**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/RC:rmr

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 01/25/10

TO SPE OF : ART UNIT 1644

SUBJECT : Request for Certificate of Correction for Appl. No.: 09958617 Patent No.: 6995018

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (C of C)
Randolph Square 9D40-D
Palm Location 7580

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

Lamonte Newsome
Certificates of Correction Branch
703-756-1574

Thank You For Your Assistance

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

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

Comments: _____

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER
SPE 1644

UNITED STATES PATENT AND TRADEMARK OFFICE

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

29 AUG 2003

GlaxoSmithKline
Corporate Intellectual Property-UW2220
PO Box 1539
King of Prussia, PA 19406-0939

In re Application of ERICKSON-MILLER, Connie L. Application No.: 09/958,620 PCT No.: PCT/US00/10284 Int. Filing Date: 14 April 2000 Priority Date: 14 April 1999 Attorney Docket No.: P50911 For: ERYTHROPOIETIN RECEPTOR ANTIBODIES	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to "Petition For Withdrawal of Abandonment," submitted to the United States Patent and Trademark Office on 06 February 2003.

BACKGROUND

On 08 November 1998, applicant filed international application PCT/US00/10284. On 06 November 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 15 October 2001 (14 October 2001).

On 12 October 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an executed declaration.

On 23 November 2001, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that a sequence listing in computer readable format was required.

On 15 January 2003, USPTO mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the above-identified application was abandoned for failure to respond to the Notification of Missing Requirements mailed 23 November 2001.

On 06 February 2003, applicants submitted the instant 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) has been satisfied.

As to (2), practitioner does not state that a search of docket records indicates that the Office action was not received.

As to (3), practitioner must provide a copy of the docket record where the nonrecieved Office communication would have been entered had it been received and docketed and reference the docket record in the 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." MPEP §711.03(c) para. II.

In the alternative, applicant argues that an executed declaration was submitted on 12 October 2001. The application went abandoned for failure to furnish a sequence listing in computer readable format, not for lack of an executed oath or declaration. Further, the postcard receipt does not list either a diskette or a computer readable format.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Application remains **ABANDONED**.

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

24 FEB 2004

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GlaxoSmithKline
Corporate Intellectual Property-UW2220
PO Box 1539
King of Prussia, PA 19406-0939

In re Application of ERICKSON-MILLER, Connie L. Application No.: 09/958,620 PCT No.: PCT/US00/10284 Int. Filing Date: 14 April 2000 Priority Date: 14 April 1999 Attorney Docket No.: P50911 For: ERYTHROPOIETIN RECEPTOR ANTIBODIES	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to "Renewed Petition For Withdrawal of Abandonment Under 37 C.F.R. 1.181," submitted to the United States Patent and Trademark Office on 29 October 2003.

BACKGROUND

On 08 November 1998, applicant filed international application PCT/US00/10284. On 06 November 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 15 October 2001 (14 October 2001).

On 12 October 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an executed declaration.

On 23 November 2001, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that a sequence listing in computer readable format was required.

On 15 January 2003, USPTO mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the above-identified application was abandoned for failure to respond to the Notification of Missing Requirements mailed 23 November 2001.

On 06 February 2003, applicants submitted a petition.

On 29 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicant's petition without prejudice.

On 29 October 2003, applicant submitted 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. Practitioner states that a search of docket records indicates that the Office action was not received and has provided a copy of the docket record where the nonrecieved Office communication would have been entered had it been received and docketed and has referenced the docket record in the practitioner's statement.

The sequence listing has been entered.

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 issuance of a new Notification of Acceptance indicating that the application's 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements were met on 12 October 2001.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

21 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & NEAVE
1251 Avenue of the Americas
50th Floor
New York, NY 10020-1105

In re Application of
ZANGER, Ulrich M. *et al*
U.S. Application No.: 09/958,635
PCT No.: PCT/EP01/01456
Int. Filing Date: 09 February 2001
Priority Date: 09 February 2000
Attorney's Docket No.: VOS-19
For: POLYMORPHISMS IN THE HUMAN CYP2B6 GENE . . .

DECISION TO WITHDRAW HOLDING OF ABANDONMENT

This decision is in response to applicants' "Petition for Withdrawal of Holding of Abandonment" ("Pet") filed 07 January 2003. No fee is required.

BACKGROUND

On 04 December 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 sequence listing, and a declaration in compliance with 37 CFR 1.497(a) and (b) was required. A two-month time period for response was set with extensions of time available.

On 04 February 2002, applicants submitted a response to the Form PCT/DO/EO/905 which included a sequence listing and executed declaration.

On 03 April 2002, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the sequence listing was defective and a substitute must be provided. A one-month time period for response was set.

On 02 May 2002, applicants purportedly filed a document titled "Response to Notice to File Corrected Application Papers" which was accompanied *by, inter* alia, a substitute sequence listing.

On 18 November 2002, a Notice of Abandonment was mailed stating that the above-captioned application was abandoned because applicants failed to timely respond to the Form PCT/DO/EO/916 mailed on 03 April 2002.

On 07 January 2003, applicants filed the instant petition which was accompanied by, *inter alia*, Exhibits A-E.

EK170575415US

DISCUSSION

In the instant petition to withdraw the holding of abandonment, applicants claim that they "filed a response to the 4/3/02 Notice (copy enclosed as Exhibit E) on May 2, 2002, i.e., within the one month period set for responding." Pet. at ¶ 3.

The Office has established a practice of providing a receipt for papers filed in the Office to any applicants 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 Procedure 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 on 02 May 2002. Applicants have not even addressed this issue in the instant petition. Thus, applicants have not provided *prima facie* evidence that a proper reply to the Form PCT/DO/EO/916 was filed.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment 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.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

15 AUG 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

FISH & NEAVE
1251 Avenue of the Americas
50th Floor
New York, NY 10020-1105

In re Application of :
ZANGER, Ulrich M. *et al* :
U.S. Application No.: 09/958,635 :
PCT No.: PCT/EP01/01456 :
Int. Filing Date: 09 February 2001 : **DECISION**
Priority Date: 09 February 2000 :
Attorney's Docket No.: VOS-19 :
For: POLYMORPHISMS IN THE HUMAN :
CYP2B6 GENE . . . :

This decision is in response to applicants' "Request for Reconsideration" filed 18 July 2003 requesting to reconsider the dismissal of applicants' petition for withdrawal of holding of abandonment mailed 12 June 2003. No fee is required.

BACKGROUND

On 12 June 2003, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed because of a failure to provide a true copy of all the originally filed documents. Specifically, applicants failed to include a working copy of the Substitute Computer Readable Form (CFR) of the Biochemical Sequence Listing (computer diskette) mailed 02 May 2002.

On 18 July 2003, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a copy of the originally filed diskette mailed 02 May 2002.

DISCUSSION

In the prior petition, applicants provided *prima facie* evidence that the following documents were received by the USPTO on 02 May 2002:

A Response to a Notification of a Defective Response (in duplicate);
A copy of the Original Notification of a Defective Response;
A Transmittal letter (in duplicate); a Substitute Biochemical Sequence Listing;
A Substitute Computer Readable Form (CFR) of the Biochemical Sequence Listing; Statements in Support of Amendment to Sequence Listing under 37 C.F.R. § 1.825(a) and in Support of Computer Readable Form Submission under 37 C.F.R. § 1.825(a); and
An Express Mail Certification.

However, applicants failed to provide a working copy of the originally filed Substitute Computer Readable Form (CFR) of the Biochemical Sequence Listing (computer diskette). Thus, the petition to withdraw the holding of abandonment was not granted. In the renewed petition, applicants have provided a copy of the missing diskette as originally submitted on 02 May 2002.

Applicants have now satisfied the requirements for a grantable petition.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notice of Abandonment mailed 18 November 2002 is **VACATED**.

The surcharge fee of $130.00 for providing the declaration late pursuant to 37 CFR 1.492(e) has been charged to Deposit Account No. 06-1075 as authorized.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 09 February 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 04 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
PCT Legal Office

Tel.: (703) 308-6457

1 2 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

FISH & NEAVE
1251 Avenue of the Americas
50th Floor
New York, NY 10020-1105

In re Application of	:	
ZANGER, Ulrich M. *et al*	:	
U.S. Application No.: 09/958,635	:	
PCT No.: PCT/EP01/01456	:	
Int. Filing Date: 09 February 2001	:	**DECISION**
Priority Date: 09 February 2000	:	
Attorney's Docket No.: VOS-19	:	
For: POLYMORPHISMS IN THE HUMAN	:	
CYP2B6 GENE . . .	:	

This decision is in response to applicants' "Supplemental Petition for Withdrawal of Holding of Abandonment" filed 21 May 2003.

BACKGROUND

On 21 March 2003, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed due to a lack of proper evidence submitted.

On 21 May 2003, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a date-stamped postcard receipt for documents filed 02 May 2002.

DISCUSSION

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. MPEP § 503.

In this case, applicants have provided a copy of the date-stamped postcard receipt for documents submitted 02 May 2002. The U.S. application number, and name of the applicants are all listed on the postcard receipt. The postcard receipt records that the following documents were received: "A Response to a Notification of a Defective Response (in duplicate); A copy of the Original Notification of a Defective Response; A Transmittal letter (in duplicate); a Substitute Biochemical Sequence Listing; a Substitute Computer Readable Form (CFR) of the Biochemical Sequence Listing; Statements in Support of Amendment to Sequence Listing under 37 C.F.R. § 1.825(a) and in Support of Computer Readable Form Submission under 37 C.F.R. § 1.825(a); and an Express Mail Certification." The receipt is stamped "JC02 Rec'd

PCT/PTO 02 MAY 2002" across its face.

Accordingly, applicants have provided *prima facie* evidence that the above-listed documents were received by the USPTO on 02 May 2002.

However, applicants did not submit a copy of the originally filed Substitute Computer Readable Form (CFR) of the Biochemical Sequence Listing (computer diskette) with the original petition or the instant renewed petition. In both cases, applicants filed a photocopy of the diskette as part of the petition. A working copy of the diskette is required for a grantable petition. Applicants must submit a true copy of all the originally filed documents.

CONCLUSION

For the reason discussed above, applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, applicants must submit a renewed response within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a copy of the computer readable diskette as originally filed on 02 May 2002.

Applicants are advised that the correspondence address has changed. Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

04 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Chimie

Rhone-Poulenc NHS/TSR

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

OSS 9/12/02

EKS 9-17-02

CRS 9-11-02

Response Due 11-4-02

Norman H. Stepno
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria VA 22313-1404

In re Application of VASLIN et al.	:
Application No.: 09/958,673	:
PCT No.: PCT/FR00/00907	:
Int. Filing: 10 April 2000	:
Priority Date: 15 April 1999	: DECISION ON PETITION
Attorney Docket No.: 022701-956	: UNDER 37 CFR 1.47(a)
For: HETEROPOLYSACCHARIDE	:
PRODUCED BY *PSEUDOMONAS SP*	:

This decision is in response to applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 14 June 2002. Applicant also requested a five month extension of time, which is granted. This is in response to applicant's Letter to the U.S. Patent and Trademark Office Petitions Branch filed in the USPTO on 28 June 2002.

BACKGROUND

On 15 November 200, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the 30 month period was required. A two month time period within which to respond was set. Extensions of time were available under 37 CFR 1.136(a).

On 14 June 2002, applicant, in response to the Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Robert Cantiani, on the grounds that the non-signing inventor refused to execute the declaration. Applicants also requested a five month extension of time, which was granted.

On 28 June 2002, applicants filed a "Letter to the U.S. Patent and Trademark Office Petitions Branch" that applicant had provided an acceptable declaration signed by the 37 CFR

1.47(a) applicants on b[illegible] of the non-signing inventor.

DISCUSSION

On 28 June 2002, applicants filed the instant renewed petition under 37 CFR 1.47(a) along with a declaration executed by inventor Robert Cantiani. The renewed petition under 37 CFR 1.47(a) is considered moot as a declaration executed by all the inventors has now been submitted. However, the declaration signed by Mr. Cantiani has an uninitialed change in the address in pencil. Changes must be done in pen and initialed by the inventor.

Although the declaration submitted on 14 June 2002 identifies each inventor and states the citizenship, residency and mailing address of each of the inventors, the declaration contained three identical sheets of page 3. Each page is signed by different inventors. Thus, the declaration is not properly executed. It appears that the attorney pieced together three separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. What is required is one declaration where all inventors have signed or three separate complete declarations. Thus, the requirements of 37 CFR 1.497 have not been met.

CONCLUSION

For the above reasons, the renewed petition under 37 CFR 1.47(a) is considered **MOOT**. However, the declaration as submitted is unacceptable under 37 CFR 1.497.

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.497 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 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.

This application is being forwarded to United States Designated/Elected Office to await receipt of the oath/declaration in compliance with 37 CFR 1.497 as required above.

Leonard E. Smith
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: 703-306-5467
Facsimile: 703-308-6459
CMK/LES:cmk

27 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Norman H. Stepno
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria VA 22313-1404

In re Application of VASLIN et al.	:
Application No.: 09/958,673	:
PCT No.: PCT/FR00/00907	:
Int. Filing: 10 April 2000	:
Priority Date: 15 April 1999	: DECISION ON PETITION
Attorney Docket No.: 022701-956	: UNDER 37 CFR 1.47(a)
For: HETEROPOLYSACCHARIDE	:
PRODUCED BY *PSEUDOMONAS SP*	:

This decision is in response to applicant's submission under 37 CFR 1.497 filed in the United States Patent and Trademark Office (USPTO) on 03 December 2002. Applicant also requested a one month extension of time, which is granted.

BACKGROUND

On 28 June 2002, applicants filed a renewed petition under 37 CFR 1.47(a) along with a declaration executed by inventor Robert Cantiani. The renewed petition under 37 CFR 1.47(a) was considered moot as a declaration executed by all the inventors had been submitted. However, the declaration signed by Mr. Cantiani had an uninitialed change in the address in pencil and contained multiple page 3s. Applicant was advised that changes must be done in pen and initialed by the inventor and that the declaration as submitted did not comply with the requirements of 37 CFR 1.497.

On 03 December 2002, applicant submitted four complete declarations.

DISCUSSION

The declarations submitted on 03 December 2002 identify each inventor and state the citizenship, residency and mailing address of each of the inventors and are properly executed. Thus, the requirements of 37 CFR 1.497 have now been met.

CONCLUSION

The declarations submitted on 03 December 2002 are acceptable under 37 CFR 1.497.

This application will be forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371 date is 03 December 2002.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: 703-306-5467
Facsimile: 703-308-6459

CMK:cmk

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

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/23/2010

Applicant	: Wolfgang Dultz	: DECISION ON REQUEST FOR
Patent Number	: 7649610	: RECALCULATION of PATENT
Issue Date	: 01/19/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/958,686	: OF WYETH
Filed	: 02/27/2002	:
		:

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark J Patterson
Waddey & Patterson
Bank of America Plaza Suite 2020
414 Union Street
Nashville TN 37219

COPY MAILED

MAR 0 4 2005

OFFICE OF PETITIONS

In re Application of :
William Hofmeister :
Application No. 09/958,705 :
Filed: October 9, 2001 :
Attorney Docket No. N-7856 :

ON PETITION

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

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper response to the final Office action mailed on April 21, 2004. On September 20, 2004, petitioner filed an amendment in reply to the final Office action and a request for a two-month extension of time. On October 26, 2004, the Office mailed an advisory action informing petitioner that the amendment had been considered, but was not deemed to place the application in condition for allowance because it raised new issues that would require further consideration and/or search. Accordingly, the application became abandoned on September 22, 2004.

The petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of an RCE and an amendment, authorized payment of the petition fee, and made the proper statement of unintentional delay.

Petitioner's Deposit Account, No. 23-0035, will be charged the petition fee of $750.00, as authorized.

The matter is being referred to Technology Center Art Unit 1762.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions

03 JUN 2003

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Steven H. Noll
Schiff, Hardin & White
6600 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

In re Application of OPPELT, et al. U.S. Application No.: 09/958,717 PCT No.: PCT/DE00/01045 Date of Receipt: 04 April 2000 Priority Date: 14 April 1999 Attorney's Docket No.: P01,0321 For: AMPLIFIER DEVICE WITH AN ADJUSTABLE OPERATING-CONTROL AND USE OF SAID OPERATING AMPLIFIER	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment" filed 19 February 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 04 April 2000, applicant filed international application PCT/DE00/01045, which claimed priority of an earlier application filed 14 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 October 2000. A Demand 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 14 October 2001.

On 12 October 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 Information Disclosure Statement and a First Preliminary Amendment.

On 12 December 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 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. Applicant was provided two months to file the proper response and advised that this time could be extended pursuant to 37 CFR 1.136(a). In addition, applicant was advised of the need to provide payment of the $130.00 surcharge for providing an oath or declaration of the inventors later than thirty

months from the priority date.

On 15 January 2003, applicant was mailed a Notification of Abandonment (Form PCT/DO/EO/909) for having failed to respond to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 12 December 2001.

On 19 February 2003, applicant filed the present petition to withdraw the holding of abandonment.

DISCUSSION

The Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant's petition and accompanying papers filed 19 February 2003 satisfy items (1) and (4).

As to item (2), counsel has not attested that a search of the file jacket indicates that the Office action was not received.

Regarding item (3), counsel has not attested that a search of counsel's docket records indicates the Office action was not received.

For the reason indicated above, it is not proper to grant applicant's petition at this time.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 has been considered, however, for the reasons indicated above, the petition stands **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration of 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." No additional fee is required.

Any further correspondence with respect to this matter should be directed 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.

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

16 OCT 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Steven H. Noll
Schiff, Hardin & White
6600 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

In re Application of OPPELT, et al. U.S. Application No.: 09/958,717 PCT No.: PCT/DE00/01045 Int. Filing Date: 04 April 2000 Priority Date: 14 April 1999 Attorney's Docket No.: P01,0321 For: AMPLIFIER DEVICE WITH AN ADJUSTABLE OPERATING-CONTROL AND USE OF SAID OPERATING AMPLIFIER	DECISION ON RENEWED PETITION UNDER 37 CFR 1.181

This decision is in response to applicant's "Request For Reconsideration of Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181" filed 04 August 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 03 June 2003, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment in the present application. Applicant was afforded two months to file any request for reconsideration.

On 04 August 2003, applicant filed the present renewed petition to withdraw the holding of abandonment. 03 August 2003 being a Sunday, the response is considered timely filed..

DISCUSSION

As detailed in the decision mailed 03 June 2003, the Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant originally satisfied items (1) and (4).

As to item (2), counsel has presently attested that a search of the file jacket indicates that the Office action was not received.

Regarding item (3), counsel has presently attested that a search of counsel's docket records indicates the Office action was not received.

Therefore, it is proper to grant applicant's petition at this time. A review of the application file finds that applicant filed an executed combined declaration and power of attorney along with the originally filed petition on 19 February 2003 and thus all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

Applicant's Request For Reconsideration of Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181 is **GRANTED**.

The application has an international filing date of **04 April 2000** under 35 U.S.C. 363 and will be given a date of **19 February 2003** 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.

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

JOSEPH S TRIPOLI
THOMSON MULTIMEDIA LICENSING
PATENT DEPARTMENT
PO BOX 5312
PRINCETON, NJ 08540

COPY MAILED
DEC 21 2006
OFFICE OF PETITIONS

In re Application of	:	
Ques et al.	:	
Application No. 09/958,733	:	ON PETITION
Filed: January 16, 2002	:	
Attorney Docket No. PF990017	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 11, 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 a Request for Continued Examination (RCE) and an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 2100 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 11 2001

LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON DC 20005-3960

In re Application of MURAI Application No.: 09/958,789 PCT No.: PCT/JP00/08477 Int. Filing Date: 30 November 2000 Priority Date: 03 December 1999 Attorney Docket No.: 401402 For: LIQUID CRYSTAL DISPLAY DEVICE	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "PETITION PURSUANT TO 37 CFR 1.137(b) TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION" filed 10 October 2001.

BACKGROUND

On 30 November 2000, applicants filed international application PCT/JP00/08477, which claimed a priority date of 03 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 June 2001. The twenty-month period for paying the basic national fee in the United States expired at midnight on 03 August 2001.

On 10 October 2001, applicants filed, *inter alia*, a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the instant "PETITION PURSUANT TO 37 CFR 1.137(b) TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION".

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:

(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicants submitted the basic national fee on 10 October 2001.

As to item (2), applicants submitted the petition fee of $1,280.00 on 10 October 2001.

With regard to item (3), petitioner's statement that "the entire delay in the filing of the United States national phase application from the 20 month deadline or filing pursuant to Chapter I of the PCT, which expired on August 3, 2001, until the filing of this Petition was unintentional" has been construed as meaning that the "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." If this interpretation is incorrect, applicant must *immediately* notify the Office of PCT Legal Administration of such fact.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

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.

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 preparing and mailing a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE
MAR 2 9 2002
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#5

Robert L. Stearns
Reising Ethington Barnes
Kisselle Learman & McCull
5291 Colony Drive North
Saginaw, MI 48603

In re Application of	:	
Evans et al.	:	
Application No.: 09/958,793	:	DECISION ON
Int. Appl. No.: PCT/GB00/01321	:	
Int. Filing Date: 07 April 2000	:	PETITION UNDER
Priority Date: 16 April 1999	:	
Attorney Docket No.: 1970 P-3007.001	:	37 CFR 1.182
For: Container For Waste	:	

This is a decision on applicant's petition under 37 CFR 1.182 filed on 07 January 2002.

BACKGROUND

This international application was filed on 07 April 2000 and claimed an earlier priority date of 16 April 1999. The International Bureau transmitted a copy of the published international application to the USPTO on 26 October 2000. A Demand electing the United States was filed on 08 November 2000, which was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 16 October 2001.

On 15 October 2001, applicants filed a Transmittal Letter accompanied by, *inter alia*, the basic national fee.

On 16 November 2001, a Notification of Missing Requirements was mailed to applicants, requiring the filing of an executed oath or declaration and a surcharge under 37 CFR 1.492(e).

Applicants filed the instant petition on 07 January 2002.

