UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

Mr. Eric S. Chen
PILLSBURY MADISON & SUTRO LLP
Suite 2800
725 South Figueroa Street
Los Angeles, CA 90017

COPY MAILED

JUN 0 6 2002

OFFICE OF PETITIONS

In re Application of :
Egan, et al. :
Application No. 10/080,694 : DECISION GRANTING STATUS
Filed: February 22, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No. PW 71525 277201:
For: REMOTE COUNTING DEVICE FOR A :
PRINTING SYSTEM :

This is in response to the petition under 37 CFR 1.47(a), filed May 17, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Elizabeth Fitzgerald has refused to join in the filing of the above-identified application after having been presented with the application papers.

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

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

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

As per the authorization contained in the application transmittal letter, the required surcharge of $130.00 has been charged to deposit account No. 03-3975.

Telephone inquiries related to this decision may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

E. Shirene Willis

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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ELIZABETH FITZGERALD
21601 ERWIN STREET, #290
WOODLAND HILLS, CA 91367

In re Application of
Egan, et al.
Application No. 10/080,694
Filed: February 22, 2002
Atty. Dkt. No. PW 71525 277201
For: REMOTE COUNTING DEVICE FOR A PRINTING SYSTEM

LETTER

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JUN 0 6 2002

OFFICE OF PETITIONS

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).

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

CC: Mr. Eric S. Chen
PILLSBURY MADISON & SUTRO LLP
Suite 2800
725 South Figueroa Street
Los Angeles, CA 90017

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DFW May-05

JOHN A. HANKINS
MCDERMOTT, WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

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**MAY 2 7 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,785,632 | : | |
| Issued: 31 August, 2004 | : | |
| Application No. 10/080,696 | : | ON PETITION |
| Filed: 25 February, 2002 | : | |
| Atty Docket No. 50103-422 | : | |

This is a decision on the petition filed on 12 January, 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

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

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APR 2 8 2006

OFFICE OF PETITIONS

In re Application of
Alan Colman et al
Application No. 10/080,713
Filed: February 25, 2002
Attorney Docket No. 1966.0020003

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 28, 2005.

The petition is **NOT APPROVED**.

A review of the file record indicates that no power of attorney was ever submitted for the above application. A power of attorney in a patent application (e.g. 09/475,674) does not carry over to a child application. Therefore, Eric K. Steffe does 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.

All future communications from the Office will continue to be directed to the address currently of record until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Karen Creasy at 571-272- 3208.

Denise Pothier
Petitions Examiner
Office of Petitions

cc:
**KING & SPALDING, LLP**
**191 PEACHTREE STREET**
**ATLANTA GA 30303**

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, DC 20231
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Paper No. 3

Martin J. Jaquez, Esq.
JAQUEZ & ASSOCIATES
750 B Street, Suite 2640
San Diego CA 92101

MAIL

JAN 13 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Brian Banister :
Application No. 10/080,728 :
Filed: February 22, 2002 :
For: **METHOD AND APPARATUS FOR IMPROVING TRANSMIT ANTENNA WEIGHT TRACKING USING CHANNEL CORRELATIONS IN A WIRELESS COMMUNICATION SYSTEM** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on November 25, 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: LSI LOGIC CORPORATION
1551 McCarthy BLVD.
Milpitas, CA 90535

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JJGJr: 03-04

Paper No: 5

WOMBLE CARLYLE
SANDRIDGE & RICE
P.O. BOX 7037
ATLANTA GA 30357-0037

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MAR 1 2 2004

OFFICE OF PETITIONS

In re Application of :
Beiswenger, et al. :
Application No. 10/080,746 : DECISION ON PETITION
Filed: 22 February, 2002 :
Attorney Docket No.: H159 1010 :

This is a decision on the petition, filed via 13 May, 2003, and resubmitted via FAX on 5 March, 2004, to revive the instant nonprovisional application under the provisions of 37 C.F.R. §1.137(f).

The Office regrets the delay in addressing this matter.

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on 22 February, 2003. Petitioner rescinded the non-publication request on 10 March, 2003, however, Petitioner failed to Notice the Office of the action.

Thus, Petitioner alleges that he unintentionally failed to notify the U.S. Patent and Trademark Office of this filing of the subject application in a foreign country within 45 days of that filing.

In view of the above, this application became abandoned pursuant to 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R. §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 C.F.R. §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 C.F.R. §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 C.F.R. §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 C.F.R. §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 17 June, 2004, accompanies this decision.

This application is being forwarded to Technology Center Art Unit 2100 for examination in due course.

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

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

Martin J. Jaquez, Esq.
JAQUEZ & ASSOCIATES
Suite 2640
750 B Street
San Diego CA 92101

MAIL

FEB 1 1 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Brian Banister :
Application No. 10/080,751 : DECISION ON REQUEST TO
Filed: February 22, 2002 : WITHDRAW AS ATTORNEY
For: **METHOD AND APPARATUS FOR GENERATING TRANSMIT ADAPTIVE ANTENNA WEIGHTS WITH NULLING USING BINARY GRADIENT FEEDBACK** :

This is a decision on the request to withdraw as attorney/agent of record filed on November 25, 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: LSI Logic Corporation
1551 McCarthy Blvd.
Milpitas, CA 90535

# 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) |
|---|---|---|---|---|
| 6606343 | 2003-08-12 | 10080759 | 2002-02-22 | I-2-0141.2US |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

NOT Small Entity

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

Small Entity

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Jeffrey M. Glabicki/ | Date (YYYY-MM-DD) | 2007-09-28 |
| Name | Jeffrey M. Glabicki | Registration Number | 42584 |

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. 6606343
Issue Date: August 12,2003
Application No. 10080759
Filed: February 22,2002
Attorney Docket No. L-2-0141.2US

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

This is a decision on the electronic petition, filed September 28,2007,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 28,2007. This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**August 27, 2009**

Karen Moir
VMware, Inc.
3401 Hillview Avenue
Palo Alto, CA 94304

Patent No.: 7,111,086 B1
Application No.: 10/080,782
Inventor(s): Matthew Ecoleston, et al.
Issued: September 19, 2006
Title: **HIGH-SPEED PACKET TRANSFER IN COMPUTER SYSTEMS WITH MULTIPLE INTERFACES**

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.

Since inventors' names are printed in accordance with the *typed names* on the Declaration on file, *at the time of payment of the issue fee,* no correction is in order here under the provision of Rule 1.322.

In view of the foregoing, your request, in this mater, is hereby denied. However, further consideration will be given your request, upon receipt of a signed request, under the provisions of Rule 1.323, accompanied by a declaration **and** a statement over the signature of the inventor, whose name is in question and the appropriate fee of $100.

*/Virginia Tolbert/*
Virginia Tolbert
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **756-1591**

vt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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WESTERN DIGITAL CORP.
20511 LAKE FOREST DRIVE
C205 - INTELLECTUAL PROPERTY DEPT.
LAKE FOREST, CA 92630

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FEB 15 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Michael S. Rothberg | : | |
| Application No. 10/080,784 | : | DECISION |
| Filed: February 22, 2002 | : | ON PETITION |
| Atty Docket No.: | : | |
| K35A0462 | : | |

This is a decision on the Petition to Withdraw Holding of Abandonment, filed January 5, 2005. The petition is properly treated under 37 CFR 1.181.

The petition is **granted.**

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Non-Compliant Amendment ("Notice"), mailed May 24, 2005. The Notice set a one (1) month period for reply. No reply having been received, this application became abandoned on June 25, 2005.

The instant petition

Applicant responds with the instant petition wherein Applicant avers that a timely reply to the Notice was filed on June 20, 2005 (Certificate of Mailing dated June 17, 2005), and was received by this Office as evidenced by Applicant's return-receipt postcard. Applicant provides that, due to a scrivener's error, the application number was entered on the Cover Letter as application serial number 09/080,784, instead of 10/080,784.

The application papers filed June 17, 2005 have not been located in application serial number 09/080,784; however, in view of Applicant's return-receipt postcard, and Certificate of Mailing, it is apparent that the Response to Notice was filed in this Office

on June 17, 2005, and due to errors on the part of applicant and this Office, was inadvertently misplaced. Accord MPEP 502.

In view of the foregoing, the holding of abandonment is hereby withdrawn.

No fee has been charged and none is due.

The application will be referred to Technology Center 2651 for continued processing in due course.

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin NJ 08830

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JAN 17 2006

OFFICE OF PETITIONS

In re Application of
Fang et al.
Application No. 10/080,805
Filed: February 21, 2002
Attorney Docket No. 2002P02988 US

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

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

This application became abandoned for failure to reply timely to the nonfinal Office Action mailed December 9, 2004, which set a three (3) month shortened statutory period to reply. Accordingly, this application became abandoned on March 10, 2005. A Notice of Abandonment was mailed on December 13, 2005.

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

The finance records indicate that petitioner's Deposit Account was charged a $1,590.00 extension of time fee for filing a response. 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. Additionally, the response period cannot be extended beyond six months of the mailing date of the Office action as set by statute. Accordingly, this fee will be refunded to petitioner's Deposit Account.

This matter is being referred to Technology Center Art Unit 2625.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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BINGHAM, MCCUTCHEN LLP
THREE EMBARCADERO CENTER
18th FLOOR
SAN FRANCISCO, CA 94111-4067

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**JUN 28 2005**

**OFFICE OF PETITIONS**

In re Application of :
Wiltshire, et al. :
Application No. 10/080,816 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. M-7001-1P US :

This is a decision on the petition under 37 CFR 1.137(b), filed May 20, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the non-final Office action mailed December 18, 2003. Accordingly, this application became abandoned on March 19, 2004. A Notice of Abandonment was mailed on July 21, 2004.

The file is being forwarded to Technology Center 3700, for review of the amendment and terminal disclaimer, filed May 20, 2005, *in due course*.

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

Edward J. Tannouse
Petitions Attorney
Office of Petitions/Patent
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

CHRISTIE, PARKER & HALE, LLP
P.O. BOX 7068
PASADENA, CA 91109-7068

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MAY 1 0 2002

OFFICE OF PETITIONS

In re Application of :
Thomas Dean Gulley :
Application No. 10/080,818 : DECISION ACCORDING STATUS
Filed: February 22, 2002 : UNDER 37 C.F.R. §1.47(b)
Attorney Docket No. 46893/DRK/S1050:
Title: THREE-PIECE BARREL HINGE :

This is in response to the "Petition under 37 CFR 1.47(b) and MPEP 409.03," filed February 22, 2002. Receipt of the letter filed April 22, 2002, noting the previous filing of this petition on February 22, 2002 is acknowledged.

The petition is **GRANTED**.

The above-identified application was filed on February 22, 2002, with an unexecuted declaration and the instant petition (and fee) under §1.47(b). Thomas Dean Gulley was named as sole inventor. Rule 47 applicant asserts that status under §1.47(b) is proper because sole inventor Gulley refuses to execute the application and refuses to cooperate with the prosecution of the application.

In support thereof, rule 47(b) applicant submitted *inter alia*:

- another copy of the unexecuted declaration;
- declarations by Larry Myrick, President of rule 47(b) applicant Sierra Pacific Engineering and Products; George Alvarado, Engineering Manager of rule 47(b) applicant; and Todd M. Kawai, Controller and Human Resource Manager of rule 47(b) applicant;
- a copy of the executed assignment from inventor Gulley to rule 47(b) applicant; and
- a petition including a statement of the last known address of sole inventor Gulley.

In addition, on May 9, 2002, rule 47(b) applicant submitted a statement under 37 CFR 3.73(b) and a revised declaration for patent executed by Larry Myrick on behalf of sole inventor Gulley.

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) proof that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage.

The declarations of Messrs. Myrick, Alvarado and Kawai are found sufficient to show that i) non-signing inventor Gulley has refused to join in the application after having been presented with the application papers, and ii) filing of the application is

necessary to preserve the rights of rule 47 applicant. Further, a review of the executed assignment reveals that it clearly indicates that the invention described in the 37 CFR 1.47(b) application was assigned to the rule 47(b) applicant. In addition, rule 47(b) applicant paid the petition fee and included a statement of the non-signing inventor's last known address in the petition.

However, as filed initially, the petition was deficient because rule 47(b) applicant had not established proprietary interest and had not provided an acceptable oath or declaration. The assignment was not accompanied by a statement under 37 CFR 3.73(b) by the assignee[1] and the declaration was unexecuted.

The statement under §3.73(b) and the revised declaration filed May 9, 2002, cured those deficiencies.

The declaration filed May 9, 2002, and the petition filed February 22, 2002 have been reviewed and found in compliance with 37 CFR 1.47(b).

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

As provided in 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 declaration. 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 completion of pre-examination processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

Christina Tartera Donnell for

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

[1] See MPEP §§ 409.03(f), 324

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THOMAS DEAN GULLEY
534 WEST LIME AVENUE
MONROVIA, CA 91016

COPY MAILED

MAY 1 0 2002

OFFICE OF PETITIONS

In re Application of :
Thomas Dean Gulley :
Application No. 10/080,818 : LETTER
Filed: February 22, 2002 :
Attorney Docket No. 46893/DRK/S1050:
Title: THREE-PIECE BARREL HINGE :

Dear Mr. Gulley:

You are named as the sole inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 118 (United States Code) and 37 CFR 1.47(b), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as the sole inventor.

As the 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).

Christina Partera Donnell for

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

CHRISTIE, PARKER & HALE, LLP
P.O. BOX 7068
PASADENA, CA 91109-7068

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#15

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ALEXANDRIA, VA 22313-1450
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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

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

In re Application of
Thomas Dean Gulley
Application No. 10/080,818
Filed: February 22, 2002
For: THREE-PIECE BARREL HINGE

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is a decision on applicant's petition filed May 19, 2004 which is being treated as a petition to withdraw the holding of abandonment.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action dated September 16, 2003 and a Notice to that effect was mailed on April 20, 2004.

Petitioner states that a response was filed on December 17, 2003 by facsimile transmission. The copy of the response submitted with the petition includes a Certificate of Transmission dated December 17, 2003 and a copy of a transmission sheet. However the transmission sheet is not an official USPTO return facsimile receipt. Therefore, applicant must rely on the Certificate of Transmission by facsimile as the basis for the petition to withdraw the holding of abandonment.

Any petition to withdraw the holding of abandonment based upon a Certificate of Transmission by facsimile must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the *original* response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above the petition fails, under requirement (2), to also include a statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of sending the original response by facsimile transmission on the date indicated on the certificate, by the person who signed the certificate.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/vdb: 7/1/04

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**FROM DIRECTORS OFFICE**

DEC 16 2004

**TECHNOLOGY CENTER 3600**

Christie, Parker & Hale, LLP
PO Box 7068
Pasadena, CA 91109-7068

In re Application of
Thomas Dean Gulley
Application No. 10/080,818
Filed: February 22, 2002
For: THREE-PIECE BARREL HINGE

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in reply to applicant's renewed petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on November 16, 2004.

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

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on December 17, 2003 . and supported by a statement under 37 C.F.R. 1.8(b)(3).

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

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

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

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

SNM/rwg: 12/9/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

FISH & RICHARDSON P.C.
45 ROCKEFELLER PLAZA, SUITE 2800
NEW YORK NY 10111

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DEC 2 3 2002

OFFICE OF PETITIONS

In re Application of:
Janice M. Lingwood, Paul J. Evans,
Andrew H. Cantos, Annette Watson
and Philip P. Ashton
Application No. 10/080,846
Filed: February 22, 2002
Title of Invention: EVALUATING AN ORGANIZATION'S LEVEL OF SELF-REPORTING

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This Decision is in response to a Petition Under 37 C.F.R. 1.47(a), filed October 21, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). A five (5) month extension of time is requested and is hereby granted.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 22, 2002, without a fully executed oath or declaration. Accordingly, on March 19, 2002 a "Notice to File Missing Parts of Nonprovisional Application" (hereinafter "Notice"), was mailed to Petitioner. The Notice required, in relevant part, a fully executed oath or declaration. Applicant was given two-months from the date of the Notice within which to file a fully executed oath or declaration. Extensions of time were available under 37 CFR 1.136(a).

Petitioner responds with the instant petition, extension-of-time request and Declarations of David Phillips and of Selina Reynolds. The Phillips Declaration avers, in relevant part, that the nonsigning inventor was sent a copy of the above-identified application at her place of employment.

Applicable Law:

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.

As to item (1), the applicant has failed to establish that the nonsigning inventor was ever presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states 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*, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. Emphasis supplied.

MPEP 409.03(d).

As required by the MPEP, a copy of the application should be sent to the last known address of the nonsigning inventor(s). The last known address should be the last known residence at which the inventor customarily receives mail. See, MPEP 409.03(e) and 605.03.

Petitioner must send a copy of the entire application, including the specification, claims and drawings, along with the oath or declaration to the nonsigning inventor at the last known address of the inventor, as set forth in the first page of the petition, before refusal can be alleged.

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

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

By FAX: (703) 308-6916
Attn: Office of Petitions

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

Telephone inquiries 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

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United States Patent and Trademark Office
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Paper No. 9

FISH & RICHARDSON PC
45 ROCKEFELLER PLAZA, SUITE 2800
NEW YORK, NY 10111

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MAR 2 4 2003

OFFICE OF PETITIONS

In re Application of :
Janice M. Lingwood et al :DECISION NOTING JOINDER OF
Application No. 10/080,846 :INVENTOR AND PETITION UNDER
Filed: February 22, 2002 :37 1.47(a) MOOT
Attorney Docket No. 13325-002001 :

This is in response to papers filed on February 24, 2003 and February 27, 2003 in response to a "Decision Refusing Status Under 37 CFR 1.47(a)," mailed December 23, 2002. The papers filed on February 27, 2003 included a Declaration signed by previously nonsigning inventor Annette Watson in compliance with 37 CFR 1.63.

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

This application is being forwarded to Technology Center AU 2821 for examination in due course.

Inquiries related to this decision may be addressed to the undersigned at (703) 305-8680.

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

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

UR
PAPER NO. 7

JUN 18 2003

In re Application of :
Jyrki Ignatius et al. :
Serial No. 10/080,862 :
Filed: February 22, 2002 :
For: CLEAN BURNING MTBE-FREE GASOLINE: FUEL :

DECISION
ON
PETITION
UNDER 708.02,VIII

This is in response to the petition filed April 08, 2002 requesting that the above-identified application be granted Special Status under Section 708.02 (VIII) of the MPEP and 37 CFR 1.102(d) (fee paid).

The petition has been considered and found to to comply with the requirements set forth under the above-noted section. Accordingly, the petition is **GRANTED.**

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Birch Stewart Kolasch & Birch
PO Box 747
Falls Church, VA 22040-0747

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

Date: 4/28/03

To: SPE, Art Unit 1764

From: Director's Office, 8019

Subject: Petition for accelerated examination

A petition for accelerated examination, pursuant to MPEP 708.02 (VIII), has been filed in this application.

In order to respond to this request as promptly as possible, please complete the questions below and return to the Director's Office - CP3-8D 19 by COB 5/2/03.

| | Yes | No |
|---|---|---|
| 1. **Are all the claims directed to a single invention (no restriction required)?** | [✓] | [ ] |
| a. If "no", has the petitioner made an election in the petition? | [ ] | [ ] |
| b. If "no", has a restriction requirement been made by examiner? | [ ] | [ ] |
| If "no" to (b), give to examiner for telephone restriction only | | |
| c. If "yes" to (b), was election made without traverse? | [ ] | [ ] |
| If "no" to (c), return to secretary for "DENIAL" of petition. | | |
| 2. **Is the field of search listed in the petition correct:** | | |
| **a. Classes and subclasses?** No search given | [ ] | [✓] |
| If "no", please list all reasonable, additional classes/subclasses 208/16 585/14 44/447 44/451 | | |
| **b. Publications? (If applicable)** None given | [ ] | [ ] |
| If "no", please list all reasonable publications | | |
| **c. Foreign patent IPC classes/subclass? (If applicable)** None given | [ ] | [✓] |
| If "no", please list all reasonable, additional IPC classes/subclasses C10L 1/06 ; C10L 1/18 | | |
| **d. Database searches, e.g., Chemical Abstract? (If applicable)** | [ ] | [ ] |
| If "no", please list all reasonable, additional databases None given | | |
| 3. **Has a search been performed by a foreign patent office, e.g., is an EPO, JPO, or WIPO document present in the application file or supplied by applicant, and is the document for an equivalent foreign application?** | [✓] | [ ] |
| a. If "yes", does the document list an IPC type search? | [✓] | [ ] |
| b. If "yes" to (a), are the IPC classes/subclasses reasonable?(Optional) | [✓] | [ ] |

PLEASE RETURN THIS SHEET AND THE APPLICATION TO THE DIRECTOR'S SECRETARY UPON COMPLETION.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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**FOLEY AND LARDNER**
**SUITE 500**
**3000 K STREET NW**
**WASHINGTON, DC 20007**

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DEC 19 2005

**OFFICE OF PETITIONS**

In re Application of :
Osamu Takagi et al :
Application No. 11/080,898 : ON PETITION
Filed: March 16, 2005 :
Attorney Docket No. 016907-1835 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 16, 2005, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on December 7, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

This matter is being referred to Technology Center AU 3742 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment and IDS.

Wan Laymon
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).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3-20-06

TO SPE OF : ART UNIT 2116

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/108,299 Patent No.: 6823464

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

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

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

Please check Drawings

E Young

**Certificates of Correction Branch**

**703-308-9390 ext. 117**

**Thank You For Your Assistance**

---

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

Note your decision on the appropriate box.

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

**Comments:** _____

LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

**SPE** **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8-22-05

TO SPE OF : ART UNIT 2116

SUBJECT : Request for Certificate of Correction on Patent No.: 6823469

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 Drawings

**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:**

_____

_____

_____

_____

_____

**LYNNE H. BROWNE**
**SUPERVISORY PATENT EXAMINER**
**TECHNOLOGY CENTER 2100**

SPE _____ Art Unit _____

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

JUL 2 2 2004

Mailed:_____

rvk

Paper Number:_____

In re application of :
Randy A. Harris et al. : DECISION ON
Serial No. 10/080,914 : PETITION
Filed: February 22, 2002 :
For: METHOD AND APPARATUS FOR MANUALLY AND AUTOMATICALLY PROCESSING MICROELECTRONIC WORKPIECES :

This is a response to the "REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT UNDER MPEP 711.03", filed May 07, 2004. The request asks that the abandonment, as set forth in the Notice of Abandonment of April 21, 2004, for failure to timely file a proper response to the Office letter dated September 15, 2003 be withdrawn. The requester asserts that applicants timely filed a proper response to the Office letter of September 15, 2003 on December 15, 2003.

**DECISION**

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee).

A review of the petitioner's evidence provided with the instant petition indicates that the request has merit. The evidence presented is sufficient to establish that the applicants did file the proper response to the Office letter of September 15, 2003 in a timely manner. The evidence provided includes : 1) a copy of the Amendment in Response to the Office letter of September 15, 2003, Fee Transmittal for FY 2004 and Information Disclosure Statement mailed December 15, 2003, with Express Mail No. EV335521226US; 2) a copy of Express Mail Label No.EV335521226US showing receipt by the U.S.Post Office on December 15, 2003; 3) a copy of the U.S.Post Office receipt of Express Mail No.EV335521226US on December 15, 2003; and 4) a copy of returned stamped postcard confirming receipt by the USPTO dated December 15, 2003.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The case will be forwarded to the Technical Support Staff for entering of the Response of December 15, 2003 and then forwarded to the examiner for prompt consideration.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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1/21/05

| | | |
|---|---|---|
| In re Application of | : | |
| HARRIS, RANDY | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/080915 | : | FROM ISSUE |
| Filed: February 2, 2002 | : | UNDER 37 CFR 1.313(b) |
| For: APPARATUS WITH PROCESSING | : | |
| STATIONS FOR MANUALLY AND AUTO- | : | |
| MATICALLY PROCESSING MICRO- | : | |
| ELECTRONIC WORKPIECES | : | |

The above-identified application is withdrawn from issue after payment of the issue fee due to reopening of prosecution. See 37 CFR 1.313 (b).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to Roy King (571) 272-1244.

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

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

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

cc: Allowed Files—Pk3-910

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PO BOX 1022
MINNEAPOLIS MN 55440-1022

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SEP 14 2007

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re | : DECISION ON APPLICATION |
| Cadet, et al. | : FOR PATENT TERM ADJUSTMENT |
| Application No. 10/080,917 | : AND NOTICE OF INTENT |
| Filed: February 22, 2002 | : TO ISSUE |
| Patent No. 7,094,892 | : CERTIFICATE OF CORRECTION |
| Issued: August 22, 2006 | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)", filed October 16, 2006. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred seven (407) days.

The application for patent term adjustment is **GRANTED**.

The Patent Term Adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **three hundred eighty-five (385) days.**

On March 20, 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 was three hundred eighty-six (386) days. On June 15, 2006, Applicants timely[1] submitted an application for patent term adjustment, asserting that the Office had accorded too many days of PTA.

[1] Applicant filed the application for patent term adjustment together with the issue fee.

The application issued into Patent No. 7,094,892 on August 22, 2006. Applicants were assessed delay of sixty-nine (69) days for filing the application for patent term adjustment. Patentees timely filed the instant request for reconsideration on October 16, 2006.

The Office determined a patent term adjustment of four hundred seven (407) days based on an adjustment for PTO delay of four hundred nineteen (419) days pursuant to U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), thirty-seven (37) days pursuant to U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(3), and ninety (90) days U.S.C. 154(b)(1)(B)(iii) and 37 C.F.R. § 1.703(b), reduced by thirty-five (35) and thirty-five (35) days of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and sixty-nine (69) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(c)(8). The adjustment of sixty-nine (69) days is at issue.

Patentees point out that they were improperly assessed applicant delay of sixty-nine (69) days for filing the application for patent term adjustment on June 15, 2006. In addition, Patentees argue that the Office should have assessed additional days of applicant delay for filings on December 6, 2005 and January 27, 2006.

With respect to the sixty-nine (69) days of applicant delay assessed for filing the application for patent term adjustment, pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application. Accordingly, zero (0) days should have been assessed for this filing.

In addition, applicants should have been assessed additional days of delay. The Office mailed a final Office action on June 6, 2005. Applicants did not file a proper reply until they filed a Notice of Appeal on December 6, 2005. Accordingly, pursuant to 37 CFR 1.704(b), ninety-one (91) days of applicant delay should have been assessed. However, no applicant delay should have been assessed for filing an Amendment after the Notice of Appeal on January 27, 2006. Applicant delay is not assessed when an application is under appeal.

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

In view thereof, the correct determination of patent term adjustment is four hundred twenty (420) days (546 (419+37+90) days of PTO delay, reduced by 161 (35+35+91) days of applicant delay).

The application file is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment **three hundred eighty-five (385) days.**

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

Nancy Johnson for

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

Enclosure: draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,094,892 B2

DATED : August 22, 2006

INVENTOR(S) : Cadet et al.