DISCUSSION

The instant petition alleges that the correct name of the first named inventor is Raymond Victor Evans, as opposed to the name which appears on the published international application, Ronald Victor Evans. Petitioner indicates that this "error arose during completion of the PCT Request Form." Based on the evidence currently of record, this explanation is deemed to be satisfactory. However, the declaration filed on 07 January 2002 is defective because it appears that the declaration as filed may have been assembled by taking sheets from more than one declaration and combining them. Thus, it is not clear whether any of the inventors signed a complete copy of the declaration, naming all of the inventors. Therefore, it

would not be appropriate to accept the declaration filed on 07 January 2002.

DECISION

For the reasons explained *supra*, the petition is **GRANTED**.

Counsel's Deposit Account 12-0755 is being charged in the amount of $130.00 for the petition fee.

Applicants are REQUIRED to file a properly executed oath or declaration of the inventors within **TWO (2) MONTHS** of the mailing date of this decision. Failure to comply will result in **ABANDONMENT** of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

13 SEP 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

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

#7

Robert L. Stearns
Reising Ethington Barnes
Kisselle Learman & McCull
5291 Colony Drive North
Saginaw, MI 48603

In re Application of	:	
Evans et al.	:	
Application No.: 09/958,793	:	
Int. Appl. No.: PCT/GB00/01321	:	
Int. Filing Date: 07 April 2000	:	DECISION
Priority Date: 16 April 1999	:	
Attorney Docket No.: 1970 P-3007.001	:	
For: Container For Waste	:	

This is a decision on applicant's response filed on 19 June 2002.

In a decision mailed on 29 March 2002, applicants' petition to correct the name of inventor Raymond Victor Evans was granted. However, the declaration filed on 07 January 2002 was deemed to be defective because it appeared that the declaration as filed may have been assembled by taking sheets from more than one declaration and combining them. Thus, it was not clear whether any of the inventors signed a complete copy of the declaration, naming all of the inventors.

The instant response is accompanied by three executed declarations of the inventors. Review of the declarations reveals that it is in compliance with 37 CFR 1.497(a) and (b). As such, applicants have now complied with the requirements of 35 U.S.C. 371, including § 371(c)(4).

This application is being forwarded to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371 is **19 June 2002**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

NOTICE RE: CERTIFICATES OF CORRECTION

DATE : 4/16/05 Paper No.: _____

TO : Supervisor, Art Unit 2836

SUBJECT : Certificate of Correction Request in Patent No.: 6,777,830 09/958,794 B2

A response to the following question is requested with respect to the accompanying request for a certificate of correction.

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922 PALM LOCATION 7580 - TEL. NO. 305-8309

H. Green

THANK YOU FOR YOUR ASSISTANCE!

Note your decision by placing a check mark in the appropriate box below, indicating whether all changes requested in the Request for Certificate of Correction should be applied. Please specify which changes should not be applied and indicate the reason(s) for denial, in the "Comments" section below.

☒ YES ☐ NO

☐ Comments: _____

BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
Supervisor

2836
Art Unit

PTOL-306 (REV. 2/02)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

BEST AVAILABLE COPY

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

JUDY JARECKI-BLACK; PH.D., J.D.
3239 SATELLITE BLVD. 3RD FLOOR
DULUTH, GA 30096

Mail Date: 05/24/2010

Applicant	: Colin Manson Harvey	: DECISION ON REQUEST FOR
Patent Number	: 7638545	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 09/958,814	: OF WYETH
Filed	: 01/08/2002	:
		:

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Jun-08

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

COPY MAILED

JUN 13 2008

OFFICE OF PETITIONS

In re Application of	:	
Fisk et al.	:	
Application Number: 09/958881	:	ON PETITION
Filing Date: 03/19/2002	:	
Attorney Docket Number: MJS-4616-2	:	

This is a decision on the petition to withdraw the holding of abandonment, filed on April 29, 2008.

This application became abandoned on November 1, 2007, for failure to timely submit a reply to the non-final Office action mailed on July 31, 2007, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on March 6, 2008.

Petitioners requests that the holding of abandonment be withdrawn because the Office action was mailed to an old correspondence address, and consequently returned to the Office as undeliverable.

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to

establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

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).

The showing of record is that the Office action mailed on July 31, 2007, was mailed to Nixon & Vanderhye, 8th Floor, 1100 North Glebe Road, Arlington, VA 22201-4714. The Notice of Abandonment mailed on March 6, 2008, states, in pertinent part however, that "the Office action was mailed to the wrong address and was not received by the applicant." On March 6, 2008, a Change of Correspondence address was filed, changing the address to the address associated with Customer Number 23117, which is Nixon & Vanderhye, PC, 901 North Glebe Road, 11th Floor, Arlington, VA 22203.

Further, a review of the file reveals that no change of correspondence address was filed prior to the mailing of the non-final Office action mailed on July 31, 2007.

MPEP 601.03 states, in pertinent part that where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR 11.11. The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

As such, a question is raised as to whether petitioners were receiving mail at the address of record at the time the Office action mailed on July 31, 2007, was mailed. Petitioners must verify that they were, in fact, receiving mail at the correspondence address listed in the non-Office action mailed on July 31, 2007, at the time the Office action was mailed, and for a reasonable time thereafter. The showing of record leads to a

conclusion that the Office action was returned as undeliverable because petitioners were no longer receiving mail at that address.

Any renewed petition must explain when petitioners' address changed, and explain whether petitioners were receiving mail at the address listed on the Office action at the time the Office action was mailed.

Accordingly, the showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Extensions of time are permitted under 37 CFR 1.136(a). In the alternative, petitioners may wish to file a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

COPY MAILED
JUL 17 2008
OFFICE OF PETITIONS

In re Application of	:	
Fisk et al.	:	DECISION ON PETITION
Application Number: 09/958881	:	
Filing Date: 03/19/2002	:	
Attorney Docket Number: MJS-4616-2	:	

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on June 19, 2008.

The petition is **GRANTED**.

This application became abandoned on November 1, 2007, for failure to timely submit a reply to the non-final Office action mailed on July 31, 2007, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on March 6, 2008. On April 29, 2008, a petition to withdraw the holding of abandonment was filed. On June 13, 2008, the petition was dismissed.

---

[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 Director 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(d)).

Receipt of the amendment, filed on April 29, 2008, in response to the non-final Office action mailed on July 31, 2007, is acknowledged.

The application is being referred to Technology Center Art Unit 2623 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ——

DATE : 10/19/06

TO SPE OF : ART UNIT 1647

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/958914 Patent No.: 7098002 B1

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Virginia Tolbert
Certificates of Correction Branch

703-308-9390 ext. 113

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments:

No new matter is added.

[signature] SPE

1647 Art Unit

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

JJGJR.: 06-06

Paper No: __

WILLIAM B PATTERSON
THOMASON MOSER & PETTERSON
3040 POST OAK BOULEVARD SUITE 1500
HOUSTON TX 77056

COPY MAILED

JUN 19 2006

OFFICE OF PETITIONS

In re Application of	:	
Pietras, et al.	:	
Application No. 09/958,917	:	ON PETITION
Filed: 11 October, 2001	:	
Attorney Docket No. MRKS/0046	:	

This is a decision on a petition filed on 25 May, 2006, under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates:

- Petitioner failed to reply timely to the Notice of Allowance/Allowability and Fees Due mailed on 5 April, 2005, with reply due absent extension of time on or before 5 July, 2005 (a supplemental Notice was mailed on 12 July, 2005, but did not alter the required reply date);
- the instant application went abandoned by operation of law after midnight 5 July, 2005;
- the Office mailed the Notice of Abandonment on 26 April, 2006;
- Petitioner filed the instant petition with fee on 25 May, 2006, with, *inter alia*, a reply in the form of payment of fees due (noting that the fees had been timely mailed, however, Petitioner did not provide a copy of the Fee Transmittal with a signed and dated certificate of mailing and did not plead the petition in the alternative as abandonment due to unavoidable delay), and made the statement of unintentional delay–thus, Petitioner

appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[1]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[2]

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

---

[1] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[2] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[3] See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[4] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[5] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[6] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and–where appropriate–a terminal disclaimer and fee.

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

Because Petitioner appears to have satisfied the regulatory requirements, regulation, the petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to Publications Branch to be processed into a patent 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

#8

10 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Benoit Castel
745 South 23rd Street
Arlington, VA 22202

In re Application of	
Huard et al.	
Application No.: 09/958,921	DECISION ON
PCT No.: PCT/FR00/00929	
Int. Filing Date: 11 April 2000	PETITION
Priority Date: 13 April 1999	
Attorney's Docket No.: EP/AD BIF 103874/US	UNDER 37 CFR 1.47(a)
For: INJECTION VALVE, ESPECIALLY FOR A MOULD FOR AN OPTICAL LENS	

This is a decision in response to the petition filed under 37 CFR 1.47(a) on 31 May 2002, to accept the application without the signature of co-inventor Mr. Benoit Bessiere. The required $130 petition fee was included.

BACKGROUND

On 11 April 2000, applicant filed international application PCT/FR00/00929 that claimed priority of an earlier French application filed 13 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 September 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 13 October 2001. However, since 13 October 2001 fell on a Saturday, applicant had until 15 October 2001 to enter the national stage in the United States.

On 15 October 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 translation of the application, an information disclosure statement, a preliminary amendment and the basic national fee of $890 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/958,921.

On 15 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. The notification set a two-month time period in which to respond.

On 15 April 2002, applicants filed the signed declaration along with a three month extension of time fee of $920.

On 09 May 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed 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) indicating that all of the requirements under 35 U.S.C. 371 had been met.

On 31 May 2002, applicant filed the present petition. In order to satisfy the requirements of 35 U.S.C. 371(c)(4), , applicants filed the following papers:

1) a Petition under 37 CFR 1.47(a);

2) the required petition fee;

3) an affidavit of Bernard Marchaison;

4) an affidavit of Herbert Lewitter;

5) various other documents intended to show that Mr. Benoit Bessiere received the application papers and has refused to sign the application papers and giving his last known address.

DISCUSSION

MPEP 605.04 states, in part:

> Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether noninitialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

Applicant states that at the time of filing of the declaration, it was not appreciated by either applicant's attorney or the USPTO that the mark next to inventor Benoit Bessiere's name was not, in fact, his signature. Since the attorney was not aware that the mark next to Mr. Bessiere's name was not a signature, it is not clear that at the time the inventor signed the declaration they were aware that Mr. Bessiere had not signed the declaration. Applicants must provide either a new declaration or a statement by the

applicants that at the time the declaration was signed they were aware that Mr. Bassiere had not signed the declaration and they were signing on his behalf.

The proper reply to 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) was a declaration complying with 37 CFR 1.497 executed by all of the inventors, and if not a petition under 37 CFR 1.47. A proper reply was not filed until the filing of this petition. Thus, a six month extension is required.

The declaration filed previously is not considered a bona fide response the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" as it appears that the failure to obtain the signature of the third inventor was not an inadvertent error.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor.

With respect to item (1), applicant has submitted the proper petition fee of $130. With respect to item (2), applicant has submitted copies of letters sent to Mr. Benoit Bessiere indicating that the application was forwarded for his signature. Affiant Herbert Lewitter states that he sent Mr. Bessiere a copy of the application, the drawings and the published PCT application. Applicant has also submitted a copy of a return receipt that is signed by Mr. Benoit Bessiere. With respect to item (3), applicant has provided the last known address for Mr. Benoit Bessiere. With respect to item (4), applicant has not provided a proper declaration.

CONCLUSION

The "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) mailed on 09 May 2002 has been vacated.

The fee for responding in the fifth month of the extension is $1960. Applicant previously paid $920 for responding in the third month of the extension. Therefore, applicant's **DEPOSIT ACCOUNT No. 25-0120 has been charged $1020**.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

DSB/LS:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

29 AUG 2003

Benoit Castel
745 South 23rd Street
Arlington, VA 22202

In re Application of	:
Huard et al.	:
Application No.: 09/958,921	: DECISION ON
PCT No.: PCT/FR00/00929	:
Int. Filing Date: 11 April 2000	: RENEWED PETITION
Priority Date: 13 April 1999	:
Attorney's Docket No.: EP/AD BIF 103874/US	: UNDER 37 CFR 1.47(a)
For: INJECTION VALVE, ESPECIALLY FOR A	:
MOULD FOR AN OPTICAL LENS	:

This is a decision in response to the "RENEWED PETITION UNDER 37 CFR §1.47(a)" filed on 05 February 2003, to accept the application without the signature of co-inventor Mr. Benoit Bessiere. The required $130 petition fee was included with the original petition.

BACKGROUND

On 11 April 2000, applicant filed international application PCT/FR00/00929 that claimed priority of an earlier French application filed 13 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 September 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 13 October 2001. However, since 13 October 2001 fell on a Saturday, applicant had until 15 October 2001 to enter the national stage in the United States.

On 15 October 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 translation of the application, an information disclosure statement, a preliminary amendment and the basic national fee of $890 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/958,921.

On 15 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. The notification set a two-month time period in which to respond.

On 15 April 2002, applicants filed the signed declaration along with a three month extension of time fee of $920.

On 09 May 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed 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) indicating that all of the requirements under 35 U.S.C. 371 had been met.

On 31 May 2002, applicant filed a petition under 37 CFR 1.47(a). On 10 December 2002, the USPTO mailed applicants a decision indicating that applicants had to either file a new declaration or a statement by the applicants that at the time the declaration was signed they were aware that Mr. Bassiere had not signed the declaration and they were signing on his behalf.

On 05 February 2003, applicant filed the current renewed petition and a new declaration signed by inventor Huard and inventor Massau.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor.

With respect to item (1), applicant submitted the proper petition fee of $130 with the earlier filed petition. With respect to item (2), applicant submitted copies of letters sent to Mr. Benoit Bessiere indicating that the application was forwarded for his signature with the earlier filed petition. Affiant Herbert Lewitter stated that he sent Mr. Bessiere a copy of the application, the drawings and the published PCT application. Applicant also submitted a copy of a return receipt that was signed by Mr. Benoit Bessiere with the earlier filed petition. With respect to item (3), applicant provided the last known address for Mr. Benoit Bessiere with the earlier filed petition. With respect to item (4), applicant has provided a proper declaration signed by inventor Huard and inventor Massau on their behalf as well as on behalf of the non-signing inventor Mr. Benoit Bessiere.

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given an international filing date of 11 April 2000 under 35 U.S.C. 363, and a date of 05 February 2003 under 35 U.S.C. 371.

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.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

DSB/LS:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

29 AUG 2003

Mr. Benoit Bessiere
12 avenue de la Tremouille
94100 SAINT MAUR

In re Application of: Huard, et al.
Application No.: 09/958,921
PCT No.: PCT/FR 00/00929
Int. Filing Date: 11 April 2000
Attorney's Docket No.: 6393
For: INJECTION VALVE, ESPECIALLY FOR A MOULD FOR AN OPTICAL LENS

Dear Mr. Bessiere:

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

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Counsel of Record: Benoit Castel
745 South 23rd 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

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. Benoit Bessiere) 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/FR00/00929 and was filed on 11 April 2000 in the names of Marc Huard, Benoit Bessiere and Joel Massau for the invention entitled INJECTION VALVE, ESPECIALLY FOR A MOULD FOR AN OPTICAL LENS. The national stage application number is 09/958,921 and has a 35 U.S.C. 371 date of 05 February 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

THOMAS E KOCOVSKY JR
FAY SHARPE FAGAN MINNICH & MCKEE
1100 SUPERIOR AVENUE SEVENTH FLOOR
CLEVELAND, OH 44114-2518

COPY MAILED

MAR 0 2 2006

OFFICE OF PETITIONS

In re Application of	:	
Jean-Philippe Minot	:	
Application No. 09/958,973	:	ON PETITION
Filed: March 4, 2002	:	
Attorney Docket No. GSQ 2 0045	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 1, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioner is advised that this is **not** a final agency action decision.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed September 9, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 10, 2004.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee 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)). This petition lacks item (1) above.

As to item (1), the amendment submitted on December 1, 2005 does not *prima facie* places the application in condition for allowance. The required reply to the final Office action must be an

amendment that *prima facie* places the application in condition for allowance, a Notice of Appeal and the requisite fee, or a request for continued examination (RCE). A courtesy copy of the Advisory Action is enclosed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300

The filing of a terminal disclaimer is unnecessary as a condition for revival pursuant to the provisions of 37 CFR 1.137(b) under the current rules. Therefore, the terminal disclaimer filed with the petition will not be processed. The terminal disclaimer fee ($130) is unnecessary and will be credited to petitioner's deposit account in due course.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

Wan Laymon
Petitions Examiner
Office of Petitions

Attachments: Courtesy copy of the Advisory Action

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/958,973	Applicant(s) MINOT, JEAN-PHILIPPE	
	Examiner Toan C. To	Art Unit 3616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *5,6 and 8*.
   Claim(s) objected to: *2 and 10*.
   Claim(s) rejected: *1,3,4,9,11 and 12*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

2/28/06

PAUL N. DICKSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Toan To
Patent Examiner
February 28, 2006

Continuation of 3. NOTE: The proposed amendment of the claims appears to contain 112 second paragraph issues that would required further consideration. For example, "the carrying frame" in at least claims 2 and 3 is lacking of antecendent basis. The amendments to the specification would require further consideration to determine whether or not they raise the issue of new matter. For example, changing of "steering fork" to "pivoting shaft" and "reference plate" to "return bearing". Therefore, the proposed response would not place the application in condition for allowance .

UNITED STATES 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

THOMAS E KOCOVSKY JR
FAY SHARPE FAGAN MINNICH & MCKEE
1100 SUPERIOR AVENUE SEVENTH FLOOR
CLEVELAND OH 44114-2518

COPY MAILED
AUG 0 8 2006
OFFICE OF PETITIONS

In re Application of	:	
Jean-Philippe Minot	:	
Application No. 09/958,973	:	DECISION ON PETITION
Filed: 4 March, 2002	:	
Atty Docket No. GSQ 2 0045	:	

This is a decision on the renewed petition filed on 28 April, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 10 December, 2004, for failure to file a proper reply to the final Office action mailed on 9 September, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply under 37 CFR 1.136(a) were obtained. The filing of the present

[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)).

petition precedes the mailing of Notice of Abandonment. The petition filed on 1 December, 2005, was dismissed on 2 March, 2006.

Petitioners have filed a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

The statement contained in the instant renewed petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

This application is being referred to Technology Center Art Unit 3616 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

11 SEP 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1816

In re Application of	:	
LAMBALK, et al.	:	
Application No.: 09/959,037	:	DECISION ON PETITION
PCT No.: PCT/NL00/00241	:	
Int. Filing Date: 13 April 2000	:	UNDER 37 CFR 1.181
Priority Date: 16 April 1999	:	
Attorney Docket No.: 702-011768	:	
For: METHOD FOR OBTAINING A PLANT WITH	:	
A LASTING RESISTANCE TO A PATHOGEN	:	

This decision is in response to applicant's "PETITION TO CORRECT THE FILING DATE" filed 06 January 2006, requesting that the United States Patent and Trademark Office (USPTO) correct the 371(c) date for the above captioned application to 08 March 2002. The request is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 13 April 2000, applicant filed the international application, which claimed a priority date of 16 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 October 2000. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 16 October 2001.

On 16 October 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee.

On 08 January 2002, 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 afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 17 April 2002 and again on 23 May 2003, applicant was mailed a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903) indicating an date of completion of all 35 U.S.C. 371 requirements of 28 March 2002.

On 06 January 2006, applicant filed the petition considered herein. A review of USPTO

records finds that similar petitions were previously filed in this application.

DISCUSSION

Applicant has provided a legible copy of the receipt postcard which shows a USPTO date stamp, "JC10 Rec'd PCT/PTO 08 MAR 2002" and clearly identifies in part: "Letter Re Completion Of Filing Requirements; Declaration And Power of Attorney" as well as listing the applicant, serial number, and attorney docket number. The evidence is sufficient to establish that the last of the 35 U.S.C. 371 requirements were received in the USPTO on 08 March 2002. As such, it is proper to **GRANT** applicant's petition at this time.

The application has an international filing date of 13 April 2000 under 35 U.S.C. 363 and will be accorded a date of **08 March 2002** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903) mailed 23 May 2002 is hereby **VACATED**.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for further processing in accordance with this decision, namely the issuance of a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903) and a corrected filing receipt indicating the correct 371 date as detailed above.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11-17-09

TO SPE OF : ART UNIT 1724

SUBJECT : Request for Certificate of Correction for Appl. No.: D995903B Patent No.: 7311206

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

Valerie Jackson
Certificates of Correction Branch
703-756-1573

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- [x] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments: _____

Walter D. Griffin
SPE

1797
Art Unit

FEB 2 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

McGlew & Tuttle, P.C.
Scarborough Station
Scarborough, NY 10510-0827

In re Application of	:	
Bielli	:	
Application No.: 09/959056	:	DECISION ON
PCT No.: PCT/IT99/00091	:	
Int. Filing Date: 15 April 1999	:	PETITION UNDER
Priority Date: 29 December 1998	:	
Attorney Docket No.: 70232	:	37 CFR 1.137(b)
For: Two-Station Press For Textile Material	:	

This is a decision on applicant's petition under 37 CFR 1.137(b) filed on 15 October 2001.

BACKGROUND

This international application was filed on 15 April 1999 and claimed a priority date of 29 December 1998. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 06 July 2000. A Demand electing the United States was filed on 06 June 2000, which was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 29 June 2001. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

On 15 October 2001, applicant filed the instant petition accompanied by, *inter alia*, a transmittal letter for entry into the national stage in the United States.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (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. Requirements (2), (3) and (4) were previously satisfied.

Regarding requirement (1), the petition is accompanied by the required reply in the form of the basic national fee.

Regarding requirement (2), the petition is accompanied by the petition fee.

Regarding requirement (3), the petition includes a statement that "the delay in filing the application was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition is **GRANTED**.

Counsel's Deposit Account No. 13-0410 is being charged in the amount of $65.00 for the surcharge under 37 CFR 1.492(e).

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The date of this application under 35 U.S.C. 371 is **15 October 2001**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

NOV -1 2004

Paper No. 18

In re Application of
Tiziano Bielli
Application No. 09/959,056
Filed: October 15, 2001
Attorney Docket No. 70232

: DECISION ON PETITION

The paper filed by facsimile transmission on September 9, 2004 is being treated as a petition to withdraw the technically abandoned status of this application. The petition is being considered under 37 CFR 1.181, and no fee is required.

The petition is dismissed.

It appears from the record that a Notice of Allowance was mailed on March 10, 2004, correctly addressed to the correspondence address of record. It further appears from the record, and from the PALM database, that the issue fee that was due not later than June 10, 2004 has not been paid. The application, is therefore, technically abandoned, notwithstanding that a Notice of Abandonment has not yet been mailed.

Petitioner alleges that this application is not abandoned because petitioner did not the Notice of Allowance mailed on March 10, 2004. A review of the petition shows that petitioner has not provided the required showing that this correspondence was not received. See the Notice published at 1156 OG 53, as discussed in MPEP § 711.03(c), subsection entitled "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action." Absent a showing that the Notice of Allowance was not received, there is no basis upon which the abandoned status of this application can be withdrawn.

Petitioner may file a renewed petition, without fee, addressing the matters discussed above.. The renewed petition should be directed to Technology Center 3700 at the address in the letterhead above. The renewed petition must be filed within two months of the date of this decision, or it will not received consideration on the merits. See 37 CFR 1.181(f).

The application is being retained in Technology Center 3700 pending further action by petitioner.

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

McGlew and Tuttle, P.C.
1 Scarborough Station Plaza
Scarborough, NY 10510-0827

UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 19 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.go

McGlew & Tuttle
Scarborough Station
Scarborough, NY 10510-0827

Paper No. 21

In re Application of
BIELLI, TIZIANO
Appl No.: 09/959,056
Filed: October 15, 2001

DECISION GRANTING PETITION
37 CFR 1.181

This application is before the Director of Technology Center 3700 to review petitioner's renewed request to withdraw the abandoned status of the application. A Notice of Abandonment has not been mailed. However, it appears that the application stands abandoned for failure to timely file a response to the Notice of Allowability and the Notice of Allowance and Fee(s) Due, mailed March 10, 2004. The renewed petition is being considered pursuant to 37 CFR 1.181, and no fee is required for this petition.

The petition is granted.

In support of the request, petitioner has provided a showing of non-receipt of the Office action in accordance with MPEP 711.03(c)IA.

In view of the above, the present application is returned to an active status. The Notice of Allowability and the Notice of Allowance and Fee(s) Due will be remailed and the statutory period that was originally set forth in the Office communication will be restarted to run from the mail date of the newly supplied Notice of Allowability and the Notice of Allowance and Fee(s) Due.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Baker & Daniels, LLP
111 E. Wayne Street
Suite 800
Forth Wayne, IN 46802

COPY MAILED

FEB 1 3 2008

OFFICE OF PETITIONS

In re Application of	:	
Jean-Claude Vandevoorde	:	
Application No. 09/959,065	:	DECISION ON PETITION
Filed: October 16, 2001	:	
Attorney Docket No. HERO128	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 31, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before November 24, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed August 24, 2006. 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 payment of the issue fee of $1,440.00, (2) the petition fee of $1,540, and (3) a proper statement of unintentional delay. Accordingly, the issue fee 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.

Since there was no publication fee due, according to the Notice of Allowance mailed on August 24, 2006, the $300.00 fee will be refunded to the petitioner by Treasury check in due course.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Publishing Division for appropriate processing in accordance with this decision on petition.

Andrea Smith
Petitions Examiner
Office of Petitions

MAY 1 0 2002

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Joseph S. Tripoli
Thomson Multimedia Licensing
Patent Department
P.O. Box 5312
Princeton, NJ 08543-5312

In re Application of GRUBBS et al.	:
Application No.: 09/959,083	:
PCT No.: PCT/US00/10724	:
Int. Filing: 20 April 2000	:
Priority Date: 20 April 1999	: DECISION ON PETITION
Attorney Docket No.: RCA 89364	: UNDER 37 CFR 1.47(a)
For: IF SIGNAL PROCESSING APPARATUS	:
	:

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 25 February 2002. The petition is considered under 37 CFR 1.47(a) because applicant seeks acceptance of the application without the signature of one inventors among several joint inventors. The petition fee of $130 has been charged to applicant's deposit account per their authorization.

BACKGROUND

On 20 April 2000, applicant filed international application No. PCT//US00/10724 which claimed priority of an earlier U.S. application filed 20 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 October 2000.

On 17 November 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 20 October 2001.

On 16 October 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 29 November 2001, a Notification of Missing Requirements (FORM

PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration executed by the inventors and a surcharge for filing the oath or declaration after the thirty month period was required.

On 25 February 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47 in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of joint inventor Ricardo Haro, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicants Gary Dean Grubbs, Rodger Anthony Diemer, and Daniel Mark Hutchinson on behalf of Ricardo Haro, evidence of the assignee's proprietary interest, and a statement of facts under 37 CFR 1.47(a) by Davida Fornarotto. It is noted that the evidence of the assignee's proprietary interest is not relevant to a petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the $130 petition fee. Item (3) is satisfied with the statement of the last known address of non-signing inventor, Ricardo Haro. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With respect to item (2), applicant must demonstrate that Ricardo Haro's conduct constitutes a refusal to sign the declaration for the above referenced application..

Inventor's Refusal to Sign

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:....

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers

and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner submitted the first-hand statement of facts under 37 CFR 1.47(a) in the form of a declaration signed by Davida Fornarotto, a paralegal for Thomson multimedia Licensing, Inc. (assignee). Ms. Fornarotto's declaration is dated 20 February 2002. Ms. Fornarotto states that on 06 September 2001, she sent a letter to the last known address of Ricardo Haro by Federal Express. The letter (attached as an exhibit) referenced the attorney docket number RCA 89364, which is associated with PCT/US00/10724, and indicated that a copy of the PCT application and "forms" were included for Mr. Haro's signature and return. Ms. Fornarotto never states that a <u>declaration</u> was sent to Mr. Haro nor does the letter indicate such. It can not be concluded that a declaration for PCT/US00/10724 was delivered to Mr. Haro for his signature.

On 04 October, 08 October and 23 October 2001, Ms. Fornarotto telephoned Mr. Haro and left voice mail messages at his home. On 07 November 2001, Mr. Haro returned Ms. Fornarotto's calls and asked if there was still time to sign the forms. According to the declaration, Mr. Haro told Ms. Fornarotto that he would try to get them signed "soon". This statement does not indicate that Mr. Haro refuses to sign.

Ms. Fornarotto states that on 20 December 2001, she sent a second letter to Mr. Haro at his last known address. A copy of the letter was attached to the petition. This letter references attorney docket number **RCA 89694** and indicates that a "U.S. declaration form for the above

case" together with a copy of the PCT application was sent to Mr. Haro's last known home address. The attorney docket number RCA 89694 is not the docket number associated with international application PCT/US00/10724. Thus, it cannot be concluded that a declaration for international application PCT/US00/10724 was delivered to Mr. Haro for his signature.

Furthermore, the declaration executed by the other inventors, which was submitted to the USPTO, is unacceptable because the box containing Mr. Haro's name, residence, citizenship and mailing address has been lined through in pencil. This may indicate to the other applicant/inventors, who have executed the declaration, that either they do not consider Mr. Haro an inventor or that they are not executing the declaration on his behalf.

Thus, the evidence is insufficient to conclude that applicant/inventor Ricardo Haro has refused to sign the application.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/BM:cmk

Telephone: (703) 306-5467

8 JUL 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#5

THOMSON multmedia Licensing, Inc.
Patent Department
P.O. Box 5312
Princeton, NJ 08540

In re Application of GRUBBS et al.	
Application No.: 09/959,083	:
PCT No.: PCT/US00/10724	:
Int. Filing: 20 April 2000	: DECISION ON PETITION
Priority Date: 20 April 1999	:
Attorney Docket No.: RCA 89364	:UNDER 37 CFR 1.47(a)
For: IF SIGNAL PROCESSING APPARATUS	:

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 25 February 2002. The original decision was mailed on 10 May 2002 and returned to the USPTO. The decision is being remailed with a new mail date upon confirmation of the proper address with the correspondence address provided in the transmittal letter.

The petition is considered under 37 CFR 1.47(a) because applicant seeks acceptance of the application without the signature of one inventors among several joint inventors. The petition fee of $130 has been charged to applicant's deposit account per their authorization.

BACKGROUND

On 20 April 2000, applicant filed international application No. PCT//US00/10724 which claimed priority of an earlier U.S. application filed 20 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 October 2000.

On 17 November 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 20 October 2001.

On 16 October 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the

Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 29 November 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration executed by the inventors and a surcharge for filing the oath or declaration after the thirty month period was required.

On 25 February 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47 in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of joint inventor Ricardo Haro, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicants Gary Dean Grubbs, Rodger Anthony Diemer, and Daniel Mark Hutchinson on behalf of Ricardo Haro, evidence of the assignee's proprietary interest, and a statement of facts under 37 CFR 1.47(a) by Davida Fornarotto. It is noted that the evidence of the assignee's proprietary interest is not relevant to a petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the $130 petition fee. Item (3) is satisfied with the statement of the last known address of non-signing inventor, Ricardo Haro. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With respect to item (2), applicant must demonstrate that Ricardo Haro's conduct constitutes a refusal to sign the declaration for the above referenced application..

Inventor's Refusal to Sign

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:....

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner submitted the first-hand statement of facts under 37 CFR 1.47(a) in the form of a declaration signed by Davida Fornarotto, a paralegal for Thomson multimedia Licensing, Inc. (assignee). Ms. Fornarotto's declaration is dated 20 February 2002. Ms. Fornarotto states that on 06 September 2001, she sent a letter to the last known address of Ricardo Haro by Federal Express. The letter (attached as an exhibit) referenced the attorney docket number RCA 89364, which is associated with PCT/US00/10724, and indicated that a copy of the PCT application and "forms" were included for Mr. Haro's signature and return. Ms. Fornarotto never states that a <u>declaration</u> was sent to Mr. Haro nor does the letter indicate such. It can not be concluded that a declaration for PCT/US00/10724 was delivered to Mr. Haro for his signature.

On 04 October, 08 October and 23 October 2001, Ms. Fornarotto telephoned Mr. Haro and left voice mail messages at his home. On 07 November 2001, Mr. Haro returned Ms. Fornarotto's calls and asked if there was still time to sign the forms. According to the declaration, Mr. Haro told Ms. Fornarotto that he would try to get them signed "soon". This statement does not indicate that Mr. Haro refuses to sign.

Ms. Fornarotto states that on 20 December 2001, she sent a second letter to Mr. Haro at

his last known address. A copy of the letter was attached to the petition. This letter references attorney docket number **RCA 89694** and indicates that a "U.S. declaration form for the above case" together with a copy of the PCT application was sent to Mr. Haro's last known home address. The attorney docket number RCA 89694 is not the docket number associated with international application PCT/US00/10724. Thus, it cannot be concluded that a declaration for international application PCT/US00/10724 was delivered to Mr. Haro for his signature.

Furthermore, the declaration executed by the other inventors, which was submitted to the USPTO, is unacceptable because the box containing Mr. Haro's name, residence, citizenship and mailing address has been lined through in pencil. This may indicate to the other applicant/inventors, who have executed the declaration, that either they do not consider Mr. Haro an inventor or that they are not executing the declaration on his behalf.

Thus, the evidence is insufficient to conclude that applicant/inventor Ricardo Haro has refused to sign the application.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/BM:cmk

Telephone: (703) 306-5467

16 JAN 2003

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

THOMSON multmedia Licensing, Inc.
Patent Department
P.O. Box 5312
Princeton, NJ 08540

In re Application of GRUBBS et al.	
Application No.: 09/959,083	:
PCT No.: PCT/US00/10724	:
Int. Filing: 20 April 2000	: DECISION ON PETITION
Priority Date: 20 April 1999	:
Attorney Docket No.: RCA 89364	:UNDER 37 CFR 1.47(a)
For: IF SIGNAL PROCESSING APPARATUS	:

This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 19 August 2002.

BACKGROUND

On 29 November 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration executed by the inventors and a surcharge for filing the oath or declaration after the thirty month period was required.

On 25 February 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47 in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of joint inventor Ricardo Haro, on the grounds that the nonsigning inventor refused to execute the declaration.

On 19 August 2002, applicants filed a "Renewed Petition under 37 CFR 1.47(b)[sic] Inventor Not Available" with a declaration signed by previously unavailable non-signing inventor, Ricardo Haro.

DISCUSSION

The instant renewed petition under 37 CFR 1.47(a) was accompanied by a declaration executed by inventor Ricardo Haro. Thus, the renewed petition under 37 CFR 1.47(a) is considered moot as a declaration executed by the previously unavailable inventor has now been

submitted and is acceptable under 37 CFR 1.497.

However, as indicated in the decision mailed on 08 July 2002, the declaration executed by the other inventors, which was submitted to the USPTO on 25 February 2002, is unacceptable because the box containing Mr. Haro's name, residence, citizenship and mailing address has been lined through in pencil. It appears that the other applicant/inventors, who executed the declaration, do not consider Mr. Haro an inventor.

What is required is a newly executed oath or declaration by inventors Gary Dean Grubbs, Rodger Anthony Diemer, and Daniel Mark Hutchinson that does not bear any indication that Mr. Haro may not be an inventor. Thus, the requirements of 37 CFR 1.497 have not been met.

CONCLUSION

For the above reasons, the renewed petition under 37 CFR 1.47(a) is considered **MOOT**. The declaration executed by Mr. Haro is acceptable. The declaration executed by the other inventors and submitted on 25 February 2002 is unacceptable under 37 CFR 1.497 for the reason stated above.

Applicants' response appears to be a *bona fide* response to the 08 July 2002 decision. Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.497.

Applicant has **ONE** (1) month from the mail date of this decision or the time remaining under the 29 November 2001 Notification of Missing Requirements to submit a proper oath or declaration in compliance with 37 CFR 1.497. Any extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231.

This application is being forwarded to United States Designated/Elected Office to await receipt of the oath/declaration in compliance with 37 CFR 1.497 as required above.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: 703-306-5467
Facsimile: 703-308-6459
CMK:cmk

14 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

THOMSON multmedia Licensing, Inc.
Patent Department
P.O. Box 5312
Princeton, NJ 08540

In re Application of GRUBBS et al.	:
Application No.: 09/959,083	:
PCT No.: PCT/US00/10724	: DECISION ON
Int. Filing: 20 April 2000	:
Priority Date: 20 April 1999	:DECLARATION
Attorney Docket No.: RCA 89364	:
For: IF SIGNAL PROCESSING APPARATUS	

This is a decision on applicant's supplemental petition to accept declaration filed in the United States Patent and Trademark Office (USPTO) on 14 February 2003.

On 19 August 2002, applicants filed a "Renewed Petition under 37 CFR 1.47(b)[sic] Inventor Not Available" with a declaration signed by previously unavailable non-signing inventor, Ricardo Haro.

In a decision mailed on 16 January 2003, applicants were advised that the declaration signed by Ricardo Haro was acceptable; however, the declaration executed by the other inventors, which was submitted to the USPTO on 25 February 2002, was unacceptable because the box containing Mr. Haro's name, residence, citizenship and mailing address has been lined through in pencil.

On 14 February 2003, applicants filed a new executed declaration by inventors, Gary Dean Grubbs, Rodger Anthony Diemer, and Daniel Mark Hutchinson, which also names Ricardo Haro as an inventor. The declaration is acceptable. Thus, the requirements of 37 CFR 1.497 have not been met.

This application is being forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371 date is 14 February 2003.

Cynthia M. Kratz

/Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: 703-306-5467

MAY 27 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of LOHRAY et al.
Application No.: 09/959,093
PCT No.: PCT/IB00/00501
Int. Filing: 25 April 2000
Priority Date: 28 April 1999
Attorney Docket No.: U 013634-8
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 27 March 2002.

BACKGROUND

On 25 April 2000, applicant filed international application No. PCT/IB00/00501 which claimed priority of an earlier Indian application filed 28 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 November 2000.

On 20 November 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 28 October 2001.

On 17 October 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the

Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 27 November 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the thirty month period was required. The notification set a two month time period from the mail date, within which to respond or by 28 January 2002 (27 January 2002 was a Sunday). Extensions of time under 37 CFR 1.136(a) were available.

On 27 March 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The response was filed two months after 29 January 2002 deadline and therefore, a two month extension of time is required. Per applicant's authorization on 17 October 2001 to charge his deposit account for additional fees "during the entire pendency of this application" and to avoid abandonment of the application, the fee of $400 for a two month extension of time will be charged to applicant's deposit account.

DISCUSSION

The petition under 37 CFR 1.47(a) requested the acceptance of the application without the signatures of two inventors, Channaveerappa Bajji Ashok and Shivaramayya Kalchar, on the grounds that the nonsigning inventors refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicants on behalf of Channaveerappa Bajji Ashok and Shivaramayya Kalchar. However, a statement of facts under 37 CFR 1.47(a) was not submitted.

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the $130 petition fee. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar and satisfies the requirements of 37 CFR 1.47(a).

However, with regard to Item (3), petitioner has not provided a statement of the last known address for each of the non-signing inventors, Channaveerappa Bajji Ashok and Shivaramayya Kalchar.

With respect to item (2), petitioner only states that inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar refuse to sign the Declaration. No further evidence of their refusal is submitted. An explanation of what is required to meet this requirement follows.

Inventor's Refusal to Sign

Petitioner appears to allege that the two nonsigning inventors have refused to sign the declaration.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:....

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Inability to Find or Reach Nonsigning Inventor After Diligent Effort

If petitioner is alleging his inability to find or reach a nonsigning inventor after diligent effort, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.
>
> ....
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, Petitioner did not submit any statement of facts under 37 CFR 1.47(a) No evidence was submitted to support a finding that the nonsigning inventors refused to sign the application or are unavailable after diligent effort for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

For these reasons, petitioner has presented insufficient evidence to conclude that applicant/inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar have refused to sign the application.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR

1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard E. Smith
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/LES:cmk

Telephone: (703) 306-5467

30 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of LOHRAY et al.
Application No.: 09/959,093
PCT No.: PCT/IB00/00501
Int. Filing: 25 April 2000
Priority Date: 28 April 1999
Attorney Docket No.: U 013634-8
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS

: DECISION ON
: RENEWED PETITION
:UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 26 November 2002. Applicant submitted a request for a four month extension of time, which is granted.

BACKGROUND

On 27 March 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) along with the petition fee of $130.

On 27 May 2002, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant stating that petitioner had not provided: (1) a statement of the last known address for each of the non-signing inventors, Channaveerappa Bajji Ashok and Shivaramayya Kalchar and (2) evidence of their refusal or unavailability to sign an oath or declaration.

On 26 November 2002, petitioner filed the instant renewed petition accompanied by a new declaration and statements of facts under 37 CFR 1.47(a) concerning the refusal to sign or unavailability of four of the seven named inventors. Petitioner states that Braj Bhushan Lohray

and Vidya Bhushan Lohray now refuse to sign the combined declaration and power of attorney on behalf of the non-signing inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar.

DISCUSSION

The original petition under 37 CFR 1.47(a) requested the acceptance of the application without the signatures of two inventors, Channaveerappa Bajji Ashok and Shivaramayya Kalchar, on the grounds that the nonsigning inventors refused to execute the declaration. With their renewed petition, petitioner states that two additional inventors, Braj Bhushan Lohray and Vidya Bhushan Lohray, now refuse to sign the declaration on behalf of the two nonsigning inventors.

With the petition, Petitioner submitted a new declaration executed by the available joint inventors on behalf of the non-signing inventors Vidya Bhushan Lohray, Braj Bhushan Lohray, Channaveerappa Bajji Ashok and Shivaramayya Kalchar and satisfies the requirements of 37 CFR 1.47(a). Petitioner also identified the last known addresses for the nonsigning inventors. At the outset, it is noted that the statement of facts under 37 CFR 1.47(a) provided by Dr. Rajagopalan does not claim that he has first hand knowledge of any of the facts supplied in his statement.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:....

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> ....
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.
>
> ...
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Inventor Vidya Bhushan Lohray's Refusal to Sign

Petitioner relies on the statement of Dr. R. Rajagopalan to support the conclusion that Vidya Lohray refuses to sign the declaration. His statement in pertinent part, states:

> We were informed that *Vidya Bhushan Lohray* wanted to know why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the forms. We did not know the reasons why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the declaration forms as they had not given any reasons for refusing to sign the 'Combined Declaration and Power of Attorney'. In fact, at the time of this exchange, we could not locate the inventors as they were not available at the last known address. We informed *Braj Bhushan Lohray* of these facts and were informed...We informed *Vidya Bhushan Lohray* of these facts [that the inventors were not available as they could not be located] and were informed on October 11, 2002 that because we could not give reasons (which we did not have) why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the 'Combined Declaration and Power of Attorney', *Vidya Bhushan Lohray* refused to sign on their behalf."

Here, the circumstances of the presentation of the application papers and of the refusal are not specified in a statement of facts provided by the person who presented the inventor with the application papers and/or to whom the refusal was made. Dr. Rajagopalan does not indicate in his statement that he is the person with first hand knowledge of Ms. Lohray's refusal. Furthermore, the details of Ms. Lohray's refusal are not provided by a party with first hand knowledge; that is, the person who spoke to Ms. Lohray by telephone and obtained her oral refusal to sign should prepare a statement of the details of her refusal. If there was a written communication in which Ms. Lohray indicated that she refused to sign, that statement should be provided. Dr. Rajagopalan indicates that the information of her refusal was received on 11 October 2002, but does not provide any details of this refusal. The statement by a party not present when an oral refusal is made will not be accepted. The statement submitted by Dr. Rajagopalan is insufficient and thus, with regard to inventor Vidya Bhushan Lohray, petitioner has not provided sufficient evidence of her refusal to sign the declaration.

Inventor Braj Bhushan Lohray's Refusal to Sign

Petitioner submits a similar statement with regard to Braj Bhushan Lohray's refusal to sign. Dr. Rajagopalan states:

> We were informed that *Braj Bhushan Lohray* wanted to know why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the forms. We did not know the reasons why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the declaration forms as they had not given any reasons for refusing to sign the 'Combined Declaration and Power of Attorney'. In fact, at the time of this exchange, we could not locate the inventors as they were not available at the last known address. We informed *Braj Bhushan Lohray* of these facts and were informed on October 11, 2002 that because we could not give reasons (which we did not have) why *Channaveerappa Bajji Ashok and Shivaramayya Kalchar* would not sign the 'Combined Declaration and Power of

Attorney', *Braj Bhushan Lohray* refused to sign on their behalf.