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 (407) days

Delete the phrase "by 407" and insert – by 385 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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JJC/jr: 05-03

Paper No: 17

THOMAS M SAUNDERS
BROWN RUDNICK
BERLACK ISRAELS LLP
18TH FLOOR
ONE FINANCIAL CENTER
BOSTON MA 02111

COPY MAILED

MAY 2 2 2003

OFFICE OF PETITIONS

In re Application of
Gonzalez-Villasenor :
Application No. 10/080,919 : ON PETITION
Filed: 22 February, 2002 :
Attorney Docket No. 22918/1 :

This is a decision on the petition filed herein on 1 April, 2003, under 37 C.F.R. §1.137(a)[1] to revive the above-identified application, and in light of the allegations also considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.[2]

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[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.
(c) 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

For the reasons set forth below, the petition under 37 C.F.R.:

- §1.181 is **GRANTED**.
- §1.137(a) is **DISMISSED as moot**.

## BACKGROUND

The record indicates that:

- it appeared that Petitioner failed to reply timely and properly to Notice of Missing Parts mailed on 18 March, 2002, with reply due (absent an extension of time) on or before 18 May, 2002;
- the application was deemed abandoned after midnight 18 May, 2002;
- no Notice of Abandonment was mailed before the instant petition was filed;
- Petitioner Thomas M. Saunders (Reg. No. 29,585) addresses the "showing" requirement of 37 C.F.R. §1.137 and indicates through his statement and supporting documentation (including declarations of Margaret Ritchie (docket clerk at Lorusso & Loud) and June Kaps (docket clerk at Brown Rudnick Berklack Israels LLP), and docket evidence from the firms that the Notice of Missing Parts was not received at either office subsequent to its mailing;
- contemporaneously with the filing of the instant petition Petitioner submitted a signed oath/declaration (power of attorney), and the petition fee (which has not been charged), surcharge and application and claims fees in response to the Notice of Missing Parts, and so satisfied the reply requirement of 37 C.F.R. §1.137.

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

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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. * * * (Emphasis supplied.)

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[4]

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

And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[8]))

The courts have determined the construct for properly supporting a request to withdraw a holding of abandonment.[9]

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[3] 35 U.S.C. §133 provides:

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

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

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

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

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

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

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

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

Petitioner has made an adequate showing as to non-receipt.[10]

Accordingly, in view of the showing and statement of Petitioner, the petition:

- as considered to withdraw the holding of abandonment under 37 C.F.R. §1.181 hereby is **granted**; and

- under 37 C.F.R. §1.137(a) hereby is **dismissed as moot** (and the petition fee was not charged).

The instant file is being forwarded to OIPE for further processing before being forwarded for examination in due course.

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

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

[10] See MPEP 711.03(c)(III)(C)(2).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : September 5, 2006

**TO SPE OF** : ART UNIT 1625

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/080926 Patent No.: 7,026,484 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:** _____

_____

_____

_____

_____

Thomas M. McKenzie — SPE

1625 — Art Unit

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20081112

**DATE** :

**TO SPE OF** : ART UNIT

**SUBJECT** : Request for Certificate of Correction on Patent No.:

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

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

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

/J. L. A./
Supervisory Patent Examiner.Art Unit 1625

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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**DATE:** July 22, 2009
**TO:** Certificates of Correction Branch
**FROM:** Janet L. Andres
SPE, Art Unit 1625
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7026484 as specified on the attached Certificate.

/Janet L. Andres/

Janet L. Andres, SPE
Art Unit 1625

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 7026484
Patented: April 11, 2006

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:

Lin Zhi
Cornelis Arjan Van Oeveren

/Janet L. Andres/
Supervisory Patent Examiner
Art Unit 1625

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MARLBOROUGH MA 01752-3064

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MAR 12 2007

OFFICE OF PETITIONS

In re Application of :
Chhabra, et al. :
Application No. 10/080,931 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 3645.US.P :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed January 23, 2007.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.181."

The above-identified application became abandoned for failure to timely file a **proper** response to the final Office action mailed August 11, 2005, which set a shortened statutory period for reply of three (3) months. No response having been received, the application became abandoned on November 12, 2005. A Notice of Abandonment was mailed on March 23, 2006.

On petition, applicants have successfully demonstrated that they filed a response on December 12, 2005. However, the response was not proper because it failed to place the application in condition for allowance.

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. An applicant should not permit the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action, such as an Advisory Action.[1]

Applicant should have ensured that the amendment had been entered or applicant should have filed either a Request for Continued Examination (RCE), continuing application, or Notice of Appeal. The last day an RCE, continuing application, or Notice of Appeal could have been filed, with the maximum allowed three month extension of time, would have been February 11, 2006. An applicant should not wait to take action until receipt of an advisory action which might not even be mailed until more than six months after the mailing of the final Office action.

While the showing of record is not sufficient to withdraw the holding of abandonment, applicants are not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); currently $750, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

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

---

[1] MPEP 711.03(c)(III)(C)(2).

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 23 2007

**OFFICE OF PETITIONS**

In re Application of :
Chhabra, et al. :
Application No. 10/080,931 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 3645.US.P :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed April 6, 2007.

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

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed August 11, 2005, which set a shortened statutory period for reply of three (3) months. No response having been received, the application became abandoned on November 12, 2005. A Notice of Abandonment was mailed on March 23, 2006. Applicants filed a petition to withdraw the holding of abandonment on January 23, 2007. However, the petition was dismissed in a decision mailed on March 12, 2007.

With the instant petition, applicants paid the petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of an RCE (and fee) and submission (an Amendment).

The matter is being forwarded to Group Art Unit 2193 for consideration of the RCE filed April 6, 2007.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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JUL 25 2006

OFFICE OF PETITIONS

HOLLAND & KNIGHT LLP
10 ST. JAMES AVENUE
BOSTON MA 02116

In re Application of :

Jane Wen Chang et al :
Application No. 10/080,945 : DECISION ON PETITION
Filed: February 22, 2002 : TO WITHDRAW
Attorney Docket No. 103594.00001 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 3, 2006.

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

A review of the file record indicates that the power of attorney to Christine H. Smith, along with all of the other attorneys associated with Customer No. **58326** has been revoked by the assignee of the patent application on May 3, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant/assignee or the current attorneys of record.

This application is being referred to Technology Center AU 2167 for the mailing of the Non-final Rejection on July 6, 2006.

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

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**GATES & COOPER LLP**
**6701 CENTER DRIVE WEST**
**SUITE 1050**
**LOS ANGELES, CA 90045**

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**C/O MORRISON & FOERSTER LLP**
**1650 TYSONS BOULEVARD, SUITE 300**
**MCLEAN VA 22102**

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DEC 0 7 2006

OFFICE OF PETITIONS

In re Application of :
**HUBER, et al.** :
Application No. 10/080,996 : DECISION ON PETITION
Filed: February 20, 2002 : TO WITHDRAW
Attorney Docket No. INTE.25USU1 (ITC38) : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 14, 2006.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request, "Application is being transferred to another attorney" does not meet any conditions set forth in 37 CFR 1040.

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

There is no outstanding Office action that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: **Marc Kaufman, Esq.**
**NIXON PEABODY LLP**
**401 9th Street, N.W.**
**Suite 900**
**Washington, D.C. 20004**

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 22 2007

OFFICE OF PETITIONS

In re Application of :
Thomas Huber, et al. :
Application No. 10/080,996 : DECISION ON PETITION
Filed: February 20, 2002 : TO WITHDRAW
Attorney Docket No. INTE.25USU1 (ITC38) : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed January 17, 2007.

The request is **APPROVED**.

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

The request was signed by Adam Keser on behalf of all attorneys of record who are associated with customer No. 43997.

All attorneys/agents associated with the Customer Number 43997 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed April 25, 2007 that requires a reply from the applicant.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: INTELLOCITY USA, INC.
275 SACRAMENTO STREET
SAN FRANCISCO, CA 94111

cc: MARC KAUFMAN, ESQ.
NIXON PEABODY LLP
401 9TH STREET NW
SUITH 900
WASHINGTON, DC 20004

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/080,996 | 02/20/2002 | Thomas Huber | INTE.25USU1 (ITC38) |

**CONFIRMATION NO. 9681**

*OC000000023907128*

43997
OPTV/MOFO
C/O MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
MCLEAN, VA 22102

Date Mailed: 05/17/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/17/2007.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

---

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

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FORT COLLINS CO 80527-2400

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JAN 14 2009

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Oar, et al. :
Application No. 10/081,005 :
Filed: February 19, 2002 :
Attorney Docket No. 10006644-1 :
For: POWER SAVING FEATURES FOR COMPUTING SYSTEMS

This is a decision on the petition, filed December 22, 2008, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the February 28, 2008 non-final Office action. No response being received and no extensions of time being obtained under the provisions of 37 CFR 1.136(a), this application became abandoned on May 29, 2008. The filing of the present petition precedes the mailing of a Notice of Abandonment.

Applicants have submitted an amendment in reply to the February 28, 2008 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the February 28, 2008 non-final Office action, and authorization to charge the $1,620.00 petition fee. Deposit account no. 08-2025 will be charged the petition fee.

All of the requirements under 37 CFR 1.137(b) being met, the petition is granted.

After the mailing of this decision, the application will be returned to Technology Center AU 2116 for consideration of the amendment filed on December 22, 2008.

Telephone inquiries should 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
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JUN 11 2004

EDWARDS & ANGELL, LLP
P. O. BOX 9169
BOSTON, MA 02209

In re Application of :
Lutz Weber et al :
Serial No.: 10/081,009 : PETITION DECISION
Filed: February 20, 2002 :
Attorney Docket No.: 41925-56937 :

This is in response to the petition under 37 CFR 1.181, filed April 1, 2004, 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 August 19, 2003, setting a three month shortened statutory period for reply. Upon failure to receive a reply the application was held abandoned by Notice of Abandonment mailed March 10, 2004. Applicants state that a reply was submitted on February 12, 2004, which included a Notice of Appeal, a request for a three month extension of time and the fees therefore, and provide a copy of the reply with a properly executed Certificate of Mailing dated February 12, 2004. Applicants state that the reply was returned to the sender (for reasons unknown) on February 23, 2004. Applicants have resubmitted the reply with the petition. In view of applicants' attempted timely reply, as evidenced by a properly executed Certificate of Mailing, the Notice of Abandonment is withdrawn and the application restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**The two month period for submission of the Appeal Brief as required under 37 CFR 1.196, is restarted as of the date of mailing of this decision.**

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 703-872-9306.

Bruce M. Kisliuk
Director, Technology Center 1600

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WASHINGTON, DC 20231
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JUN 2 6 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Paper No. 16

Wesley Eugene Kendall
106 Pine Needle Lane
Altamonte Springs, FL 32714

In re Application of:
Wesley Eugene Kendall
Application No. 10/081036
Filed: February 22, 2002
For: **CARD ONE**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the Petition To Make Special under MPEP 708.02, XI: Invention for Countering Terrorism, filed May 16, 2003 and copy faxed on May 22, 2003. Petitioner has also submitted a request for fee payment exclusion.

A grantable petition to make an application special under 37 C.F.R. 1.102(d), and in accordance with MPEP 708.02, XI, for an invention which contributes to the countering of terrorism, must include the petition fee under 37 CFR 1.17(i). The petition must also be accompanied by a statement explaining how the invention contributes to countering terrorism. The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.

The petition states that it is directly related to the security of the United States of America and that it consists of a system which will secure all sterile areas of our airports, and identify all commercial travelers and also aviation related employees. The petition does not set forth specifically how this would be accomplished. Also, the petition does not include the required $130.00 fee, nor does it include an authorization to charge a deposit account for the fee.

As set forth in 37 CFR 102(c), the petition could be filed without a fee if the basis for the petition is applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources. Petitioner does not specifically set forth the comparison of the systems before and after his invention to establish any benefit. Petitioner has not explained how the invention contributes to the restoration of one of the life-sustaining elements, i.e. air, water, and soil to establish enhancement of the quality of the environment. Petitioner also does not qualify under age or health. Therefore, the conditions to file without the required fee have not been satisfied.

Accordingly, the petition is **DENIED**.

Petitioner is given TWO MONTHS from the date of this decision to request reconsideration and supplement the original petition as appropriate.

The application file will be returned to the Technology Center's central files storage area to await action in its regular turn.

Reinhard J. Eisenzopf
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4711

UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 26 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Wesley Eugene Kendall
106 Pine Needle Lane
Altamonte Springs, FL 32714

In re application of : **DECISION ON PETITION**
Wesley Eugene Kendall : **TO MAKE SPECIAL**
Application No.10/081,036 : **(COUNTER TERRORISM)**
Filed: February 22, 2002 :
For: CARD ONE

This is in response to the petition filed on June 30, 2003 to make the above-identified application special on the basis of inventions for countering terrorism as set forth in MPEP § 708.02 XI and further in view of the fee transmittal received August 15, 2003.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); and (B) a statement explaining how the invention contributes to countering terrorism.

Applicant's statement explains that the present invention contributes to countering terrorism by limiting identification fraud via a secure form of ID that links to a Federal database and to a biometric. The secure form of ID operates as an ID, ticket, boarding pass and baggage claim and links the passenger directly to his ticket purchase. Further, the secure form of ID is read at a series of airport checkpoints of which one, a Federal database, is used to eliminate passengers who are not legally permitted to fly commercially. This is an acceptable explanation of how the invention would act to counter terrorism.

Since all of the requirements for special status under MPEP § 708.02 XI have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

**SUMMARY**: Petition to Make Special **GRANTED**.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121

RAR/ekn 09/22/03

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SCHWEGMAN LUNDBERG WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

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JAN 11 2005

OFFICE OF PETITIONS

In re Application of :
David W. Osborne :
Application No. 10/081,050 : ON PETITION
Filed: February 20, 2002 :
Attorney Docket No. 359872001400 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 29, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed March 16, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provision of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 17, 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 $980 extension of time submitted with the petition on November 29, 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 with a Request For Continued Examination (RCE) filed on November 29, 2004.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

The matter is being forwarded to Technology Center AU 1615 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 2938
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of :
**OSBORNE**, David W. :
Application No. 10/081,050 : DECISION ON PETITION
Filed: February 20, 2002 : TO WITHDRAW
Attorney Docket No. **1195.346US1** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 16, 2008.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that the acts noted in the above-identified certifications have been performed.

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 Michelle R. Eason at 571-272- 4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **JOHN WURST**
**SENIOR PATENT COUNSEL**
**ALLERGAN, INC.**
**2525 DUPONT DRIVE**
**IRVINE, CA 92612-1599**

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Paper No. 4

LAW OFFICE OF THOMAS SCHNECK
P.O. BOX 2-E
SAN JOSE, CA 95109-0005

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OFFICE OF PETITIONS

In re Application of :
Adam E. Norton :
Application No. 10/081,078 : NOTICE
Filed: February 21, 2002 :
Attorney Docket No. SEN-020 :

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 2877.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAMES M. STOVER
NCR CORPORATION
1700 SOUTH PATTERSON BLVD, WHQ4
DAYTON OH 45479

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MAY 2 2 2006

OFFICE OF PETITIONS

In re Application of:
STEGELMANN, et al.
Application No.: 10/081,079
Filing Date: February 21, 2002
Attorney's Docket No.: 10157
For: EVALUATING EXPRESSIONS IN STORED PROCEDURES

DECISION ON PETITION FOR REVIVAL OF ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-entitled application, filed February 03, 2006.

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the final Office action mailed June 13, 2005, which set a shortened statutory period of reply of three (3) months. On November 17, 2005, applicants filed two "Declarations Of Facts Under 37 CFR 1.131" in response to the final Office Action, accompanied by payment for a two-month extension of time under 37 CFR 1.136(a). However, as indicated in the Advisory Action mailed December 19, 2005, because applicants had failed to provide an adequate showing supporting entry of these materials, the declarations filed 17 November 2005 were not entered and considered herein. Accordingly, the application was abandoned as of midnight on November 13, 2005.

On February 03, 2006, applicants filed the petition for revival under 37 CFR 1.137(b) considered herein. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of a Request For Continued Examination (RCE), with fee and submission (the materials previously filed on November 17, 2005 satisfy the submission requirement of 37 CFR 1.114). Accordingly, the reply to the final Office action of June 13, 2005 (in the form of the RCE and submission) is accepted as having been unintentionally delayed.

The application file is being referred to Technology Center AU 2167.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3296.

Richard M. Ross
Attorney Advisor

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Mark R. Wisner
Wisner & Associates
1177 West Loop South Suite 400
Houston, TX 77027-9012

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OFFICE OF PETITIONS

In re Application of :
Ilyas Juzer Najmuddin :
Application No. 10/081,090 :
Filed: February 22, 2002 :
Attorney Docket No. 94.0048 :

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed July 12, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on January 31, 2003. 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 December 16, 2004 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

The application is being returned to Technology Center Art Unit 2863 for further processing of the request for continued examination (RCE) filed July 12, 2004.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

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Houston, TX 77027-9012

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OFFICE OF PETITIONS

In re Application of :
Ilyas Juzer Najmuddin :
Application No. 10/081,090 : ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. 94.0048 :

This is a decision on the request to restart the time for payment of the issue fee filed by on March 3, 2006, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment, or in the alternative, a petition under 37 CFR 1.137(b) to revive the above-identified application.

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

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

As to the petition under 37 CFR 1.181, petitioner argues that the Notice of Allowance and Fee(s) Due/Notice of Allowability mailed December 14, 2004, was received in an envelope bearing a postmark date of December 17, 2004. Petitioner also argues that the envelope was not received until thirteen months after it was mailed.

The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; Notice 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

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 and docketed had it been received must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition fails to satisfy items (2) and (3) of the above-stated requirements.

Accordingly, absent the required evidence to establish nonreceipt of the Notice of Allowance and Fee(s) Due/Notice of Allowability mailed December 14, 2004, the petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1,500 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

The Office hereby acknowledges receipt of $1,400 for payment of the issue fee, and $300 for payment of the publication fee submitted on March 3, 2006. The Office also acknowledges receipt of an authorization to charge $1,500 for the petition fee to the deposit account listed in the instant petition. However, there is no indication that corrected formal drawings as required by the Notice of Allowability mailed December 17, 2004 have been submitted. Consequently, this application cannot be treated as a petition to revive under 37 CFR 1.137(b) until corrected formal drawings have been submitted.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181, or in the alternative, a Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

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

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

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

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

Telephone inquiries concerning this decision should be directed to 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
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OFFICE OF PETITIONS

OSHA LIANG LLP/SLB
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

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OFFICE OF PETITIONS

In re Application of :
Ilyas Juzer Najmuddin :
Application No. 10/081,090 : ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. 09469/059001;94.0048 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed on October 24, 2006, to revive the above-identified application. The delay in responding is regretted.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) the reply in the form of $1,400 for payment of the issue fee, $300 for payment of the publication fee and five (5) replacement sheets of drawings containing Figures 1-11; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

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

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

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Danita J.M. Maseles
Schlumberger Technology Corporation
5599 San Felipe, Suite 1700
Houston, TX 77056

UNITED STATES PATENT AND TRADEMARK OFFICE

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Director's Office
Office of Patent Publication

HOGAN & HARTSON L.L.P.
875 THIRD AVENUE
NEW YORK, NY 10022

In re Application of :
FISCH, HARRY et al. :
Application No. 10/081,098 : **DECISION ON PETITION**
Filed: February 21, 2002 :
Attorney's Docket No. 21084.0019(7202-227):

This is a decision on the Petition To Withdraw Holding Of Abandonment Under MPEP 711.03(C)(I), received in the United States Patent and Trademark Office (USPTO) on May 20, 2004.

The petition is **GRANTED.**

The application was held abandoned for failure to timely pay the issue fee as required in the NOTICE OF ALLOWANCE AND FEE(S) DUE, mailed November 7, 2003, which set a three (3) month statutory period for reply.

Petitioner has demonstrated that the PART B - FEE(S) TRANSMITTAL was timely and successfully transmitted via facsimile transmission to the USPTO on November 21, 2003, and is in compliance with 37 CFR 1.8(b) in that (1) the United States Patent and Trademark Office was promptly informed of the previous timely transmission, (2) a copy of the previously facsimiled correspondence with certificate of facsimile transmission thereon has been submitted, and (3) included a statement which attests to the previous timely transmission.

In view of the above, the holding of abandonment is hereby withdrawn. Accordingly, the issue fee and publication fee are accepted as timely transmitted via certificate of mailing on November 21, 2003.

The issue fee in the amount of $665, $300 for the publication fee, and $30 for ten (10) advance order copies were charged to Deposit Account No. 50-3024.

The application will be forwarded to the Publishing Division to be processed into a patent.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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DIW 11-04

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON DC 20005

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Sakamoto et al. | : | |
| Application No. 10/081,109 | : | ON PETITION |
| Filed: 25 February, 2002 | : | |
| Attorney Docket No. 4329.2270-01 | : | |

This is a decision on the petition to defer issuance filed on 6 July, 2004.

The petition is **granted**.

In the absence of an extraordinary circumstance, it has been the policy of the Office to defer issance of a patent, upon request, for a period of up to one (1) month only.[1] Accordingly, since the period of deferral requested has passed, the petition to defer issue is granted.

If an additional deferral period is required, another petition and fee should be promptly submitted. The petition must include a showing of extraordinary circumstances.[2]

The application is being referred to Technology Center 2800 for consideration of the papers filed on 6 July, 2004.

Telephone inquiries specific to this matter should be directed to the undersigned at 571 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

[1] See MPEP 1306.01.

[2] See Note 1, supra.

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SCOTT A. MCBAIN, ESQ.
DELPHI TECHNOLOGIES INC.
LEGAL STAFF, MAIL CODE: 480-414-420
P.O. BOX 5052
TROY, MI 48007-5052

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OFFICE OF PETITIONS

In re Application of :
Riddiford, et al. : DECISION ON PETITION
Application No. 10/081,122 :
Filed: February 22, 2002 :
Dkt. No.: DP-305565 (7500/87) :

This decision is in response to the "PETITION UNDER 37 CFR 1.183," filed February 16, 2005, requesting waiver or suspension of the rules to allow consideration of the response submitted herewith.

Petitioners argue that the Office was untimely in processing and considering the response submitted June 10, 2004 to the Final Office Action mailed June 2, 2004, and request that the response submitted herewith be deemed timely submitted.

The final Office action was mailed June 2, 2004. A response was filed June 10, 2004. An Advisory Action was mailed January 13, 2005 indicating that the June 10, 2004 response was not approved. Accordingly, the instant application became abandoned September 3, 2004 for failure to timely submit a proper reply to the final Office action mailed June 2, 2004. This decision precedes Notice of Abandonment.

In no event will the statutory period for reply expire later than six months from the mailing date of the final rejection. *See*, MPEP 706.07(f) and 37 CFR 1.134. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. *See*, 37 CFR 1.116(b). Moreover, the maximum period allowed by statute for reply to the Office action is six months. *See*, 35 USC 133.

In an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the

statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. *See*, 37 CFR 1.183.

A timely and proper reply to the final Office action is, by statute, required within six months, and, thus, this requirement is not subject to waiver or suspension under 37 CFR 1.183.

Accordingly, the petition under 1.183 is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183."

Petitioner is advised to promptly seek revival of the instant application in accordance with 37 CFR 1.137. The filing of a petition under 37 CFR 1.137 cannot be intentionally delayed and therefore must be filed promptly.

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

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

By facsimile: (703) 872-9306

**New Central FAX Number**: On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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SCOTT A. MCBAIN, ESQ.
DELPHI TECHNOLOGIES INC.
LEGAL STAFF, MAIL CODE: 480-414-420
P.O. BOX 5052
TROY, MI 48007-5052

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**OFFICE OF PETITIONS**

In re Application of :
Riddiford, et al. : DECISION ON PETITION
Application No. 10/081,122 :
Filed: February 22, 2002 :
Dkt. No.: DP-305565 (7500/87) :

This decision is in response to the petition under 37 CFR 1.137(b), filed July 21, 2005.

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

This application became abandoned September 3, 2004 for failure to timely submit a proper reply to the final Office action mailed June 2, 2004. The final Office action set a three month shortened statutory period of time for reply. No petition for extension of time under 37 CFR 1.136(a) was timely filed. Notice of Abandonment was mailed February 26, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit a proper reply to the final Office action mailed October 9, 2003 is accepted as having been unintentionally delayed.

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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Paper No. 10

Flehr Hohbach Test
Albritton & Herbert
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

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OFFICE OF PETITIONS

In re Application of :
Richard E. Riley :
Application No. 10/081,123 : DECISION GRANTING PETITION
Filed: February 21, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. A-70431/ESW :

This is a decision on the petition, filed June 10, 2003, under 37 CFR 1.137(b), and supplemented on June 23, 2003, to revive the instant nonprovisional application.

The petition is GRANTED.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on February 21, 2003. 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(b) to revive for failure to timely notify the Office of the filing of an application in a foreign country must be accompanied by:

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

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

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

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

A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of October 9, 2003 accompanies this decision on petition.

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

**This application is being forwarded to Technology Center Art Unit 1772 to await a reply to the Non-Final Office action mailed May 15, 2003. Failure to timely reply will again result in the abandonment of the application.**

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

Frances Hicks
Petitions Examiner

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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**SCHWEGMAN LUNDBERG & WOESSNER, PA**
**P.O. BOX 2938**
**MINNEAPOLIS, MN 55402**

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APR 09 2008

OFFICE OF PETITIONS

In re Application of :
**ANGEL**, et al. :
Application No. 10/081,125 : DECISION ON PETITION
Filed: February 21, 2002 : TO WITHDRAW
Attorney Docket No. **P01655-US-01(12178.0066)** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 23, 2007.

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

A review of the file record indicates that the power of attorney to **SCHWEGMAN LUNDBERG & WOESSNER, PA** has been revoked by the assignee of the patent application on February 11, 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 the undersigned at 571-272- 7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **ICE MILLER LLP**
**ONE AMERICAN SQUARE, SUITE 3100**
**INDIANAPOLIS, IN 46282-0200**

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SAN FRANCISCO, CA 94111-3834

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OFFICE OF PETITIONS

In re Application of Graham :
Application No. 10/081,129 : On Application For
Filing Date: February 21, 2002 : Patent Term Adjustment
Attorney Docket No. 015358-006600US :

This is in response to the "Request for Reconsideration of Patent Term Adjustment Determination" filed May 13, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is one thousand four hundred fifty-one (1,451) days, not six hundred eighty-four (684) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 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 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (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]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

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

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

[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.

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LEGAL DEPARTMENT
47690 EAST ANCHOR COURT
PLYMOUTH MI 48170-2455

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NOV 15 2005

**OFFICE OF PETITIONS**

In re Application of :
David Ernest JOHNSTON :
Application No. 10/081,130 : DECISION DISMISSING PETITIONS
Filed: February 22, 2002 : UNDER 37 CFR 1.78(a)(3) AND (a)(6)
Attorney Docket No. 01-002 :

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed August 16, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional 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 Commissioner may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application. The amendment filed August 16, 2005 fails to state the relationship of Application No. 09/494,050, filed January 28, 2000, to this application and is therefore unacceptable.

For the above-stated reasons, the petition is **DISMISSED**

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and a substitute amendment or an Application Data Sheet (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5) and (6)) to correct the above matters are required.

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

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of Petitions |

Any questions concerning this matter may be directed to David Bucci at (571) 272-7099.