As indicated above, the circumstances of the presentation of the application papers and of the refusal are not specified in a statement of facts by the person who presented the inventor with the application papers and to whom the refusal was made. Dr. Rajagopalan does not make this statement as the person having first hand knowledge of Mr. Lohray's refusal. Furthermore, the details of Mr. Lohray's refusal are not provided and the same questions arise: did someone speak to Mr. Lohray by telephone and obtained an oral refusal to sign? Or was there a written communication in which Mr. Lohray indicated that he refused to sign? Such evidence should be presented in the statement of facts. Dr. Rajagopalan indicates that the information of his refusal was received on 11 October 2002, but does not indicate any details of this refusal. The statement by a party not present when an oral refusal is made will not be accepted. Dr. Rajagopalan is insufficient and thus, with regard to inventor Braj Bhushan Lohray, petitioner has not provided sufficient evidence of his refusal to sign the declaration.

Inventor Channaveerappa Bajji Ashok's Unavailability to Sign

With respect to inventor Channaveerappa Bajji Ashok, Dr. Rajagopalan's statement explains that on 07 February 2002, a letter was sent to Channaveerappa Bajji Ashok at his last known address along with a copy of the international application and combined declaration and power of attorney; however, no response was received. Without providing any details of the date and time or with whom, Dr. Rajagopalan states that contact with Dr. Ashok was made by telephone and that Dr. Ashok confirmed receipt of the declaration and indicated that he would send the forms. Dr. Rajagopalan further states, without more detail, that on 22 June 2002, Dr. Ashok was contacted and he indicated that he would sign and return the declaration. Dr. Rajagopalan further states that on 13 November 2002, a contact was made with Dr. Ashok and he indicated that he would send the signed declaration but the signed declaration was not received. The details of these contacts are not provided and thus this statement is insufficient to conclude that inventor Ashok refuses to sign the declaration.

Again, Petitioner has not provided a statement from the party having first hand knowledge of the facts recited therein. Statements based on hearsay will not be accepted. Copies of documentary evidence such as internet searches, telephone calls, email or the like, to support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. Although petitioner states that the whereabouts of inventor Ashok is unknown, petitioner has not detailed the diligent efforts taken to locate the whereabouts of the nonsigning inventor. The statement should contain facts as opposed to conclusions.

Inventor Shivaramayya Kalchar's Unavailability to Sign

Likewise, Petitioner submits that inventor Shivaramayya Kalchar is unavailable and refuses to sign the declaration. In his statement, Dr. Rajagopalan states that on 07 February 2002, a combined declaration and power of attorney along with a copy of the international application was sent by courier to Dr. Shivaramayya's last known address. On 20 June 2002, a reminder was sent to Dr. Shivaramayya via facsimile. On the same day, Professor Ji Wang Chern returned the reminder via facsimile with a handwritten noted indicating that Dr.

Shivaramayya had returned to India and his location was unknown. A copy of this facsimile was provided. In addition, the courier service was not able to deliver the package to Dr. Shivaramayya's last known address. Dr. Rajagopalan states that Dr. Shivaramayya called his office promising "to send all the address details through e-mail but to date he has not provided ...any contact information."

The evidence with regard to Dr. Kalchar's refusal is insufficient to conclude that he is unavailable and by his conduct, unwilling to cooperate in the signing of the declaration. Dr. Rajagopalan's statement is not from the party having first hand knowledge of the facts recited therein. Further attempts to locate Inventor Kalchar via internet searches, telephone calls, emails or the like were not undertaken and detailed.

For the reasons stated above, petitioner has presented insufficient evidence to conclude that applicant/inventors Braj Bhushan Lohray, Vidya Bhushan Lohray, Channaveerappa Bajji Ashok and Shivaramayya Kalchar have refused to sign or are unavailable to sign the application.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk
Telephone: (703) 306-5467

03 SEP 2003

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of LOHRAY et al.	:
Application No.: 09/959,093	:
PCT No.: PCT/IB00/00501	: DECISION ON SECOND
Int. Filing: 25 April 2000	:
Priority Date: 28 April 1999	: RENEWED PETITION
Attorney Docket No.: U 013634-8	:
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS	:UNDER 37 CFR 1.47(a)

This is a decision on applicant's second renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 27 June 2003.

On 26 November 2002, petitioner filed a renewed petition accompanied by a new declaration and statements of facts under 37 CFR 1.47(a) concerning the refusal to sign or unavailability of four of the seven named inventors. Petitioner stated that Braj Bhushan Lohray and Vidya Bhushan Lohray refused to sign the combined declaration and power of attorney on behalf of the non-signing inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar.

On 30 April 2003, a decision dismissing the renewed petition on the grounds that applicant had failed to provide sufficient evidence of the non-signing inventors refusal to sign or unavailability.

On 27 June 2003, with the renewed petition, petitioner has now provided the first hand statements from Dr. A.V.S. Sesha Kumar, of the Discovery Research division of Dr. Reddy's Laboratories Ltd., regarding the refusal or unavailability of the non-signing inventors Channaveerappa Bajji Ashok and Shivaramayya Kalchar and the first hand statements of Dr. V.M. Sharma, also of Discovery Research, regarding the refusal of Braj Bhushan Lohray and Vidya Bhushan Lohray to sign the declaration.

DISCUSSION

Inventors Vidya Bhushan Lohray and Braj Bhushan Lohray's Refusal to Sign

Petitioner relies on the statement of Dr. V. M. Sharma to support the conclusion that Vidya Bhushan Lohray and Braj Bhushan Lohray refuse to sign the declaration. Dr. Kumar's statement is supported by a letter, dated 11 October 2002 and signed by both Vidya Bhushan Lohray and Braj Bhushan Lohray, which states they are unable sign on behalf of the other non-signing inventors. This is sufficient evidence to show the refusal of Vidya Bhushan Lohray and Braj Bhushan Lohray to sign the declaration.

Inventor Shivaramayya Kalchar's Unavailability to Sign

Petitioner submits the first hand statement of Dr. A.V.S. Sesha Kumar, dated 20 June 2003, confirming telephone contact with Dr. Kalchar "on or about September 15, 2002". Dr. Kumar states that he explained to Dr. Kalchar the necessity of signing the declaration forms. Dr. Kumar states that he requested that Dr. Kalchar provide the address for communication to facilitate sending the forms. Dr. Kalchar indicated that he would provide the address for communication through e-mail "but to date he has not provided us with any information". An internet search to locate Dr. Kalchar was unsuccessful. The evidence with regard to Dr. Kalchar's refusal is now sufficient to conclude that by his conduct, unwilling to cooperate in the signing of the declaration and he is unavailable.

Inventor Channaveerappa Bajji Ashok's Unavailability to Sign

With respect to inventor Channaveerappa Bajji Ashok, it is noted that the Request, the published international application and the declaration submitted on 27 March 2002 all identify the inventor as Channaveerappa Bajji Ashok. However, in the declaration submitted on 26 November 2002, the inventor's name appears as Ashok Channaveerappa Bajji. There is no indication in the application file or communication from the International Bureau (Form PCT/IB/306) that Mr. Ashok's name was corrected or changed from that presented in the Request and published application. The communications and internet search for the inventor was undertaken using Bajji as the family or last name, rather than Ashok. Given the confusion in the family name of the inventor, an explanation is required to explain the discrepancy in family name.

Dr. Kumar's statement indicates that on or about June 21 and July 2002 {the year was corrected by counsel in the petition), he contacted Dr. Ashok C. Bajji by telephone and requested that he sign the declaration forms and return the forms. Dr. Kumar states, that during this conversation, Dr. Bajji confirmed that he received the forms and said that he would send the forms. Dr. Kumar states that on June 22, he spoke to Dr. Ashok Channaveerappa Bajji and he said that he would sign and return the declaration forms.

For the reasons stated above, petitioner has presented sufficient evidence to conclude that applicant/inventors Braj Bhushan Lohray, Vidya Bhushan Lohray, and Shivaramayya Kalchar have refused to sign or are unavailable to sign the application. However, with regard to inventor

Channaveerappa Bajji Ashok's unavailability or refusal to sign, the petition under 37 CFR 1.47(a) is dismissed. An explanation is required to ascertain if the correct inventor was contacted.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

21 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

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of LOHRAY et al.	:
Application No.: 09/959,093	:
PCT No.: PCT/IB00/00501	: DECISION ON SECOND
Int. Filing: 25 April 2000	:
Priority Date: 28 April 1999	: RENEWED PETITION
Attorney Docket No.: U 013634-8	:
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS	:UNDER 37 CFR 1.47(a)

This is a decision on applicant's third renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 03 November 2003.

On 27 June 2003, with the second renewed petition, petitioner provided the first hand statements from Dr. A.V.S. Sesha Kumar, of the Discovery Research division of Dr. Reddy's Laboratories Ltd., regarding the refusal or unavailability of the non-signing inventors Ashok Channaveerappa Bajji and Shivaramayya Kalchar and the first hand statements of Dr. V.M. Sharma, also of Discovery Research, regarding the refusal of Braj Bhushan Lohray and Vidya Bhushan Lohray to sign the declaration.

On 03 September 2003, a decision was mailed indicating that applicant had presented sufficient evidence to conclude that applicant/inventors Braj Bhushan Lohray, Vidya Bhushan Lohray, and Shivaramayya Kalchar refused to sign or were unavailable to sign the application. However, the petition was dismissed with regard to the unavailability or refusal to sign of inventor Ashok Channaveerappa Bajji on the grounds that applicant had not provided sufficient evidence of his refusal or unavailability.

On 03 November 2003, applicants filed the instant renewed petition along with the first hand statement of A.V.S. Sesha Kumar regarding the refusal of Ashok Channaveerappa Bajji.

DISCUSSION

In the decision mailed 27 May 2002, applicant was advised that a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor. Here, counsel has not provided any proof 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. *See* MPEP 409.03(d) Proof of Unavailability or Refusal.

The 20 October 2003 letter sent to Dr. Bajji indicates that the declaration forms only were sent for his signature, rather than a complete copy of the application.

It is noted that the Request, the published international application and the declaration submitted on 27 March 2002 all identify the inventor as Channaveerappa Bajji Ashok. However, in the declaration submitted on 26 November 2002, the inventor's name appears as Ashok Channaveerappa Bajji. There is no indication in the application file or communication from the International Bureau (Form PCT/IB/306) that inventor Ashok's name was corrected or changed from that presented in the Request and published application. **An explanation is required to explain the discrepancy in family name.**

The petition under 37 CFR 1.47(a), with regard to inventor Channaveerappa Bajji Ashok's refusal to sign, is dismissed.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467

08 SEP 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

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of LOHRAY et al. Application No.: 09/959,093 PCT No.: PCT/IB00/00501 Int. Filing: 25 April 2000 Priority Date: 28 April 1999 Attorney Docket No.: U 013634-8 For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS	DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on applicant's "Response to Decision on Second Renewed Petition", treated as a petition under 37 CFR 1.182, filed in the United States Patent and Trademark Office (USPTO) on 01 July 2004. The petition fee of $130 will be charged to applicant's deposit account, per their authorization. Applicant's request for a four month extension is granted. With the response, applicant filed a declaration signed by Ashok Channaveerappa Bajji.

The Request, the published international application and the declaration submitted on 27 March 2002 all identify the inventor as Channaveerappa Bajji Ashok. However, in the declaration submitted on 26 November 2002 and the executed declaration submitted with the instant response, the inventor's name appears as Ashok Channaveerappa Bajji.

In cases where the inventor desires to change his or her name on the application, he must submit a petition under 37 CFR 1.182. In the instant application, applicant filed a petition under 37 CFR 1.182 and paid the petition fee. Ashok Channaveerappa Bajji confirms the correction to his family name as Bajji to explain the discrepancy in family name as it appears on the Request, published international application and declaration.

The petition under 37 CFR §1.182 is **GRANTED**.

The application will be forwarded to the U.S. Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 01 July 2004.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467

2 9 JAN 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

Jason Johnson
P.O. Box 1449
Greenville, SC 29602-1449

Reddy Us Therapeutics, Inc
3065 Northwoods Circle
Norcross GA 30071

In re Application of LOHRAY et al.	:
Application No.: 09/959,093	:
PCT No.: PCT/IB00/00501	: DECISION ON
Int. Filing: 25 April 2000	:
Priority Date: 28 April 1999	: RENEWED PETITION
Attorney Docket No.: U 013634-8	:
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS	:UNDER 37 CFR 1.47(a)

This is in response to applicant's communication filed on 10 January 2008 in the United States Patent and Trademark Office. This also serves as a decision on applicant's third renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 03 November 2003 in light of the 08 September 2004 decision granting a petition under 37 CFR 1.182. The petition under 37 CFR 1.47(a) is granted.

On 27 June 2003, with the second renewed petition, petitioner provided the first hand statements from Dr. A.V.S. Sesha Kumar, of the Discovery Research division of Dr. Reddy's Laboratories Ltd., regarding the refusal or unavailability of the non-signing inventors Ashok Channaveerappa Bajji and Shivaramayya Kalchar and the first hand statements of Dr. V.M. Sharma, also of Discovery Research, regarding the refusal of Braj Bhushan Lohray and Vidya Bhushan Lohray to sign the declaration.

On 03 September 2003, a decision was mailed indicating that applicant had presented sufficient evidence to conclude that applicant/inventors Braj Bhushan Lohray, Vidya Bhushan Lohray, and Shivaramayya Kalchar refused to sign or were unavailable to sign the application. However, the petition was dismissed with regard to the unavailability or refusal to sign of inventor Ashok Channaveerappa Bajji on the grounds that applicant had not provided sufficient evidence of his refusal or unavailability.

On 03 November 2003, applicants filed a renewed petition along with the first hand statement of A.V.S. Sesha Kumar regarding the refusal of Ashok Channaveerappa Bajji. On 08 September 2004, a decision granting the petition under 37 CFR 1.182 was mailed to applicant. That decision did not clearly indicate that the petition under 37 CFR 1.47(a) was also granted.

On 25 October 2004, a Notification of Acceptance was mailed to applicant indicating

that Date of Receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and the Date of Completion of all 35 U.S.C. 371 requirements was 01 July 2004.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant has satisfied items (1) through (4) above with the requisite petition fee, factual proof that the nonsigning inventor Kalchar refuses to sign the declaration, the last known address of inventor Kalchar and declarations executed by the joint inventors, submitted on 27 March 2002 and 01 July 2004.

Petitioner has satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

For the above reasons, the petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office has accepted the application as a 37 CFR 1.47(a) application using the declarations filed 27 March 2002 and 01 July 2004. The application has an international filing date of 25 April 2000 under 35 U.S.C. 363, and a date of 01 July 2004 under 35 U.S.C. 371(c). The 25 October 2004 Notification of Acceptance remains in effect.

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 respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286

29 JAN 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

Shivaramayya KALCHAR
c/o II Wang-Chem
School of Pharmacy
National University of Taiwan
Taipei 1000
Taiwan

In re Application of LOHRAY et al.	:
Application No.: 09/959,093	:
PCT No.: PCT/IB00/00501	: DECISION ON
Int. Filing: 25 April 2000	:
Priority Date: 28 April 1999	: RENEWED PETITION
Attorney Docket No.: U 013634-8	:
For: SUBSTITUTED BICYCLIC HETEROCYCLES, PROCESS FOR THEIR PREPARATION AND THEIR USE AS ANTIOBESITY AND HYPOCHOLESTEROLEMIC AGENTS	:UNDER 37 CFR 1.47(a)

Dear Mr. Kalchar:

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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone: (571) 272-3286

Jason Johnson
P.O. Box 1449
Greenville, SC 29602-1449

Reddy Us Therapeutics, Inc
3065 Northwoods Circle
Norcross GA 30071

19 MAY 2004

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael J. Striker
STRIKER STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

In re Application of KRIMMER, Erwin *et al* U.S. Application No.: 09/959,106 PCT No.: PCT/DE00/01142 Int. Filing Date: 13 April 2000 Priority Date: 17 April 1999 Attorney Docket No.: 1789 For: MEASURING INSTRUMENT FOR CONTACTLESS DETECTION OF AN ANGLE OF ROTATION	**DECISION ON RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

This decision is in response to the papers filed 29 April 2004 which are treated as a renewed petition to withdraw the holding of abandonment.

BACKGROUND

On 05 April 2004, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed because applicants did not provide a date-stamped postcard receipt for the declaration purportedly filed.

On 29 April 2004, applicants submitted the instant renewed petition which was accompanied by, *inter alia*, a copy of the date-stamped postcard receipt for documents filed 08 February 2002.

DISCUSSION

In the renewed petition, applicants have provided a copy of a date-stamped postcard receipt for the documents purportedly filed 08 February 2002. The postcard receipt clearly identifies the application with the application and docket number.

The receipt acknowledges that an "Executed Declaration" was recorded as one of the documents submitted. The receipt has a stamp of "JC18 Rec'd PCT/PTO 08 FEB 2002" across its face. Accordingly, applicants have provided *prima facie* evidence that a declaration was received by the USPTO on 08 February 2002.

A review of USPTO financial records indicates that a $130.00 surcharge fee pursuant to 37 CFR 1.492(e) was also received on 08 February 2002.

DECISION

Applicants' renewed petition to withdraw the holding of abandonment is **GRANTED**.

The declaration originally submitted on 08 February 2002 is in compliance with 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 13 April 2000, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 08 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

05 APR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

05 APR 2004

#4

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael J. Striker
STRIKER STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

In re Application of
KRIMMER, Erwin *et al*
U.S. Application No.: 09/959,106
PCT No.: PCT/DE00/01142
Int. Filing Date: 13 April 2000
Priority Date: 17 April 1999
Attorney Docket No.: 1789
For: MEASURING INSTRUMENT FOR CONTACTLESS DETECTION OF AN ANGLE OF ROTATION

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This decision is in response to the papers filed 16 January 2004 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

BACKGROUND

On 07 December 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 an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) was required. A two-month time limit in which to respond was set with extensions of time available.

Applicants purportedly filed a response which contained an executed declaration. This response was not located in the above-captioned application.

On 26 June 2003, a request for status was received in the above-captioned application.

On 16 January 2004, applicants filed via facsimile several papers including a copy of an executed declaration, a copy of handwritten notes, and two copies of a computer docket record.

DISCUSSION

A review of the above-captioned application shows that a response to the Form PCT/DO/EO/905 mailed 07 December 2001 was not located in the file until the receipt of the instant petition on 16 January 2004 included a copy of an executed declaration.

Accordingly, the application is hereby **ABANDONED** for failing to timely respond to the Form PCT/DO/EO/905.

Petition to Withdraw Holding of Abandonment

Applicants submitted a copy of an executed declaration apparently claiming that a response to the Form PCT/DO/EO/905 was submitted.

The Office has established a practice of providing a receipt for papers filed in the Office to any applicants 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 Procedure 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 declaration. Applicants have not even addressed this issue in the instant petition. Instead, applicants provided a copy of handwritten notes without an explanation and a copy of a computer docket record for docket number 1789 which does not show that a response to the Form PCT/DO/EO/905 mailed 07 December 2001 was provided.

Therefore, applicants have not provided *prima facie* evidence that a proper reply to the Form PCT/DO/EO/905 was filed.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment 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).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for

Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-645

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

K&L Gates LLP
STATE STREET FINANCIAL CENTER
One Lincoln Street
BOSTON MA 02111-2950

COPY MAILED

JUL 27 2009

OFFICE OF PETITIONS

In re Patent No. 7,204,102	:	
Issue Date: 04/17/2007	:	
Application No. 09/959,111	:	DECISION ON PETITION
Filed: 02/11/2002	:	
Attorney Docket No. W01000/80241	:	

This is a decision on the petition under 37 CFR 1.182, filed March 3, 2009, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Office of Data Management is directed to issue a duplicate Letters Patent.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211. Inquiries regarding the issuance of a duplicate Letters Patent may be directed to Niomi Farmer, Office of Data Management at (703) 308-9250, Ext. 119.

A copy of this decision is being faxed to the Office of Data Management for issuance of a duplicate Letters Patent.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

cc: Niomi Farmer, Office of Data Management, South Tower, 8th Floor, Room C23 (Fax No. (571) 270-9937)

27 AUG 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

William H. Holt
LAW OFFICES OF WILLIAM H. HOLT
12311 Harbor Drive
Woodbridge, VA 22192

In re Application of	:	
SHILTON, Mark Golder	:	
U.S. Application No.: 09/959,125	:	
PCT No.: PCT/GB00/01549	:	
Int. Filing Date: 20 April 2000	:	**DECISION**
Priority Date: 27 April 1999	:	
Attorney Docket No.: SHILTON-15410	:	
For: GAMMA RADIATION SOURCE	:	

This is a decision on applicant's "Petition Under 37 C.F.R. 1.181 for a Review of the File to Ensure that all Documents are Properly in the File" filed with the United States Designated/Elected Office (DO/EO/US) on 21 June 2004 via facsimile. No fee is required.

BACKGROUND

On 22 October 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, the basic national fee and an executed declaration. A copy of the international application was transmitted from the International Bureau on 02 November 2000.

On 06 December 2003, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating, *inter alia*, a copy of the international application and Preliminary Amendments were received.

On 04 June 2004, an Office Action was mailed indicating that claims 1 - 27 were rejected. The examiner indicated that the specification in the electronic file contained only three pages.

DISCUSSION

During examination of the above-captioned application, counsel was informed by the examiner that the "electronic file from which he (Examiner Joseph D. Anthony) is working on is incomplete." Consequently, counsel requests a review of the above-captioned application file to ensure that the file is complete. Counsel also requests that the Office Action dated 04 June 2004 be withdrawn pending the decision on this petition and the reconstruction of this file.

A review of the electronic file verifies that the above-captioned application scanned in was complete. However, the papers were not properly indexed.

The document titled SPEC (10/22/2001) in the electronic file contained only three pages. A review of the international application shows that the specification should have contained seven pages. The full specification was indexed under a document titled LET (10/22/2001). The amended claims were located under a document titled CLM (10/22/2001).

CONCLUSION

Since the above-captioned application was complete, applicant's petition to reconstruct the application is hereby **DISMISSED** without prejudice.

This application is being returned to Art Unit 1714 for further processing in accordance with this decision, that is, the examiner should consider the amended claims 1 - 27 using the complete specification provided in the electronic file.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Aug. 8, 2008

TO SPE OF : ART UNIT 2800

SUBJECT : Request for Certificate of Correction for Appl. No 09/959127 patent no7293241

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**

Magdalene Talley

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☐ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: No new matter has been added. Claim 149 should have been canceled however was allowed as claim 47, and claim 151 has been omitted because of the error. The replacement of the claim 47 to include the one or more directional keys does not introduce new matter since it was an allowed claim.

/Ryan Pitaro/ Primary Examiner Art Unit 2174

/Dennis-Doon Chow/ SPE — **SPE**

AU.2174 — **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

29 AUG 2003

Karl F. Milde Jr.
Milde Hoffberg & Macklin
10 Bank Street, Suite 460
White Plains, NY 10606

In re Application of	:	
HAESELICH, Detlef	:	
Application No.: 09/959,170	:	DECISION ON
PCT No.: PCT/DE00/01281	:	
Int. Filing Date: 19 April 2000	:	PETITION
Priority Date: 19 April 1999	:	
Attorney Docket No.: HBC 237-KFM	:	UNDER 37 CFR 1.181
For: TRAINING PROJECTILE FOR AN	:	
AUTOMATIC RAPID-FIRE WEAPON	:	

This decision is in response to applicant's "Response to Notice of Abandonment," filed on 19 February 2003. It has been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 19 April 2000, applicant filed international application PCT/DE00/01281. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 October 2000. A demand for international preliminary examination was filed 10 November 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, 19 October 2001.

On 18 October 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 11 January 2002, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required..

On 06 January 2003, the Office mailed a Notice of Abandonment indicating that the application went abandoned for failure to timely respond to the Notice to File Missing Parts mailed 11 January 2002.

On 19 February 2003, applicant filed the instant petition under 37 CFR 1.181, accompanied by, *inter alia*, two postcard receipt, a request for a refund and a 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 28 January 2002 postcard receipt lists, *inter alia*, the declaration. The postcard receipt is date stamped and indicates serial number. The 08 February 2002 postcard lists a Request for Refund. It too is date stamped and indicates the serial number.

The postcard receipt is adequate evidence the declaration was received on 28 January 2002 and that the request for refund was received on 08 February 2002. Practitioner indicates that the papers accompanying this submission are copies of the papers submitted on their respective dates.

A review of the declaration reveals that it is in compliance with 37 CFR 1.497(a)-(b) and that applicant has satisfied the requirements under 35 U.S.C. §371.

Request For Refund

The Request For Refund claims that applicant submitted $65 in payment of the late declaration fee with the 28 January 2002 submission. Applicant's postcard and Office records do not support the claim. The 28 January 2002 postcard lists "$40 Assn Record Fee." Office records list a $40 fee credited to this application with a mail room date of 28 January 2002. The declaration fee on record with the Office for this application has a mail room date of 18 October 2001.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The Request For Refund is **REFUSED**.

The Notice of Abandonment mailed 06 January 2003 is hereby **VACATED**.

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 28 January 2002.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

MAR 0 6 2002

Sheridan Neimark
BROWDY & NEIMARK, P.L.L.C.
624 Ninth Street, NW
Suite 300
Washington, D.C. 20001-5303

In re Application of	:	
SAGIV, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/959,207	:	
PCT No.: PCT/IL01/00152	:	UNDER 37 CFR 1.181
Int. Filing Date: 19 February 2001	:	
Priority Date: 20 February 2000	:	
Attorney Docket Number: SAGIV3	:	
For: CONSTRUCTIVE NANOLITHOGRAPHY	:	

This decision is in response to applicant's "Petition to Restart Period For Reply Due to Late Receipt of Office Communication (MPEP §710.06)" filed 16 January 2002 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 19 February 2001, applicant filed international application PCT/IL01/00152, which claimed priority of an earlier application filed 20 February 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 August 2001. A Demand for international preliminary examination, in which the United States was elected, was not filed on prior to the expiration of nineteen months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 20 October 2001.

On 22 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 International Search Report and a Preliminary Amendment. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed. Applicant included the $65.00 surcharge for providing an oath or declaration later than 20 months from the priority date. (20 October 2001 being a Saturday, applicant filed the papers and paid the full U.S. Basic National fee on the next business day, 22 October 2001, therefore the payment is considered timely.)

On 06 December 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 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. In addition, applicant was informed of the need to provide additional claim fees of $275.00 as a small entity.

On 16 January 2002, applicant filed the present petition.

On 06 February 2002, applicant filed a "Late Submission of Declaration and or Translation in Application Filed Under 35 USC 371" accompanied by a combined declaration and power of attorney executed by the inventors.

DISCUSSION

As applicant has responded in a timely and complete manner to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 06 December 2001, the present petition is **DISMISSED as moot**.

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.

CONCLUSION

Applicant's petition to restart the time period to respond to the Office Action is **DISMISSED as moot**.

This application will be given an international application filing date of 19 February 2001 and a date of **06 February 2002** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax (703) 308-6459

UNITED STATES 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
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, VA 22102

COPY MAILED

DEC 1 0 2007

OFFICE OF PETITIONS

In re Application of :
MECKLENBRAEUKER, et al. :
Application No. 09/959,215 : DECISION ON PETITION
Filed: January 23, 2002 : TO WITHDRAW
Attorney Docket No. **449122011600** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 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 July 31, 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 the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL BOYD & LLOYD, LLP**
P.O. BOX 1135
CHICAGO, IL 60690

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

#16

COPY MAILED

MAR 0 3 2004

OFFICE OF PETITIONS

GODFREY & KAHN S.C.
780 NORTH WATER STREET
MILWAUKEE, WI 53202

In re Application of :
Paul Omdoll et al :
Application No. 09/959,251 :
Filed: January 29, 2002 :
Attorney Docket No. 008646-0064

ON PETITION

This is a decision on the petition, filed March 2, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 2, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Irvin Dingle at (703) 306-5684.

After receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 3654 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).

FEB 1 5 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

H.B. FULLER COMPANY
Patent Department
1200 Willow Lake Blvd.
P.O. Box 64683
St. Paul, Minnesota 55164-0683

In re Application of
MAKSYMKIW, Mike *et al*
U.S. Application No.: 09/959,255
PCT No.: PCT/US99/22536
Int. Filing Date: 30 September 1999
Priority Date: 19 March 1999
Attorney Docket No.: 97-087-US-WO
For: METHODS FOR THE PREPARATION OF NON-BLOCKING ADHESIVE COATING ARTICLES AND COLD SEAL BONDED LAMINATES

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 the national stage papers on 18 October 2001 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate basic national fee and the petition fee have been paid. Applicants state that "[t]he entire delay in filing the national stage application until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration was not included with any of the papers submitted.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements indicating that the declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) is required.

James Thomson

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

H B Fuller Company
1200 Willow Lake Boulevard
PO Box 64683
St Paul MN 55164-0683

COPY MAILED

MAR 07 2008

OFFICE OF PETITIONS

In re Application of	:	
Maksymkiw et al.	:	
Application No. 09/959,255	:	DECISION ON PETITION
Filed: April 26, 2002	:	
Attorney Docket No. 97-087-US-WO	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 17, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision of April 12, 2006 by the Board of Patent Appeals and Interferences. A supplemental examiner's answer was written in response to a remand by the Board. The appellant was required to respond within two months to the examiner's supplemental answer, which was mailed on January 13, 2005. Petitioner's failure to exercise one of the two options provided in 37 CFR 41.50(a)(2), resulted in the dismissal of the Appeal.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a reply brief, (2) the petition fee of $1500.00, and (3) a proper statement of unintentional delay.

The address provided on the petition differs from the correspondence address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition. However, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3215.

This application is being referred to Technology Center AU 1794 for appropriate action by the

Examiner in the normal course of business on the reply received

Charlema Grant
Petitions Attorney
Office of Petitions

Cc: Allison Johnson, PA
Lake Calhoun Executive Center
3033 Excelsior, MN 55416

MAY 01 2002

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

HALE and DORR LLP
1455 Pennsylvania Avenue NW
Suite 1000
Washington, DC 20004

In re Application of Mathews et al. US Application No.: 09/959,269 PCT Application No.: PCT/GB00/01272 International Filing Date: 4 April 2000 Priority Date: 20 April 1999 Attorney's Docket No.: 109846.292 For: PESTICIDAL INDAZOLE OR BENZOTRIAZOLE DERIVATIVES	DECISION ON PAPERS UNDER 37 CFR 1.42

This is a decision on the national stage application papers submitted 12 February 2002 for entry into the national stage in the United States of America. A review of the Declaration reveals that joint inventor Brian Leslie Pilkington is deceased. Applicants' submission of the Declaration taken together with the indication that joint inventor Brian Pilkington is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 4 April 2000, applicants filed International Application PCT/FI99/00163 which claimed its earliest priority from application 9909062.3 filed in Great Britain on 20 April 1999. The international application designated the United States. A Demand for international preliminary examination, in which the United States was elected, was filed on 7 September 2000, prior to the expiration of nineteen months from the earliest priority date. Accordingly, the thirty month period for meeting the requirements for entry into the national stage expired at midnight on 22 October 2001.

On 19 October 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 filing fee and a copy of the international application. Applicants did not submit a declaration.

On 27 November 2001, the United States Designated/Elected Office (DO/EO/US) mailed applicant a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" which required a signed oath or declaration and a surcharge under 37 CFR 1.492(e).

On 12 February 2002, applicants filed a "TRANSMITTAL LETTER" which includes a response to the Notification of Missing Requirements, executed Declaration, and the required surcharge under 37 CFR 1.492(e).

The declaration was signed by Joan Pilkington, acting as a Legal Representative for deceased inventor Brian Leslie Pilkington, and the remaining inventors.

DISCUSSION

37 CFR 1.42 states:

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. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

37 CFR 1.497(b) states:

(1) The oath or declaration must be made by all of the actual inventors except as provided for in 37 CFR 1.42, 1.43, or 1.47.

(2) If the person making the oath of declaration or any supplemental oath or declaration is not the inventor (37 CFR 1.42. 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Applicants have failed to satisfy the requirements under 37 CFR 1.497(b). The Declaration does not provide the citizenship, residence and mailing address of the legal representative, Joan Pilkington.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**

Applicant is required to submit a declaration in compliance with 37 CFR 1.42 and 1.497 within a time period of TWO (2) MONTHS from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Gregory Vidovich
PCT Legal Detailee
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

09 OCT 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
1455 Pennsylvania Avenue NW
Suite 1000
Washington, DC 20004

In re Application of
HUGHES et al.
Application No.: 09/959,269
PCT No.: PCT/GB00/01272
Int. Filing Date: 04 April 2000
Priority Date: 20 April 1999
Attorney's Docket No.: 109846.292
For: PESTICIDAL INDAZOLE OR BENZOTRIAZOLE DERIVATIVES

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.42

This is a decision on applicant's renewed petition under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on 22 July 2002.

BACKGROUND

On 04 April 2000, applicants filed international application PCT/GB00/01272, which claimed priority of an earlier British application filed 20 April 2000. On 07 September 2000, a Demand for international preliminary examination was filed. Accordingly, the thirty month period for paying the basic national fee for processing in the United States expired at midnight on 20 October 2001.

On 19 October 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*: the basic national fee.

On 27 November 2001, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b) and the $130 surcharge for providing the oath or declaration for filing the oath or declaration after the thirty month.

On 12 February 2002, in order to satisfy the requirement that an oath or declaration of the inventors be furnished, applicants also filed a declaration that was signed by applicant/inventors Sarah Armstrong, Nigel John Barnes, Susan Patricia Barnett, Eric Daniel Clarke, Patrick Jeff Crowley, Torquil Eoghan Macleod Fraser, David John Hughes, Christopher John Mathews, Roger Salmon, Stephen Christopher Smith, Russell Viner, William Guy Whittingham, John Williams and Alan John Whittle and by Joan Pilkington, as legal representative for deceased co-inventor, Brian Leslie Pilkington.

On 01 May 2002, a decision was mailed to applicant indicating that the declaration did

not specify the citizenship, residence and mailing address of the legal representative and thus the declaration did not meet the requirements of 37 CFR 1.497(b) and was unacceptable.

On 22 July 2002, applicant filed a renewed petition under 37 CFR 1.42 along a new declaration identifying and executed only by Joan Pilkington, as legal representative for deceased co-inventor, Brian Leslie Pilkington. None of the joint inventors were identified in the declaration.

DISCUSSION

The declaration submitted on 22 July 2002 identifies Joan Pilkington, as legal representative for deceased co-inventor Brian Leslie Pilkington and states the country of citizenship, former residency and mailing address of the deceased inventor and the legal representative's country of citizenship, residency and mailing address as required for compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.64.

However, the declaration submitted on 22 July 2002 identifies Joan Pilkington as the "original, first and joint inventor of the subject matter which is claimed" without listing the joint inventors as indicated on the published international application. As such, the declaration is not in compliance with 37 CFR 1.497(a)(3) and is unacceptable.

What is required is a declaration executed by Joan Pilkington, as legal representative for deceased co-inventor Brian Leslie Pilkington, providing her citizenship, residency and mailing address and stating the citizenship, residency and mailing address of the deceased inventor on the declaration which identifies the inventors as listed on the international application publication.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is presently **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.42 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 §1.42." No additional petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard E. Smith
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/LES:cmk

Telephone: (703) 306-5467
Facsimile: (703) 308-6459

15 MAY 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.go

Edward D. Grieff
Hale and Dorr
1455 Pennsylvania Avenue NW
Suite 1000
Washington, DC 20004

In re Application of HUGHES et al. Application No.: 09/959,269 PCT No.: PCT/GB00/01272 Int. Filing Date: 04 April 2000 Priority Date: 20 April 1999 Attorney's Docket No.: 109846.292 For: PESTICIDAL INDAZOLE OR BENZOTRIAZOLE DERIVATIVES	DECISION ON RENEWED PETITION UNDER 37 CFR 1.42

This is a decision on applicant's renewed petition under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on 04 February 2003.

BACKGROUND

On 12 February 2002, in order to satisfy the requirement that an oath or declaration of the inventors be furnished, applicants also filed a declaration that was signed by applicant/inventors Sarah Armstrong, Nigel John Barnes, Susan Patricia Barnett, Eric Daniel Clarke, Patrick Jelf Crowley, Torquil Eoghan Macleod Fraser, David John Hughes, Christopher John Mathews, Roger Salmon, Stephen Christopher Smith, Russell Viner, William Guy Whittingham, John Williams and Alan John Whittle and by Joan Pilkington, as legal representative for deceased co-inventor, Brian Leslie Pilkington.

On 01 May 2002, a decision was mailed to applicant indicating that the declaration did not specify the citizenship, residence and mailing address of the legal representative and thus the declaration did not meet the requirements of 37 CFR 1.497(b) and was unacceptable.

On 22 July 2002, applicant filed a renewed petition under 37 CFR 1.42 along a new declaration identifying and executed only by Joan Pilkington, as legal representative for deceased co-inventor, Brian Leslie Pilkington. None of the joint inventors were identified in the declaration.

Applicants' renewed petition was dismissed in a decision mailed on 09 October 2002. Applicants were advised that the declaration submitted with the renewed petition indicating that the declaration submitted on 22 July 2002 identified Joan Pilkington as the "original, first and joint inventor of the subject matter which is claimed" without listing the joint inventors as indicated on the published international application. As such, the declaration was not in compliance with 37 CFR 1.497(a)(3) and was unacceptable.

On 04 February 2003, applicants submitted a newly executed declaration identifying all of the co-inventors as identified on the published international application in compliance with 37 CFR 1.497.

DISCUSSION

The declaration submitted on 04 February 2003 identifies Joan Pilkington, as legal representative for deceased co-inventor Brian Leslie Pilkington and states the country of citizenship, former residency and mailing address of the deceased inventor and the legal representative's country of citizenship, residency and mailing address as required for compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.64. The declaration also identifies the inventors as listed on the international application publication. Accordingly, 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 application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The 35 U.S.C. 371(c) date is **04 February 2003.**

Cynthia M. Kratz

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

JUL 13 2005

SYNGENTA CROP PROTECTION, INC.
PATENT AND TRADEMARK DEPARTMENT
410 SWING ROAD
GREENSBORO, NC 27409

In re Application of	:
Sarah Armstrong et al	:
Serial No.: 09/959,269	: PETITION DECISION
Filed: February 4, 2003	:
Attorney Docket No.: 109846.997	:

This is in response to the petition under 37 CFR 1.181, filed March 30, 2005, requesting withdrawal of abandonment based on failure to receive an Office action.

A review of the file history shows that the examiner mailed an Office action to applicants on July 29, 2004, setting a one month shortened statutory period for reply. Upon failure to receive a reply a Notice of Abandonment was mailed to applicants on February 3, 2005. Applicants state that the Office action was never received and provide a statement and copies of mail log entries as evidence on non-receipt. In view of the evidence presented, the Notice of Abandonment is withdrawn and the application restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

The application will forwarded to the examiner for mailing of a new Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott
Director, Technology Center 1600

JC13 Rec'd PCT/PTO 16 OCT 2001
09/959295

3/prts

MOORIN[illegible]ACILITY FOR TETHERED GAS [illegible]LLOON

This invention relates to a mooring facility for a tethered gas balloon.

Modern tethered gas balloons, normally helium filled, are capable of lifting significant numbers of fare-paying passengers, e.g. from 10 to 50, through vertical distances of 100 to 1000 feet primarily for sightseeing purposes. Repeated liftings represent a significant revenue-generating capability. Such balloons are expensive to manufacture and require careful operation and mooring to avoid damage due to weather conditions, vandalism, and unwanted or uncontrolled movement, while ensuring and maintaining safety of passengers and operating personnel.

In particular, since lighter-than-air gas-filled balloons remain permanently inflated, it is important to be able to moor the balloons overnight and during more extended non-operating periods, including periods of inclement weather conditions, in a safe and secure manner. In the past, many tethered gas balloons have been extensively damaged due to weather conditions while moored.

United States Patent No. 5,775,640 (Gobbi et al) describes a landing installation for landing a tethered balloon having an annular gondola. The landing installation comprises a generally rectangular cavity in the ground, a landing platform covering the cavity and generally flush with the ground surface and provided with an opening through which the tethering cable passes. The landing platform is provided with an annular landing zone, while the gondola is fitted with swivel-mounted wheels fixed beneath the gondola in an annular zone the same size as the landing zone. This arrangement facilitates centering of the gondola when the balloon lands.

Neither of these prior systems affords a means of protecting and stabilizing the moored balloon/gondola combination from adverse weather conditions.

It is an object of the present invention to provide a system which avoids the drawbacks and shortcomings of the prior art and facilitates the mooring of a tethered gas balloon in a secure and safe manner under adverse weather conditions.

Another object of the invention is to provide a facility for safely mooring a tethered gas balloon while acting as a convenient and attractive launching station for balloon operation.

Accordingly, the invention provides a mooring facility for a tethered gas balloon, comprising:

(a) a building structure containing a hemispherical basin capable of receiving a lower portion of a tethered gas balloon, the surface of said hemispherical basin approximating the surface contour of the lower portion of said balloon;

(b) a recessed portion centrally of said hemispherical basin for accommodating a gondola suspended beneath said gas balloon; and

(c) mooring means for securing the gas balloon in a moored position in said hemispherical basin with said gondola disposed in said recessed portion.

The balloon is generally spherical in configuration and the said hemispherical basin, referred to herein as a nest basin, is normally hemispherical so that, in the moored position, the lower balloon surface is substantially parallel to and slightly spaced from the surface of the nest basin. The spacing between the balloon and basin surfaces may be maintained by the presence of inflated tubes or the like, in contact with the basin surface, for instance a plurality of annular inflated tubes disposed horizontally in spaced relation around the interior basin surface.

In the moored position, the top of the nest basin is advantageously approximately level with the equator of the balloon. A seal is effected between the upper lip of the nest basin and the adjacent balloon surface, for instance by means of an annular inflated tube, so as to prevent wind gusts from inducing air pressure surges

in the space between t[illegible]hoored balloon and the nest bas[illegible]which can give rise to instability of the balloon and potentially lead to damage or even destruction thereof.

The infrastructure surrounding and supporting the nest basin is comprised of a building with optional rooms, hallways, etc., for commercial or retail outlets, such as stores, kiosks, offices or restaurants, which may enhance the commercial viability of the tethered balloon as a tourist attraction. In this case, the top of the structure surrounding the nest basin may constitute a roof.

Furthermore, the fact that the tethered balloon occupies a fixed location is moored by being secured in a compact nest , as opposed to mooring lines extending far out from a balloon in the open air, means that relatively little space is required for operation and enables the facility to be positioned in or close to a built-up area, such as within or adjacent a town or city. This is in marked contrast to the usual space required to operate tethered balloons.

If desired, the mooring facility can be disposed on the top of an existing building, even a high rise building, to provide gondola based balloon flights high above a town or city, with the attendant panoramic views.

Alternatively, the facility can be built underground, with the roof of the facility being substantially flush with a ground surface.

The gondola suspended below the balloon is accommodated in the central recessed portion, referred to herein as a nest hole. The gondola rests on the floor of the nest hole, which may advantageously be raised and lowered, as required, to afford in a raised position a launching platform. A door and stairway can be provided between an interior room or passageway in a building structure surrounding the mooring facility to permit access of balloon operating personnel and passengers to the gondola.

In general, the mooring facility of the invention avoids the shortcomings and drawbacks of the prior art and permits safe and stable mooring of a large tethered gas balloon, even in windy conditions or other inclement weather.

Moreover, such a facility avoids the need for a large space requirement, and can be erected or installed in a relatively restricted area, such as a built-up area inside of or adjacent to a town or city.

Embodiments of the invention will now be described, by way of example, with reference to the accompanying drawings, in which:

Figure 1 is a side elevation, partly in cross-section, of a mooring facility for a tethered gas balloon;

Figure 2 is a cross-sectional view of the mooring facility with the balloon in the moored position; and

Figure 3 is a plan view of the mooring facility with the balloon absent.

Referring now to the drawings, the mooring facility comprises a nest structure 1 with a concave nest basin 2 formed centrally in the upper surface thereof. The dimensions and contours of the nest basin 2 are complementary to those of a gas balloon 3 having a balloon envelope 4. The gas balloon 3 is tethered above the nest basin 2 by cable 5 and can be raised and lowered by means of a winch (not shown) between an elevated operating or flight position (see Figure 1) and a moored position (show in Figure 2). When inflated, the balloon envelope is substantially spherical and has volume generally in the range of 100,000 to 300,000 cubic feet, and a diameter of 20 to 30 meters, e.g. 22 meters.