Brian Hearn
Petitions Examiner
Office of Petitions

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**47690 EAST ANCHOR COURT**
**PLYMOUTH MI 48170-2455**

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APR 0 4 2006

OFFICE OF PETITIONS

In re Application of :
David Ernest JOHNSTON :
Application No. 10/081,130 : DECISION ON PETITIONS
Filed: February 22, 2002 : UNDER 37 CFR 1.78(a)(3) AND (a)(6)
Attorney Docket No. 01-002 :

This is a decision on the petitions under 37 CFR 1.78(a)(3) and 1.78(a)(6), filed January 19, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petitions are **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 information where there is a question whether the delay was unintentional.

The prior formerly pending nonprovisional application No. 09/494,050 was pending during the filing of this nonprovisional application, and was filed January 28, 2000, which is within twelve months of the filing date of the prior-filed provisional application No. 60/117,723 which was filed January 29, 1999, for which priority is claimed.

All of the above requirements having bee satisfied, the late claim for priority under 35 U.S.C. § 120 and 119(e) is accepted as being unintentionally delyaed.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Also, the reference to the prior-filed provisional application was submitted during the pendency of the prior nonprovisional application through which benefit is sought. See 35 U.S.C. §119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(3) and (a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. § 120 and 119(e), the petition to accept an unintentionally delayed claim of benefit to prior-filed nonprovisional application No. 09/494,050 and provisional application No. 60/117,723 is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §120 and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.***

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

Any questions concerning this matter may be directed to David Bucci at (571) 272-7099. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3673 for appropriate action on the amendment submitted January 19, 2006, including consideration by the examiner of the claim under 35 U.S.C. § §120 and 119(e) of the prior-filed nonprovisional and provisional applications.

Brian Hearn
Petitions Examiner
Office of Petitions

**ATTACHMENT** : Corrected Filing Receipt

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 3 2008

TO SPE OF : ART UNIT 1626

SUBJECT : Request for Certificate of Correction for Appl. No 10/081147 patent no7119090 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**

**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:** _____

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

on behalf of

_____ _____

**SPE** **Art Unit**

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

In re Application of :
Makoto Morishima et al :
Application No. 10/081,148 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 062807-042

This is a decision on the petition, filed April 4, 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 January 14, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter will be forwarded to Technology Center AU 1745 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

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OFFICE OF PETITIONS
ON PETITION

In re Application of :
Makoto Morishima et al :
Application No. 10/081,148 :
Filed: February 25, 2002 :
Attorney Docket No. 062807-042

This is a decision on the petition, filed April 4, 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 January 14, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter will be forwarded to Technology Center AU 1745 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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**P.O. BOX 8910**
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OFFICE OF PETITIONS

In re Application of
Anders Terje Brandt et al
Application No. 10/081,152
Filed: February 25, 2002
Attorney Docket No. 37400-00101/US

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 17, 2006.

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 John A. Castellano on behalf of himself and all the attorneys/agents associated with Customer No. **30593** for the above application.

All attorneys/agents of record have been withdrawn.

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

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named inventor; or (2) the intervening assignee of the entire interest. All future communications from the Office will be directed to the first named inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to Karen Creasy at 571-272-3208.

This application is being referred to Technology Center AU 2616 to await a reply to the Non-final Office action mailed January 10, 2006.

Amelia Au
Petitions Examiner
Office of Petitions

cc:
**ANDERS TERJE BRANDT**
**MARS ALE 8, DK-2860**
**SOBORG DENMARK**

**DANIEL M. CAVANAGH, ESQ.,**
**CHRISTIE, PARKER & HALE**
**3501 JAMBOREE ROAD, SUITE 6000**
**NEWPORT BEACH CA 92660**

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PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA CA 95050

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JUN 2 0 2008

OFFICE OF PETITIONS

In re Patent No.

7,299,209

Application No. 10/081,173

Filed: February 22, 2002

Issued: November 20, 2007

: DECISION ON PETITION

Attorney Docket No. **213**

This is a decision on the petition under 37 CFR §1.182, filed January 30, 2008, and in supplement on February 27, 2008 and March 7, 2008.

The petition is **dismissed as moot.**

In the petition filed January 30, 2008, petitioner requested a duplicate Letter of Patent. In the supplemental petitions, petitioner indicated that the Letters of Patent has been received. The instant petition is dismissed as moot accordingly.

The petition fee of $400.00 will be refunded, in due course.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Paper No.

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

MAILED

JUL 12 2010

OFFICE OF PETITIONS

| | |
|---|---|
| Applicant: Mochida, et al. | : ON PETITION |
| Issue Date: Dec. 16, 2008 | : 37 CFR 1.705(d) |
| Application No: 10/081,208 | |
| Patent No. 7,465,429 | : REQUEST FOR RECON |
| Filed: Feb. 25, 2002 | |
| Attorney Docket: 080542-0157 | : PATENT TERM ADJUSTMENT |

This is a decision on the petitions filed on January 5 and January 15, 2010, which are 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 one thousand one hundred forty-one (1141) days. The Office is acting upon the timely filed petition filed January 5, 2008 and not the untimely filed request of January 15, 2010.

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 one thousand one hundred forty-one (1141) days is **GRANTED-in-PART.**

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that in view of the decision in Wyeth, they are entitled to a total patent term adjustment of 1141 days, which includes 290 days due to exceeding three year pendency.

In view of the Federal Circuit decision Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010), patentees request is granted-in-part. In the instant situation, patentees do not dispute the "A" period delay of 518 days.

Patentees err in the "B" period calculation by one day. In that, the period is calculated from the day after the 36 months, i.e. from February 26, 2005 until one day before the filing of an RCE or the issue date. In this case the RCE was filed on December 12, 2005; hence the "B" period extends from February 26, 2005 to December 11, 2005, for a total of 289 days. Thus, the PTA term is the total "A" delay of 518 days, plus the total "B" delay of 289 days, plus the "C" delay of 519 days, minus applicant's delay of 0 days. As a result the request of a total PTA of 1141 days is **granted-in-part for a total of 1140 days.**

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The applicant is giving **one month or thirty (30) days** whichever is longer to reply to this DECISION. After the response period has elapsed, the Office will *sua sponte* issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand one hundred and forty (1140) days.

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

Telephone inquiries specific to this matter should be directed to Maria Nuzzolillo, (571) 272-8150.

/Kery Fries/

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

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,465,429 B2

DATED : December 16, 2008 **Draft**

INVENTOR(S) : Mochida, 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 (1140) days

Delete the phrase "by 851 days" and insert – by 1140 days--

Day : Monday
Date: 7/12/2010

PALM INTRANET

Time: 09:08:53

| PTA Calculations for Application: 10/081208 | | | |
|---|---|---|---|
| Application Filing Date: | 02/25/2002 | PTO Delay (PTO): | 1037 |
| Issue Date of Patent: | 12/16/2008 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 186 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1140 |
| PTO Delay Adjustment: | 289 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 95 | 07/12/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 289 | | |
| 91.5 | 11/25/2008 | PTA 36 MONTHS | | | |
| 91 | 12/16/2008 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 90 | 11/20/2008 | EXPORT TO FINAL DATA CAPTURE | | | |
| 89 | 11/19/2008 | DISPATCH TO FDC | | | |
| 88 | 11/19/2008 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 87 | 11/14/2008 | ISSUE FEE PAYMENT VERIFIED | | | |
| 86 | 11/14/2008 | ISSUE FEE PAYMENT RECEIVED | | | |
| 85 | 10/06/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 84 | 09/25/2008 | MAIL RESPONSE TO 312 AMENDMENT (PTO-271) | | | |
| 83 | 09/24/2008 | RESPONSE TO AMENDMENT UNDER RULE 312 | | | |
| 82 | 09/12/2008 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 14 | 84 |
| 81 | 09/12/2008 | MAIL BOA MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 80 | 09/12/2008 | BOA MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 79 | 08/18/2008 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 78 | 08/15/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 77 | 08/15/2008 | ISSUE REVISION COMPLETED | | | |
| 74 | 08/07/2008 | ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING | | | |
| 73 | 08/06/2008 | DOCUMENT VERIFICATION | | | |
| 72 | 08/07/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 71 | 08/01/2008 | NOTICE OF ALLOWABILITY | | | |
| 70 | 07/23/2008 | MAIL BPAI DECISION ON APPEAL - REVERSED | 519 | | 46 |
| 69 | 07/23/2008 | BPAI DECISION - EXAMINER REVERSED | | | |
| 68 | 06/25/2008 | CONFIRMATION OF HEARING BY APPELLANT | | | |
| 67 | 06/05/2008 | NOTIFICATION OF APPEAL HEARING | | | |
| 65 | 04/25/2008 | DOCKETING NOTICE MAILED TO APPELLANT | | | |
| 64 | 04/25/2008 | ASSIGNMENT OF APPEAL NUMBER | | | |
| 63 | 04/02/2008 | APPEAL AWAITING BPAI DOCKETING | | | |
| 62 | 11/29/2007 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 61 | 11/27/2007 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 60 | 11/16/2007 | DATE FORWARDED TO EXAMINER | | | |
| 59 | 11/07/2007 | REPLY BRIEF FILED | | | |
| 58 | 11/07/2007 | REQUEST FOR ORAL HEARING | | | |
| 57 | 10/05/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 56 | 10/01/2007 | EXAM. ANS. REVIEW COMPLETE | | | |
| 55 | 09/07/2007 | MAIL EXAMINER'S ANSWER | | | |
| 54 | 09/05/2007 | EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 53 | 07/12/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 52 | 07/12/2007 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 06/13/2007 | APPEAL BRIEF FILED | | | |
| 50 | 06/11/2007 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 49 | 06/07/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 48 | 06/07/2007 | DATE FORWARDED TO EXAMINER | | | |
| 47.1 | 04/18/2007 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 47 | 04/18/2007 | APPEAL BRIEF FILED | | | |
| 46 | 02/21/2007 | NOTICE OF APPEAL FILED | | 28 | 40 |
| 45 | 02/21/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 44 | 02/12/2007 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 43 | 02/07/2007 | ADVISORY ACTION (PTOL-303) | | | |
| 42 | 02/06/2007 | DATE FORWARDED TO EXAMINER | | | |
| 41 | 01/23/2007 | AMENDMENT AFTER FINAL REJECTION | | | |
| 40 | 10/24/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 39 | 10/23/2006 | FINAL REJECTION | | | |
| 38 | 08/31/2006 | DATE FORWARDED TO EXAMINER | | | |
| 37 | 08/24/2006 | RESPONSE AFTER NON-FINAL ACTION | | 88 | 35 |
| 36 | 08/24/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 35 | 02/28/2006 | MAIL NON-FINAL REJECTION | | | |

| | | | | | |
|---|---|---|---|---|---|
| 34 | 02/24/2006 | NON-FINAL REJECTION | | | |
| 33 | 02/25/2002 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 32 | 12/20/2005 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 12/12/2005 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 30 | 12/20/2005 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 12/12/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 31 | 25 |
| 28 | 12/20/2005 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 27 | 12/12/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 26 | 12/12/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 25 | 08/11/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 24 | 08/08/2005 | FINAL REJECTION | | | |
| 23 | 05/25/2005 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 05/06/2005 | RESPONSE AFTER NON-FINAL ACTION | | 25 | 20 |
| 21 | 05/06/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 20 | 01/11/2005 | MAIL NON-FINAL REJECTION | | | |
| 19 | 01/10/2005 | NON-FINAL REJECTION | | | |
| 18 | 10/28/2004 | DATE FORWARDED TO EXAMINER | | | |
| 17 | 10/22/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 16 | 10/22/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 15 | 09/24/2004 | MAIL RESTRICTION REQUIREMENT | 518 | | -1 |
| 14 | 09/21/2004 | ISSUE REVISION COMPLETED | | | |
| 13 | 09/21/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 12 | 10/15/2003 | REFERENCE CAPTURE ON IDS | | | |
| 11 | 10/15/2003 | CLAIMS PTO | | | |
| 10 | 10/14/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 9 | 10/14/2003 | CLAIMS PTO | | | |
| 8.7 | 02/25/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 02/25/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 02/25/2002 | PRELIMINARY AMENDMENT | | | |
| 6 | 04/16/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 5 | 04/09/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 4 | 04/09/2002 | APPLICATION IS NOW COMPLETE | | | |
| 3 | 03/27/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |

| | | | | | |
|---|---|---|---|---|---|
| 2 | 03/08/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 02/25/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

## EXPLANATION OF PTA CALCULATION

## EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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OFFICE OF PETITIONS

In re Application of :
Christian MOY, et al :
Application No. 10/081,263 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 770P010693-US (PAR) :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 27, 2007, to revive the above-identified application.

The petition is **GRANTED**.

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

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 11/672,711.

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.

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 February 27, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account 50-2927.

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

Thurman Page
Petitions Examiner
Office of Petitions

cc: MIKE S. RYU
158 RUE DE L'UNIVERSITE
PARIS 75007
FRANCE

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OCT 12 2007

**OFFICE OF PETITIONS**

In re Application of :
Christian MOY et al. :
Application No. 10/081,278 : DECISION ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 770P101633-US (PAR) :

This is a decision on the petition under 37 CFR 1.137(b), filed June 28, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, July 28, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on October 29, 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 an amendment; (2) the petition fee $1,500.00; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of July 28, 2006 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 it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

The application file is being referred to Technology Center AU 3628 for appropriate action on the concurrently filed amendment.

Michelle R. Eason

Michelle R. Eason
Paralegal Specialist
Office of Petitions

Cc: **CABINET BEAU DE LOMENIE**
**158 RUE DE L'UNIVERSITE**
**PARIS, FRANCE 75007**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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Paper No. 5

DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

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FEB 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Tim Hui-Ming Huang :
Application No. 10/081,327 : DECISION ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 40629-2 :

This is a decision on the "Petition to Accord Nonprovisional Application with a Filing Date" filed July 11, 2002 (certificate of mailing July 8, 2002). The application file was recently forwarded to the Office of Petitions for consideration of the petition.

Application papers in the above-identified application were filed on February 21, 2002. However, on May 8, 2002, the Office of Initial Patent Examination mailed applicants a "Notice of Omitted Item(s) in a Nonprovisional Application." Applicants were thereby notified that the application papers had been accorded a filing date; however, figures 12-57 described in the specification appeared to have been omitted. In addition, applicants were advised that the Office was unable to read all of the files on the compact disc submitted and a new duplicate set of discs was required.

In response, applicants timely filed the instant petition. With respect to figures 12-57, petitioner acknowledges that these figures were not included in the papers filed on February 21, 2002. Petitioner asserts that the subject matter of figures 12-57 was, and is, represented in the originally filed sequence listing of this continuation application. However, with respect to the compact discs, petitioner contends that the two compact disks and floppy diskette which contained the sequence listing were, in fact, provided on filing. Petitioner acknowledges, however, that the disks were not in PatentIn format, and states that they are submitting on petition two compact disks and one floppy diskette of the sequence listing in PatentIn 3.1 format.

As stated in the "Notice of Omitted Items," this application has been accorded a filing date of February 21, 2002. The mailing of a "Notice of Omitted Items," asserting that figures described in the specification appear to have been omitted from the application, permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept

the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that drawing sheets containing figures 12-57 were deposited on February 21, 2002, nor requests a later filing date based on later filing of the omitted drawings.

Accordingly, with respect to the figures, the petition is inappropriate and is subject to dismissal.

The compact discs submitted with the application on filing and the new compact discs submitted with the petition could not be read by the Office using a standard Office workstation. After further investigation it appears that the discs were unreadable on a standard Office workstation because they are not permanent, i.e., not closed and finalized. Compact discs are required to be "permanent." See 37 C.F.R. § 1.52(e)(2).

Thus, the "Notice of Omitted Items" was correct in stating that the Office was unable to read all of the files and in requiring a new duplicate set of discs. The Notice was properly mailed and will not be withdrawn.

The petition is **DISMISSED**. The petition fee will not be refunded as the petition was not necessitated by any Office error.

In a telephone communication between Barry L. Davison, attorney for applicant, and Michael Lewis of the Office of Patent Legal Administration, USPTO, Mr. Davison agreed to file a new copy of the compact discs, wherein the compact discs would be finalized and closed. Michael Lewis compared the sequence on a compact disc filed December 19, 2002, with the sequence contained on the compact disc submitted with the application on filing and determined that they contain the same sequence.

The compact disc filed on December 19, 2002 has been entered into the record of the application.

The application with a filing date of February 21, 2002, is being returned to the Office of Initial Patent Examination for completion of preexamination processing.

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

17 SEP 2004

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William F. Lawrence
FROMMER LAWRENCE & HAUG
747 Fifth Avenue
Washington, DC 20005

In re Application of :
BARTSCH, Klaus :
Application No.: 10/018,331 :
PCT No.: PCT/EP00/02809 :
Int. Filing Date: 30 March 2000 : **DECISION**
Priority Date: 30 April 1999 :
Attorney Docket No.: 514413-3899 :
For: PROCESS FOR THE PREPARATION :
OF L-PHOSPHINOTHRICINE BY :
ENZYMATIC TRANSAMINATION WITH :
ASPARTATE :

This decision is in response to applicant's "Request for Correction of Filing Receipt" filed via facsimile on 10 March 2004 which is hereby **GRANTED** as follows:

A review of the filing receipt indicates that the total claim number is incorrect. The number of claims should be "13," not "15." Moreover, international publication records indicate that the international filing date of PCT/EP00/02809 is 30 March 2000, not 30 June 2000 as listed on the filing receipt. In addition, applicant submitted a preliminary amendment on changing the title listed in the international application to "Process for the Preparation of L-Phosphinothricine by Enzymatic Transamination with Aspartate."

This application is being forwarded to the DO/EO/US to mail a corrected filing receipt indicating the correct number of claims, the proper international filing date for PCT/EP00/02809 and the correct title.

The application will then be forwarded to Technology Center 1600 for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457
(571) 272-3302 (after 01 October 2004)

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 07/03/07

TO SPE OF : ART UNIT 1615

SUBJECT : Request for Certificate of Correction for Appl. No 10/081333 Patent No.: 7198794

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

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

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

**Angela Green**
**Certificates of Correction Branch**
**703.308.9380 ext.** 23

**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:** _____

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE _____ Art Unit 1615

UNITED STATES PATENT AND TRADEMARK OFFICE

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MICHELLE L. JOHNSON
ZYMOGENETICS INC.
1201 EASTLAKE AVENUE
SEATTLE, WA 98102

COPY MAILED

SEP 20 2006

OFFICE OF PETITIONS

In re Application of :
Theresa A. Deisher et al. :
Application No. 10/081,347 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 96-20C5 :

This is a decision on the petition, filed April 7, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on June 16, 2005, for failure to file a timely response to the non-Final Office Action mailed March 15, 2005. A response was filed September 15, 2005 with a three month extension of time request. However, an Office communication (notification of non-responsive but *bona fide* reply) mailed September 23, 2005 advised that the amendment was non-responsive. The period for reply ran from the mailing of the Office communication mailed June 16, 2005 and was only subject to be extended pursuant to 37 CFR 1.136 to three months from the statutory reply date. Since a three month extension of time had already been requested, no additional extensions were allowable and in view of the non-responsive amendment filed, the application became abandoned. The instant petition and this decision precede the mailing of the Notice of Abandonment.

The application is being forwarded to Technology Center 1647 for consideration of the response filed April 7, 2006 and for further examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

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

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

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Paper No. 4

MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581415
MINNEAPOLIS, MN 55458

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JUL 10 2003

OFFICE OF PETITIONS

In re Application of :
Brandenburger, et al. :
Application No. 10/081,351 : ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. 287.0002 0101 :

This is a decision on the petition under 37 CFR 1.182, filed June 25, 2003, to change the last name of the third named inventor.

The petition is GRANTED.

The last name of the third inventor will be changed from "OWENS" to -- **HIBBEN** --.

The file is being forwarded to Technology Center 1700 for examination in due course.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 6

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

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SEP 16 2004

**OFFICE OF PETITIONS**

In re Application of :
Anandakumar, et al. :
Application No. 10/081,355 :
Filed: February 21, 2002 :
Attorney Docket No. TI-29773

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed March 3, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension 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 action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the Notice to File Missing Parts of Nonprovisional Application mailed March 20, 2002, which set a shortened period for reply of two (2) months from its mailing date. No response was received within the allowable period, and the application became abandoned on May 21, 2002. A Notice of Abandonment was mailed on December 31, 2003.

A grantable petition under 37 CFR 1.137(a)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

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

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

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

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

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

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."[4]

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"[5]
"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."[6]

**The standard**

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[7]

---

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

[4]Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

[5]Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

[6]Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

[7]Id.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[8] Nonawarness of a PTO rule will not constitute unavoidable delay.[9]

**Application of the standard to the current facts and circumstances**

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that the Notice to File Missing Parts of Nonprovisional Application mailed March 20, 2002, was not received.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

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 of Patent Examining Procedure* (MPEP) that requires the following:

> [t]he showing requires to establish nonreceipt of an Office communication must include a statement from the fractioned 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 practioner's statement.

Petitioner has not provided the statements of corroborative documents requested. Any renewed petition filed must comply with the requirements of section 711.03(c) of the MPEP.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b) (enclosed). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee ($1,330.00 for a large entity and $665.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

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[8]See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

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

Deposit account 20-0668 will be charged $110.00 for the instant petition fee.

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

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Form PTO/SB/64

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Paper No. 8

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

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DEC 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Anandakumar, et al. :
Application No. 10/081,355 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. TI-29773 :

This is a decision on the renewed petition under 37 CFR 1.137(a), filed November 16, 2004, to revive the above-identified application.

The renewed petition is **GRANTED.**

The application became abandoned for failure to reply to the Notice to File Missing Parts of Nonprovisional Application mailed March 20, 2002, which set a shortened period for reply of two (2) months from its mailing date. No response was received within the allowable period, and the application became abandoned on May 21, 2002. A Notice of Abandonment was mailed on December 31, 2003. A petition under 37 CFR 1.137(a) was filed on March 3, 2004, by was dismissed by a decision mailed September 16, 2004. The renewed petition was filed on November 16, 2004.

It is noted that an additional $110.00 was remitted with the instant petition, however; there is no petition fee for the renewed petition. Deposit account 20-0668 will be refunded $110.00, accordingly.

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

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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

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OCT 0 3 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hirose et al. | : | |
| Application No. 10/081,385 | : | ON PETITION |
| Filed: February 20, 2002 | : | |
| Attorney Docket No. | : | |
| 16869P-042900US | : | |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 25, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

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

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3232. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 2877 for appropriate action on the amendment filed July 25, 2005, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.

Frances Hicks

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

**ATTACHMENT:** Corrected Filing Receipt

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20050630

**DATE** : June 30, 2005

**TO SPE OF** : ART UNIT 1712

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,793,951

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

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

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

☐ **Approved** **All** changes apply.

☒ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

The changes specified in all of column 12, all of column 13, and all of column 14 do not apply. Said changes use improper line numbers and would not read correctly if said changes were made. It is further unclear what error on the part of the Office exist that would require the renumbering of the claims.

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 23 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

KENNETH R. GLASER
MICHAEL E. MARTIN
GARDERE WYNNE SEWELL LLP
1601 ELM STREET, SUITE 3000
DALLAS, TX 75201

Paper No. 6

In re Application of :
Jerry W. Stewart, et al. :
Application No. 10/081,412 :
Filed: February 22, 2002 :
For: MULTI-STORY MULTIPLE DWELLING COMPLEX WITH SEMI-PRIVATE GARAGE...

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is a decision on applicant's petition to withdraw the holding of abandonment filed January 13, 2004 in the United States Patent and Trademark Office.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action dated June 13, 2003 and a Notice to that effect was mailed on December 30, 2003.

Petitioner states that a response with a request for a three month extension of time was filed on December 15, 2003 by facsimile transmission. The copy of the response submitted with the petition includes a Certificate of Transmission dated December 15, 2003, authorization to charge applicants deposit account for three months, and a post card receipt dated December 18, 2003. The post card receipt however cannot be used as evidence of timely filing since it extends past the six month statutory period.

(MAILING)

Any petition to withdraw the holding of abandonment based upon a Certificate of Transmission by facsimile must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the *original* response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above the petition fails, under requirement (2), to also include a statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of sending the *original*

response by facsimile transmission on the date indicated on the certificate, by the person who signed the certificate.

Therefore a statement under 37 C.F.R. 1.8(b)(3), as noted above, is needed from Anne Ziegler attesting to the personal knowledge of sending the *original* response by facsimile transmission on the date indicated on the certificate for the petition to be granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/cps: 2/18/04

#8
DW

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JUN 09 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

KENNETH R. GLASER
MICHAEL E. MARTIN
GARDERE WYNNE SEWELL LLP
1601 ELM STREET, SUITE 3000
DALLAS TX 75201

In re Application of :
Jerry W. Stewart et al. :
Application No. 10/081,412 :
Filed: February 22, 2002 :
For: MULTI-STORY MULTIPLE DWELLING :
COMPLEX WITH SEMI-PRIVATE GARAGE TO
APARTMENT ENTRY AND EXIT PATHWAYS

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is in response to the renewed Petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on March 8, 2004.

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

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____.

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

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

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

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

☒ Originally sent response filed December 15, 2003 has been found and matched with the application.

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

RAR/mjz: 5/27/04

Randolph A. Reese
Special Programs Examiner
Group 3600

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WWW.USPTO.GOV

HAYNES BEFFEL & WOLFELD LLP
P.O. BOX 366
HALF MOON BAY CA 94019

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AUG 07 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Rajendra Pendse
Application No. 10/081,425
Filed: February 22, 2002
Attorney Docket No. CPAC 1011-2 US

This is a decision on the petition, filed August 7, 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 19, 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 2829 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
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Paper No. 17

Date : August 7, 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) : Rajendra Pendse
Application No. : 10/081,425
Filed : February 22, 2002

The above-identified application has been assigned Patent No. 6,610,562 and an issue date of August 26, 2003.

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

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 August 26, 2003:

"All reference to Patent No. 6,610,562 to Rajendra Pendse of California for APPARATUS AND PROCESS FOR PRECISE ENCAPSULATION OF FLIP CHIP INTERCONNECTS appearing in the Official Gazette of August 26, 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

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JJGJR.: 03-05

Paper No: 7

SHIH-JONG J. LEE
15418 SE 53RD PLACE
BELLEVUE WA 98006

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MAR 0 9 2005

OFFICE OF PETITIONS

In re Application of
Lee :
Application No. 10/081,441 :
Filing Date: 22 February, 2002
Attorney Docket No. TAL: SV16 :

This is a decision on the petition filed on 17 February, 2005, alleging unavoidable delay under 37 C.F.R. §1.137(a).

For the reasons set forth below, the petition as considered under 37 C.F.R.§1.137(a) is **GRANTED**.

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 3 May, 2004, with reply due absent extension of time on or before 3 August, 2004;
- the instant application went abandoned after midnight 3 August, 2004;
- the Office mailed a Notice of Abandonment on 11 February, 2005;
- with the instant petition (with fee), Petitioner submits the required reply (amendment),

alleges timely transmittal of the reply to the Office, and supports the allegation with evidence of a transmittal fax with amendment and an Office confirmation of receipt (Auto Reply Facsimile Transmission) dated "7/6/2004."

## 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).[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.

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

Petitioner has satisfied the requirements of the regulation.

**Petitioner is cautioned to accompany every submission to the Office with a Certificate of Mailing/FAX Transmission (Forms PTO/SB/92 and PTO/SB/95) (sample copies enclosed).**

CONCLUSION

The instant petition under 37 C.F.R. §1.137(a) hereby is **granted**.