The nest basin 2 is somewhat larger in diameter than the balloon envelope 4, such that, when the balloon 3 is moored, the lower half of the balloon envelope 4 rests inside the nest basin 2 and is slightly spaced therefrom, with the lower surface of the balloon envelope 4 substantially parallel to, but slightly spaced from, the upper surface of the nest basin 2, as shown in Figure 2. The spacing of the balloon envelope 4 from the nest basin 2 is maintained by the provision of a plurality of horizontal annular

inflatable tubes 7, 8 and which sandwich between the nest basin 2 and the balloon envelope 4 upon and during mooring thereof, to stabilize the balloon 3 in a fixed position, while preventing damage to the balloon 3 or the nest basin 2 by inadvertent contract there between during a mooring operation. Annular tubes 7, 8 and 9, made of strong nylon or similar fabric, may be inflated and pressurized by means of forced air electric fans or other suitable devices.

The balloon is stabilized and immobilized during mooring by the provision of a plurality of mooring lines 10 extending between anchor points 11 and winches 11a spaced equidistantly around the roof 1a of the nest structure 1 and points on the outer surface of the balloon envelope 4 at a region approximately two-thirds up the side of the envelope. The mooring lines 10 are permanently anchored to the balloon envelope and attach to guy lines extending from the anchor points 11 and winches 11a for line-to-line hook up. On disconnection of the mooring lines 10 preparatory to raising the balloon, the lines 10 simply hang freely against the surface of the balloon envelope 4. The balloon is aggressively moored after a flight by securing the lines 10 to the guy lines extending from anchor points 11 utilizing synchronized electrical winches 11a also located on the roof 1a of the nest structure 1. The roof 1a is constructed in suitably reinforced manner to withstand the stresses placed upon it by the installation of heavy equipment, such as the winches 11a, and the strain exerted during use thereof.

Suspended below the balloon 3 is a gondola 6 for accommodating an operator and a plurality of fare paying passengers. The gondola may be of any convenient configuration, but is preferably circular or multi-sided, such as hexagonal or octagonal. The gondola has a generally annular configuration, with a central opening to facilitate passage of cable 5. An annular pressurized air filled tube 12 is disposed around the perimeter of the gondola at the bottom thereof to function as a cushion which will allow gentle bumping and rubbing of the gondola against the walls of the nest basin 2 during landing of the balloon. Alternatively, a flat annular cushion can be provided to cover the annular bottom of the gondola 6, to provide a cushioning effect under the gondola as well as at the edges thereof.

At the centre of bottom of the nest basin 2 is loca a nest hole 13, which comprises a recess dimensioned to receive the gondola 6 during landing and to accommodate the gondola during mooring of the balloon 3 resting on a floor 16 of the nest hole 13. On landing, the balloon is winched slowly down to the moored position, with the gondola 6 sliding into the nest hole 13 utilizing the resiliency of the tube 12 to effect a damage-free landing. The horizontal annular tubes 7, 8 and 9 disposed on the surface of the nest basin 2 assure a snug fit of the balloon 3 into the nest basin 2 and protect the balloon envelope 4 from aggressive friction with the basin surface. The top tube 7 is located within the basin at its top edge where the balloon meets the edge of the nest roof 1a and provides a snug fit between the basin and the balloon to protect the balloon envelope against outside air flow and aggressive friction. As a consequence of the weather-resistant and windproof fit in the peripheral region between the balloon and the nest at the location of top tube 7, changes in air pressure inside the nest and in the space between the surface of the interior of the nest and the lower surface of the balloon envelope are modulated, so as to avoid sudden pressure surges in windy conditions, thereby maintaining the balloon in a stable and secure mode.

An optional balloon blanket 14, intended to protect the balloon from solar radiation, can be applied over top of the balloon envelope 4 and secured to a plurality of points 15 on the nest roof. Rope ladders (not shown) secured to the top of the balloon may be used to put the blanket in place. Because the roof of the nest place is normally located at the equator of the balloon, the top of the balloon is more accessible by rope ladder.

In operation of the balloon, the balloon is freed from the mooring points and remains connected to the nest basin by the main system winch and cable 5. Using the winch, the balloon and gondola are permitted to rise through the height of the nest hole, so the bottom of the gondola becomes level with the bottom of the nest basin. The nest hole floor 16 is raised to the level of the bottom of the basin - where it will become the launch pad for the gondola. The hole floor 16 is raised and lowered through the use of hydraulic lifts 20 or alternatively by means of electric winches (not shown) located just outside the basin walls. Once in place, the hole floor 16 is firmly secured to the

basin wall by use of la[illegible]s (not shown). A nest basin do[illegible]7 is opened to allow passengers entry into the basin and onto the gondola via door 18.

According to a further aspect of the present invention, the portions of the nest structure 1 surrounding the nest basin 2 may be developed into a building structure with rooms 21, 22, 23 for accommodating stores, kiosks, offices or other retail or commercial uses which complement the ballooning activity. In addition, the building may be provided with entry and exit means for passengers to access to the gondola in the nest.

THE EMBODIMENTS OF THE INVENTION IN WHICH AN EXCLUSIVE PROPERTY OR PRIVILEGE IS CLAIMED ARE DEFINED AS FOLLOWS:

1. A mooring facility for tethered gas balloon, comprising:
(a) a building structure containing a hemispherical basin capable of receiving a lower portion of a tethered gas balloon, the surface of said basin approximating the surface contour of the lower half of said balloon;
(b) a recessed portion centrally located at the lower part of said basin for accommodating a gondola suspended beneath said gas balloon in a moored position; and
(c) mooring means for securing the gas balloon in the moored position in said hemispherical basin with said gondola disposed in said recess.

2. A mooring facility according to claim 1, wherein the hemispherical basin is provided with means to cushion the surface of the balloon when in the moored position.

3. A mooring facility according to claim 2, wherein said cushioning means comprises a plurality of spaced apart horizontal inflated tubes to facilitate a snug fit of the balloon therein.

4. A mooring facility according to claim 3, wherein the upper tube is located proximal to the upper periphery of the hemispherical basin, and provides a weather-resistant and wind-proof seal between the balloon and the hemispherical basin to mitigate pressure surges from impinging on the lower surface of the balloon when moored.

5. A mooring facility according to claims 1, 2, 3 or 4, wherein annular cushioning means is disposed around the periphery of the bottom of the gondola to cushion the gondola upon ingress into the recessed portion and during subsequent mooring therein.

6. A mooring [illegible]lity according to any preceding c[illegible], wherein the building is provided with entry and exit means for passengers to access to the gondola in the nest.

7. A mooring facility according to any preceding claim, wherein at least a portion of the infrastructure surrounding the hemispherical basin constitutes a building with facilities for commercial activities, the hemispherical basin being disposed in the roof of said building.

8. A tethered gas balloon mooring facility, comprising an inflated, lighter than-air balloon suspended by a cable, a mooring facility as defined in any of claims 1 to 7, and means for raising and lowering the balloon between a moored position in which said balloon is moored in said mooring facility, and an elevated operating position.

ABSTRACT

A mooring facility for a tethered gas balloon comprises a building structure containing a hemispherical basin capable of receiving the lower portion of an inflated lighter-than-air gas balloon for mooring the balloon. The surface of the bowl structure is complementary to the surface contour of the lower portion of the balloon. A gondola is suspended beneath the balloon and occupies a central recess in the bowl structure when the balloon is moored. The balloon is tethered by a cable and can be raised and lowered between an elevated operating position and a lowered moored position. The facility avoids the need for a large space requirement and can be erected or installed in a built-up area in or adjacent to a town or city.

17 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

George C. Beck
Foley & Lardner
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109

In re Application of SEO, Yoon-Deuk et al. Application No.: 09/959,320 PCT No.: PCT/KR00/01430 Int. Filing Date: 08 December 2000 Priority Date: 23 February 2000 Attorney's Docket No.: 078134-0103 For: APPARATUS AND METHOD FOR RECORDING DIGITAL AUDIO DATA FILE	DECISION ON PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' response to Notification of Missing Requirements, filed 12 June 2002. Applicants' submission has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 08 December 2000, applicants filed international application PCT/KR00/01430. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 November 2001. As such, the deadline for entry into the national stage in the United States was 23 October 2001.

On 23 October 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 13 November 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 12 June 2002, applicants filed the instant response to the Notification of Missing Requirements accompanied by a declaration.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the

deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, Bong-Ja Choi signed the declaration for the deceased inventor. However, the declaration must list the citizenship, residence and postal address for both Bong-Ja Choi and inventor Seo and state the relationship of Bong-Ja Choi to the deceased inventor, e.g. "Legal representative of deceased inventor Yoon-Deuk Seo." See 37 CFR 1.497 and 37 CFR 1.63. The declaration only lists the information for either Bong-Ja Choi or inventor Seo, not both as required.

The surcharge for furnishing the oath or declaration later than twenty months from the priority date will be charged to deposit account no. 19-0741, as authorized by the transmittal letter.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

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

0 6 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

George C. Beck
Foley & Lardner
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109

In re Application of SEO, Yoon-Deuk et al. Application No.: 09/959,320 PCT No.: PCT/KR00/01430 Int. Filing Date: 08 December 2000 Priority Date: 23 February 2000 Attorney's Docket No.: 078134-0103 For: APPARATUS AND METHOD FOR RECORDING DIGITAL AUDIO DATA FILE	DECISION ON REQUEST UNDER 37 CFR 1.42

This decision is in response to applicants' "Transmittal of Renewed Submission Under 37 CFR 1.42," filed 17 September 2002.

BACKGROUND

On 08 December 2000, applicants filed international application PCT/KR00/01430. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 November 2001. As such, the deadline for entry into the national stage in the United States was 23 October 2001.

On 23 October 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 13 November 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 12 June 2002, applicants filed the instant response to the Notification of Missing Requirements accompanied by a declaration.

On 17 July 2002, the Office mailed Decision On Papers Under 37 CFR 1.42, refusing applicants' request.

On 17 September 2002, applicants filed the instant renewed submission.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

Previously, Bong-Ja Choi signed the declaration for the deceased inventor. However, the declaration must list the citizenship, residence and postal address for both Bong-Ja Choi and inventor Seo and state the relationship of Bong-Ja Choi to the deceased inventor, e.g. "Legal representative of deceased inventor Yoon-Deuk Seo." See 37 CFR 1.497 and 37 CFR 1.63. The declaration only listed the information for either Bong-Ja Choi or inventor Seo, not both as required.

The renewed submission includes a declaration that lists three people, namely inventor Yoon-Deuk Seo and Bum-Ho Seo and Bong-Ja Choi, each listed as legal representative. The new declaration is defective as it fails to list all of the inventors with their required information and the legal representatives with their required information. 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

2 8 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

George C. Beck
Foley & Lardner
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109

In re Application of SEO, Yoon-Deuk et al. Application No.: 09/959,320 PCT No.: PCT/KR00/01430 Int. Filing Date: 08 December 2000 Priority Date: 23 February 2000 Attorney's Docket No.: 078134-0103 For: APPARATUS AND METHOD FOR RECORDING DIGITAL AUDIO DATA FILE	DECISION ON REQUEST UNDER 37 CFR 1.42

This decision is in response to applicants' "Renewed Submission For Request Under 37 CFR 1.42," filed 06 February 2003.

BACKGROUND

On 08 December 2000, applicants filed international application PCT/KR00/01430. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 November 2001. As such, the deadline for entry into the national stage in the United States was 23 October 2001.

On 23 October 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 13 November 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 12 June 2002, applicants filed a response to the Notification of Missing Requirements accompanied by a declaration.

On 17 July 2002, the Office mailed Decision On Papers Under 37 CFR 1.42, refusing applicants' request.

On 17 September 2002, applicants filed a renewed submission.

On 06 December 2002, the Office mailed Decision On Request Under 37 CFR 1.42, dismissing applicants' request without prejudice.

On 06 February 2003, applicants submitted the instant renewed submission.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The 06 February 2003 declaration and the 12 June 2002 declaration taken together comply with 37 CFR 1.497(a)-(b) and 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **GRANTED**.

The application has an international filing date of 08 December 2000 under 35 U.S.C. §363 and a date of 06 February 2003 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of PCT Operations for continued processing.

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

JUN 28 2005

ADELMAN FRAYNE & SCHWAB
150 EAST 42ND STREET
NEW YORK, NY 10017

In re Application of	:
Luciano Zardi et al	:
Serial No.: 09/959,373	: PETITION DECISION
Filed: October 18, 2001	:
Attorney Docket No.: 205,359	:

This is in response to the petition under 37 CFR 1.181, filed April 5, 2005, requesting withdrawal of abandonment based on timely filing of a reply.

A review of the file history shows that the examiner mailed an Office action to applicants on June 6, 2004, setting a three month shortened statutory period for reply. Applicants replied on August 25, 2004. The examiner mailed an Advisory action to applicants on January 13, 2005, denying entry of the amendment. A Notice of Abandonment was then mailed to applicants on January 18, 2005. Applicants state that the Office action of June 6, 2004, was not considered to be a Final Office action.

A review of the Office action shows that the Office Action Summary indicates that the action is a non-Final Office action. A review of the written comments shows that the examiner made one or more new grounds of rejection in the Office action and then concluded by making the action Final in contrast to the Summary page indicating the action is non-Final. In instances where there is a discrepancy between the summary page and the written comments as to status of the Office action, the discrepancy must always be resolved in favor of the lesser status or requirement. It appears here that the examiner originally intended to make the Office action non-Final and changed her mind at the conclusion of her comments and inserted the text related to Final Office actions. In view of the discrepancy, the Office action mailed June 6, 2004, is designated a non-Final Office action and the timely reply thereto will be entered. The Advisory action and the Notice of Abandonment are withdrawn as having been improperly mailed and the application is restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

The application will be forwarded to the examiner for further consideration of the reply filed August 25, 2004.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

George C. Elliott
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DEC 28 2004

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON DC 20036

In re Application of	:
Malanie Brunner et al	:
Serial No.: 09/959,380	: SUSPENSION OF ACTION
Filed: October 24, 2001	:
Attorney Docket No.: 50054	:

This is in reply to the petition under 37 CFR 1.103 to suspend action on this application at applicant's request for a period of four months, filed December 2, 2004.

A review of the file history shows that applicants replied to the non-Final Office action mailed May 27, 2004, on November 29, 2004, including a request and fee for a three month extension of time. Applicants request that action on this application be suspended for four months in order to complete experiments demonstrating unexpected properties..

§ 1.103 Suspension of action by the Office.

(a) Suspension for cause . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
(1) A showing of good and sufficient cause for suspension of action; and
(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

It is noted that an unsigned one page letter was mailed to applicants on December 15, 2004, indicating the suspension was granted. This letter was improperly mailed. All suspensions of action must be approved by a Technology Center Director. The letter is, therefore, vacated.

Applicants' petition states that they are presently conducting experiments to support a contention of unexpected results and/or advantageous properties of the claimed compounds in order to overcome a rejection under 35 U.S.C. 103. Applicants state that this request is not for purposes of delay. However, applicants delayed replying to the last Office action to the maximum extent possible (six months) and provided a complete (in that all rejections are addressed), but abbreviated reply as to the merits of the patentability of the application. Further, no general description of the experiments being conducted is set forth nor any indication given when the experiments will be completed or results will be tabulated for presentation. No explanation is given as to why the experiments could not have been completed earlier.

In view of the above reason the petition is **DISMISSED**. Applicants may submit a renewed petition, if desired, addressing the deficiencies noted above. Any renewed petition must be submitted within TWO MONTHS of the mail date of this decision in order to be considered timely.

The application will be forwarded to the examiner for further consideration.

Applicants should note that the petition fee for suspension of action has been raised to $200.00 and this amount was charged to applicants' Deposit Account No., as directed.

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.

Bruce M. Kisliuk
Director, Technology Center 1600

DEC 1 4 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Anthony J. Zelano
MILLEN, WHITE, ZELANO AND BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201

In re Application of	:	
Michael John MORSER, et al.	:	
Application No.: 09/959,392	:	DECISION ON
PCT No.: PCT/EP99/03895	:	PETITION
Int. Filing Date: 04 June 1999	:	UNDER 37 CFR 1.137(b)
Priority Date: 05 June 1998	:	
Attorney Docket No.: BERLX 74 A	:	
For: CORIN, A SERINE PROTEASE	:	

The petition to revive under 37 CFR 1.137(b) filed 25 October 2001 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. 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" meets the requirements under 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the application papers filed with the petition reveals that an oath or declaration of the inventors has not been filed.

Applicants' claim for priority is acknowledged. The application has an international filing date of **04 June 1999** under 35 U.S.C. 363).

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing including the issuance of a Notification of Missing Requirements under 35

U.S.C. 371(c) and 37 CFR 1.495 (Form PCT/DO/ EO/905) to inform applicants that an oath or declaration of the inventors must be filed along with the surcharge under 37 CFR 1.492(e) for providing an oath or declaration after 30 months from the priority date in order to avoid abandonment of the application as to the national stage in the United States.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/RC:hn

Tel: (703) 308-6508

2 4 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

HERBERT B. WEIL
KEIL & WEINKAUF
1101 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

IN RE APPLICATION OF LUBISCH et al. Application No.: 09/959,404 PCT application no.: PCT/EP00/03967 International Filing Date: 03 May 2000 Priority Date: 11 May 1999 Attorney Docket No.:49988 Title: USE OF PHTHALAZINE DERIVATIVES	DECISION GRANTING PETITION TO RESET PERIOD FOR REPLY

This is a decision on the petition filed on 04 March 2002, requesting that the shortened statutory period for reply set forth in the Office communication mailed on 28 November 2001 be reset to run from the date on which the Office communication was actually received at the correspondence address of record.

The petition is **granted**.

Petitioner provided a statement that the Office communication in question was received at the correspondence address of record on February 21, 2002. The petition was filed within two weeks of receipt of the Office communication. The entire reply period set in the Office communication had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002 when delivery of mail from the Office to certain regions of the country was delayed.

Accordingly, the shortened statutory period that was originally set forth in the Office communication originally mailed on 28 November 2001 is hereby reset to run FROM THE RECEIPT DATE OF 21 FEBRUARY 2002.

Leonard Edwards

for Richard R. Cole
Legal Examiner
PCT Legal Office

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/RRC:cmk

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

Herbert B. Keil
KEIL & WEINKAUF
1101 Connecticut Avenue, NW
Washington, DC 20036

In re Application of:	:	
LUBISCH, et al.	:	COMMUNICATION
U.S. Application No.: 09/959,404	:	
PCT No.: PCT/EP00/03967	:	
International Filing Date: 03 May 2000	:	
Priority Date: 11 May 1999	:	
Attorney's Docket No.: 49988	:	
For: USE OF PHTHALAZINE DERIVATIVES	:	

In a decision mailed by this Office on 24 July 2002, the response period for the Notification Of Missing requirements originally mailed 28 November 2001 was reset to begin running from 21 February 2002.

On 02 July 2002, prior to the mailing of the decision resetting the response time, applicant filed a response to the Notification Of Missing Requirements (the response bears a 37 CFR 1.8 certification dated 26 June 2002). Because the decision resetting the response time had not yet been issued, applicants included with this response the fee for a five month extension of time (based on the original due date of 28 January 2002.

In light of the reset response time, an extension fee for a three month period is all that is required to make the 02 July 2002 filing timely. Accordingly, Deposit Account No. 11-0345 will be credited with a refund of $1,040, such being the difference between the fees for a three and five month extension. The declaration filed on 02 July 2002 is in compliance with 37 CFR 1.497, and the filing included the required surcharge for filing the declaration later than thirty months after the priority date.

The application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is **02 July 2002**.

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

wak

8/23/05

Mailed:

In re application of	:	
Ichiro Wada, et al.	:	DECISION ON
Serial No. 09/959,418	:	PETITION
Filed: October 26, 2001	:	
For: RUBBER COMPOSITION FOR INNER LINER	:	

This is a response to the PETITION UNDER RULE 181(a) TO WITHDRAW NOTICE OF ABANDONMENT, filed August 30, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment mailed August 16, 2004, be withdrawn since the applicant did not receive the Notice of Allowance mailed April 13, 2004.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, TMOG 1156 O.G. 53, November 16, 1993, (see also MPEP 711.03(c) - NEW PROCEDURE TMOG 1170 O.G. 114). A review of the petitioner's evidence indicates that the request has merit. The evidence presented is sufficient to establish that the applicant or any authorized representative of the applicant did not receive the Notice of Allowance mailed April 13, 2004. The evidence provided includes a statement by the petitioner that the Office letter mailed April 13, 2004 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 mailed April 13, 2004 was not received. Also provided is a copy of the attorney's application docket records where the Office letter mailed April 13, 2004 would have been posted had it been timely received.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the examiner for prompt remailing of the Notice of Allowance originally mailed April 13, 2004 and restarting of the period of response from the remail date thereof.

The Petition is **GRANTED**.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

L. Raul Tamayo
Sughrue Mion Zinn
Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington DC 20037-3202

GAU 1655
BOX SEQ

OIPE JC177
DEC 3 1 2001
PATENT & TRADEMARK OFFICE

BOX SEQUENCE
PATENT
1422-0504P

IN THE U.S. PATENT AND TRADEMARK OFFICE

RECEIVED
JAN 0 3 2001
TECH CENTER 1600

Applicant:	Tetsuya KAMATAKI	Conf.:	1795
Appl. No.:	09/959,433	Group:	1655
Filed:	October 25, 2001	Examiner:	C. Myers
For:	CYP2A6 GENE JUDGMENT METHODS		

LARGE ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents
Washington, DC 20231

December 31, 2001

Sir:

Transmitted herewith is a letter in the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

☐ The enclosed document is being transmitted via facsimile.

The fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	31	-	31	=	0	$ 18	$0.00
INDEPENDENT	6	-	6	=	0	$ 80	$0.00
__ FIRST PRESENTATION OF A MULTIPLE CLAIM						$270	$0.00
						TOTAL	$0.00

☐ Petition for ( ) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). $0.00 for the extension of time.

☒ No fee is required.

☐ A check in the amount of $0.00 is enclosed.

☐ Please charge Deposit Account No. 02-2448 in the amount of $0.00. This form is submitted in triplicate.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
Gerald M. Murphy, Jr., #28,977

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

GMM/LPS
1422-0504P

OIPE JC177
DEC 3 1 2001
PATENT & TRADEMARK OFFICE

#8
01-04-02
LN

BOX SEQUENCE
PATENT
1422-504P

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT(S): Tetsuya KAMATAKI

APPLICATION NO.: 09/959,433 GROUP: 1655

FILED: October 25, 2001 EXAMINER: C. Myers

FOR: CYP2A6 GENE JUDGMENT METHODS

RECEIVED
JAN 03 2001
TECH CENTER 1600/2900

LETTER

Honorable Commissioner of Patents
Washington, D.C. 20231

December 31, 2001

Sir:

Further to the Amendment and Substitute Sequence Listing filed on November 28, 2001, and in response to the Office communication of Examiner Carla J. Myers, dated December 13, 2001, the following remarks are respectfully submitted in connection with the above-identified application.

REMARKS

Submitted herewith in full compliance to 37 C.F.R. §§1.821-1.825 is a second disk copy of the Substitute Sequence Listing. The second disk copy of the Substitute Sequence Listing, file "1422-504P.st25.txt", is identical to the paper copy and disk copy, submitted November 28,

2001, except that it lacks formatting. As such, an additional paper copy is not believed to be necessary.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____

Gerald M. Murphy, Jr.
Reg. No. 28,977
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachments: Second Disk Copy of Substitute Sequence Listing
Copy of November 28, 2001 Postcard
Copy of December 13, 2001 Office Communication

GMM/LPS
1422-504P

Papers Filed herewith on: November 28, 2001 5

DOCKET NO.: 1422-504P ATTY.: GHM

APPLICANT(S): Tetsuya KAMATAKI

APPLN. NO: 09/959,433 FILED: October 25, 2001

PAT NO.:

- ☐ New Application with Transmittal Letter
- ☐ Utility ☐ Design ☐ CIP ☐ PCT ☐ Provisional
- ☐ Filing Under 37 CFR 1.53(b) ☐ CONT ☐ DIV
- ☐ Filing Under 37 CFR 1.53(d) (CPA)
- ☐ Filing Under 37 CFR 1.114(RCE)
- ☐ Specification Consisting of: _____ pages
- ☐ Combined Declaration & Power of Attorney
- ☐ Assignment / Cover Letter
- ☐ Letter to Official Draftsman
- ☐ Drawings ____ Sheets ☐ Formal ☐ Informal ☐ Red-Ink
- ☐ Completion of Filing Requirements, PCT/DO/EO/905 or Formalities Letter and Executed Declaration
- ☐ Priority Document(s) / Cover Letter, No. Doc. _____
- ☑ Amendment:
  - ☑ Transmtl Ltr ☑ Large Entity ☐ Small Entity
- ☐ Response
- ☐ Information Discl Stmnt, PTO-1449(s) _____ ref(s)
- ☐ Notice of Appeal ☐ Appeal Brief
- ☐ Issue Fee Transmittal
- ☐ FEES:
- ☐ Letter:
- ☑ Other: Paper Copy of Substitute Sequence Listing
  Disk Copy of Substitute Sequence Listing

O I P E JC111
NOV 28 2001
PATENT & TRADEMARK OFFICE

Receipt is hereby acknowledged of the papers filed as indicated in connection with the above identified case.
COMMISSIONER OF PATENTS AND TRADEMARKS

Due Date:

Handcarry:

DOCKET NO. 1422-504P

RECEIVED
JAN 03 2001
TECH CENTER 1600/2900

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/959,433	10/25/2001	Tetsuya Kamataki	1422-0504P	1795

2292 7590 12/13/2001
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
MYERS, CARLA J

ART UNIT	PAPER NUMBER
1655	5

DATE MAILED: 12/13/2001

OIPE JC177 DEC 3 1 2001 PATENT & TRADEMARK OFFICE

Docketed ES
1-12-02

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
JAN 0 3 2001
TECH CENTER 1600/2900

PTO-90C (Rev. 07-01)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

OIPE JC177
DEC 3 1 2001
PATENT & TRADEMARK OFFICE

EXAMINER	
ART UNIT	PAPER NUMBER
	5

Please find below a communication from the EXAMINER in charge of this application

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN 30 days FROM THE DATE OF THIS LETTER WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.R.F. §§ 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

Carla Myers
CARLA J. MYERS
PRIMARY EXAMINER

RECEIVED
JAN 0 3 2001
TECH CENTER 1600/2900

09/959,433

Application No.:

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s)

☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.

☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).

☐ 7. Other: _____

Applicant Must Provide:

☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".

☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216
For CRF Submission Help, call (703) 308-4212
For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections <u>within the time period set in the attached Office communication</u>. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JAN 30 2002

Robert J. Seas, Jr.
Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

In re Application of GUNALTUN Application No.: 09/959,437 PCT No.: PCT/FR00/00819 Int. Filing Date: 31 March 2000 Priority Date: 02 April 1999 Attorney Docket No.: Q66758 For: METHOD FOR INHIBITING CORROSION IN THE ARCH OF A PIPE CARRYING A MULTI-PHASE CORROSIVE LIQUID AND A SCRAPER FOR THE IMPLEMENTATION OF SAID LIQUID	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is in response to applicant's, "Petition to Revive Under 37 CFR § 1.137(b) and Payment of Fee Under 37 CFR § 1.17(m)" filed 25 October 2001. Applicant included the $1280.00 petition fee.

BACKGROUND

On 31 March 2000, applicant filed international application PCT/FR00/00819, which claimed priority of an earlier application filed 02 April 1999. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 02 October 2001.

On 03 October 2001, the application became abandoned for failure to pay the basic national fee for a U.S. national stage entry application.

On 25 October 2001, applicant filed the present petition accompanied by: a request to enter the National stage under 35 U.S.C. § 371; a check for $890.00 as payment for the basic national fee, a check for $1280.00 as payment of the petition fee under 37 CFR 1.17(m); an English translation of the International Application; two sheets of drawings; an English translation of the Article 34 Amendments and a First Preliminary Amendment.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the

grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was the payment of the basic national fee. Applicant has provided this payment along with the present petition.

As to Item (2), a check in the amount of the $1280.00 was included with the petition.

With regard to Item (3), applicant's statement that, "the abandonment was unintentional, and also states that the delay in prosecution was unintentional" is being interpreted to mean 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. If this is an incorrect reading of applicant's statement applicant should contact the PCT Legal Office immediately. Applicant's statement and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Applicant is still required to file an executed oath or declaration of the inventor.

CONCLUSION

For the reasons stated above, the petition for revival is **GRANTED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) for the reason stated above.

Boris Milef
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

MAY 17 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Wenderoth, Lind & Ponack LLP
2033 K Street NW
Suite 800
Washington, DC 20006-1021

In re Application of NAKAMUTA, Makoto, et al. Application No.: 09/959,441 PCT No.: PCT/JP00/02797 Int. Filing Date: 27 April 2000 Priority Date: 27 April 1999 Attorney's Docket No.: 2001-1600A For: AGENT FOR PROPHYLAXIS AND TREATMENT OF LIVER DISEASE	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicants' "Petition To Reset Period of Reply Due To Late Receipt of Notice of Missing Parts Under MPEP 710.06," filed with the Office on 08 February 2002. This has been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 27 April 2000, applicants filed international application PCT/JP00/02797, which claimed a priority date of 27 April 1999. A copy of the international application was transmitted to the United States Patent and Trademark Office (USPTO) on 02 November 2000. On 08 November 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 29 October 2001 (27 October 2001 was a Saturday).

On 25 October 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 06 December 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 08 February 2002, applicants filed the instant 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.

DISCUSSION

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)-(5) have been met. Applicants filed the petition on the day following the receipt of the communication. The entire two month period for reply had elapsed. Applicants have provided the communication with the law office's receipt stamp on it and state that the communication was received on that date. Finally, the petition is signed by a practitioner registered to practice before the Office.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.181 is **GRANTED**.

The period for reply is reset to begin on 07 February 2002.

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.

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

FISHER CHRISTEN & SABOL
1725 K STREET NW SUITE 1401
WASHINGTON, DC 20006

COPY MAILED
AUG 19 2004
OFFICE OF PETITIONS

In re Application of :
Kazuhiko Kasei, et al. :
Application No. 09/959,445 :
Filed: February 8, 2002 :
Attorney Docket No. KATA-172 :

ON PETITION

This is a decision on the petition, filed August 12, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on May 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.

The application is being referred to Technology Center AU 1755 for further processing of the request for continued examination under 37 CFR 1.114 filed August 12, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN VA 22102-3833

COPY MAILED

MAR 25 2008

OFFICE OF PETITIONS

In re Patent No. 6,999,290 :
Issue Date: February 14, 2006 :
Application No. 09/959,466 : ON PETITION
Filed: October 26, 2001 :
Attorney Docket No. XA-9565 :

This is a decision on the petition filed February 4, 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 Carl Friedman at (571) 272-6842. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Carl Friedman
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED
SEP 19 2006
OFFICE OF PETITIONS

DAVID A. LUNDY
KRIEG DEVAULT, LLP
ONE INDIANA SQUARE
SUITE 2800
INDIANAPOLIS, IN 46204

In re Application of	:	
Tabe	:	
Application No. 09/959,503	:	DECISION ON PETITION
Filed: October 18, 2001	:	TO WITHDRAW
Attorney Docket No. TABE-6	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 16, 2006

The request is **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, "termination of attorney/client relationship", does not meet any 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 April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: Joseph A. Tabe
11700 Old Columbia Pike
Apt. 717
Silver Spring, MD 20904

OIPE JC73
FEB 1 1 2005
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No: 38464-0011

In re patent application of: Confirmation No.: 2389

Gilles TRUAN et al.

Application No.: 09/959,519 Art Unit: 1639

Filed: March 14, 2002 Examiner: Wessendorf, Teresa D.

For: COMBINATORIAL LIBRARIES ENHANCED BY RECOMBINATION IN YEAST, AND ANALYTICAL METHOD

PETITION UNDER 37 CFR § 1.144 FROM RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit herewith a Petition Under 37 CFR § 1.144 from the restriction requirement mailed from the U.S. Patent and Trademark Office on July 14, 2004. Applicants respectfully submit that this Petition should be considered because reconsideration of the restriction requirement has already been properly requested under 37 CFR § 1.111 in Applicant's response filed September 29, 2004 and in Applicants' response filed herewith, in accordance with 37 CFR § 1.181 and MPEP § 818.03(c). Applicants hereby petition the Commissioner of the U.S. Patent and Trademark Office to review and set aside the restriction and species election requirements issued by the Examiner in the above-mentioned application on July 14, 2004. Applicants submit herewith a list of pending claims in Appendix A to which the restriction requirement pertains.

In the Restriction Requirement mailed July 17, 2004, the Examiner instructed the Applicants to elect one of the following groups for prosecution in this case:

Group I: Claims 1-16 and 28-29, drawn to a method for constructing a combinatorial expression library of nucleic acids and the library;

Group II: Claims 17-20, drawn to a method of producing active mosaic proteins and the protein obtained from said method;

Group III: Claims 21-22, drawn to a method for analyzing the combinatorial expression library;

Group IV: Claim 23, drawn to a method for determining links between sequence signatures and functional signatures of a protein;

Group V: Claim 24, drawn to a method for predicting structures which have a given function;

Group VI: Claims 25-26, drawn to a method for obtaining a protein having enhanced properties;

Group VII: Claim 27, drawn to a method for determining a protein structure in response to a selection pressure.

The Examiner further stated that the application has subject matter directed to the following patentably distinct species of the claimed invention and requests Applicants to elect one of them for examination purposes:

Claim 11: eukaryotic enzyme;

Claim 13: expression vector;

Claim 14: protein, *i.e.*, a species of the *e.g.*, phase II enzyme.

Finally, the Examiner stated that the following claims are considered generic: Claims 1, 17, 21, 23, 24, 25, and 27.

In the Notice of Non-Compliant Amendment mailed December 28, 2004, the Examiner stated that the Applicants' response filed September 29, 2004 was not fully responsive to the prior Office Action because Applicants' election of a eukaryotic enzyme as a species is not a proper species election. The Examiner stated that the eukaryotic enzyme is a genus, not a species. The Examiner also stated that in the previous Office Action of July 14, 2004, Applicants were requested to elect a single species from each of the different sub-groups. The Examiner reiterated the species/election requirement and subdivided it to clarify the species election as follows:

1. Eukaryotic enzyme as recited in claim 11 (the Examiner has noted that these subgroups of enzymes are actually part of a genus, not a species. Therefore, the Examiner has asked that Applicants elect a species of, e.g., phase II enzymes should this be the elected eukaryotic enzyme).

   a. eukaryotic cytochrome P450

   b. Phase II enzymes (a species, epoxide hydrolase, is given in claim 29)

   c. a single or species member of eukaryotic ABC transporter family

2. Expression vector, as recited in claim 13

a. eukaryotic cells, e.g., of a species are yeast or human and other mammalian cells

3. Genetic expression expressing the protein species recited in claim 14

a. endogenous P450 reductase

b. exogenous P450 reductase

c. andrenodoxin

d. andrenodoxin reductase

e. heterologous cytochrome b5

f. phase 11 enzyme (a species of this genus phase 11 enzyme is required for a proper election)

The Examiner has stated that Applicants must select one species from each of the subgroups A-C under 37 CR 1.111.

Applicants respectfully submit that in contrast to the Examiner's reasoning, claims 1-15 concern method claims that are applicable to a variety of products. Applicants further respectfully submit that the Examiner's attempt to divide the present application into every product for which the method is applicable is not an effective means of arguing that the methods of claims 1-15 are not in accordance with PCT Rule 13. Applicants note that under PCT Rule 13.1, the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Furthermore, under PCT Rule 13.2, the Examiner must consider the invention as a

whole. Applicants respectfully submit that the Examiner has given no real reason why no technical relationship may be found among the inventions that involves at least one common or corresponding special technical feature. Applicants respectfully submit that by ignoring the common feature of the present invention (i.e., the method of constructing a combinatorial functional expression library), the Examiner has failed to consider the invention as a whole and therefore has misapplied Rule 13.2.

Applicants hereby petition the Commissioner for the withdrawal of the restriction and election of species requirements. If the Commissioner is unwilling to set aside the restriction and species election requirements mailed July 4, 2004, Applicants urge that the restriction requirement at least be based upon different groups. For instance, Applicants respectfully submit that it is clear that the method of Group I is the central technical feature of the method of Group II.

Respectfully submitted,

Date: Feb 11, 2005

By Patricia D. Granados

Patricia D. Granados
Attorney for Applicant
Reg. No.: 33,683

HELLER EHRMAN WHITE &
MCAULIFFE LLP
1666 K Street, NW, Suite 300
Washington, D.C. 20006
Phone: (202) 912-2000
Fax: (202) 912-2020

Customer No. 26633

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Bradford G. Addison
Barnes & Thornburg
11 South Meridian Street
Indianapolis, Indiana 46204-7253

(Petitioner)

COPY MAILED

OCT 06 2004

OFFICE OF PETITIONS

In re Application of
Koji Sode
Application No. 09/959,549
Filed: January 18, 2000
For: GLUCOSE DEHYDROGENASE

: Decision
: On Petition
: Granting
: Access

A petition for access to entire contents of the above referenced application was filed by Bradford G. Addison on July 29, 2004, without proof of service on applicant. Accordingly, a copy of the petition is included with this decision.

The petition is **DISMISSED**.

The petition requests access to the above referenced application under 37 CFR 1.14(h) because it is the national stage application of PCT/JP00/02872 which was published as WO 00/66744. Petitioner states that 35 USC § 122 requires publication of the above referenced application based upon its origin from an application filed pursuant to a multilateral international agreement. Petitioner states that if the application had been published, the contents of the application file would be accessible to him. This apparently would constitute special circumstances to carry out an act of Congress as provided in 37 CFR 1.14(h).

Section 4502 of the American Inventors Protection Act of 1999 (P.L. 106-113) which amended 35 USC § 122 to provide for publication of patent applications limited its scope in § 4508, to applications filed on or after November 29, 2000. The above referenced application was filed (the international filing date) January 18, 2000. The date of entry into the national stage is not a filing date. Hence the filing date is prior to the effective date of the AIPA changes to § 122 and the above referenced application is not subject to publication.

Since the above referenced application is a pending application, access cannot be obtained under 37 CFR 1.14(a)(1)(iv). Access under 37 CFR 1.14(a)(1)(vi) is limited to the application as filed, not the entire contents of the application as requested in the petition.

Telephone inquiries should be directed to Michael L. Lewis at (703) 306-5585.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Petition

cc: BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

(Applicant)

27 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

In re Application of TAKASAKI Application No.: 09/959,563 PCT No.: PCT/JP00/02630 Int. Filing Date: 21 April 2000 Priority Date: 30 April 1999 Attorney Docket No.: 2001-1634A For: HEAT-RESISTANT MANNOSE ISOMERASE, PROCESS FOR PRODUCING THE SAME AND PROCESS FOR PRODUCING MANNOSE BY USING THE SAME	DECISION

This is a decision on applicant's "Response to Notification of Defective Response" filed in the United States Patent and Trademark Office (USPTO) in the above referenced application on 29 April 2002. No petition fee is required.

BACKGROUND

On 21 April 2000, applicant filed international application No. PCT/JP00/02630 which claimed a priority date of 30 April 1999, and which designated the United States.

On 22 November 2000, a Demand was filed with an International Preliminary Examining Authority. Since the election was made prior to the expiration of 19 months from the priority date, the deadline for entry into the national stage in the U.S. expired 30 months from the priority date, i.e. 30 October 2001.

On 30 October 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: the basic national fee and an unexecuted declaration.

On 21 November 2001, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant 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.

On 13 March 2002, applicant submitted a Response, including the surcharge and a declaration executed by sole inventor, Yoshiyuki Takasaki. However, Mr. Takasaki's name differed from the surname as listed on the published international application, where it appeared as "Takahashi".

On 27 March 2002, a Notification of Defective Response was mailed to applicant indicating, in pertinent part, that "the last name of the inventor is different on the declaration, than on the International Application" and requesting clarification.

On 29 April 2002, applicant responded to the request for clarification with a copy of the request for correction of the inventor's name (with an English translation) along with a copy of the PCT/RO/109 (with English translation) issued on 7 November 2000, which corrected the inventor's surname from Takahashi to Takasaki. In light of this correction, the executed declaration, filed in the USPTO on 13 March 2002, is acceptable.

CONCLUSION

For the reasons indicated above, applicant's Response to Notification of Defective Response is

The application will be forwarded to the U.S. Designated/Elected Office for further processing. The 35 U.S.C. 371 date is **13 March 2002.**

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/cmk
Telephone: (703) 306-5467

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DATE: June 6, 2005
TO: Certificates of Correction Branch
FROM: Monica S. Carter
Acting SPE, Art Unit 3749
SUBJECT: REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 6,803,390 as specified on the attached Certificate.

Monica S. Carter

Monica S. Carter, Acting SPE
Art Unit 3749

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE

Patent No. 6,803,390
Patented: 10/26/04

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Paul Y.H. Fung
Adrian Isaac De Vos
Velauthapillai Muruganathan
Hoc Soo Ng

Monica S. Carter
Acting Supervisory Patent Examiner
Art Unit 3722

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Jan. 12, 2005

TO SPE OF : ART UNIT 3749

SUBJECT : Request for Certificate of Correction on Patent No.: 6,808,390

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 code PET– should the inventors 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:

_____

_____

_____

_____

_____

Monica D Carter — Acting **SPE**

3749 — **Art Unit**

JAN 1 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

In re Application of RIONDEL et al. Serial No.: 09/959,623 PCT No.: PCT/FR01/00180 Int. Filing Date: 19 January 2001 Priority Date: 24 January 2000 Attorney's Docket No.: CHAIL 33 For: NOVEL MONOMERS WITH QUATERNARY AMINO GROUPS, METHOD FOR MAKING SAME, AND NOVEL (CO)POLYMERS OBTAINED FROM SAID NOVEL MONOMERS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 01 November 2001 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).

A review of the application file reveals that the basic national fee of $890 and the required petition fee of $1280 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 the issuance of a Notification of Missing Requirements indicating that an oath or declaration executed by the inventor, the surcharge for filing the oath or declaration and the processing fee for filing the English translation of the international application after the twenty month period is required.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone: (703) 306-5467

JAN 1 5 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of
JOFUKU, Diane K.
U.S. Application No.: 09/959,625
PCT No.: PCT/US00/04718
Int. Filing Date: 25 February 2000
Priority Date: 25 February 1999
Attorney Docket No.: 2750-0197P
For: NOVEL ADC POLYNUCLEOTIDES AND POLYPEPTIDES . . .

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

The "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)" filed 01 November 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's 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" satisfies the requirements of 37 CFR § 1.137(b)(3). The basic national fee, extra claim fees, independent claim fee, petition fee, and the surcharge fee for a small entity have been submitted with the national stage papers. A terminal disclaimer is not required. Therefore, all requirements of 37 CFR 1.137(b) have been completed.

A signed oath or declaration in compliance with 37 CFR 1.497(a) and (b) was not included with any of the papers submitted on 01 November 2001.

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) 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

D'vorah Graeser
G.E. Ehrlich (1995) Ltd.
C/o Anthony Castorina
2001 Jefferson Davis Highway
Suite 207
Arlington, VA 22202

In re Application of	:	
Pecker et al.	:	
Serial No. 09/959643	:	Decision on Petition
Filed : 2 November 2001	:	
Attorney Docket No. 01/22693	:	

This letter is in response to the Petition under 37 C.F.R. 1.84, filed 20 December 2004, requesting acceptance of color drawings/photographs.

DISCUSSION

Applicants petition to have color drawings accepted and entered into the instant application and provide 1) the fee set forth in 37 C.F.R. 1.17(h) and 2) three sets of color drawings. Although applicants request amending the specification to comply with the third requirement under 37 C.F.R. 1.84(a)(2)(iii), said proposed amendment does not comply with 37 C.F.R. 1.121(h) that requires the amendment to the specification to be presented on a separate sheet.

DECISION

For all of the above reason, the Petition, requesting acceptance of color drawings/photographs, is **denied.**

Andrew Wang
Supervisory Patent Examiner 1639

ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

DT06 Rec'd PCT/PTO 1 DEC 2002

PCT

OIPE JC184
DEC 17 2002
PATENT & TRADEMARK OFFICE

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q66884

Masayuki NAYA, et al.