The file is forwarded to Technology Center 2100 for further processing in due course.

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

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

Encl: Certificate of Mailing/FAX Transmission (Forms PTO/SB/92 and PTO/SB/95)

# 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) |
|---|---|---|---|---|
| 6,673,612 | 2004-01-06 | 10081461 | 2002-02-21 | 7.01.1 |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Mark K Johnson/ | Date (YYYY-MM-DD) | 2008-02-26 |
| Name | Mark K Johnson | Registration Number | 35909 |

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. 6673612
Issue Date: January 6,2004
Application No. 10081461
Filed: February 21,2002
Attorney Docket No. 7.01.1

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

This is a decision on the electronic petition, filed February 26,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 26,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Orrick Herrington & Sutcliffe, LLP
4 Park Plaza
Suite 1600
Irvine, CA 92614-2558

COPY MAILED

JUL 2 5 2003

OFFICE OF PETITIONS

In re Application of :
R. W. Besoyan :
Application No. 10/081,471 : DECISION GRANTING PETITION
Filed: February 21, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 13364.4001 :

This is a decision on the petition, filed July 2, 2003, under 37 CFR 1.137(f), which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application.

The petition is GRANTED.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on February 17, 2003. 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(b) to revive for failure to timely notify the Office of the filing of an application in a foreign country 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 [notification of foreign filing under 35 U.S.C. § 122(b)(2)(B)(iii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of October 30, 2003 accompanies this decision on petition.

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

There is no indication that a reply to the non-final Office action of March 28, 2003 has been filed. Accordingly, a shortened statutory period of three (3) months from the reply to the non-final Office action of March 28, 2003 is restarted with the mailing date of this decision. Extensions of time pursuant to the provisions of 37 CFR 1.136(a) are permitted. Failure to timely reply within the period restarted by this decision will result in the abandonment of this application.

This application is being forwarded to Technology Center Art Unit 3761 to await a reply to the non-final Office action, the period of which is restarted to run from the mailing date of this decision on petition as noted above.

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

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

Frances Hicks
Lead Petitions Examiner

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 6

Waters & Morse, P.C.
400 Ledyard Building
125 Ottawa Avenue, NW
Grand Rapids, MI 49503

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JUL 16 2003

OFFICE OF PETITIONS

In re Application of
Mark L. Groendal, et al.
Application No. 10/081,492
Filed: February 22, 2002
Attorney Docket No. GROM 2.2-2

ON PETITION

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

The petition is GRANTED.

The above-identified application became abandoned for failure to submit an oath/declaration and substitute drawings in a timely manner in reply to the Notice To File Missing Parts of NonProvisional Application mailed March 15, 2002, which set a shortened statutory period for reply of two(2) months. Accordingly, the application became abandoned on May 16, 2002.

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

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry D. Brinkley at (703)305-9220.

The application file is being forwarded to 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 D. Brinkley
Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 15 2010

OFFICE OF PETITIONS

**FARJAMI & FARJAMI LLP**
**26522 LA ALAMEDA AVE.**
**SUITE 360**
**MISSION VIEJO CA 92691**

In re Patent No 6,961,424
Issue Date: November 1, 2005
Application No. 10/081,509
Filed: February 21, 2002
Attorney Docket No. 01CON317P

ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed December 18, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on November 1, 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.

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

The patent file is being forwarded to Files Repository.

/Diane C. Goodwyn/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

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DEC 0 6 2006

OFFICE OF PETITIONS

Timothy P. O'Hagan
8710 Kilkenny Court
Fort Myers, FL 33912

In re Application of :

Robert F. Meyerson et al. :
Application No. 10/081,513 : DECISION ON PETITION
Filed: February 21, 2002 : TO WITHDRAW
Attorney Docket No. 24831-011 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 16, 2006.

The request is **APPROVED**.

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

The request was signed by Timothy P. O'Hagan on behalf of all attorneys of record.

All attorneys/agents have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed May 4, 2006 that requires a reply from the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Robert F. Meyerson**
2180 Immokalee Road
Suite 311
Naples, FL 34110

cc: **Adam Meyerson**
Telantis Research
791 Wye Road
Akron, OH 44333

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/081,513 | 02/21/2002 | Robert F. Meyerson | 24831-011 |

**CONFIRMATION NO. 2825**

*OC000000021490447*

*OC000000021490447*

29956
TIMOTHY P. O'HAGAN
8710 KILKENNY CT
FORT MYERS, FL 33912

Date Mailed: 12/06/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/16/2006.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

---

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

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KENYON & KENYON
ONE BROADWAY
NEW YORK NY 10004

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DEC 15 2005

OFFICE OF PETITIONS

In re Application of :
Walter Brandenburger :
Application No. 10/081,517 : DECISION ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 22750/527 :

This is a decision on the petition under 37 CFR 1.181, filed November 4, 2005, to withdraw the holding of abandonment.

The application became abandoned on March 30, 2005, for failure to reply pay the issue and publication fees in response to the Notice of Allowance and Fee(s) Due mailed on December 29, 2004, which set a three-month statutory period for reply. A Notice of Abandonment was mailed on October 13, 2005.

In the present petition, the petitioner asserted that practitioner did not receive the Notice of Allowance of December 29, 2004.

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

A review of the record indicates no irregularity in the mailing of the Notice of Allowance, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. 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).

In the present petition, the practitioner, Richard Rosati, stated that he enclosed a copy of the docket records for mail received from December 27, 2004 to January 21, 2005, which he alleged showed that he did not receive any mail relating to the above-identified application from the United States Patent and Trademark Office during that period. Mr. Rosati asserted that if he had received the Notice of Allowance of December 29, 2004, it would have been indicated on the docket records for mail received. Additionally, Mr. Rosati submitted a copy of the file jacket for the above-referenced application. Mr. Rosati explained that the file jacket did not include an entry for the Notice of Allowance, which would have been entered if it was received in his office and the appropriate due date for the payment of issue fee would have been indicated on the same file jacket. Additionally, Mr. Rosati indicated that the docket reports would have been sent to the applicant indicating a due date for the issue fee.

Upon a review of the statement of Mr. Rosati and the documents submitted with the petition, the Office concludes that the showing of record is sufficient to warrant withdrawal of the holding of abandonment. Accordingly, the petition to withdraw the holding of abandonment is granted.

This matter is being referred to the Office of Patent Publications.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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PO BOX 747
FALLS CHURCH, VA 22040-0747

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MAR 10 2006

**OFFICE OF PETITIONS**

In re Application of :
Yoshitomo Tokumoto et al :
Application No. 10/081,518 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 1560-0377P

This is a decision on the petition filed, March 3, 2006 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on July 27, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2855 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

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P.O. BOX 747
FALLS CHURCH, VA 22040-0747

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JUN 2 0 2006

OFFICE OF PETITIONS

In re Application of :
Yoshitomo Tokumoto et al :
Application No. 10/081,518 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 1560-0377P

This is a decision on the petition filed June 13, 2006 under 37 CFR 1.313(c)(2), 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 was mailed on March 22, 2006, with the issue fee being due on or before June 22, 2006.

37 CFR 1.313(c)(2) provides for withdrawal of an application from issue after payment of the issue fee. In the instant case, as noted above, the issue fee in reply to the Notice of Allowance of March 22, 2006 has not been received. Therefore, the filing of a petition to withdraw this application from issue is unnecessary at this time. 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.

The $130 fee submitted for the petition under 37 CFR 1.313(c)(2) is unnecessary; therefore, petitioner may request a refund of this fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

Inquiries concerning this decision may be directed to the undersigned at (571) 272-3210.

This matter is being referred to Technology Center Art Unit 2855.

Irvin Dingle
Petitions Examiner
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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**BANNER & WITCOFF, LTD.**
**1100 13th STREET, N.W.**
**SUITE 1200**
**WASHINGTON DC 20005-4051**

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APR 0 5 2007

OFFICE OF PETITIONS

In re Patent No. 6,762,215 :
Application No. 10/081,533 :
Filed: February 25, 2002 : ON PETITION
Issued: July 13, 2004 :
Attorney Docket No. 001458.00012 :

This is a decision on the petition filed April 20, 2005, 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**.

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

Petitioner's deposit account will be charged an additional $100.00 for the Certificate of Correction fee.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Liana Walsh at (571) 272-3206. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Frances Hicks
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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Paper No. 7

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

JUL 15 2004

In re Application of:
IWATA *et al.*
Serial No.: 10/081,541
Filed: February 22, 2002
Attorney Docket No.: **5000-4999**

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed on February 11, 2004. The petition has been treated as a petition filed under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **GRANTED**.

A requirement for Restriction and/or Election (Requirement for Restriction) was mailed on May 02, 2003. The application was held abandoned for failure to timely file a response to the Requirement for Restriction, and a Notice of Abandonment was mailed on January 27, 2004.

Petitioner asserts that on May 30, 2003, a response to the Requirement for Restriction was filed. To support this assertion, petitioner has submitted a copy of the response, which bears a Certificate of Mailing under 37 CFR § 1.8, of May 30, 2003, and a copy of a return postcard receipt, which acknowledges receipt in the USPTO of a Response to the Requirement for Restriction on June 02, 2003.

A review of the application file record reveals that the above-identified response having been acknowledged as being received in the PTO on June 02, 2003, is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states, "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the response was timely received in the PTO but lost somewhere after receipt thereof.

For the above stated reason, the petition is granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The copy of the Response to the Requirement for Restriction submitted with the petition on February 11, 2004, is accepted since the response originally submitted was apparently lost.

The application file is being forwarded to the examiner of record for further examination.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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

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NOV 29 2007

**OFFICE OF PETITIONS**

In re Application of
**SEO**, et al.
Application No. 10/081,558
Filed: February 20, 2002
Attorney Docket No. **07977-304001**

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 23, 2007, 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 18, 2007 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 Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2826 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Frances Hicks
Petitions Examiner
Office of Petitions

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment of the application.*

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Husch Blackwell Sanders, LLP
Husch Blackwell Sanders LLP Welsh & Katz
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

Mail Date: 04/22/2010

| | | |
|---|---|---|
| **Applicant** | : Michael Ely | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7606909 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/081,560 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/20/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1612** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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LEE M. DEGROSS
400 PARK PLACE, #1H
FORT LEE, NJ 07024

**MAILED**

APR 01 2010

**OFFICE OF PETITIONS**

In re Application of
Lee M. DeGross
Application No. 10/081,579
Filed: February 22, 2002
Attorney Docket No.: None

ON PETITION

This is a decision in response to the petition, filed December 31, 2009, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, July 25, 2005, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on October 26, 2005. On February 17, 2006, a Notice of Abandonment was mailed.

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

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

This application is being referred to Technology Center AU 2655 for appropriate action by the Examiner in the normal course of business on the response filed December 31, 2009.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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P.O. Box 1450
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**PHILIP S. JOHNSON**
**JOHNSON & JOHNSON**
**ONE JOHNSON & JOHNSON PLAZA**
**NEW BRUNSWICK NJ 08933-7003**

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JAN 13 2006

**OFFICE OF PETITIONS**

In re Application of :
Carlos R. Plata-Salaman et al :
Application No. 10/081,606 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. ORT-1581 :

This is a decision on the petition, filed January 9, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

**Petitioner is advised that the issue fee paid on June 30, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 1614 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

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SEYFARTH SHAW LLP
WORLD TRADE CENTER EAST
TWO SEAPORT LANE, SUITE 300
BOSTON MA 02210-2028

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JAN 16 2008

**OFFICE OF PETITIONS**

In re Application of :
**PANZNER**, et al. :
Application No. 10/081,617 : DECISION ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. **24793/10** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 9, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to submit formal drawings in a timely manner in reply to the Notice to File Corrected Application Papers, mailed February 28, 2007, which set a period for reply of sixty (60) days. Accordingly, this application became abandoned on April 29, 2007.

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

The replacement drawing(s) submitted on July 9, 2007 have been approved by the USPTO draftsperson.

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

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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PERKINS COIE LLP
PATENT-SEA
PO BOX 1247
SEATTLE WA 98111-1247

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OFFICE OF PETITIONS

In re Application of :
Fuller, et al. :
Application No. 10/081,624 : DECISION ON PETITION
Filed: February 20, 2002 :
Attorney Docket No. 108298636US :

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

The petition is **GRANTED**.

The above-identified application was held abandoned for failure to timely file an Appeal Brief. Applicants filed a Notice of Appeal on March 13, 2006. Accordingly, Applicants had a two month extendable period for reply in which to file an Appeal Brief. See 37 CFR 41.37(e). However, the Office mailed a Notice of Abandonment on June 20, 2006.

In view of 37 CFR 41.37(e), it is obvious that the Notice of Abandonment was mailed in error.

Accordingly, **the holding of abandonment is withdrawn.**

The matter is being forwarded to Group Art Unit 1733 for consideration of the Appeal Brief filed July 13, 2006 (made timely by obtaining a two month extension of time).

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

Cliff Congo
Petitions Attorney
Office of Petitions

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

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ON PETITION JAN 27 2005

OFFICE OF PETITIONS

In re Application of :
Masahiko Igaki et al :
Application No. 10/081,626 :
Filed: February 20, 2002 :
Attorney Docket No. 1232-4822 :

This is a decision on the petition, filed January 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 December 21, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 2877 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).

PETN

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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SEP 20 2002

#3

DRINKER BIDDLE & REATH LLP
ONE LOGAN SQUARE
18TH & CHERRY STREETS
PHILADELPHIA PA 19103-6996

| | |
|---|---|
| In re Application of | : |
| Robert Norman Rice et al | : |
| Serial No.: 10/081,646 | : PETITION TO MAKE SPECIAL |
| Filed: February 22, 2002 | : |
| Attorney Docket No.: 37921-2 | : |

This is in response to applicants' petition filed February 22, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

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

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

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

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

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701 FIFTH AVE
SUITE 6300
SEATTLE WA 98104-7092

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NOV 16 2004

**OFFICE OF PETITIONS**

Applicant: Tay et al.
Appl. No.: 10/081,700
Filing Date: February 22, 2002
U.S. Patent No.: 6,793,822
Issue Date: September 21, 2004
Title: AEROBIC BIOMASS GRANULES FOR WASTE WATER TREATMENT
Attorney Docket No.: 690105.401
Pub. No.: US 2003/0159991 A1
Pub. Date: August 28, 2003

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on October 28, 2003.

The request is DISMISSED as moot.

The instant request identifies numerous errors in the published patent application publication. Since the application has already issued as U.S. Patent No. 6,793,822 on September 21, 2004, the request is deemed moot.

Inquiries relating to this matter may be directed to the undersigned at (571) 272-7709.

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

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MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581415
MINNEAPOLIS MN 55458

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NOV 16 2004

OFFICE OF PETITIONS

Applicant: Vaartstra
Appl. No.: 10/229,802
Filing Date: August 28, 2002
U.S. Patent No.: 6,794,284
Issue Date: September 21, 2004
Title: SYSTEMS AND METHODS FOR FORMING REFRACTORY METAL NITRIDE LAYERS USING DISILAZANES
Attorney Docket No.: 150.01280101
Pub. No.: US 2004/00043604 A1
Pub. Date: March 4, 2004

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on March 4, 2004.

The request is DISMISSED as moot.

The instant request identifies numerous errors in the published patent application publication. Since the application has already issued as U.S. Patent No. 6,794,284 on September 21, 2004, the request is deemed moot.

Inquiries relating to this matter may be directed to the undersigned at (571) 272-7709.

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

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

DATE : 4/22/08

Paper No.: —

TO SPE OF : ART UNIT 1614

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/081713 Patent No: 7078436 B2

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

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within 7 days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

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**

*VIRGINIA TOLBERT*
**Certificates of Correction Branch**
**703-308-9390 ext. 113**

**Thank You For Your Assistance**

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

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

**Comments:** Note line changes in columns 12-14 and 16.

Phyllis Spivack

PHYLLIS SPIVACK
PRIMARY EXAMINER

Ardin H. Marschel

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

SPE

1614
Art Unit

PTO/SB/44 (09-07)
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# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION

**PATENT NO. :** US 7,078,436 B2

**APPLICATION NO.:** 10/081,713

**ISSUE DATE :** July 18, 2006

**INVENTOR(S) :** Plata-Salaman et al.

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

On the title page, item (54), delete "CARBAMATE COMPOUNDS FOR USE IN PREVENTING OR TREATING ANXIETY DISORDERS" and in place thereof insert --CARBAMATE COMPOUNDS FOR USE IN THE TREATMENT OF IMPULSE CONTROL DISORDERS--;

Column 12, line 64, delete "preventing or";

Column 12, line 64, delete "anxiety disorders" and in place thereof insert --an Impulse Control Disorder,--;

Column 12, line 65, delete "thereof" and in place thereof insert --of treatment,--;

Column 12, line 66, after the word "compound", insert --, or a pharmaceutically acceptable salt or ester thereof--;

Column 13, line 27, delete the parenthesis "(" before the word "wherein";

Column 13, line 30, delete the parenthesis ")" after the word "cyano";

Column 13, line 35, delete "preventing or";

Column 13, line 35, delete "anxiety disorders" and in place thereof insert the words --an Impulse Control Disorder--;

Column 13, line 36, delete "thereof" and in place thereof insert --of treatment--;

Column 13, line 37, after the word "enantiomer" insert --, or a pharmaceutically acceptable salt or ester thereof,--;

Column 13, line 67, after the word "phenyl" add a comma --,--;

Column 13, line 67, delete the parenthesis"(" before the word "wherein";

MAILING ADDRESS OF SENDER:
PETER HERRIDGE
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

EPM

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7078436 B2

## UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION

Column 13, line ~~69~~ 67, after the word "wherein" add the word --the--;

Column 14, line 20, after the words "Formula (IIa)" add the words --or a pharmaceutically acceptable salt or ester thereof--;

Column 14, line ~~40~~ 47, delete the parenthesis "(" before the word "wherein";

Column 14, line ~~40~~ 47, after the word "wherein" add the word --the--;

Column 14, line ~~60~~ 67, after the words "Formula (IIa)" add the words --or a pharmaceutically acceptable salt or ester thereof--;

Column 16, line 5, after the word "method" insert a comma --,--;

Column 16, line 5, after the word "as" insert the word --claimed--;

Column 16, line 5, delete the word "impulse" and in place thereof insert --Impulse--;

Column 16, line 12, delete the word "personally" and in place thereof insert --personality--;

Column 16, line ~~16~~ 15, after the word "method" insert a comma --,--;

Column 16, line ~~16~~ 15, after the word "as" insert the word --claimed--;

Column 16, line ~~16~~ 15, delete the numerals and words "1 or 5" and in place thereof insert the numeral --20--;

Column 16, lines ~~16~~ 15 to ~~18~~ 17, delete the words "therapeutically effective amount is from 0.001 mg/Kg/dose to about 100 mg/Kg/dose" and in place thereof insert the words --Impulse Control--;

Column 16, line ~~20~~ 19, delete the words and numerals "of claim 21" and in place thereof insert the words and numerals --as in claims 1 or 5--;

Column 16, lines ~~20~~ 19 to ~~21~~ 20, delete the words "anxiety disorder is postraumatic stress disorder" and in place thereof insert the words --therapeutically effective amount is from about 0.01 mg/Kg/dose to about 100 mg/Kg/dose--.

MAILING ADDRESS OF SENDER:
**PETER HERRIDGE**
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

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**PATENT NO. 7,078,436**

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 29 2003

TECHNOLOGY CENTER 2100

Paper No. 8

Leah Sherry
DECHERT LLP
P.O. Box 10004
Palo Alto, CA 94303-0961

In re Application of: )
Ranganathan et al. )
Application No. 10/081,720 ) **DECISION ON REQUEST FOR**
Filed: February 21, 2002 ) **WITHDRAWAL AS ATTORNEY**
For: ENERGY-AWARE SOFTWARE-CONTROLLED PLURALITY OF DISPLAYS )

This is a decision on the Request To Withdraw from Representation filed December 09, 2003.

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

The request filed December 09, 2003 meets all the requirements. Accordingly the request is **GRANTED**.

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

James R. Matthews

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

cc: Attn: Richard P. Lange
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED
SEP 25 2006
OFFICE OF PETITIONS

In re Application of :
Lavelle, et al. :
Application No. 10/081,724 : ON PETITION
Filed: February 20, 2002 :
Attorney Docket No. 9623E-035000 :
For: HIGH-FREQUENCY WIRELESS PERIPHERAL DEVICE WITH AUTO-CONNECTION AND AUTO-SYNCHRONIZATION

This is a decision on the petition, filed May 9, 2006 (certificate of mailing date May 4, 2006), under 37 CFR 1.137(b) to revive the above-identified application.

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the September 12, 2005 non-final Office action. No response being received and no extensions of time being obtained, this application became abandoned on December 13, 2005. A Notice of Abandonment was mailed on April 25, 2006.

Applicants have submitted an amendment in reply to the September 12, 2005 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the September 12, 2005 non-final Office action, and the petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center AU 2611 for consideration of the amendment filed on May 9, 2006 (certificate of mailing date May 4, 2006).

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

#7
8-1-03

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 0 1 2003

TECHNOLOGY CENTER 2100

Paper No. 7

BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Washington, DC 20001-4597

In re Application of: Michael Thelander, et al. )
Application No. 10/081,728 )
Filed: February 21, 2002 ) **DECISION ON REQUEST FOR**
For: MONITORING AND ) **WITHDRAWAL AS ATTORNEY**
SYNCHRONIZATION OF POWER )
USE OF COMPUTERS IN A )
NETWORK )

This is a decision on the Request To Withdraw from Representation filed July 18, 2003.

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

The request 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: Verdiem
33 NW First Avenue
Suite 200
Portland, OR 97209

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JAN 17 2007

OFFICE OF PETITIONS

DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE,WA 98101-1688

In re Application of :
Michael Thelander, et al. :
Application No. 10/081,728 : ON PETITION
Filed: February 21, 2002 :
Attorney Docket No. 61248-9 :

This is a decision on the petition, filed August 16, 2006, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed January 5, 2005, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extension of time under the provisions of 37 CFR 1.136(a) was obtained. A Notice of Abandonment was mailed on July 25, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the response in the form of an election of the invention to be examined; (2) the petition fee of $750.00; and (3) the requisite statement of unintentional delay.

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 is being referred to Technology Center AU 2116 for consideration of the response filed August 16, 2006.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

Paper No. 5

DARBY & DARBY P.C.
805 Third Avenue
New York NY 10022

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APR 11 2003

OFFICE OF PETITIONS

In re Application of
Hazel and Williamson
Application No. 10/081,735
Filed: February 22, 2002
Attorney Docket No. 0952/1J499US1
For: FUEL COMPOSITION

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed Monday, October 28, 2002. Petitioner obtained a five-month extension of time. Accordingly, the petition is timely filed.

The petition is **granted**.

Petitioner has shown that Clifford James Hazel and Ian Vernon Williamson, the non-signing inventors, have refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the Statement of Facts of Alan Rae, Chief Operating Officer, establishes that the inventors were presented with the application papers, including the specification, claims and drawings, but failed to respond to the request that they sign the declaration. In addition, petitioner has shown that AAE Technologies Inc. has a proprietary interest in the above-identified application with the copy of an agreement transferring any patent rights to AAE Technologies Inc. The petition fee has been paid. Lastly, petitioner has submitted a declaration in compliance with 37 CFR 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 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

The application will be forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

Ian Vernon Williamson
27 Pownall Avenue
Bramhall, Stockport, Cheshire
England SK7 2HE **AIR MAIL**

COPY MAILED

APR 11 2003

OFFICE OF PETITIONS

In re Application of :
Hazel and Williamson :
Application No. 10/081,735 : LETTER
Filed: February 22, 2002 :
Attorney Docket No. 0952/1J499US1 :
For: FUEL COMPOSITION :

Dear Mr. Williamson:

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(b), 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 Christina Tartera Donnell at (703) 306-5586. 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).

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

DARBY & DARBY P.C.
805 Third Avenue
New York NY 10022

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

Clifford James Hazel
Reveral Mill
Hessenford
Cornwall
England PL11 3HW **AIR MAIL**

COPY MAILED

APR 11 2003

OFFICE OF PETITIONS

In re Application of :
Hazel and Williamson :
Application No. 10/061,735 : LETTER
Filed: February 22, 2002 :
Attorney Docket No. 0952/1J499US1 :
For: FUEL COMPOSITION :

Dear Mr. Hazel:

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(b), 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 Christina Tartera Donnell at (703) 306-5589. 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).

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

DARBY & DARBY P.C.
805 Third Avenue
New York NY 10022

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

CSERR PATENTS & STRATEGIC
COUNSELING
5 LINDEN DRIVE
PROVIDENCE RI 02906-4824

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AUG 2 5 2009

OFFICE OF PETITIONS

In re Application of :
Fallon et al. :
Application No. 10/081,736 : ON APPLICATION FOR
Filed: February 20, 2002 : PATENT TERM ADJUSTMENT
Atty Docket No. :
BURF-P02-006 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b) filed on March 16, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is two hundred forty-nine (249) days, not forty-eight (48) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, 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 can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (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].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months

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[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.

after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

Olivia Brown P/

Anthony Knight
Supervisor
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

CSERR PATENTS & STRATEGIC COUNSELING
5 LINDEN DRIVE
PROVIDENCE, RI 02906-4824

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Justin R. Fallon | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612038 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/081,736 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/20/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **197** 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

CSERR PATENTS & STRATEGIC COUNSELING
5 LINDEN DRIVE
PROVIDENCE, RI 02906-4824

Mail Date: 05/18/2010

**Applicant** : Justin R. Fallon
**Patent Number** : 7612038
**Issue Date** : 11/03/2009
**Application No**: 10/081,736
**Filed** : 02/20/2002

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

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

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

The patent term adjustment has been determined to be **291** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

THORPE, NORTH & WESTERN, L.L.P.
P. O. Box 1219
Sandy, UT 84091-1219

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SEP 16 2002

OFFICE OF PETITIONS

In re Application of
Craig et al.
Application No. 10/081,742
Filed: February 22, 2002
Attorney Docket No. T9407.NP

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed June 4, 2002, under 37 C.F.R. §1.47(a).

The petition under 37 C.F.R. §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 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 February 22, 2002, without an executed oath or declaration. Accordingly, on March 19, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set an extendable two-month period for reply of May 19, 2002.

In reply, applicant filed a petition, the surcharge for late filing of the declaration, and a partially executed declaration.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition does not satisfy requirement (1).

As to item (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 (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). The petition states the declaration was faxed twice and statements were made by Rick Craig indicating he did not wish to participate in the application.

However, rule 47 applicant has failed to provide any indication that application papers were ever sent to inventor Craig. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor.

Thus on renewed petition, rule 47 applicant must establish the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventor and he refused to sign.

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

| | |
|---|---|
| By mail: | Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By FAX: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Crystal Plaza Four, Suite 3C23<br>2201 S. Clark Place<br>Arlington, VA 22202 |

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

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

Paper No. 10

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DEC 13 2002

OFFICE OF PETITIONS

THORPE, NORTH & WESTERN, L.L.P.
P. O. Box 1219
Sandy, UT 84091-1219

In re Application of
Rick Craig, Carter Knapp and Thomas Wright
Application No. 10/081742
Filed: February 22, 2002
Attorney Docket No. T9407.NP

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR 1.47(a), filed November 4, 2002.

The petition is GRANTED.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the petition indicates a copy of the application was sent to the non-signing inventor's last known address. Petitioner has provided evidence that correspondence sent to non-signing inventor was received. Petitioner also indicates several faxes were sent to the non-signing inventor. Receipt of the faxes were confirmed via telephone calls to the non-signing inventor. The non-signing inventor's failure to respond to the application sufficiently establishes that he refuses to execute the application papers.

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

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

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

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

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

Rick G. Craig
1028 West Park Palisades Drive
South Jordan, Utah 84095

COPY MAILED

DEC 13 2002

OFFICE OF PETITIONS

In re Application of
Rick Craig, Carter Knapp and Thomas Wright
Application No. 10/081,742
Filed: February 22, 2002
Attorney Docket No. T9407.NP

LETTER

Dear Mr. Craig:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

For

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

Steve M. Perry
THORPE, NORTH & WESTERN, L.L.P.
P. O. Box 1219
Sandy, UT 84091-1219

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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NIXON PEABODY LLP
401 9TH STREET, N.W., SUITE 900
WASHINGTON, DC 20004-2128

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JUL 16 2004

OFFICE OF PETITIONS

In re Application of :
Shunpei Yamazaki et al :
Application No. 10/081,767 :
Filed: February 25, 2002 :
Attorney Docket No. 740756-2443

ON PETITION

This is a decision on the petition, filed July 15, 2004, which is being treated as a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on June 24, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The file will be forwarded to Technology Center AU 2813 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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NIXON PEABODY, LLP
401 9TH STREET, NW
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WASHINGTON, DC 20004-2128

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APR 2 0 2006
OFFICE OF PETITIONS

In re Application of :
Shunpei Yamazaki, et al. :
Application No. 10/081,767 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No.: 740756-2443 :

This is a decision on the petition, filed April 18, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on April 10, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being referred to Technology Center AU 2813 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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Hickman Palermo Truong & Becker, LLP
2055 Gateway Place
Suite 550
San Jose, CA 95110

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MAR 1 4 2005

OFFICE OF PETITIONS

In re Application of :
James M. Barton, et al. :
Application No. 10/081,776 : ON PETITION
Filed: February 20, 2002 :
Attorney Docket No. TIVO0003C-E :

This is a decision on the petition under 37 CFR 1.137(b), filed February 18, 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 2600 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

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH PA
P O BOX 2938
MINNEAPOLIS, MN 55402

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FEB 06 2007

OFFICE OF PETITIONS

In re Application of :
Jerome M. Eldridge et al :
Application No. 10/081,818 : DECISION GRANTING PETITION
Filed: February 20, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 1303.045US1 :

This is a decision on the petition, filed February 5, 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 December 26, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This matter is being referred to Technology Center AU 2828 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). 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
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William C. Fuess
FUESS & DAVIDENAS
Attorneys at law
10951 Sorrento Valley Road, Suite II-G
San Diego CA 92121-1613

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SEP 14 2007

OFFICE OF PETITIONS

In re Application of
BRUCE CARLIN
Application No. 10/081,841
Filed: 02/20/2002
Attorney Docket No. CAR 0002CIP

DECISION ON PETITION

This is a decision on the petition filed March 5, 2007, to withdraw the holding of abandonment.

On April 27, 2006, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. In the apparent absence of a timely filed reply, the Office mailed a Notice of Abandonment on November 14, 2006.

In the present petition, applicant averred that he filed a timely reply to the final Office action in the form of an amendment and a request for an extension of time for response within the first month, accompanied with a certificate of mailing dated August 28, 2006. Applicant requested that the Office withdraw the holding of abandonment in view of the timely submission of the reply. Furthermore, applicant asserted:

> Neither Applicant's (1) mailed, nor (2) complete facsimile documents, have apparently correctly timely reached the Examiner in this application.
>
> Applicant requests supervisory review not of the Examiner, who has evidently proceeded on what he has, but of the (apparent) clerical procedures and personnel involved in the scanning and/or movement of documents.
>
> Applicant does not know the exact procedure as to how mailed documents are electronically scanned and entered into the PTO system, but if this is done or supposed to be done by the person also responsible for receiving and for submitting for processing Applicant's check, and if this person is identifiable, then investigation as to why Applicant's initial mailed transmittal was not scanned and entered would seemingly be warranted.

*Petition, p. 3.*

In response to applicant's request the Office investigated the matter and determined that applicant identified an incorrect application, No. **09**/801,841, on the present petition, the amendment after final, and the request for extension of time for response within the first month, which directly resulted in the documents being scanned into an incorrect application rather than the intended and correct application, No. **10**/081,841. Accordingly, the Office has located the amendment and the request for an extension of time for response within the first month filed on September 6, 2006 (certificate of mailing dated August 28, 2006), but it was not matched with the file due to the incorrect application number. The Office has transferred these documents from the incorrect application, No. **09**/801,841 to the present petition. The Office advises applicant to ensure that any future communication regarding the present application clearly identify the correct application, No. **10**/081,841, to avoid delay in the examination of the application.

## DISCUSSION

Initially, the Office must determine whether the application is, in fact, abandoned. Namely, the Office must review the present petition to evaluate if petitioner's assertions merely involve the cause of the abandonment. Therefore, where there is no dispute as to whether an application is abandoned because no disagreement exists regarding the sufficiency of the reply or controlling dates, the filing of a petition under 37 CFR 1.181(a) to withdraw the holding of abandonment would be inappropriate. See MPEP 711.03(c)(I). Instead, a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. See MPEP 711.03(c)(I).

The Examiner has reviewed applicant's reply of September 6, 2006, in the form of an amendment after final. The Examiner issued an Advisory Action Before the Filing of an Appeal Brief, which is enclosed. As stated in the Advisory Action, applicant's reply filed on September 6, 2006, failed to place this application in condition for allowance.

A response to a final Office action may be entered if it places the application in condition for allowance. However, the admission or refusal to admit an amendment after a final rejection will not operate to relieve the application from its condition. Further, the entry of an amendment after a final rejection is not a matter of right.

In the present case, it is regrettable that the Office was unable to match the amendment with the application earlier, and therefore, did not mail an Advisory Action until the date of this decision. Nevertheless, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment is filed after a final Office action. Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action, not by the mailing of an Office communication, such an Advisory Action.[1] The mere filing of an amendment in response to a final Office action does not save the application from abandonment. Rather, the filing of a Notice of Appeal, a Request for Continued Examination accompanied by a proper submission, or a continuing application in response to a final rejection guarantees the pendency of the application.

---

[1] MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

## CONCLUSION

The application is currently abandoned due to applicant's failure to submit a proper response to the final Office action. Under the circumstances of this case, the application did not become abandoned due to a delay in reviewing the amendment or the mailing of the Advisory Action or any other error on the part of the U.S. Patent and Trademark Office. Accordingly, the petition to withdraw the holding of abandonment is **dismissed**. The application will remain in its abandoned state until applicant files a petition to revive the application accompanied by a proper reply and the appropriate petition fee.

## ALTERNATIVE VENUE

Applicant is encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The reply required to the outstanding final Office action in the form of **either:** (1) a Notice of Appeal (and appeal fee); (2) an amendment that *prima facie* places the application in condition for allowance; (3) a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or (4) the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(III)(A)(2).

(2) The petition fee as set forth in 37 CFR 1.17(m),

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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

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

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

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

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Advisory Action

| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/081,841 | Applicant(s) CARLIN, BRUCE | |
|---|---|---|---|
| | Examiner Steven B. Theriault | Art Unit 2179 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 06 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a). ☒ The period for reply expires 4 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 20-41.
   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: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Weilun Lo/
Supervisory Patent Examiner TC 2100

Continuation of 11. The request for reconsideration does NOT place the application in condition for allowance because: The applicants amendment and arguments have been analyzed, considered, entered and are not persuasive for the following reasons: It is noted that the amendment filed 08/23/2006 was submitted with an improper series number and the amendment was routed improperly to the application on the submission and subsequent communications with the examiner, after the 6 moth period for reply had expired, did not contain a complete amendment (missing claims and arguments), however even if the response was considered when submitted the decision would have been as follows: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "generating and rendering a perspective in a powerful computer such as a super computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims, state a second computer is used to generate a high quality image but do not state that a more powerful or supercomputer is required, as applicant argues (Se argument page 6, middle). Moreover, the applicant argues that a camera position is not communicated in Smith (See argument page 6, top). The Examiner disagrees as it is clear from the image presented as shown in Smith that the image is shown from a particular perspective of a shelf or chair in an office setting that is rendered in 3D, which is "a" position. For example, the camera position in Smith is not shown from the bottom of a chair showing the legs only, requiring the user to pan to see the front of the chair. Nor is the positional view of the image such that the user would have to zoom in or out to see the chair. Therefore, a reasonable interpretation of the image as shown is that the image is rendered at a given camera position. Finally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the applicant argues that Smith does not show rendering a camera or photo realistic image. The Examiner does not debate the point, as the final office action states the Examiner relied on the combination of Smith and Technicon as shown in several pages of the final office action mailed 04/27/2006 (e.g. page 5), to teach the photorealistic image rendering in 3D. In fact, Technicon expressly states the rendering is photorealistic (See page 2, bottom). Smith suggests that other systems can perform the rendering and Technicon is an expressed example of an "other system that can render a photorealistic rendering of a 3D scene. Therefore, based on the broadest reasonable interpretation of the claims, as recited, the claims are not allowable over the final rejection.

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William C. Fuess
FUESS & DAVIDENAS
Attorneys at law
10951 Sorrento Valley Road, Suite II-G
San Diego CA 92121-1613

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JAN 17 2008

OFFICE OF PETITIONS

In re Application of :
BRUCE CARLIN :
Application No. 10/081,841 :
Filed: 02/20/2002 :
Attorney Docket No. CAR 0002CIP :

DECISION ON PETITION

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

On April 27, 2006, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). In the absence of a timely and proper reply, the Office mailed a Notice of Abandonment on November 14, 2006. On March 5, 2007, applicant filed a petition to withdraw the holding of abandonment, which was dismissed by the decision of September 14, 2007. On November 26, 2007, applicant filed the present petition.

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

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

This application is being referred to Technology Center AU 2179 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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
WASHINGTON, D.C. 20231
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DIW 06-02

Paper No. 4

#4

NORMAN FRIEDLAND
SUITE 400
11300 U.S. HIGHWAY ONE
NORTH PALM BEACH FL 33408

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JUL 05 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Patrick | : | |
| Application No. 10/081,847 | : | DECISION DISMISSING |
| Filed: 26 February, 2002 | : | PETITION |
| Attorney Docket No. N883B | : | |

This is a decision on the petition filed on 22 May, 2002, requesting that the above-identified application be accorded a filing date of 26 February, 2002, with Page 2 of the specification as a part of the original disclosure.

On 26 February, 2002, the application was filed.

On 29 March, 2002, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application stating that the application had been accorded a filing date of 26 February, 2002, but that, *inter alia*, Page 2 of the specification (description and claims) appeared to have been omitted from the application.

In response, on 22 May, 2002 (certificate of mailing date 10 May, 2002, the present petition was filed. Petitioners argue that Page 2 of the specification was not missing on 26 February, 2002. In support, petitioners point to their postcard receipt as evidence that Page 2 of the specification was among the application papers filed on 26 February, 2002. Petitioners request that the application be accorded a filing date of 26 February, 2002, with Page 2 as a part of the original disclosure.

The argument and evidence supplied with the petition have been carefully considered, but are not persuasive. The USPTO has a well-established and well-publicized practice of providing a receipt for papers filed in the USPTO to any applicant desiring a receipt. The practice requires that any paper for which a receipt

is desired be filed in the USPTO with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. See section 503, Manual of Patent Examining Procedure (MPEP 503).

Unfortunately, in this case, petitioners' postcard receipt fails to itemize the papers allegedly filed in this application. The postcard receipt does not itemize the number of pages of specification filed, or a specification at all. A postcard receipt will not serve as prima facie evidence of receipt in the USPTO of any items which are not properly itemized and identified.

The petition is dismissed.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 09/656,313 and 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 to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Page 2 of the specification is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of 26 February, 2002, using the application papers filed on that date.

The copy of Page 2 of the specification supplied with the present petition will not be used for processing or examination, but will be retained in the application file. Petitioner may file Page 2 as a preliminary amendment.

As this petition was necessitated by applicants' filing error rather than an error on the part of the Office, the petition fee will not be refunded.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 26 February, 2002, using the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4/27/05

TO SPE OF : ART UNIT 1644

SUBJECT : Request for Certificate of Correction on Patent No.: 6858395 B2

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-915**
Palm location **7580** - Tel. No. 305-8309

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

Virginia Tolbert

**Thank You For Your Assistance** — **Certificates of Correction Branch**

---

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

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

**Comments:**

Christina Chan — **SPE**

1644 — **Art Unit**

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LOOPER, VALERIE E.
11726 LIGHTFALL COURT
COLUMBIA, MD 21044

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JUN 16 2005

OFFICE OF PETITIONS

In re Application of :
Lisziewicz, et al. : DECISION ON PETITION
Application No. 10/081,922 :
Filed: February 21, 2002 :
Atty. Dkt. No.: RGT 9771 :

This is a decision on the petition under 37 CFR 1.137(a), filed April 13, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

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

This application became abandoned December 23, 2004 for failure to timely reply to the final Office action mailed September 22, 2004. 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 April 4, 2005.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

As to item (1), the instant application lacks the required reply. Petitioners have submitted the required fee for a request for continued examination, however, the instant petition is not accompanied by the required submission. See MPEP 706.07(h). Any renewed petition must be accompanied by the required reply, such as an amendment that places the application in condition for

allowance, a notice of appeal, an RCE in full compliance with 37 CFR 1.114, or a continuation application.

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).

A final Office action was mailed in the instant case on September 22, 2004. A response to the final Office action was submitted October 22, 2004. The response consisted of a copy of a previously submitted amendment and a request for an interview. As set forth in the Notice of Abandonment, submission of a copy of a previously submitted amendment and a request for an interview do not constitute a bona fide reply to the final Office action. Petitioners argue that they had "reasonably expected withdrawal and revision of the Final Rejection."

Petitioners' argument has been considered, but found unconvincing. A proper reply to the final Office action was required to consist of an amendment placing the application in condition for allowance, a notice of appeal, a request for

continued examination, or a continuation application. Accordingly, petitioners' expectation that the final Office action would be withdrawn and revised is not deemed a reasonable explanation of unavoidable delay within the meaning of 37 CFR 1.137(a)(3).

Any renewed petition must be accompanied evidence to sufficiently establish that the entire period of time that a reply to the final Office action was due until the filing of a grantable petition has been unavoidable.

**ALTERNATE VENUE**

Petitioner is urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

| | |
|---|---|
| By mail: | **Mail Stop Petition**<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (703) 872-9306 |
| By hand: | U.S. Patent and Trademark Office<br>Customer Service Window<br>Mail Stop Petition |

Application No. 10/081,922

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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AUG 18 2005

OFFICE OF PETITIONS

LOOPER, VALERIE E.
11726 LIGHTFALL COURT
COLUMBIA, MD 21044

In re Application of :
Liszewicz, et al. : DECISION ON PETITION
Application No. 10/081,922 :
Filed: February 21, 2002 :
Atty. Dkt. No.: RGT 9771 :

This is a decision on the renewed "PETITION TO REVIVE 37 CFR 1.137(b) or (b)," filed June 20, 2005, to revive the above-identified application.

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

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

This application became abandoned December 23, 2004 for failure to timely reply to the final Office action mailed September 22, 2004. 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 April 4, 2005. A petition under 37 CFR 1.137(a) was filed April 13, 2005 and dismissed June 16, 2005.

## DECISION UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant renewed petition under 37 CFR 1.137(a) fails to satisfy the requirement 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 for the reasons set forth in the decision mailed June 16, 2005, the contents of which are hereby incorporated by reference.

Application No. 10/081,922

Petitioners continue to attribute the failure to timely submit a proper reply to the final Office action to petitioners' expectation that petitioners would have an interview with the examiner prior to the time that a response was due. As previously set forth, failure take any and all action required to avoid abandonment because petitioners' expectation that once an interview was held with the examiner the finality of the final Office action would be withdrawn cannot be found to be unavoidable delay within the meaning of 37 CFR 1.137(a)(3).

**DECISION UNDER 37 CFR 1.137(b)**

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit a proper reply to the final Office action mailed September 22, 2004 is accepted as having been unintentionally delayed.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 12

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FEB 13 2004

OFFICE OF PETITIONS

In re Application of :
Jon Faiz Kayyem et al :
Application No. 10/081,936 : DECISION ON PETITION
Filed: February 20, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 7/RFT/RMS/CYO :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 2, 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.

Any request for reconsideration must be filed within **TWO MONTHS** from the mail date of this decision. Note 37 CFR 1.181(f).

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The reference to the above-noted, prior-filed applications was not included in the manner

---

[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).

specified in 37 CFR 1.78(a)(2)(i) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

A reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification has been included in an amendment filed on June 2, 2003. 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 de Seversky, *supra. Note also* MPEP 201.06(c).

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment [2] deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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

By mail:
Mail Stop PETITION
Commissioner for Patents
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

---

[2]Note 37 CFR 1.121

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

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859.

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

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APR 1 4 2004

OFFICE OF PETITIONS

In re Application of :
Jon Faiz Kayyem et al :
Application No. 10/081,936 : DECISION ON PETITION
Filed: February 20, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 7/RFT/RMS/CYO :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed March 29, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 08/873,978, filed June 12, 1997 set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant pending application was filed on February 20, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

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

Petitioner should be aware that in the Amendment and the Application Data Sheet submitted with the instant petition; the Application No. 08/743,798, filed November 5, 1996, indicates the filing date of September 5, 1996. Petitioner is encouraged to submit a Supplemental Amendment and an Application Data Sheet to show the correct filing date for Application No. 08/743,798 as November 5, 1996.

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 1631 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 08/873,978, filed June 12, 1997.

Karen Creasy

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

**ATTACHMENT**: Corrected Filing Receipt

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75 STATE STREET
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ALBANY NY 12207

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**OFFICE OF PETITIONS**

In re Application of :
Infantino et al. :
Application No. 10/081,938 : ON PETITION
Filed: 22 February, 2002 :
Attorney Docket No. HANN-0002 :

This is a decision in reference to the petition under 37 CFR 1.181 filed on 12 December, 2005, to withdraw the holding of abandonment.

The petition is **DISMISSED**.

This application became abandoned on 28 April, 2005, for failure to submit a proper response to the final Office action mailed on 27 January, 2005, which set a three (3) month shortened statutory period for reply. An amendment after final rejection was filed on 28 March, 2005. However, the amendment was determined not to place the application in *prima facie* condition for allowance, and On 14 April, 2005, an Advisory Action was mailed. No extensions of the time for reply were obtained in accordance with 37 CFR 1.136(a). Notice of Abandonment was mailed on 16 November, 2005.

Petitioners assert that a timely reply was filed on 22 April, 2005. In support, petitioners have provided a copy of a "Replacement After Final Amendment" including a Certificate of Transmission dated 22 April, 2005, showing transmission via facsimile, and a copy of the Auto-Reply Facsimile Transmission sheet and sending unit's report, both showing a date of 22 April, 2005. It is noted that a copy of the amendment was previously filed on 1 June, 2005.

Petitioners' showing has been considered, but is not persuasive. The examiner has determined that the proposed amendment, a copy of which was supplied on 1 June, 2005, does not place the application in condition for allowance. As such, petitioners'

amendment would not have been a proper reply to the final Office action. The only proper reply to a final Office action is a Notice of Appeal, an amendment which places the application in *prima facie* condition for allowance, a Request for Continued Examination and submission, or a continuing application. As petitioners have not shown that a timely and proper reply to the final Office action was filed, the application is properly held abandoned.

Petitioners may wish to consider filing a petition to revive the application, accompanied by a proper reply.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. **This period may not be extended.**[1]

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

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

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

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

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

---

[1] 37 CFR 1.181(f).

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ALBANY NY 12207

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JAN 29 2007

OFFICE OF PETITIONS

In re Application of :
Infantino et al. :
Application No. 10/081,938 : DECISION ON PETITION
Filed: 22 February, 2002 :
Attorney Docket No. HANN-0002 :

This is a decision on the petition filed on 9 November, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 28 April, 2005, for failure to submit a proper response to the final Office action mailed on 27 January, 2005, which set a three (3) month shortened statutory period for reply. An amendment after final rejection was filed on 28 March, 2005. However, the amendment was determined not to place the application in *prima facie* condition for allowance, and On 14 April, 2005, an Advisory Action was mailed. No extensions of the time for reply were obtained in accordance with 37 CFR

[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)).

1.136(a). Notice of Abandonment was mailed on 16 November, 2005. The petition to withdraw the holding of abandonment filed on 12 December, 2005, was dismissed on 11 September, 2006.

Petitioners have filed a Request for Continued Examination (RCE) and indicated that the previously filed amendment after final rejection is the required submission.

The application is being referred to Technology Center Art Unit 3761 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUN 14 2004

OFFICE OF PETITIONS

In re Application of :
Zhi-Cherng Lu et al :
Application No. 10/081,985 : DECISION GRANTING PETITION
Filed: February 21, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. TS01-725 :

This is a decision on the petition, filed May 11, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is GRANTED.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on March 15, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and

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

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was rescinded by Notice on July 24, 2003.

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

This application is being referred back to Technology Center Art Unit 2829 for further action as the nature of the case may require.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

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SEP 0 6 2002

OFFICE OF PETITIONS

In re Application of
Wright, Knapp & Craig
Application No.: 10/081,988
Filed: February 22, 2002
Attorney Docket No.: 20356.NP
For: NETWORKED REFERRAL COMMISSION SYSTEM WITH CUSTOMER SERVICE FUNCTIONS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed June 4, 2002 (certificate of mailing date May 20, 2002).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on February 22, 2002 without an executed oath or declaration and filing fees. Accordingly, on March 20, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and filing fees, and a surcharge for their late filing.

In response, on June 4, 2002 (certificate of mailing date May 20, 2002) a declaration executed by 2 of 3 joint inventors, the surcharge, application filing fees, the petition fee, and the instant petition were filed. The petition states that the non-signing inventor, Mr. Rick G. Craig, reviewed a related provisional application at some time prior to the filing of the above-identified application and refused to sign the declaration for the above-identified application at a later time.

A grantable petition under 37 CFR 1.47(a) requires

(1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
(2) a proper oath or Declaration executed by the available joint inventor(s),
(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with

first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). The petition states that Mr. Craig has only seen a related provisional application.

Mr. Craig must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. Mr. Craig cannot make the necessary statements ("I have reviewed and understand...", etc.) without looking at the application. When petitioners can show that Mr. Craig was mailed or received the complete application as filed and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioners will have satisfied this requirement.

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

| | |
|---|---|
| By mail: | Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By facsimile: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Office of Petitions<br>2201 South Clark Place<br>Crystal Plaza 4, Suite 3C23<br>Arlington, VA 22202 |

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

E. Shirene Willis

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Steve M. Perry
THORPE, NORTH & WESTERN, L.L.P.
P.O. Box 1219
Sandy UT 84091-1219

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DEC 0 9 2002

OFFICE OF PETITIONS

In re Application of
Wright, Knapp & Craig
Application No.: 10/081,988
Filed: February 22, 2002
Attorney Docket No.: 20356.NP
For: NETWORKED REFERRAL COMMISSION SYSTEM WITH CUSTOMER SERVICE FUNCTIONS

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed November 4, 2002.

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventor, Mr. Rick G. Craig, has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the renewed petition states that Mr. Craig was mailed a copy of the application, but failed to respond to the request that he sign the declaration. Petitioners have submitted a declaration in compliance with 37 CFR 1.63 and 1.64.

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

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

After this decision is mailed, the above-identified application will be forwarded to the Office of Initial Patent Examination for further processing.

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

E. Shirene Willis

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Rick Craig
1028 West Park Palisades Drive
South Jordan, UT 84095

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DEC 0 9 2002

OFFICE OF PETITIONS

In re Application of
Wright, Knapp & Craig
Application No.: 10/081,988
Filed: February 22, 2002
Attorney Docket No.: 20356.NP
For: NETWORKED REFERRAL COMMISSION SYSTEM WITH CUSTOMER SERVICE FUNCTIONS

LETTER

Dear Mr. Craig:

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

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

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

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

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

ATTORNEY OF RECORD: Steve M. Perry
THORPE, NORTH & WESTERN, L.L.P.
P.O. Box 1219
Sandy UT 84091-1219

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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CAMPBELL & FLORES LLP
4370 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO CA 92122

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NOV 16 2004

OFFICE OF PETITIONS

Applicant: Yu et al.
Appl. No.: 10/081,989
Filing Date: February 21, 2002
Title: COMMON LIGAND MIMICS: THIAZOLIDINEDIONES AND RHODANINES
Attorney Docket No.: 66692-030
Pub. No.: US 2004/0009526 A1
Pub. Date: January 15, 2004

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on March 15, 2004 for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course, unless the patent issues before the application republishes.

Applicant should file applications having larger text, which is cleaner and with sufficient clarity and contrast to permit reproduction to avoid errors in the patent application publication process. See 37 CFR 1.52.

Inquires concerning this communication should be directed to Mark Polutta at (571) 272-7709.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 6812936
Issue Date: November 2,2004
Application No. 10082005
Filed: February 21,2002
Attorney Docket No. NL010114

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

This is a decision on the electronic petition, filed June 2,2009 ,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 2,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

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SEP 16 2002

OFFICE OF PETITIONS

In re Application of
Ashley J. Birkett
Application No. 10/082,014
Filed: February 21, 2002
Attorney Docket No. 85124

: DECISION GRANTING
: PETITION

This is a decision on the petition filed April 22, 2002, to accord the above-identified application a filing date of February 21, 2002, instead of February 22, 2002.

The petition is **granted**.

37 CFR 1.10(d) states,

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

All of the above requirements have been met. Therefore, the application will be accorded a filing date of February 21, 2002.

Receipt of the Declaration and Power of Attorney and $65 surcharge in response to the Notice of March 29, 2002 is acknowledge.

A petition fee is unnecessary for a petition requesting relief under 37 CFR 1.10. Therefore, a refund of the petition fee will be scheduled.

This application is being forwarded to the Office of Initial Patent Examination Division for further processing with a filing date of February 21, 2002.

Telephone inquiries concerning this matter may be directed to Karen Creasy at (703) 305-8859.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**WOLF GREENFIELD & SACKS, PC**
**FEDERAL RESERVE PLAZA**
**600 ATLANTIC AVENUE**
**BOSTON, MA 02210-2206**

**COPY MAILED**

APR 12 2007

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Li-How Chen et al | : DECISION ON PETITIONS |
| Application No. 10/082,018 | : UNDER 37 CFR 1.181 AND |
| Filed: February 20, 2002 | : 37 CFR 1.313(c)(2) |
| Attorney Docket No. G07470031US03 | : |

This is a decision on the petitions under 37 CFR 1.181 (no fee), filed September 25, 2006, requesting withdrawal of the holding of abandonment in the above-identified application and on the petition under 37 CFR 1.313(c)(2), filed March 21, 2007.

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

The petition under 37 CFR 1.313(c)(2) is **DISMISSED.**

***DISCUSSION OF PETITION UNDER 37 CFR 1.181***

This application was held abandoned for failure to timely pay the issue fee on or before July 25, 2006, as required by the Notice of Allowance and Issue Fee(s) Due, mailed April 25, 2006. A Notice of Abandonment was mailed on August 28, 2006.

Petitioner asserts that the issue fee (and publication fee) was timely paid by authorization to the USPTO to charge the required fee(s) to Deposit Account No. 50-2092 as shown on the Part B-Fee(s) Transmittal submitted on May 10, 2006. In support of this assertion, petitioner has supplied a copy of a stamped postcard, which evidences receipt in the USPTO of the Issue Fee Transmittal on May 10, 2006. Accordingly, petitioner requests that the holding of abandonment be withdrawn.

The Issue Fee Transmittal was in fact received on May 10, 2006. However, at the time the Office attempted to charge the issue fee, there were insufficient funds in petitioner's deposit account (only $134 was present in the deposit account). 37 CFR 1.25 requires that there must be sufficient funds in the deposit

account at all times to charge the requested fees. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee(s). Accordingly, the Notice of Abandonment mailed on August 28, 2006 was proper and will not be vacated.

It is noted that a Notice of Rescinded Abandonment was mailed on December 7, 2006. However, this Notice was mailed in error and is hereby vacated. The Office of Patent Publication has confirmed to the undersigned that this Notice was in fact mailed in error.

In view of the above, this application is abandoned for failure to timely pay the issue fee on or before July 25, 2006.

Petitioner may wish 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 required 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).

***DISCUSS OF PETITION UNDER 37 CFR 1.313(c)(2)***

As this application is abandoned, the petition to withdraw this application from issue is moot.

Any petition to revive should be accompanied by a renewed petition under 37 CFR 1.313(c)(2) if it is still desired to have this application withdrawn from issue.

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

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

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

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

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

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**WOLF GREENFIELD & SACKS, P.C.**
**600 ATLANTIC AVENUE**
**BOSTON, MA 02210-2206**

COPY MAILED

JUL 20 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Li-How Chen et al | : | |
| Application No. 10/082,018 | : | DECISION GRANTING PETITIONS |
| Filed: February 20, 2002 | : | UNDER 37 CFR 1.137(b) AND |
| Attorney Docket No. G074470031US03 | : | 37 CFR 1.313(c)(2) |

This is a decision on the petition, filed July 16, 2007, under 37 CFR 1.137(b), to revive the above-identified abandoned application and on the renewed petition treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue.

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

The petition under 37 CFR 1.313(c)(2) is **GRANTED**.

***As to the petition under 37 CFR 1.137(b):***

This application became abandoned for failure to timely pay the issue fee on or before July 25, 2006, as required by the Notice of Allowance and Fee(s) Due mailed April 25, 2006.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has submitted (1) payment of the $1,400 issue fee, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the reply to the Notice of April 25, 2006 is accepted as having been unintentionally delayed.

***As to the petition under 37 CFR 1.313(c)(2):***

Petitioner requests withdrawal of this application from issue to allow consideration of a Request for Continued Examination (RCE) and an Information Disclosure Statement submitted on March 21, 2007.

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

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

The issue and petition fees paid in this case are those for an application claiming large entity status. However, Office records indicate that this application is entitled to small entity status. If this application no longer qualifies for small entity status, a notification of loss of small entity status in accordance with 37 CFR 1.27(g)(2) must be submitted. If large entity fees were paid in error, petitioner may request one-half of the amount submitted. *See* 37 CFR 1.28(a) and (b).

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

This matter is being referred to Technology Center AU 1632 for processing the RCE and for consideration of the Information Disclosure Statement submitted on March 21, 2007.

Frances Hicks
Petitions Examiner
Office of Petitions

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Part B – Fee(s) Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment.*

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

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MAY 23 2008

In re Application of :
Li How Chen et al :
Application No. 10/082,018 : ON PETITION
Filed: February 20, 2002 :
Attorney Docket No. G0744.70031US03

This is a decision on the petition, filed May 22, 2008 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, 2008 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1632 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

**CARMAN WENKOFF**
**ONTAIN CORPORATION**
**SUITE C-245**
**1750 - 112TH AVENUE NE**
**BELLEVUE, WA 98004**

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OCT 2 4 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Stephen Elston et al | : | |
| Application No. 10/082,057 | : | NOTICE |
| Filed: February 26, 2002 | : | |
| Attorney Docket No. | : | |

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 3627.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

MATHEW T BYRNE
SHEARMAN & STERLING
599 LEXINGTON AVENUE
NEW YORK NY 10022

COPY MAILED

AUG 0 2 2002

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Adams et al. | : DECISION GRANTING |
| Application No. 10/082,064 | : PETITION |
| Filed: October 19, 2001 | : |
| Attorney Docket No. 32480/3 | : |

This is a decision on the petition filed April 11, 2002 under 37 1.10(c), requesting that the above-identified application be accorded a filing date of October 19, 2001 rather than the presently accorded filing date of February 19, 2002.

The petition is **granted**.

The copy of Express Mail Label No. EE645127921US proffered with the petition clearly shows a USPS "date-in" postal stamp of October 19, 2001, and further, matches the Express Mail Label No. found on the above-captioned application papers.

This application is being forwarded to the Office of Initial Patent Examination (OIPE), Customer Corrections, for further processing with a filing date of October 19, 2001.

No fee is due and no fee has been charged. The error is regretted.

Telephone inquiries specific to this decision should be directed to the undersigned at (703) 305-1820. Inquiries related to OIPE processing should be directed to OIPE at (703) 308-1202.

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

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

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,705,805 | 2004-03-16 | 10/082,117 | 2002-02-26 | 47113-0031 (406711) |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

NOT Small Entity

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

Small Entity

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | //Ronald L. Grudziecki// | Date (YYYY-MM-DD) | 2008-06-04 |
| Name | Ronald L. Grudziecki | Registration Number | 24970 |

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

# Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6705805
Issue Date: March 16,2004
Application No. 10082117
Filed: February 26,2002
Attorney Docket No. 47113-0031 (406711)

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

This is a decision on the electronic petition, filed June 4,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 4,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

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Paper No. 6

MCINTYRE-LILLEY INTELLECTUAL PROPERTY
MANAGEMENT SERVICES
SUITE #12
2000 SOUTH 2ND STREET
ARLINGTON, VA 22204

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MAR 1 8 2004

OFFICE OF PETITIONS

In re Application of
Mashimo, Akira
Application No. 10/082,128
Filed: February 26, 2002
Attorney Docket No. WC-01-11-02.00

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 8, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed March 21, 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 May 22, 2002. A Notice of Abandonment was mailed on December 10, 2003.

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

The file is now being forwarded to the 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

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper No. 6

**MCINTYRE-LILLEY**
**INTELLECTUAL PROPERTY MANAGEMENT SERVICES**
**SUITE #12**
**2000 SOUTH 2ND STREET**
**ARLINGTON, VA 22204**

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MAR 1 7 2004

OFFICE OF PETITIONS

In re Application of
Mashimo, Akira
Application No. 10/082,129
Filed: February 26, 2002
Attorney Docket No. WC-01-11-03.00

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 8, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed March 21, 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 May 22, 2002. A Notice of Abandonment was mailed on December 4, 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

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Paper No. 042604

MAY 6 2004

OLIFF & BERRIDGE, PLC
P.O Box 19928
Alexandria, VA 22320

In re Application of:
FERRELL *et al.*
Serial No.: 10/082,149
Filed: February 26, 2002
Attorney Docket No.: **D/A0550**

DECISION ON PETITION
TO RESET A PERIOD
FOR REPLY

This is a decision on the petition filed March 23, 2004, to reset a period for reply due to a late receipt of an office action. No fee is required.

The petition is **GRANTED.**

Petitioner asserts that the Office action mailed on December 03, 2003, was not received. To support this assertion, petitioner provided a statement attesting that a search of the file jacket and docket records showed that the Office action was not received. It is further asserted that a Power of Attorney by Assignee and Change of Address (PACA) was filed prior to the mailing of the Office action. A copy of the PACA, and the date stamped return postcard receipt were included with the petition.

A review of the written record indicates that the PACA was received in the United States Patent and Trademark Office on April 22, 2002, but not processed in the application file until March 09, 2004. As a result, the Office action mailed on December 03, 2003, was sent to an incorrect address.

For the above stated reason, the petition is **granted**. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the Technology Center 2800 support staff for re-mailing the Office action. The shortened statutory period for response set therein will be reset to run from the date the Office action is re-mailed. Extensions of time are available under 37 C.F.R. § 1.136.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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1100 NEW YORK AVENUE NW
WASHINGTON, DC 20005

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| | | |
|---|---|---|
| In re Application of | : | |
| Simon Knowles | : | |
| Application No. 10/082,152 | : | DECISION GRANTING PETITION |
| Filed: February 26, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 1875.2530000 | : | |

This is a decision on the petition, filed February 6, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on December 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 2193 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b) (along with any balance due 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).*

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United States Patent and Trademark Office
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YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

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MAY 10 2004

OFFICE OF PETITIONS

In re Application of :
Gerard Falcou et al :
Application No. 10/082,163 : NOTICE
Filed: February 26 ,2002 :
Attorney Docket No. 0507-1002 :

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 application file is being referred to Technology Center AU 3682.

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

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CHARLES C.H. WU
98 DISCOVERY
IRVINE CA 92618-3105

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FEB 28 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Yang et al. | : | |
| Application No. 10/082,188 | : | DECISION |
| Filed: February 26, 2002 | : | ON PETITION |
| For: METHOD OF NARROW SEARCH | : | |
| FOR BOOKS THE INTERNET | : | |

This is a decision on the Petition for Withdrawal of Abandonment, filed via Facsimile on January 10, 2006. The petition is properly treated under 37 CFR 1.181.

The petition is **granted.**

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed January 19, 2005. The Office action set a three (3) month period for reply. No complete and proper reply having been filed, this application became abandoned on April 20, 2005. A Notice of Abandonment was mailed on October 25, 2005.

The instant petition

Applicant files this petition and asserts that a complete and proper reply was timely filed in this Office via facsimile on July 18, 2005. In support of this assertion, Applicant files copies of a Request for Continued Examination ("RCE")and a Petition for Extension of Time, both of which included a Certificate of Transmission under 37 CFR 1.8. Applicant also provides a copy of an Auto-Reply Facsimile Transmission indicating receipt by this Office of 14 pages of transmission on July 18, 2005.

In view of the above, Applicant has demonstrated timely filing of the RCE by a preponderance of the evidence. As such, the holding of abandonment is improper and is hereby withdrawn.

No petition fee has been charged and none is due.

The application file is being referred to Technology Center Art Unit 2167 for consideration of the RCE filed July 18, 2005, and for continued examination in due course.

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 8

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON VA 20190

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SEP 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Rowley et al. :
Application No. 10/082,248 : DECISION GRANTING PETITION
Filed: February 26, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 23415-013 :

This is a decision on the petition, filed August 1, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the present nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the present nonprovisional application is the subject of an application filed in an 18 month publication country on November 19, 2002 and November 28, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

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

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

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

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

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. The Office records indicate that the application published on September 25, 2003.

This application is being forwarded to Technology Center Art Unit 2153 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5589.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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FULBRIGHT & JAWORSKI, L.L.P.
600 CONGRESS AVENUE
SUITE 2400
AUSTIN, TX 78701

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JUN 23 2006
OFFICE OF PETITIONS

In re Patent No. 6,891,032 :
Issued: May 10, 2005 :
Application No. 10/082,254 : DECISION REGARDING PTA
Filed: February 25, 2002 :
Atty. Dkt. No.: AMBI:035USC1 :

This decision is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§1.705(b)," filed July 1, 2005. This petition is being treated as timely filed under 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment ("PTA") under 37 CFR 1.705(d) is **GRANTED**.

The instant application issued as U.S. Pat. No. 6,891,032 on May 10, 2005 with a PTA of 0 days. The instant application for PTA was timely filed July 1, 2005. Applicants argue that the application should have been accorded a PTA of 169 days on the grounds that the submission of two miscellaneous letters (applicants' statements of the substance of interviews) did not constitute a failure by applicants to engage in reasonable efforts to conclude prosecution.

A review of the application history reveals that an adjustment of 207 days under 37 CFR 1.702(a)(1) was attributed to the Office. In accordance with 37 CFR 1.703(a)(1), the adjustment began April 26, 2003, the day after the date that is 14 months from the date upon which the application was filed, and ended November 18, 2003, the date the non-final Office action was mailed.

A further adjustment of 36 days in accordance with 37 CFR 1.702(a)(2) was attributed to the Office. The adjustment began June 24, 2004, the day after the date that is four months after the date a response to the non-final Office action was filed, and ended July 29, 2004, the date the Notice of Allowance was mailed.

A further adjustment of 70 days in accordance with 37 CFR 1.702(a)(4) was attributed to the Office. The adjustment began

March 2, 2005, the day after the date that is four months after the date that the issue fee payment was received, and ended May 10, 2005, the date of issuance of the patent.

Thus, at the time of issuance, an adjustment of 313 days could be attributed to the Office.

The adjustment of 313 days is reduced five days in accordance with 37 CFR 1.704(b). The adjustment began March 19, 2003, the day after the date that is three months after the date of mailing of non-final Office action, and ended February 23, 2004, the date a response was received.

The adjustment of 313 days is further reduced 136 days in accordance with 37 CFR 1.704(c)(8). The reduction began February 24, 2004, the date after the date the response to the non-final Office action was received, and ended July 8, 2004, the date of submission of the supplemental reply (an IDS).

The adjustment of 313 days is further reduced three days in accordance with 37 CFR 1.704(b). The adjustment began October 30, 2004, the date after the date that is three months after the date the Notice of Allowance was mailed, and ended November 1, 2004, the date of submission of issue fee payment.

The miscellaneous incoming letters submitted August 20, 2004 and March 2, 2005 were errantly deemed submissions within the meaning of 37 CFR 1.704(c)(10) which resulted in a reduction totaling 190 days. Applicants' statements on the substance of the interview summaries, which were invited by the examiner, are not deemed a failure to engage in reasonable efforts to conclude prosecution or processing within the meaning of 37 CFR 1.704. Accordingly, these submissions should have been processed so that they were included as part of an interview summary or examiner's amendment and not a separate paper for PALM to flag in the patent term adjustment calculation.

Accordingly, the patent is entitled to an adjustment of 169 days, as argued by patentees.

The required application fee of $200.00 has been charged to applicants' deposit account as authorized.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 133 days.

Telephone inquiries specific to this matter may be directed to Petitions Attorney Alesia M. Brown at (571) 272-3202.

Karin Ferriter Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT | : | 6,891,032 B2 |
| DATED | : | May 10, 2005 |
| INVENTOR(S) | : | Brown, et al. |

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 0 days

Delete the phrase "by 0 days" and insert – by 169 days--

Day : Thursday
Date: 6/22/2006

PALM INTRANET

Time: 11:49:29

| PTA Calculations for Application: 10/082254 | | | |
|---|---|---|---|
| Application Filing Date: | 02/25/2002 | PTO Delay (PTO): | 313 |
| Issue Date of Patent: | 05/10/2005 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 334 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 169 |
| PTO Delay Adjustment: | 190 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 44 | 06/22/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 380 | | |
| 43 | 06/22/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 190 | |
| 38.5 | 04/20/2005 | PTA 36 MONTHS | | | |
| 38 | 05/10/2005 | PATENT ISSUE DATE USED IN PTA CALCULATION | 70 | | 34 |
| 37 | 04/08/2005 | RECEIPT INTO PUBS | | | |
| 36 | 04/07/2005 | DISPATCH TO FDC | | | |
| 35 | 04/07/2005 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 34 | 11/01/2004 | ISSUE FEE PAYMENT VERIFIED | | 3 | 23 |
| 33 | 03/02/2005 | MISCELLANEOUS INCOMING LETTER | | 70 | 29 |
| 32 | 08/20/2004 | MISCELLANEOUS INCOMING LETTER | | 120 | 29 |
| 31 | 04/01/2005 | RECEIPT INTO PUBS | | | |
| 30 | 02/09/2005 | WORKFLOW - QUERY REQUEST - FINISH | | | |
| 29 | 02/01/2005 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 28 | 11/29/2004 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |
| 27 | 11/01/2004 | ISSUE FEE PAYMENT RECEIVED | | | |
| 26 | 09/20/2004 | WORKFLOW - QUERY REQUEST - BEGIN | | | |
| 25 | 08/12/2004 | RECEIPT INTO PUBS | | | |
| 24 | 08/11/2004 | WORKFLOW - FILE SENT TO CONTRACTOR | | | |
| 23 | 07/29/2004 | MAIL NOTICE OF ALLOWANCE | 36 | | 13 |
| 22 | 07/29/2004 | MAIL NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED | | | |
| 21 | 07/12/2004 | ISSUE REVISION COMPLETED | | | |
| 20 | 07/12/2004 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 19 | 07/12/2004 | NOTICE OF ALLOWABILITY | | | |
| 18 | 07/08/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 136 | 13 |
| 17 | 07/08/2004 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 16 | 07/09/2004 | NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED | | | |
| 15 | 03/08/2004 | IFW AMENDED CASE PROCESSING COMPLETE | | | |
| 14 | 03/08/2004 | DATE FORWARDED TO EXAMINER | | | |
| 13 | 02/23/2004 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 11 |
| 12 | 02/23/2004 | TERMINAL DISCLAIMER FILED | | | |
| 11 | 11/18/2003 | MAIL NON-FINAL REJECTION | 207 | | -1 |
| 10 | 11/17/2003 | NON-FINAL REJECTION | | | |
| 9 | 11/01/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 06/30/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 02/25/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 02/25/2002 | PRELIMINARY AMENDMENT | | | |
| 5 | 09/27/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 03/26/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 03/18/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 03/12/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 02/25/2002 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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Paper No. None

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington DC 20037-3213

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**MAR 0 3 2006**

**OFFICE OF PETITIONS**

In re Application of :
Ermanno Filippi et al. :
Application No. 10/082,264 :
Filed: February 26, 2022 : DECISION ON PETITION
Attorney Docket No. Q68570 : UNDER 37 C.F.R. §1.181(A)
Title: METHOD FOR CARRYING OUT :
CHEMICAL REACTIONS IN PSEUDO- :
ISOTHERMAL CONDITIONS

This is a decision on the petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment, filed on January 12, 2006.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed June 23, 2005, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 24, 2005. A notice of abandonment was mailed on January 4, 2006.

With the present petition, Petitioner included a response to the Office Action of June 23, 2005. It is noted that a duplicate of the same has been located in the electronic file, and it is clear that a response was received on December 23, 2005, along with a three-month extension of time.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a timely response was timely submitted.

Accordingly, the petition under 37 C.F.R. §1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

Technology Center 1700 will be notified of this decision.

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

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AGFA CORPORATION
LAW & PATENT DEPARTMENT
200 BALLARDVALE STREET
WILMINGTON, MA 01887

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OFFICE OF PETITIONS

In re Application of :
Thomas Brady :
Application No. 10/082,284 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. XP-1012 (1660/86) :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on October 18, 2006, to revive the above-identified application.

The application became abandoned for failure to timely respond to the Notice of Allowance and Fee(s) Due mailed on July 11, 2006.

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

Office records show that petitioner's deposit account was charged $1,400 for payment of the issue fee and $300 for payment of the publication fee on October 18, 2006 and October 25, 2006. For that reason, the $1,700 charged on October 25, 2006 is considered as a duplicate payment and will be credited to petitioner's deposit account.

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

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

Andrea Smith
Petitions Examiner
Office of Petitions

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ALEXANDRIA, VA 22313-1450
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Paper No.

**DICKSTEIN SHAPIRO MORIN & OSHINSKY**
**2101 L STREET NW**
**WASHINGTON, DC 20037-1526**

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JAN 0 2 2004

**OFFICE OF PETITIONS**

In re Application of :
Mitsugu Sato et al :
Application No. 10/082,288 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. H6808.0005/P005 :

This is a decision on the petition, filed December 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 December 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 Wan Laymon at (703) 306-5685.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2881 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

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

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

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Paper No. 10

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OCT 2 9 2002

OFFICE OF PETITIONS

CONNORS ASSOCIATES
1600 DOVE ST
SUITE 220
NEWPORT BEACH CA 92660

In re Application of
Wasserman & Hernandez
Application No.: 10/082,364
Filed: January 4, 2002
Attorney Docket No.: 9264.2
For: METHOD AND SYSTEM FOR TRANSFERRING FUNDS AND VIDEO MESSAGES

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed August 27, 2002 (certificate of mailing date August 20, 2002).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on January 4, 2002 without an executed oath or declaration and filing fees. Accordingly, on March 21, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, a surcharge for its late filing, and filing fees.

In response, on June 4, 2002 (certificate of mailing date May 20, 2002), petitioner submitted the filing fees, the surcharge, and a request for a one month extension of time and required fee (in order to obtain Mr. Hernandez' signature on the declaration). On June 27, 2002 (certificate of mailing date June 20, 2002), petitioner requested additional time to submit an executed declaration. Finally, on August 27, 2002 (certificate of mailing date August 20, 2002), petitioners filed the instant Rule 47(a) petition.

A grantable petition under 37 CFR 1.47(a) requires

(1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
(2) a proper oath or Declaration executed by the available joint inventor(s),
(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor(s).

This petition lacks item (1).

As to item (1), applicant has failed to establish that Mr. Hernandez has refused to sign the declaration or cannot be reached. A successful Rule 47 petition requires either (1) a clear refusal to

join, whether expressly or by conduct, or (2) a showing of diligence in trying to find an unavailable inventor. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. The petition states that the complete application as filed was forwarded to Mr. Hernandez and that no response was received by the August 16, 2002 deadline. However, the transmittal letter of Mr. Wasserman (the person who sent the application package to Mr. Hernandez) is not among the petition papers.

The Office would like to see evidence that the application package was mailed to Mr. Hernandez, starting with the transmittal letter. Mr. Wasserman should provide a declaration/statement of facts as he is the person who attempted to contact Mr. Hernandez. Assuming the package reached Mr. Hernandez, Mr. Hernandez may have been on vacation when it arrived. The Office has no idea as to the time frame set for signing the declaration because the Office does not know when the application package was mailed/received by Mr. Hernandez.

The complete application package should be sent to Mr. Hernandez' last known address with a request that he sign the declaration. If possible, return receipt or some similar form of delivery should be utilized because that way the Office can be certain that Mr. Hernandez received the package.

Any written refusal should be included as documentary evidence in the reconsideration petition. If there is an oral refusal, the facts surrounding the refusal should be included in a declaration by a party with first hand knowledge of the refusal. If it is concluded by the 37 CFR 1.47 applicant 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 petitioner is alleging that Mr. Hernandez cannot be located, other attempts to reach Mr. Hernandez are required. If the papers are returned, and other efforts to locate the inventor, e.g. through e-mail or computer searches (such as LEXIS) fail, then applicant will establish that the inventor cannot be reached.

Documentary evidence to support facts alleged in the affidavit or declaration should be submitted.

Pursuant to petitioner's authorization, deposit account no. 03-2830 will be charged the $130.00 fee associated with filing a Rule 47 petition.

The undersigned assumes that the address listed on the declaration for Mr. Hernandez is his last known address. In the reconsideration petition, please confirm that this is indeed Mr. Hernandez' last known address.

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

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

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 13

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FEB 05 2003

OFFICE OF PETITIONS

CONNORS ASSOCIATES
1600 DOVE ST
SUITE 220
NEWPORT BEACH CA 92660

In re Application of
Wasserman & Hernandez
Application No.: 10/082,364
Filed: January 4, 2002
Attorney Docket No.: 9264.2
For: METHOD AND SYSTEM FOR TRANSFERRING FUNDS AND VIDEO MESSAGES

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed January 22, 2003 and supplemented on January 27, 2003.

Pursuant to petitioner's authorization, deposit account no. 03-2830 will be charged a $55.00 one month extension of time fee.

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 cover letter from Mr. Wasserman to Mr. Hernandez and the FedEx tracking document establish that the non-signing inventor, Mr. Hernandez, was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration. Petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64.

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

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

After this decision is mailed, the above-identified application will be forwarded to Group Art Unit 3624 for further processing.

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

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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MANUEL HERNANDEZ
LEIBINITZ #44
COL. NUEVA ANSUREZ
MEXICO CITY 11560
MEXICO

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FEB 05 2003

OFFICE OF PETITIONS

In re Application of
Wasserman & Hernandez
Application No.: 10/082,364
Filed: January 4, 2002
Attorney Docket No.: 9264.2
For: METHOD AND SYSTEM FOR TRANSFERRING FUNDS AND VIDEO MESSAGES

LETTER

Dear Mr. Hernandez:

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

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

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

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

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

ATTORNEY OF RECORD: CONNORS ASSOCIATES
1600 DOVE ST
SUITE 220
NEWPORT BEACH CA 92660

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APR 18 2006

OFFICE OF PETITIONS

**TRASK BRITT**
**P.O. BOX 2550**
**SALT LAKE CITY UT 84110**

In re Application of :
Michael E. Connell et al :
Application No. 10/082,372 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 2269-5083US :

This is a decision on the petition, filed April 10, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on February 13, 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 2812 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

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Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

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**MAR 17 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mark W. Miles | : | |
| Application No. 10/082,397 | : | DECISION DISMISSING |
| Filed: August 6, 2002 | : | PETITION |
| Attorney Docket No. 5652P013XCD | : | |

This is a decision on the petition under 37 CFR 1.182 filed November 18, 2004, requesting that the above-identified application be accorded a filing date of February 25, 2002, rather than the presently accorded date of August 6, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely (see 37 CFR 1.181(f)). No extensions of time pursuant to the provisions of 37 CFR 1.136 are permitted. If reconsideration is not requested within the time period specified above, this application will be forwarded to Technology Center 2800 for review of the amendment filed November 8, 2004, with the presently accorded filing date of August 6, 2002.

On May 31, 2002, the Office mailed a Notice of Omitted Items in a Nonprovisional Application (Notice) stating that drawing Figure 23E had been omitted from the original filing. The Notice permitted applicant three options for response: (1) to disagree with the Office that the drawing figure was omitted and provide evidence to prove the Office received the omitted item; (2) to submit the omitted item and accept a later filing date based on the day the omitted item was received; or (3) to accept the application as filed without the omitted item. Petitioner chose option (2) by submitting a response to the Notice (with the omitted drawing figure) via certificate of mailing on July 31, 2002, which was received in the Office on August 6, 2002, as petitioner admits in the instant petition. As a result, the Office accorded the application a filing date of August 6, 2002.

Petitioner now requests that the filing date of the application be restored to its original date of February 25, 2002, by withdrawing the response to the Notice received on August 6, 2002. Petitioner asserts that changing the filing date from February 25, 2002 to August 6, 2002, "may be prejudicial to Applicant."

Petitioner voluntarily accepted the later filing date upon submission of the missing drawing figure and $130 petition fee on August 6, 2002. A review of the file record shows that petitioner filed a Request for Corrected Filing Receipt on May 19, 2003. However, petitioner did not request the earlier filing date at that time, but only requested correction of the assignee information. It is uncertain why petitioner waited two (2) years to file the instant request, considering the application has been examined, was under final office action at the time of filing the present petition, and is currently under appeal. Did petitioner not realize accepting the later filing date would be "prejudicial to the Applicant" before application was prosecuted? The first Office action from the Examiner was not mailed until May 29, 2003. In view thereof, petitioner had ample time, over nine (9) months, to determine and notify the Office that Drawing Figure 23E was not needed for this application.

37 CFR 1.182 states:

> "All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, **subject to such other requirements as may be imposed**, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set fort in § 1.17(h)." **(Emphasis added)**

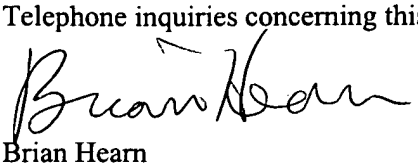
The Director is using his discretion to impose other requirements, as noted above in 37 CFR 1.182. Petitioner may obtain favorable relief, upon request for reconsideration, if petitioner submits a Request for Continued Examination (RCE) under the provisions of 37 CFR 1.114, along with an amendment deleting any reference to Figure 23E in the specification, along with any other reply needed to continue prosecution as the nature of the case then admits. No further petition fee is required.

Petitioner should also note that as the period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. If the filing date is changed to the original date of deposit, such may impact any patent term adjustment.

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

| | |
|---|---|
| By Mail: | Mail Stop PETITION<br>Commissioner for Patents<br>P. O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (703) 972-9306<br>Attn: Office of Petitions |
| By hand: | U. S. Patent and Trademark Office<br>Customer Service Window, Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

Telephone inquiries concerning this matter may be directed to Marianne Jenkins at (571) 272-3223.



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

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Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine CA92614

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JUN 21 2005

**OFFICE OF PETITIONS**

In re Application of :
Miles :
Application No. 10/082,397 : ON PETITION
Filed: February 25, 2002 :
Attorney Dck't. No. 5652P013XCD :

This is a decision renewed petition under 37 CFR 1.182 filed March 17, 2005, to restore as the filing date the date the application papers were first received at the USPTO but lacking Figure 23E, which is being treated as a petition to accord the application papers a filing date of February 25, 2002, without Figure 23E instead of the currently accorded filing date of August 6, 2002, but containing Figure 23E.

The petition is **granted.**

Petitioner includes an RCE such that examination is reopened but with the earlier filing date. The copy of Figure 23D supplied August 6, 2002, has been closed in this IFW file and will not be further relied upon.

This application is being brought to the attention of the Office of Initial Patent Examination (OIPE) for further processing with a filing date of February 25, 2002, and an indication that the drawing figures present on filing did not include Figure 23E.

Telephone inquiries relative to this decision should be directed to the undersigned at (571) 272-3217. Inquiries related to OIPE processing should be directed to (703) 308-1202

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

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2040 MAIN STREET
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IRVINE CA 92614

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NOV 2 8 2005

**OFFICE OF PETITIONS**

In re Application of :
Mark W. Miles :
Application No. 10/082,397 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No.: 5652P013XCD :
:

This is a decision on the petition, filed November 17, 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 21, 2005, in the above-identified application, cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being referred to Technology Center AU 2873 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
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IRVINE CA 92614

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MAR 1 7 2006

OFFICE OF PETITIONS

In re Application of :
Mark Miles. :
Application No. 10/082,397 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 5652P013XCD :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on January 13, 2006, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of prior-filed nonprovisional Application 09/413,222 filed October 5, 1999.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR §§1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR §§1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(I) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed application is submitted after expiration of the period specified in 37 CFR§ 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR §1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR §1.78(a)(3) in that (1) a reference to the above-noted, prior-filed application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains an adequate statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed application satisfies the conditions of 37 CFR §1.78(a)(3) the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

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

Any inquiries concerning this decision may be directed to Charlema R. Grant at (571) 272-3215. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the examiner of Technology Center Art Unit 2873 for consideration of applicants' entitlement to claim benefit of priority under 35 U.S.C. § 120 and 37 CFR 1.78(a)(3) to the above-noted, prior filed application.

Frances Hicks
Petitions Examiner
Office of Petition

Attachment: Corrected Filing Receipt

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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose CA 95113

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SEP 16 2005

**OFFICE OF PETITIONS**

In re Application of
Rubinstein et al.
Application No. 10/082,422
Filed: February 22, 2002
Attorney Docket No. 3COM-3721.BCG.US.P

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 30, 2005, to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

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 director may require additional information where there is a question whether the delay was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). The nonpublication request has been rescinded.

Accordingly, the failure to timely notify the Office of a foreign filing within 45 days as provided by 35 USC 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

A Corrected Filing Receipt which sets forth the projected publication date accompanies this decision on petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 10-02

Paper No. 5

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

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OCT 16 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kutay, Akin, Akin, Akin, Albek, | : | |
| Gilbert, and Stremel | : | DECISION REFUSING STATUS |
| Application No. 10/082,427 | : | UNDER 37 CFR 1.47(a) |
| Filed: 22 February, 2002 | : | |
| Attorney Docket No. 3866P008 | : | |

This is in response to the petition filed under 37 CFR 1.47(a) on 9 September, 2002.

The petition is **DISMISSED**.

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

The above-identified issue application was filed on 22 February, 2002, without an executed oath or declaration. Accordingly, on 27 March, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 9 September, 2002 (certificate of mailing date 27

August, 2002), the present petition was filed, accompanied by the petition fee, surcharge, a three (3) month extension of time, and a declaration naming Ali Kutay, Cihan Akin, Erhan Akin, Hakan Akin, Eliahu Albek, John Gilbert, and Paul Stremel as joint inventors and signed by joint inventors Kutay, Albek, and Stremel on behalf of themselves and joint inventors Cihan Akin, Erhan Akin, Hakan Akin, and Gilbert.

Petitioners assert that the application papers were sent to joint inventor Erhan Akin "to gather signatures on May 28, 2002 and May 30, 2002."

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 items (1) and (2). In regards to item (1), petitioners have not shown proof that a copy of the application (specification, including claims, drawings, if any, and the Declaration) was sent or given to *each* non-signing inventor (or his counsel) for review.[1] The showing of record is that the application papers were sent to only one non-signing inventor with the hope that inventor would attempt to get the other non-signing inventors to sign.

Petitioners may show proof 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 to sign can be shown, petitioners must show that the application as filed was sent or

---

[1] MPEP 409.03(d).

given to each non-signing inventor for review.[2] If there is a written refusal, a copy of that written refusal should be provided with any renewed application. 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.

In respect to item (2), above, it is noted that the declaration filed on 9 September, 2002, is defective in that it contains non initialed and/or non-dated alterations.[3] Specifically, there are unsigned and/or undated changes for joint inventor Eliahu Albek. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency relates is required.[4]

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

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

By FAX: (703) 308-6916
Attn: Office of Petitions

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

Telephone inquiries 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
Office of the Deputy Commissioner
for Patent Examination Policy

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[2] Id.

[3] See 37 CFR 1.52(c).

[4] 37 CFR 1.67(a)(2).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DRW 01-03

Paper No. 8

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

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kutay, Akin, Akin, Akin, Albek, | : | |
| Gilbert, and Stremel | : | DECISION ACCORDING STATUS |
| Application No. 10/082,427 | : | UNDER 37 CFR 1.47(a) |
| Filed: 22 February, 2002 | : | |
| Attorney Docket No. 3866P008 | : | |

This is in response to the renewed petition filed under 37 CFR 1.47(a) on 16 December, 2002.

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventors, Cihan Akin, Erhan Akin, Hakan Akin, and John Gilbert (Gilbert), have refused to join in the filing of the above-identified application after having been mailed a copy of the application papers. Specifically, the declaration of Megan Streifel, Human Resources Manager at AltoWeb, Inc., the putative assignee, establishes that the inventors were sent a copy of the application papers by Federal Express, but failed to execute and return the declaration naming them as joint inventors along with Ali Kutay, Eliahu Albek, and Paul Stremel.

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 in the petition, not the declaration.

Notice of the filing of this application will also be published in the Official Gazette.

Receipt of the oath or declaration filed in compliance with 37 CFR 1.63 and 1.67 on 16 December, 2002, is acknowledged.

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

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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OFFICE OF PETITIONS

Erhan Akin
837 Catamaran Street #2
Foster City, CA 94404

In re Application of
Kutay et al.
Application No. 10/082,427
Filed: 22 February, 2002
For: SYSTEM AND METHOD TO FACILITATE ANALYSIS AND REMOVAL OF ERRORS FROM AN APPLICATION

Dear Mr. Akin:

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).

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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JAN 03 2003

OFFICE OF PETITIONS

Cihan Akin
631 Spar Drive
Redwood City, CA 94065

In re Application of
Kutay et al.
Application No. 10/082,427
Filed: 22 February, 2002
For: SYSTEM AND METHOD TO FACILITATE ANALYSIS AND REMOVAL OF ERRORS FROM AN APPLICATION

Dear Mr. Akin:

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).

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

Hakan Akin
1951 O'Farrell Street #209
San Mateo, CA 94403

In re Application of
Kutay et al.
Application No. 10/082,427
Filed: 22 February, 2002
For: SYSTEM AND METHOD TO FACILITATE ANALYSIS AND REMOVAL OF ERRORS FROM AN APPLICATION

Dear Mr. Akin:

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
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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OFFICE OF PETITIONS

John Gilbert
1102 Continentals Way
Belmont, CA 94002

In re Application of
Kutay et al.
Application No. 10/082,427
Filed: 22 February, 2002
For: SYSTEM AND METHOD TO FACILITATE ANALYSIS AND REMOVAL OF ERRORS FROM AN APPLICATION

Dear Mr. Gilbert:

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).

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**COMMISSIONER OF PATENTS**

March 3, 2005

Robert C. Colwell
Townsend and Townsend and Crew
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

In re Application of:
Mineo Nomoto, et al
Serial No: 10/082,430 On Petition
Filing Date: February 22, 2002
For: METHOD AND APPARATUS FOR MEASURING THICKNESS OF THIN FILM AND DEVICE MANUFACTURING METHOD USING SAME

In response to the petitions received April 28, 2004, to withdraw the holding of abandonment in the above application.

The petition is Granted.

The above-identified application became abandoned for failure to reply with the meaning of 37 C.D.R 1.113 in a timely manner to the Notice to File Missing Parts of Nonprovisional Application mailed March 22, 2002. Which set forth a shortened statutory period for reply of two months. Accordingly, the above-identified application became abandoned May 23, 2002. The notice of abandonment was mailed on October 2, 2002.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts of Nonprovisional Application Papers on July 1, 2002.

The application was abandoned in error. The office regrets any inconvenience this may have caused the client.

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

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

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

11/16/08

Patent No. :7119062
Inventor(s) : MARK R. ALVIS et al.
Issued : 10/10/2006
Title : METHODS AND COMPOSITIONS FOR IMPROVED ARTICULAR SURGERY USING COLLAGEN
Atty.doc./File No.

Request for Certificates of Correction

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

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

In view of the forgoing, your request in this matter, is hereby denied.

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

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

MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO, CALIFORNIA 94304-1018

HR/CBN

UNITED STATES 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
755 PAGE MILL RD.
PALO ALTO CA 94304-1018

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FEB 07 2008

OFFICE OF PETITIONS

In re Patent No. 7,119,062 :
Issue Date: October 10, 2006 :
Application No. 10/082,443 : NOTICE
Filed: February 22, 2002 :
Attorney Docket No. 437252001200 :

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 in this file must be paid at the large entity rate, absent further notification from a proper party of a change in status. ***See 37 CFR 1.27(c)(2).***

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

**SCAN!** Please forward case and paper to address shown below.

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

Paper No.: _____

DATE : 2/29/08

TO SPE OF : ART UNIT 1654 Tsang, Cecelia

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/082443 Patent No.: 7119062

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: _____

Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600

1654

SPE Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jian Zhu | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7609695 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/082,450 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/23/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1572** 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

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 05/18/2010

**Applicant** : Jian Zhu
**Patent Number** : 7609695
**Issue Date** : 10/27/2009
**Application No**: 10/082,450
**Filed** : 02/23/2002

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

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

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

The patent term adjustment has been determined to be **1595** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

UNITED STATES 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 R. GROPPER, PC
9908 DALE RIDGE CT.
VIENNA, VA 22181

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JUN 25 2008

OFFICE OF PETITIONS

In re Application of :
Shane A. Chalke, et al. :
Application No. 10/082,470 : DECISION ON PETITION
Filed: February 21, 2002 : TO WITHDRAW
Attorney Docket No. 455.01 : 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 7, 2007.

The request is **APPROVED**.

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

The request was signed by Daniel R. Gropper on behalf of all attorneys of record who are associated with this application.

All attorneys/agents associated with this application have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must

have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

There is an outstanding Office action mailed October 17, 2007 that requires a reply from the applicant.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: SHANE A. CHALKE
108-G SOUTH STREET
LEESBURG, VA 20175

cc: SEAN T. DONAGHY
EBIX, INC.,
5 CONCOURSE PKWY
SUITE 3200
ATLANTA, GA 30328

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

DEC - 6 2004

MAILED

DEC - 6 2004

OFFICE OF THE DIRECTOR
TC 3600

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1030

In re application of
Robert Fransdonk :
Application No. 10/082,498 : **DECISION ON REQUEST**
Filed: February 22, 2002 : **FOR WITHDRAWAL OF**
For: METHOD AND SYSTEM TO PROVIDE SECURE KEY SELECTION USING A SECURE DEVICE IN A WATERCRYPTING ENVIRONMENT : **ATTORNEY**

This is a decision on the request filed on October 18, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**

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

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

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

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

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with Item B).

As to Item B), the reason "Discontinuation of the attorney/client relationship" is not appropriate since it is not clear that the client initiated the discontinuation, or that the client knowingly or freely assents to the transfer to new counsel. A proper reason for withdrawal is enumerated in 37 CFR 10.40(b) subsections (1)-(4) or subsections (1)-(6) of 37 CFR 10.40(c) must be provided.

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

SNM/pav: 11/30/04

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United States Patent and Trademark Office
P.O. Box 1450
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SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

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OCT 3 1 2007

OFFICE OF PETITIONS

In re Application of :
Robert W. Fransdonk :
Application No. 10/082,498 : DECISION ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. 2059.007US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 13, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of August 11, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Since the amendment submitted does not prima facie place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

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

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

This application is being referred to Technology Center AU 3621 for appropriate action by the Examiner in the normal course of business on the reply received June 13, 2007.

April M. Wise
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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SMITH MOORE LLP
P.O. BOX 21927
GREENSBORO NC 27420

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MAY 0 5 2005

OFFICE OF PETITIONS

In re Application of
Pajunen et al.
Application No. 10/082,507
Filed: October 19, 2001
Attorney Docket No. 05004146-001US1

:DECISIONS ON PETITIONS
:UNDER 37 CFR §1.78(a)(3)
:AND UNDER
:§37 CFR 1.55 (c)
:

This is a decision on the petition under 37 CFR §1.78(a)(3), and 37 CFR §1.55 (c) filed on July 8, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §120 and 365 (c) for the benefit of prior- filed PCT application and under 35 USC §119 (a)-(d) and (f) for the benefit of prior filed foreign application as set forth in the concurrently filed application data sheet and amendment.

The petitions are **GRANTED**.

As to the benefit claim under 37 CFR §1.78(a)(3):

A petition under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii), and must be filed during the pendency of the nonprovisional application. In addition, the petition must accompanied by:

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

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional; and

(3) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence following the title. *See* 35 USC §§120 and 37 CFR §1.78(a)(2). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on October 19, 2001 and was pending at the time of the filing of the instant petition. A reference to the prior-filed application has been included in an application data sheet (ADS) and in an amendment to the specification. It is noted that the ADS includes, under "Domestic Priority Information" an indication that PCT/EP00/03631 claims domestic benefit to EP99107354.5 (EP '354.5). This is not a proper domestic benefit claim as EP '354.5 is not a US Patent Application. See 35 USC 119(e), 120, 365(c) and 37 CFR 1.78. Petitioner has properly claimed foreign priority to EP '354.5 under the "Foreign Priority Information" section of the ADS. Since the petition correctly does not assert that the delayed claim to EP '354.5 should be accepted under 37 CFR 1.78, but rather accepted under 37 CFR 1.55, the petition has not been treated as requesting acceptance of an unintentionally delayed domestic benefit claim to EP '354.5. Applicant may correct the error in the ADS via a supplemental ADS. See 37 CFR 1.76 (d) (4).

The instant nonprovisional application was filed after November 29, 2000 and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR §1.78 (a) (2)(ii). The reference to the prior-filed PCT application was submitted during the pendency of the instant nonprovisional application for which the claim for benefit of priority is sought. See 35 USC §§120 and 365 (c). Accordingly having found that the instant petition for acceptance of an unintentionally delayed claim for benefit of priority under See 35 USC §§120 and 365(c) to the prior- filed application satisfies the conditions of 37 CFR §1.78(a)(3), the petition is granted.

As to the benefit claim under 37 CFR §1.55 (c):

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

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

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

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

(4) a statement that the entire delay between the date the claim was due under 37 CFR §1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where

there is a question whether the delay was unintentional.); and

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

The above-identified pending nonprovisional application was filed on October 19, 2001 which is after November 29, 2000, and the intermediate PCT application was filed within 12 months of April 21, 1999 of which is the earliest filing date of the foreign application to which benefit is claimed. The application data sheet filed on July 8, 2004 also identifies the foreign application to which benefit is claimed. A certified copy of the foreign patent document was filed on October 19, 2001. Lastly petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition under 37 CFR §1.55 (c) to accept an unintentionally delayed claim for priority under 35 USC §119-(a)-(d) and (f) is granted.

A corrected filing receipt, which includes priority claim to the prior filed PCT application, and the foreign priority claim, accompanies this decision on the petition.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR §1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§120 and 365 (c) and 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.

This application is being forwarded to Technology Center 1700 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 USC §§ 120 and 365 (c) to the prior-filed PCT applications and for consideration of the claim for priority under 35 USC §119 for the benefit of the foreign application as set forth in the concurrently filed amendment and application data sheet.

Telephone inquiries concerning this matter may be directed to Charlema Grant at (571) 272-3215.

Charles Pearson
Director
Office of Petitions

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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLM |
|---|---|---|---|---|---|---|---|
| 10/082,507 | 10/19/2001 | 1761 | 942 | 05004146-001US1 | 6 | 24 | 2 |

**CONFIRMATION NO. 5**
**CORRECTED FILING RECEIP**
*OC000000001587162
*OC000000015871623*

29739
SMITH MOORE LLP
P.O. BOX 21927
GREENSBORO, NC 27420

Date Mailed: 04/26/2

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

**Applicant(s)**

Esko Juhani Pajunen, Topeliuksenkatu, FINLAND;
Francis J. Lynch, Glenageary Co., IRELAND;
Joseph Bergin, Leixlip Co., IRELAND;
Timo Tapio Viljava, Kolsarintie, FINLAND;
Keld Andersen, Silkeborg, DENMARK;
Heikki Olavi Lommi, Metsapolku, FINLAND;

**Power of Attorney:** The patent practitioners associated with Customer Number **29739**.

**Domestic Priority data as claimed by applicant**

This application is a CON of PCT/EP00/03631 04/20/2000

**Foreign Applications**

EUROPEAN PATENT OFFICE (EPO) EP99107354.5 04/21/1999

**If Required, Foreign Filing License Granted:** 03/21/2002

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/082,507**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Method and apparatus for the continuous biocatalytic conversion of aqueous solutions, having one or more degassing stages

**Preliminary Class**

426

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

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICEN GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions 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. 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 (b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless 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 revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is 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 impo by any Government contract or the provisions of existing laws relating to espionage and the national security or the expor technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of o agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Impleme of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office 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 LICEN GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is des before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign the application pursuant to 37 CFR 5.15(b).

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/082,533 | 02/22/2002 | Steve Yankovich | Y-5914P001X | 8355 |

43143 7590 08/13/2007

PATENTRY
P.O. BOX 151616
SAN RAFAEL, CA 94915-1616

| EXAMINER | |
|---|---|
| HUTTON JR, WILLIAM D | |
| **ART UNIT** | **PAPER NUMBER** |
| 2176 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 08/13/2007 | 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.

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*In re* Patent No. YANKOVICH ET AL.
Issue Date: Feb. 14, 2006
Appl No.: 10/082,533
Filed: February 22, 2002

**DECISION GRANTING PETITION**
*37 CFR 1.324*

This is a decision on the petition filed 07/27/2007 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.

Doug Hutton
Supervisory Patent Examiner
Art Unit 2176
Technology Center 2100

PATENTRY
P.O. BOX 151616
SAN RAFAEL, CA 94915-1616

UNITED STATES 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:** August 8, 2007
**TO:** Certificates of Correction Branch
**FROM:** Doug Hutton
SPE, Art Unit 2176
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7,000,179 as specified on the attached Certificate.

Doug Hutton, SPE
Art Unit 2176

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 7,000,179
Patented: Feb. 14, 2006

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:

Steve Yankovich
Edwin Porter
Nathan Hoover
William Thomas Bajjek

Doug Hutton
Supervisory Patent Examiner
Art Unit 2176

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Intellectual Property Department
Cubist Pharmaceuticals, Inc.
65 Hayden Avenue
Lexington MA 02421

MAILED

MAY 17 2010

OFFICE OF PETITIONS

In re Application of :
Oleson et al. :
Application No. 10/082,544 :
Patent No.: 6,852,689 :
Filed: February 20, 2002 :
Issued: February 8, 2005 :
Attorney Docket No.: C053-03/02 US :
Title: METHODS FOR ADMINISTRATION OF ANTIBIOTICS :

DECISION ON PETITION PURSUANT TO 37 C.F.R. § 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on January 27, 2010. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. § 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 C.F.R. § 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.

Petitioner has identified the particular type of fee that was erroneously paid as a small entity, when the small entity fee was actually paid, the small entity fee that was actually paid, the deficiency owed amount, and the total deficiency payment owed.

The deficiency payment has been deducted from Deposit Account number 50-1986.

Your fee deficiency submission pursuant to 37 C.F.R. § 1.28(c) is hereby accepted. The petition is **GRANTED** accordingly.

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

1 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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DW 06-02

Paper No. 5

JULIA CHURCH DIERKER
DIERKER & GLASSMEYER, PLLC
SUITE 121
3290 W. BIG BEAVER ROAD
TROY MI 48084-2906

COPY MAILED

JUN 14 2002

OFFICE OF PETITIONS

In re Application of
Yang et al.
Application No. 10/082,550
Filed: 25 February, 2002
Atty's Dkt No. UMJ-102-C
UM-1544d1)

DECISION GRANTING PETITION

This is a decision on the petition filed on 24 May, 2002, requesting that the above-identified application, including Figures 4 and 5 described in the specification, be accorded a filing date of 25 February, 2002.

On 25 February, 2002, the application was filed.

On 2 May, 2002, Initial Patent Examination Division mailed a Notice of Omitted Item(s) in a Nonprovisional Application, stating that the application had been accorded a filing date of 25 February, 2002, but that Figures 4 and 5 described in the specification appeared to have been omitted.

In response, on 24 May, 2002, the present petition was submitted. Petitioners assert that one (1) sheet of drawings containing Figures 4 and 5 was filed with the other application papers on 25 February, 2002, but was subsequently misplaced in the U.S. Patent and Trademark Office (Office). In support, a copy of petitioners' postcard receipt was supplied with the present petition. The postcard receipt shows an Office date stamp of 02/25/02 and the above-identified application number. The postcard receipt also identifies the application by the first named inventor's name, attorney docket number, and invention title, and acknowledge receipt, *inter alia*, of 11 sheets of drawings. Petitioners request that the application, including the one (1) sheet of drawings containing Figure 4 and 5 be accorded a filing date of 25 February, 2002.

A review of the record reveals that 10 sheets of drawings containing Figures 1, 2, 2A, 3, and 6-20 are located among the application papers deposited on 25 February, 2002. However, the

evidence is convincing that the application papers deposited on 25 February, 2002, included 11 sheets of drawings and that the sheet of drawings containing Figures 4 and 5 as described in the specification was subsequently misplaced in the Office. Therefore, the application, including the one (1) sheet of drawing containing Figure 4 and 5 as described in the specification, is entitled to a filing date of 25 February, 2002.

Accordingly, the Notice of Omitted Item(s) in a Nonprovisional Application mailed on 2 May, 2002, is hereby withdrawn.

In view of the above, the petition is granted. The petition fee of $130.00 will be credited to counsel's deposit account, No. 50-2100.

The application will be processed using the application papers, filed on 25 February, 2002, and the one (1) sheet of drawings containing Figures 4 and 5 supplied on 24 May, 2002. The copies of the other sheets of drawings supplied on 24 May, 2002, will not be used for processing or examination, but will be retained in the application filed.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 25 February, 2002, using the application papers filed that date, and the one (1) sheet of drawings containing Figures 4 and 5 supplied on 24 May, 2002, and for an indication on the bib-data sheet that 11 sheets of drawings were present on filing.

Telephone inquires should be directed to Petitions Attorney Douglas I. Wood at 703 308-6918.

D Wood

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/082,587 | 02/25/2002 | Brent J. Bos | DON01 P-960 | 5708 |

28101 7590 05/07/2004

VAN DYKE, GARDNER, LINN AND BURKHART, LLP
2851 CHARLEVOIX DRIVE, S.E.
P.O. BOX 888695
GRAND RAPIDS, MI 49588-8695

| EXAMINER | |
|---|---|
| CARIASO, ALAN B | |
| ART UNIT | PAPER NUMBER |
| 2875 | |

DATE MAILED: 05/07/2004

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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/082,587 | | | |

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED:

# NOTICE OF ABANDONMENT

This application is abandoned in view of:

☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.

☐ A reply (with Certificate of Mailing or Transmission of _____ ) was received on _____ which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

☐ A proposed reply was received on _____ , but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

☐ A reply was received on _____ , but it does not constitute a proper reply, or a *bona fide* attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in the last box below).

☐ No reply has been received.

☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____ ), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85)(or Notice of Publication Fee Due).

☐ The submitted fee of $_____ is insufficient. A balance of $ _____ is due.
The issue fee by 37 CFR 1.18 is $_____ . The publication fee, if required, by 37 CFR 1.18(d) is $_____.

☐ The issue fee and publication fee, if applicable, have not been received.

☒ Applicant's failure to timely file corrrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).

☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____ ), which is after the expiration of the period for reply.

☒ No corrected drawings have been received.

☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all the applicants.

☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon filing of a continuing application.

☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ The reason(s) below: _____

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

PTO-1432 (07/01)

CLW

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 4

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

JUL 0 1 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Ulfar ERLINGSSON
Application No.: 10/082,591
Filed: February 22, 2002
For: ALTERED STATES OF SOFTWARE COMPONENT BEHAVIOR

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request For Withdrawal As Attorney Under 37 CFR § 1. 36 and 10.40(c) filed April 11, 2002.

A Revocation And Substitution Of Power Of Attorney Under 37 CFR § 1. 36 was filed on June 12, 2002. The Power Of Attorney revoked all prior Powers Of Attorney and appointed Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P. as the attorneys of record of the instant application. The Power Of Attorney of June 12, 2002 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P.

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 Program Examiner
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce
(703) 305-9750

cc: Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**TOWNSEND AND TOWNSEND AND CREW, LLP**
**TWO EMBARCADERO CENTER**
**EIGHTH FLOOR**
**SAN FRANCISCO CA 94111-3834**

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SEP 2 4 2007

OFFICE OF PETITIONS

In re Application of :
Akira Hamamatsu et al. :
Application No. 10/082,593 : ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. 16869P-041800US :

This is a decision on the petition under 37 CFR 1.137(b), filed March 2, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 11, 2006, which set a shortened statutory period for reply of three (3) months. An extension of time for three (3) months under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on January 12, 2007.

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

This application is being revived for consideration of the RCE.

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

The application file is being referred to Technology Center AU 2814 for appropriate action on the concurrently filed RCE.

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

**WALTER A. HACKLER**
**2372 S.E. BRISTOL, SUITE B**
**NEWPORT BEACH, CA 92660-0755**

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MAY 27 2004

OFFICE OF PETITIONS

In re Application of :
Bell, Otis Franklin :
Application No. 10/082,598 : DECISION GRANTING PETITION
Filed: February 22, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 2871 :

This is a decision on the petition, filed April 12, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant non-provisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on February 20, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

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

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of July 29, 2004 was previously mailed on April 20, 2004.

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

Telephone inquiries concerning this decision 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

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

Schwabe Williamson & Wyatt
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Satoshi Nakajima | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7599992 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/082,601 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/22/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1174** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

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JAN 12 2005

OFFICE OF PETITIONS

In re Application of :
Yan, et al. : DECISION ON PETITION
Application No. 10/082,603 :
Filed: February 22, 2002 :
Docket No.: LWM-A078 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 3, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned June 25, 2004 for failure to timely reply to the non-final Office action mailed March 24, 2004. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136 were timely requested. Notice of Abandonment was mailed October 5, 2004.

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 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the non-final Office action is accepted as having been unintentionally delayed.

A recent request for withdrawal of attorney directed that the correspondence in the instant application be directed to petitioners herein. However, petitioners have to date not

submitted a power of attorney. Petitioners are advised to promptly submit a power of attorney.

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

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

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Third Floor
Two North Market Street
San Jose, CA 95113

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**JAN 12 2005**

**OFFICE OF PETITIONS**

In re Application of :
Yan, et al. : DECISION ON REQUEST
Application No. 10/082,603 : TO WITHDRAW FROM RECORD
Filed: February 22, 2002 :
Docket No.: LWM-A078 :

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed November 19, 2004[1].

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 withdraw being the date of decision and not the date of request, see MPEP § 402.06.

The instant request meets the above requirements.

Accordingly, the request is **GRANTED**.

All future communications from the Office will be sent to the address listed below until notified otherwise by the applicant. This address is provided by the withdrawing attorneys.

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

[1] This matter is before the Office of the Deputy Commissioner for Patent Examination Policy in accordance with MPEP 1002.02(b)(10).

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner for Patent Examination Policy.

CC: PATTERSON, THUENTE, SKAAR & CHRISTENSEN, PA
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MINNESOTA 55402-2100

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Paper No. 10

DALY CROWLEY & MOFFORD LLP
275 TURNPIKE STREET
SUITE 101
CANTON MA 02021-2310

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AUG 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Perreault, et al. :
Application No. 10/082,616 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. MIT-106PUS :

This is a decision on the petition to revive under 37 CFR 1.137(b) pursuant to 37 CFR 1.137(f), filed May 27, 2003.

The petition is **GRANTED**.

Petitioner states that the instant patent is the subject of a PCT international application filed on November 27, 2002. However, the US Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the PCT application.

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

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

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

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

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

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after

the date of filing of such foreign or international application as provided by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 USC 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request and Notice of Foreign Filing indicating a projected publication date of November 13, 2003 accompanies this decision on petition.

The application is being forwarded to Technology Center 2800 for examination.

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

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: Notice Regarding Rescission of Nonpublication Request and Notice of Foreign Filing (2 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE

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Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
US BANK BUILDING
8000 EXCELSIOR DRIVE, SUITE 401
MADISON WI 53717-1914

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**DEC 15 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Olstein et al. | : | DECISION GRANTING PETITION |
| Application No. 10/082,618 | : | |
| Filed: February 22, 2002 | : | |
| Attorney Docket No. 21001.005 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 28, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on November 18, 2005, for failure to pay the issue and publication fees as required by the Notice of Allowance and Fee(s) Due mailed on August 17, 2005, which set a three (3) month statutory period for reply.

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

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (703) 305-8497.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**PATENT, COPYRIGHT & TRADEMARK LAW GROUP**
**4199 Kinross Lakes Parkway**
**Suite 275**
**RICHFIELD OH 44286**

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DEC 14 2009

OFFICE OF PETITIONS

In re Application of :
Abdelkhalek Elhadiri :
Application No. 10/082,665 : DECISION ON PETITION
Filed: February 25, 2002 :
:

This is a decision on the petition filed in the above-identified application.

The petition is **DISMISSED**.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition to revive an abandoned application for patent based on unintentional delay or to accept an unintentionally delayed payment of a fee for issuing a patent. In this instance, the fee required by law is $1,620. If applicant 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. See 37 CFR 1.27.

The petition in the above-identified application was not accompanied by payment of the required fee. No consideration on the merits can be given to the petition until the required fee is received.

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

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

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

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

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Abdelkhalek Elhadiri**
**Syos San Gabriel Way**
**Orlando, FL 32837**

UNITED STATES PATENT AND TRADEMARK OFFICE

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**JONDLE & ASSOCIATES P.C.**
**9085 EAST MINERAL CIRCLE**
**SUITE 200**
**CENTENNIAL CO 80112**

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DEC 27 2004

OFFICE OF PETITIONS

In re Application of :
Ted Superak et al :
Application No. 10/082,707 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. N1305-026 :

This is a decision on the petition, filed December 17, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

**Petitioner is advised that the issue fee paid on October 28, 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 1638 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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VINCENT L. CARNEY LAW OFFICE
P.O. BOX 80836
LINCOLN, NE 68501-0836

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APR 18 2005

OFFICE OF PETITIONS

In re Application of :
Allington et al. :
Application No. 10/082,710 : Decision on Petition
Filed: February 25, 2002 :
Attorney Docket No. 18-587-9-1 :

This a decision on the petition under 37 CFR 1.181, filed December 20, 2004, requesting a refund of $43. Petitioner asserts the $43 was charged in error to petitioner's deposit account.

The petition is **granted.**

The application was filed on February 25, 2002. The application had a total of six independent claims. Petitioner was charged for 3 excess independent claims.

On April 29, 2004, an amendment was filed. An Office employee determined seven independent claims were present. Petitioner's deposit account was charged $43 for the seventh independent claim. Petitioner contends only six independent claims were present.

On September 24, 2004, an amendment was filed. The amendment contained a total of 10 independent claims. Petitioner was charged $172 for extra independent claims.

A review of the file supports petitioner's assertion that only six independent claims were present on April 29, 2004. However, even if seven independent claims had been present on April 29, 2004, petitioner would be entitled to a refund of $43. Petitioner was charged for a total of 8 independent claims. At no time during prosecution did the application contain 11 independent claims. If seven claims were present on April 29, 2004, then petitioner would have only owed $129 on September 24, 2004, instead of $172. In other words, the Office either overcharged petitioner $43 on April 29, 2004, or overcharged petitioner $43 on September 24, 2004.

The fee of $43 has been credited to petitioner's deposit account.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 11

**STEVEN L. HIGHLANDER**
**FULBRIGHT & JAWORSKI**
**SUITE 2400**
**600 CONGRESS AVENUE**
**AUSTIN, TX 78701**

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OCT 2 4 2002

OFFICE OF PETITIONS

In re Application of :
Peter Droge et al :
Application No. 10/082,772 : NOTICE
Filed: February 25, 2002 :
Attorney Docket No. DEBE:008US :

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 the Office of Initial Patent Examination.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

JEFFREY C. MAYNARD
WHITEFORD, TAYLOR & PRESTON LLP
SEVEN SAINT PAUL STREET
BALTIMORE, MD 21202-1626

COPY MAILED

JUN 2 5 2003

OFFICE OF PETITIONS

In re Application of :
David Proscia et al :
Application No. 10/082,790 : NOTICE
Filed: February 25, 2002 :
Attorney Docket No. IPHO/0005.03 :

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

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

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

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center 2800.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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NTT DoCoMo Inc/BHGL
P.O. Box 10395
Chicago, IL 60610

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Masahiro Sawada | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7574222 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/082,797 | : OF WYETH |
| **Filed** | : 02/25/2002 | : |
| | | : |

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

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

NTT DoCoMo Inc/BHGL
P.O. Box 10395
Chicago, IL 60610

Mail Date: 05/18/2010

**Applicant** : Masahiro Sawada
**Patent Number** : 7574222
**Issue Date** : 08/11/2009
**Application No**: 10/082,797
**Filed** : 02/25/2002

: NOTICE CONCERNING IMPROPER
: DISMISSAL OF THE REQUEST
: FOR RECALCULATION OF
: PATENT TERM ADJUSTMENT
: IN VIEW OF WYETH

The United States Patent and Trademark Office (USPTO) discovered that in processing the recent recalculation decisions mailed in response to patentee's filed Request for Recalculation of Patent Term Adjustment in view of Wyeth, the USPTO mistakenly dismissed a small number of requests as ineligible. The dismissals involve requests that were filed on February 9-12, 2010, for patents that were granted on August 11, 2009. Any request that was filed on February 8, 2010 was properly deemed eligible for patent term adjustment (PTA) and was recalculated.

Patents meeting the above criteria were eligible because the USPTO was closed February 8-11, 2010, due to a snowstorm. See Closing of the United States Patent and Trademark Office from Monday February, 8, 2010, through Thursday, February 11, 2010, 1352 *Off. Gaz. Pat. Office* 146 (March 16, 2010). The Office considered each day from Monday, February 8, 2010, through Thursday, February 11, 2010, to be a "Federal holiday within the District of Columbia" under 35 U.S.C. § 21(b) and 37 CFR 1.6, 1.7, 1.9, 2.2(d), 2.195 and 2.196. Any actions that were due from Monday, February, 8, 2010, through Thursday, February 11, 2010, (or the preceding Saturday (February 6, 2010) or Sunday (February 7, 2010)) will be considered timely if the action was taken on the next succeeding business day on which the USPTO was open, which was February 12, 2010.

This notice **VACATES** the previous mailed decision in the patented file that deemed patentee ineligible for the request for recalculation. Patentee's request for recalculation is GRANTED.

The patent term adjustment has been determined to be **640** 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** from the mail date of this notice, whichever is longer, to file a request for reconsideration of this PTA calculation. See 35 U.S.C. § 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4).

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

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

UNITED STATES 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

WHITEFORD TAYLOR & PRESTON
ATTN: GREGORY M STONE
SEVEN SAINT PAUL STREET
BALTIMORE, MD 21202-1626

COPY MAILED

JUN 1 2 2003

OFFICE OF PETITIONS

In re Application of :
Phillip R. Sommer et al :
Application No. 10/082,799 : NOTICE
Filed: February 25, 2002 :
Attorney Docket No. IPHO/0005.02 :

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 2874.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P.O. BOX 1450
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Paper No. 8

JEFFREY C. MAYNARD
WHITEFORD TAYLOR & PRESTON L.L.P.
SEVEN SAINT PAUL STREET
BALTIMORE, MD 21202-1626

COPY MAILED

JUN 1 6 2003

OFFICE OF PETITIONS

In re Application of :
Phillip Sommer et al :
Application No. 10/082,810 : NOTICE
Filed: February 25, 2002 :
Attorney Docket No. IPHO/0005.07 :

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

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

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

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center 2800.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

GREGORY L. BRADLEY
MEDRAD, INC.
ONE MEDRAD DRIVE
INDIANOLA, PA 15051

COPY MAILED

JUL 23 2003

OFFICE OF PETITIONS

In re Application of :
George J. Misic :
Application No. 10/082,818 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. MR/98-004.C :

This is a decision on the petition under 37 CFR 1.137(a), filed July 10, 2003, 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(a)."

This application became abandoned for failure to timely reply to the Office action mailed November 18, 2002. Accordingly, this application became abandoned on February 19, 2003 . A Notice of Abandonment was mailed on June 30, 2003.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. 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 lacks item (3) above.

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

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

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner asserts that the delay was "due to an unexpected and unforeseen fault in a new docketing system ... the docketing entry for the Office Action to which this petition is directed was somehow corrupted or otherwise rendered incorrect."

Petitioner further "states that: (1) the foregoing error was the cause of the delay at issue; (2) there is, and has been, in place a business routine for performing the function of docketing that could reasonably be relied upon to avoid errors in its performance; and (3) the employees who have responsibility for our docketing system are sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employees represent the exercise of due care."

While petitioner has stated the above, 37 CFR 1.137(a)(3) requires that a showing be made that supports and evidences the statements made by petitioner.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See MPEP 711.03(c)(III)(C)(2).

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them. Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. Petitioner must also supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Accordingly, 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. § 133 and 37 CFR 1.137(a).

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries should be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 15

GREGORY L. BRADLEY
MEDRAD, INC.
ONE MEDRAD DRIVE
INDIANOLA, PA 15051

COPY MAILED

AUG 0 6 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of :
George J. Misic :
Application No. 10/082,818 :
Filed: February 25, 2002 :
Attorney Docket No. MR/98-004.C :

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

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Office action mailed November 18, 2002. Accordingly, this application became abandoned on February 19, 2003. A Notice of Abandonment was mailed on June 30, 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 $1970.00 extension of time submitted with the petition on July 10, 2003 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The file is being forwarded to Technology Center 2800 for review of the amendment, submitted July 10, 2003.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

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

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA PA 19103

COPY MAILED

APR 2 9 2002

OFFICE OF PETITIONS

In re Application of :
Jeffry R. Meyer :DECISION DISMISSING PETITION
Application No. 10/082,824 :UNDER 37 CFR 1.10(e) AS MOOT
Filed: October 19, 2001 :
Attorney Docket No. ABHS-0169/B970532 :

This is a decision on the petition under 37 CFR 1.10(e), filed March 12, 2002, requesting that previously deposited application papers for applicant Jeffry R. Meyer, entitled "System and Method for High Accuracy Activation of a Mechanism Via Solenoid," be assigned a filing date of October 19, 2001.

A request was filed on April 4, 2002 requesting that the petition under 37 CFR 1.10(e) be withdrawn, since applicant has now received an official Filing Receipt for the originally filed patent application.

The petition under 37 CFR 1.10(e) is dismissed as moot, since as stated by petitioner, the originally filed papers for applicant Jeffry R. Meyer have been assigned a filing date of October 19, 2001.

In view of the above, the check submitted with the instant petition for the filing fees in the amount of $878.00 is a duplicate payment and is therefore unnecessary. Additionally, the $130 fee submitted for the instant petition is also unnecessary. Accordingly, the checks submitted for these fees is being returned herewith.

Any questions concerning this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being returned to the Office of Initial Patent Examination to await a reply to the Notice to File Missing Parts of Nonprovisional Application, mailed March 20, 2002.

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

ATTACHMENTS: Check No. 112153 for $878
Check No. 112154 for $130

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SHLESINGER, FITZSIMMONS & SHLESINGER
SUITE 1323
183 EAST MAIN STREET
ROCHESTER NY 14604

COPY MAILED

FEB 15 2008

OFFICE OF PETITIONS

In re Application of :
Albert G. Choate et al :
Application No. 10/082,842 : DECISION GRANTING PETITION
Filed: February 21, 2002 : UNDER 37 CFR 1.137(b)
For: VARIABLE INCIDENCE OBLIQUE :
ILLUMINATOR DEVICE :

This is a decision on the petition under 37 CFR 1.137(b), filed November 24, 2003 and supplemented on August 14, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before September 3, 2003, as required by the Notice of Allowance and Fee(s) Due and the Notice of Allowability mailed June 3, 2003.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue and publication fees; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed June 3, 2003, is accepted as having been unintentionally delayed.

The Office apologizes for the delay in replying to the above petition.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

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

This matter is being referred to the Office of Data Management to be processed into a patent.

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**JOSEFINO P. DE LEON**
**SHLESINGER, ARKWRIGHT & GARVEY LLP**
**3000 SOUTH EADS STREET**
**ARLINGTON, VIRGINIA 22202**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date : January 12, 2008

Patent No. :7357529
Inventor(s) :Albert G. Choate et al.
Issued :April 15, 2008
Title :VARIABLE INCIDENCE OBLIQUE ILLUMINATOR DEVICE

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<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | 571-273-8300<br>ATTN: Office of Petitions |
| EFS web | uspto.gov/ebc/index.html<br>(must be registered as an e-filer to submit responses)<br>Technical Support 1-866-217-9197 |

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

for

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308- 9390 ext. 123

Steven R. Scott, Shlesinger & Fitzsimmons,
183 East Main Street, Ste 1323
Rochester NY 14604

/arg

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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**SHLESINGER, FITZSIMMONS & SHLESINGER**
**SUITE 1323**
**183 EAST MAIN STREET**
**ROCHESTER NY 14604**

MAILED

JUL 06 2009

OFFICE OF PETITIONS

In re Patent No. 7,357,529 :
Issue Date: April 15, 2008 :
Application No. 10/082,842 : ON PETITION
Filed: February 21, 2002 :
For: VARIABLE INCIDENCE OBLIQUE :
ILLUMINATOR DEVICE :

This is a decision on the petition filed September 23, 2008 and supplemented on April 1, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The 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.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

Mail Date: 04/26/2010

| | | |
|---|---|---|
| **Applicant** | : Stephen E. Terry | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7573913 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/082,844 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/25/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1820** 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

JONATHAN M. WALDMAN
WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE – 46TH FLOOR
PHILADELPHIA, PA 19103

COPY MAILED

JUL 05 2006

OFFICE OF PETITIONS

In re Application of :
Joel E. Cordsmeyer et al :
Application No. 10/082,864 : DECISION ON PETITION
Filed: February 26, 2002 : TO WITHDRAW
Attorney Docket No. BELL-0117/01115 : FROM RECORD
:

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

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

A review of the file record indicates that the power of attorney to Jonathan M. Waldman 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.

There is an outstanding Office action mailed April 21, 2006 that requires a reply from the applicant.

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 Irvin Dingle at 571-272- 3210.

David Bucci
Petitions Examiner
Office of Petitions

cc: Withers & Keys, LLC
P.O. Box 71355
Marietta, GA 30007-1355

6-17-05

1731

JUN 17 2005
PATENT & TRADEMARK OFFICE
TC 1700

# In The United States Patent And Trademark Office

| | | |
|---|---|---|
| Applicants | : | Billiet et al. |
| Application No. | : | 10/082,867 |
| Filed | : | February 18, 2002 |
| Title | : | Ultrasmall semiconductor bonding tools and method of fabrication thereof. |

Penang, Malaysia, Friday, June 10, 2005

## Petition to Make Special

Honorable Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450, USA

Sir:

Applicants hereby respectfully petition that the above application be made special under MPEP §708.02 for the following reason:

i. ☐ Manufacturer Available
ii. ☐ Infringement Exists
iii. ☐ Applicant's Health is Poor
iv. ☑ Applicant's Age is 65 or Greater
v. ☐ Environmental Quality Will Be Enhanced
vi. ☐ Energy Savings Will Result
vii. ☐ Recombinant DNA is involved
viii. ☐ Special Procedure Search Was Made
ix. ☐ Superconductivity Is Advanced
x. ☐ Relates to HIV/AIDS or Cancer
xi. ☐ Counters Terrorism

A copy of a Certificate of Residence issued by the Embassy of Belgium in Kuala Lumpur and stating applicant's date of birth (June 27, 1938) is attached in support of this petition.

Very respectfully submitted,

Romain L. Billiet

Nguyen Thi Hanh
Hanh T. Nguyen

Applicants Pro Se

135A Malacca Street
10400 Penang, Malaysia

**Certificate of Mailing:** I certify that on the date below this document will be deposited with the Malaysian Postal Services as Express Airmail in an envelope addressed to: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, USA

June 10, 2005

Romain L. Billiet, Applicant

**PETITION GRANTED**

Richard Crispino
Special Program Examiner
TC 1700

JUN 28 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

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

**COPY MAILED**

JAN 1 0 2005

**OFFICE OF PETITIONS**

In re Application of :
Kenneth A. Meyers, et al. :
Application No. 10/082,899 :
Filed: February 25, 2002 :
Attorney Docket No. 057351-0005 :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed July 6, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen months publication country on February 25, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen months publication country.

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

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

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

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

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

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of April 14, 2005 was mailed on January 7, 2005.

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

This application matter is being forwarded to Technology Center Art Unit 3672 for examination in due course.

Marianne E. Jenkins

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER OF PATENTS

December 8, 2004

Steve Driscoll
Honeywell International Inc.
Law Department
101 Columbia RD
P. O. Box 2245
Morristown, NJ 07962

In re application of:
Xhenrong Qian
No.: 10/082,996
Filed: February 26, 2002
For: PREPARATION OF POLYARYL CARBOXYLIC ACIDS

In response to the petition received September 22, 2004, to withdraw the holding of abandonment in the above application.

The petition is Granted.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.D.R. 1.113 in a timely manner to the Notice to File Missing Parts of Application mailed March 26, 2002. Which set forth a shortened statutory period for reply of two months. Accordingly, the above-identified application became abandoned on May 27, 2002.

On September 25, 2002, Counsel responded to the Notice to File Missing Parts of Application. The abstract was received my amendment. Not on a separate sheet of paper. A second notice was issued for the abstract on October 11, 2002 after the response and extension time had expired.

The separate sheet requirement for the abstract is not to inconvenience Counsel 37 CFR 1.72(b) and 37 CFR 1.121 is required.

The application will be completed with the documents received on September 25, 2002 and September 22, 2004.

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 OF PATENTS

December 9, 2004

Steve Driscoll
Honeywell International Inc.
Law Department
101 Columbia RD
P. O. Box 2245
Morristown, NJ 07962

In re application of:
Xhenrong Qian
No.: 10/082,996
Filed: February 26, 2002
For: PREPARATION OF POLYARYL CARBOXYLIC ACIDS

In response to the petition received September 22, 2004, to withdraw the holding of abandonment in the above application.

The petition is Granted.

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

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110

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JUL 17 2006

OFFICE OF PETITIONS

In re Application of
Aschenbrenner et al.
Application No. 10/083,008
Patent No. 6,949,567
Filed: February 26, 2002
Attorney Docket No. 50125/041002

: DECISION GRANTING APP. For PTA

This decision is in response to applicant's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) timely[1] filed on November 25, 2005 requesting that the Office adjust the PTA determination at the time of the issuance of the patent from a determination of two hundred and sixty-two (262) days to a determination of four hundred and five (405) days.

Applicant's application is **GRANTED** to the extent herein indicated. The Office will issue a certificate of correction to reflect this decision. In addition, the Office will adjust the PAIR calculation to reflect this decision. The proper amount of PTA at the time of the issuance of the patent is two hundred and eighty-three (283) days.

Applicants are given thirty days to reply to this decision if they disagree. No extensions of time are granted under 37 CFR 1.136.

Applicant assert that the Office was correct in their determination of sixty-one days of Office delay for failing to meet the requirements of 37 CFR 1.702(a)(1). Applicants dispute the amount of reduction under 37 CFR 1.704(b) for filing a response to the Notice to file missing parts more than three months after the notice was mailed. Applicants assert that the reply was submitted on June 12, 2002 not July 25, 2002 as asserted by the Office. Accordingly, applicant asserts that they did not fail to engage in reasonable efforts to conclude prosecution of the application for the reply to the missing parts notice. Applicants do not dispute the four-day reduction under 37 CFR 1.704(b) for the submission of the response to the 10/16/2003 non-final rejection on January 20, 2004. Applicants assert that the Office delayed an additional three hundred and forty-eight days under 37 CFR 1.702(a)(4) for issuing the application more than four months after the payment of the issue fee and all other requirements being satisfied. Applicants did not dispute the one hundred and twenty day reduction under 37 CFR 1.704(c)(10).

---

[1]Patent issued on September 27, 2005. The Office notes that applicants had previously timely submitted a request for reconsideration of Patent Term Adjustment under 37 CFR 1.705(b) requesting that the proper amount of PTA at the time of the mailing of the notice of allowance is fifty-seven days. The Office will combine the two applications into this one (1) decision.

Applicants arguments are persuasive as to the actual day of response to the notice to file missing parts. The Office notes that zero delay by applicant occurred in responding to the notice to file missing parts. According, at the time of the mailing of the notice of allowance the correct amount of PTA was fifty-seven days(61-4 = 57). Note that subsequent to the mailing of the notice of allowance, applicant earned an additional three hundred and forty-six (346) days for the Office's failure to issue the application within four months of the issue fee being paid and other requirements being satisfied pursuant to 37 CFR 1.702(a)(4). Applicants' assertion of delay of 348 was not accurate. [2] Accordingly, the certificate of correction will reflect a final determination of(two hundred and eighty three(283) days (346+61 -4 - 120 = 283).

After the mailing of this decision, the Office will forward this application to the certificate of correction branch for a prompt issuance of the a certificate of correction.

The Office has charged the $200.00 fee No additional fees are required. The Office is providing applicants a $200.00 refund for the submission of the application under 1.704(b). The Office improperly assessed a $400.00 fee for such application.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

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

cc: adjusted PAIR calculation
Draft cert of correction

[2]The delay began on October 17, 2004 and ending on September 27, 2005, a three hundred and forty-six day delay.

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 6,949,567 B2

DATED : September 27, 2005

INVENTOR(S) : Aschenbrenner 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 (262) days

Delete the phrase "by 262days" and insert – by 283 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

Microsoft Corporation
One Microsoft Way
Redmond, WA 98052

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Matthew Charles Priestley | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7571467 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/04/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/083,010 | : OF WYETH |
| **Filed** | : 02/26/2002 | : |
| | | : |

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
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JOHN GARRED
TUCKER, ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND OH 44115-1475

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MAR 0 2 2006

**OFFICE OF PETITIONS**

In re Application of :
CHANG et al. :
Application No. 10/083,042 : DECISION ON PETITION
Filed: February 26, 2002 : TO WITHDRAW
Attorney Docket No. 71795/20592 : 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 24, 2005.

The request is **APPROVED**.

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

The request was signed by John Garred on behalf of himself and all attorneys/agents of record who are associated with Customer No. 23380. All attorneys/agents associated with the Customer Number 23380 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed, and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed October 3, 2005 that requires a reply from the applicant.

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

Denise Pothier
Petitions Examiner
Office of Petitions

cc: RICHARD MITCHELL MARKS & CLERK
280 SLATER STREET
SUITE 1800
OTTAWA, ONTARIO K1P 1C2
CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**BRINKS HOFER GILSON & LIONE**
**P.O. BOX 10395**
**CHICAGO IL 60610**

**COPY MAILED**

MAY 16 2006

**OFFICE OF PETITIONS**

In re Application of
David J.S. Moreno et al
Application No. 10/083,047
Filed: February 26, 2002
Attorney Docket No. 11471/3

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 6, 2006.

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 Trevor K. Copeland on behalf of himself and all the attorneys/agents of record.

All attorneys/