Appln. No.: 09/959,645

Group Art Unit: NOT YET ASSIGNED

Confirmation No.: 3926

Examiner: NOT YET ASSIGNED

Filed: November 02, 2001

For: MEASURING METHOD AND APPARATUS USING ATTENUATION IN TOTAL REFLECTION

PETITION TO WITHDRAW A HOLDING OF ABANDONMENT AND PETITION TO REVIVE ABANDONED APPLICATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

The undersigned, on behalf of Applicants, petitions the Commissioner to withdraw a holding of abandonment of the above identified application. The application was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS, mailed January 11, 2002, within the time period set therein. However, the required documents were in fact filed in the U.S. Patent and Trademark Office within the required time period, but have evidently been misplaced by the PTO.

Submitted herewith are the following documents:

1. Notification of Missing Requirements Under 35 U.S.C. § 371 mailed January 11, 2002;
2. Response to Notification of Missing Requirements Under 35 U.S.C. § 371 filed January 16, 2002;
3. Executed Declaration and Power of Attorney document filed January 16, 2002;

4. Executed Assignment document filed January 16, 2002, and copy of the Notice of Recordation of Assignment document, recorded January 16, 2002, as received from the U.S. Patent and Trademark Office;
5. Stamp and Return Receipt bearing PTO mail room stamp of January 16, 2002 and identifying the above listed papers as filed on that date; and
6. Notice of Abandonment.

From documents 1-5 it is clear that this firm, representing Applicants, duly filed a Response to the Notification of Missing Requirements Under 35 U.S.C. § 371 with the PTO on January 16, 2002, well within the response time period.

In view of the above, it is respectfully submitted that the application should not have been abandoned and the Commissioner is petitioned to withdraw the holding of abandonment.

In addition, the undersigned petitions the Commissioner to revive the above application, as all required documents were filed in the U.S.P.T.O. within the required time period.

Respectfully submitted,

Paul F. Neils
Registration No. 33,102

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: December 17, 2002

Attorney Docket No.: Q66884

11 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

Darryl Mexic
SUGHRUE, MION, P.L.L.C.
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

In re Application of
NAYA, Masayuki *et al*
Application No.: 09/959,645
PCT No.: PCT/JP01/01998
Int. Filing Date: 14 March 2001
Priority Date: 16 March 2000
Attorney's Docket No.: Q66884
For: MEASURING METHOD AND APPARATUS USING ATTENUATION IN TOTAL REFLECTION

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

The decision is in response to the documents filed on 17 December 2002 and again via facsimile on 09 May 2003 which have been treated as a petition to withdraw holding of abandonment. No fee is required.

BACKGROUND

On 11 January 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. A two-month time period for response was set.

On 16 January 2002, applicants purportedly filed a response which contained an executed declaration and a check for the $65.00 surcharge fee.

On 03 December 2003, 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 Form PCT/DO/EO/905 within the time period set.

On 17 December 2002, applicants filed the instant petition which was accompanied by, *inter alia*, copies of the documents purportedly filed 16 January 2002 and a stamped postcard receipt for the 16 January 2002 documents.

On 09 May 2003, applicants resubmitted the instant petition which was accompanied by, *inter alia*, copies of the documents purportedly filed 16 January 2002, a stamped postcard receipt for the 16 January 2002 documents and a stamped postcard receipt for the 17 December 2002 petition.

DISCUSSION

MPEP § 503 lists procedures 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 this case, applicants have provided a copy of the date-stamped filing receipt for documents submitted 16 January 2002. The filing receipt records that an "executed Declaration and Power of Attorney" were received in the USPTO. The filing receipt is stamped "OIPE JC17 JAN 16 2002" across its face. The U.S. application number, title and name of the applicants are all listed on the postcard receipt. Moreover, a review of USPTO financial records show that a $130.00 surcharge fee and $40.00 assignment fee were received in the above-identified application on 16 January 2002.

Accordingly, applicants have provided *prima facie* evidence that the declaration was received by the USPTO on 16 January 2002.

DECISION

For the reasons above, applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 03 December 2003 is hereby **VACATED**.

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 14 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **16 January 2002.**

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 07/27/05

TO SPE OF : ART UNIT 1756

SUBJECT : Request for Certificate of Correction on Patent No.: 09/959646 6773868

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

BEST AVAILABLE COPY

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

SPE — **Art Unit** 1756

15 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Burton A. Amernick
Connelly Bove Lodge & Hutz LLP
1990 M Street, N.W.
Washington, D.C. 20036

In re Application of MARUSIC-ISTUK et al. Serial No.: 09/959,662 PCT No.: PCT/HR00/00013 Int. Filing Date: 02 May 2000 Priority Date: 03 May 1999 Atty. Docket No.: 21486/0523 For: HALO DERIVATIVES OF 9a-N-(N'-Arylcarbamoyl)-and 9a-N-(N'-Arylthiocarbamoyl)-9-Deoxo-9a-AZA . . .	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicants' "PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE NOTICE TO FILE MISSING PARTS" filed in the United States Patent and Trademark Office on 13 December 2002.

BACKGROUND

On 02 May 2000, applicants filed international application no. PCT/HR00/00013 which claimed a priority date of 03 May 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 November 2000. A proper Demand was filed with the International Preliminary Examining Authority. As a result, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 03 November 2001.

On 02 November 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; a copy of the international application; and a first preliminary amendment.

On 26 November 2001, the United Stated Designated/Elected Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 18 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 26 November 2001 within the time period set therein.

On 13 December 2002, applicants filed present petition accompanied by a copy of the docket record.

DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 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 record must also be referenced in practitioner's statement).

Applicant's petition filed 13 December 2002 satisfies items (1) and (2) above.

However, as to item (3) applicants have provided a copy of the docket record which purportedly shows where the paper would have been entered had it been received. The printout of the docket report for this specific application is not sufficient to establish that the Notification of Missing Requirements was not received and misdocketed to another application. Accordingly, applicant is required to provide docket records for 26 January 2002, indicating all applications for which a response was due on said date.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

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.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

17 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#9

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Burton A. Amernick
Connelly Bove Lodge & Hutz LLP
1990 M Street, N.W.
Washington, D.C. 20036

In re Application of	:	
MARUSIC-ISTUK et al.	:	
Serial No.: 09/959,662	:	
PCT No.: PCT/HR00/00013	:	DECISION ON PETITION
Int. Filing Date: 02 May 2000	:	UNDER 37 CFR 1.181
Priority Date: 03 May 1999	:	
Atty. Docket No.: 21486/0523	:	
For: HALO DERIVATIVES OF 9a-N-(N'-	:	
Arylcarbamoyl)-and 9a-N-(N'-	:	
Arylthiocarbamoyl)-9-Deoxo-9a-AZA .	:	
. . .		

This is a decision on applicants' "Renewed Petition under 37 CFR 1.181" filed in the United States Patent and Trademark Office on 17 March 2003.

BACKGROUND

On 02 May 2000, applicants filed international application no. PCT/HR00/00013 which claimed a priority date of 03 May 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 November 2000. A Demand was filed with the International Preliminary Examining Authority. As a result, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 03 November 2001.

On 02 November 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; a copy of the international application; and a first preliminary amendment.

On 26 November 2001, the United Stated Designated/Elected Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 18 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 26 November 2001 within the time period set therein.

On 13 December 2002, applicants filed a petition under 37 CFR 1.181. In a decision dated 15 January 2003, applicants' petition to withdraw the holding of abandonment was dismissed without prejudice.

On 17 March 2003, applicants filed the present petition accompanied by a copy of the docket record for 26 January 2002.

DISCUSSION

With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 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 record must also be referenced in practitioner's statement). The 15 January 2003 decision indicated that applicant satisfied requirements (1) and (2) above.

As to Item (3), applicants have submitted "a copy of the docket records for 26 January 2002, indicating all applications for which a response was due on said date." Therefore, since applicants have satisfied Items (1), (2), and (3) above, the request may be properly granted.

CONCLUSION

For the reasons above, the request is **GRANTED**. The holding of Abandonment is withdrawn.

This application is being returned to the DO/EO/US for processing in accordance with this decision, that is, for issuance of a new Notification of Missing Requirements (Form PCT/DO/EO/905), to inform applicants that an oath or declaration of the inventors in compliance with 37 CFR 1.497 along with a $130.00 surcharge for the filing of an oath or declaration later than thirty months must be submitted in order to avoid abandonment of the application.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 13

DOUGHERTY CLEMENTS & HOFER
THE ROXBOROUGH BUILDING
1901 ROXBOROUGH ROAD
SUITE 300
CHARLOTTE, NC 28211

COPY MAILED

NOV 1 4 2003

OFFICE OF PETITIONS

In re Application of :
Hirotaka Kawai, et al. :
Application No. 09/959,671 : ON PETITION
Filed: January 2, 2002 :
Attorney Docket No. 3250 :

This is a decision on the petition, filed October 6, 2003, 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 30, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. A Notice of Abandonment was mailed on April 30, 2003. On October 6, 2003, an amendment and the present petition were filed.

The petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9220. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center2872 for consideration of the amendment filed October 6, 2003.

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

DOUGHERTY CLEMENTS & HOFER
THE ROXBOROUGH BUILDING
1901 ROXBOROUGH ROAD, SUITE 300
CHARLOTTE, NC 28211

COPY MAILED
SEP 26 2006
OFFICE OF PETITIONS

In re Application of	:
Hirotaka Kawai et al	: DECISION ON PETITION
Application No. 09/959,671	: UNDER 37 CFR 1.137(b)
Filed: January 2, 2002	:
Attorney Docket No. 3250	:

This is a decision on the petition under 37 CFR 1.137(b), filed August 8, 2006, to revive the above-identified application.

The petition is **granted**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed January 16, 2004, which set a shortened statutory period for reply of three (3) months. A two month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on June 17, 2004. A Notice of Abandonment was mailed on January 21, 2005.

The petition satisfies the requirements for a grantable petition in that the reply, the petition fee of $1,500, and the required statement of unintentional delay have been submitted. Accordingly, the reply to the final Office action of January 16, 2004 is accepted as having been unintentionally delayed.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2872 for processing the Request for Continued Examination and for appropriate action in the normal course of business on the submission under 37 CFR 1.114.

Frances Hicks
Petitions Examiner
Office of Petitions

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

20 JUN 2002

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Wenderoth, Lind & Ponack, LLP
2033 K Street, NW, Suite 800
Washington, DC 20006-1021

In re Application of	:	
Maekawa et al.	:	
Application No.: 09/959,726	:	DECISION
PCT No.: PCT/JP00/02907	:	
Int. Filing Date: 02 May 2000	:	UNDER
Priority Date: 06 May 1999	:	
Attorney Docket No.: 20001_1654A	:	37 CFR 1.182
For: Apparatus For Oxidatively Destructing	:	
Trace Injurious Substance	:	

This is a decision on applicants' "Reply To Notification Of Missing Requirements Under 35 U.S.C. 371" filed on 04 April 2002, which is being treated under 37 CFR 1.182.

BACKGROUND

This international application was filed on 02 May 2000 and claimed a priority date of 06 May 1999. The International Bureau transmitted a copy of the published international application to the USPTO on 16 November 2000. A Demand electing the United States was filed on 29 November 2000, which was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 06 November 2001.

On 06 November 2001, applicants filed *inter alia* the basic national fee and an unsigned declaration. The declaration named an inventor (Denpei Ma) who was also named in the published international application, but was not named in a signed declaration filed on 04 April 2002. The signed declaration named an inventor (Chuanping Feng) who was not named in either the published international application or in the earlier-filed unsigned declaration.

DISCUSSION

Applicants argue that the name of the inventor, Denpei Ma, named in the international application, was incorrect due to a transliteration error; it is urged that the inventor's correct name is Chuanping Feng. In that this is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve this matter. Such a petition must be accompanied by the $130.00 petition fee and by verified statements by the inventor and any other individuals having first-hand knowledge of the error. These statements must set forth in detail the specific circumstances as to how and when the error was made and discovered, and must also state (if appropriate) that the mistake was an inadvertent error made without deceptive intent.

CONCLUSION

The request 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. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Petition Under 37 CFR 1.182" and be accompanied by the required petition fee and an acceptable explanation of the facts as discussed above. 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 Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter 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: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

19 DEC 2002

#6

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Wenderoth, Lind & Ponack, LLP
2033 K Street, NW, Suite 800
Washington, DC 20006-1021

In re Application of Maekawa et al. Application No.: 09/959,726 PCT No.: PCT/JP00/02907 Int. Filing Date: 02 May 2000 Priority Date: 06 May 1999 Attorney Docket No.: 20001_1654A For: Apparatus For Oxidatively Destructing Trace Injurious Substance	DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on applicants' "Petition Under 37 CFR 1.182" filed on 20 August 2002.

The instant petition contends that inventor Chuanping Feng named in the executed declaration filed on 04 April 2002 is the same person as inventor Denpei Ma named in the published international application and in the unsigned declaration filed on 06 November 2001. The petition is accompanied by a statement by Mr. Chuanping Feng indicating that he is an inventor of this international application, that his name was mistranslated as "Denpei Ma" at the time the international application was filed, that this mistranslated name refers to him, and that the inadvertent error was made without deceptive intent. The petition is also accompanied by Mr. Toshio Nishizawa, a Japanese patent attorney who prepared the international application papers for filing. Mr. Nishizawa states that at that time he incorrectly mis-transliterated the name of Chuanping Feng as "Denpei Ma," that he discovered this error in the process of obtaining execution of the declaration, and that the error was made without deceptive intent. Based on the totality of the evidence of record, it would be appropriate to accept the declaration filed on 04 April 2002, which names Chuanping Feng as an inventor.

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of this application under 35 U.S.C. 371 is **04 April 2002**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Mailed: MAY 11 2004

rvk
Paper Number: 9

In re application of
Masaki Hayashi et al
Serial No. 09/959,754
Filed: November 06, 2001
For: ALKOXYAMINES CONTAINING A VINYL GROUP, THEIR APPLICATIONS AND METHODS OF THEIR PRODUCTION

DECISION ON PETITION

This is a response to the REQUEST TO WITHDRAW NOTICE OF ABANDONMENT (MAILED TO WRONG ADDRESS), filed October 22, 2003. The petition requests that the abandonment, as set forth in the Notice of Abandonment of July 02, 2003, for failure to timely file a proper response to the Office letter dated December 11, 2002 be withdrawn. The requester asserts that the Office letter of December 11, 2002 was not received by applicants.

DECISION

The instant request is accepted as a 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 December 11, 2002 was not received by petitioner. The evidence provided includes a statement by the requester that the Office letter of December 11, 2002 was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Office letter of December 11, 2002 was not received. Also provided is a copy of the attorney's application docket records where the Office letter of December 11, 2002 would have been posted had it been timely received. A review of the instant application file indicates that the USPTO records had an incorrect correspondence address for the instant application and the Office letter of December 11, 2002 was mailed to the incorrect correspondence address.

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 correct correspondence address and restarting of the statutory period of response from the remail date thereof.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

WENDEROTH LIND & PONACK, L.L.P.
2033 K STREET, N.W., SUITE 800
WASHINGTON,D.C. 20006-1021

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BARNES & THORNBURG LLP
750-17TH STREET NW
SUITE 900
WASHINGTON DC 20006-4675

COPY MAILED

OCT 04 2007

OFFICE OF PETITIONS

In re Patent No. 6,756,790	:	
Issue Date: June 29, 2004	:	
Application No. 09/959,759	:	DECISION ON PETITION
Filed: December 3, 2001	:	
Attorney Docket No. 35640/36251	:	

This is a decision on the petition under 37 CFR 1.182, filed February 28, 2007, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Publishing Division is directed to issue a duplicate Letters Patent.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. Inquiries regarding the issuance of a duplicate Letters Patent may be directed Krystal Paige in the Publishing Division at (703) 308-9250, Ext. 139.

A copy of this decision is being faxed to Publishing Division for issuance of the duplicate Letters Patent.

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor (Fax No. (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

JUN 15 2004

Paper No. 11

In re Application of
Odd-Harry Mikkelsen *et al*
Application No. 09/959,789
Filed: December 12, 2001
Attorney Docket No. HAMSO

: DECISION ON PETITION

This is a decision on the petition filed on April 20, 2004 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 final Office action dated September 15, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioners allege that the application is not abandoned because a reply to the Office letter in question was actually filed December 4, 2003. Petitioners have supported this allegation by furnishing a copy of the reply and a copy of a filing receipt for the reply which shows that the reply was in fact received in the Office on December 4, 2003, a date within the period set for filing a reply to the Office letter in question. 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 Head Supervisory Applications Examiner for entry of the reply filed on December 4, 2003. Thereafter, the application will be forwarded to the examiner for appropriate action.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

James C. Wray
Suite 300
1493 Chain Bridge Road
McLean, VA 22101

UNITED STATES 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 23 2006
OFFICE OF PETITIONS

James Wray
Suite 300
1493 Chain Bridge Road
McLean Va 22101

In re Application of
Mikkelsen et al.
Application No. 09/959,789
Filed: December 12, 2001

: DECISION GRANTING PTA REQUEST

This decision is in response to Applicants' "APPLICATION FOR PATENT TERM ADJUSTMENT" filed on February 22, 2006 requesting that the Patent Term Adjustment be adjusted to account for the period when applicant was improperly held to be abandoned.

Applicants' request is **GRANTED.**

Applicants assert that applicants' responded to the September 5, 2003 Office action on December 4, 2003. Applicants further assert that the application was improperly held abandoned and that the applicants were granted a withdrawal of the holding of abandonment. Applicants assert that they are entitled to PTA time for the administrative delay.

The Office has reviewed the PTA determination and finds applicants arguments persuasive to the extent herein described. The application file reflects that applicants did file a response to the September 5, 2003 Office action on December 4, 2003. Since applicants properly responded to the Office action (9/5/2003) within three months, applicants met the requirement of 37 CFR 1.704(b). However, the Office did not reply to applicants'(12/4/2003) correct date of response until December 27, 2005. Accordingly, the Office delayed under 37 CFR 1.702(a)(2) by a period of 632 days.[1] Applicants did not fail to engage in any unreasonable efforts to conclude prosecution of the application. Accordingly, the correct PTA at the time of the mailing of the notice of allowance is 632 (632-0=632) days.

After the mailing of this Office action, the Office will forward such application to the Office of Patent Publication for a prompt issuance of the patent. Any delays in not issuing the patent within four months of the payment of the issue fee under 37 CFR 1.704(a)(4) or not issuing the application within three years of the filing of the application under 37 CFR 1.704(b) will be

[1]The delay began on April 5, 2004 and ended on December 27, 2005.

reflected in the issue notification letter that is mailed to applicants approximately three weeks prior to issuance of the patent.

The Office has assessed the $200.00 fee to Deposit account 02-3704. Authorization for permission to assess such fees was granted by a telephonic call between Kery Fries and the James ray Office. No additional fees are required.

Any questions concerning this determination should be directed to Kery Fries, Senior Legal Advisor, at 571-272-7757.

Kery Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Adm.
Office of Deputy Commissioner
for Patent Examination Policy

cc: Adjusted PAIR calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

COPY MAILED

AUG 16 2005

OFFICE OF PETITIONS

In re Application of	:	
Stephen Franks, et al.	:	
Application No. 09/959,799	:	ON PETITION
Filed: February 28, 2002	:	
Attorney Docket No. FRANKS=1	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 24, 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 August 31, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned at midnight on December 1, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 1600, Art Unit 1647 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

COPY MAILED

APR 0 6 2009

OFFICE OF PETITIONS

In re Application of	:	
Mitsuru **MATSUI, et al.**	:	
Application No. 09/959,853	:	DECISION GRANTING PETITION
Filed: January 8, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **2565-0240 P**	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 31, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). *See* 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on March 26, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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 Mr. Jason Rhodes 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).

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2435 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/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.*

Docket No.: 2565-0240P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Mitsuru MATSUI et al.	Allowed: December 31, 2008
Application No.: 09/959,853	Confirmation No.: 5673
Filed: January 8, 2002	Art Unit: 2435
For: BLOCK CIPHER APPARATUS USING AUXILLARY TRANSFORMATION	Examiner: E. Zee

PETITION TO WITHDRAW APPLICATION FROM ISSUE PURSUANT TO 37 CFR 1.313 (c) (1-3)

MS Post Issue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

Petitioner hereby petitions the Commissioner to withdraw the above-identified application from issue. The Issue Fee in this application was timely paid on March 26, 2009.

It is requested that the above-mentioned application be withdrawn from Issue for the following reason:

☐ Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable (37 C.F.R. § 1.313(c)(1));

☒ Consideration of a request for continued examination in compliance with § 1.114 (37 C.F.R. § 1.313(c)(2)); or

04/06/2009 CKHLOK 00000005 022448 09959853
01 FC:1464 130.00 DA

☐ Express abandonment of the application. Such express abandonment may be in favor of a continuing application (37 C.F.R. § 1.313(c)(3)).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: March 31, 2009

Respectfully submitted,

By Jam Rhl #47,305

for D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

UNITED STATES 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

JAN 0 4 2007

OFFICE OF PETITIONS

In re Patent of	:	
Wu et al.	:	
Application Number: 09/959,882	:	DECISION ON PETITION
Patent: 6,849,185	:	
Filing Date: January 29, 2002	:	
Issue Date: February 1, 2005	:	

This is a decision on the petition to correct the name of the assignee under 37 CFR 1.323 filed on October 17, 2006. The petition is properly treated under 37 CFR 3.81 (b)[1] to add the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **Granted**.

This application is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

---

[1]See 69 Fed. Reg. 29865 (May 26, 2004).

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 2023

September 24, 2003

David G. Beck
Bingharm McCutchen
Three Embarcadero Center, 18th Floor
San Francisco, CA 94111

In re application of:
Pedersen et al DECISION ON PETITION
Serial No.: 09/960,018
Filed: September 20, 2001
For: HEARING AID WITH ADAPTIVE MICROPHONE MATCHING

This is a decision on the petition received by fax on July 16, 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 corrective Notice to File Missing Parts mailed on March 26, 2002. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned May 27, 2002.

On July 16, 2003, the office received a communication from the applicant of record. Enclosed was an acknowledgement that the attorney received copies of the Notice to File Missing Parts mailed December 21, 2001 from the previous law firm.

A new Notice of Missing Parts was issued March 26, 2002 with the wrong correspondence address.

The petition is hereby Granted.

A new Notice to File Missing Part is enclosed with this petition giving counsel two months from the date of the notice to respond.

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 Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination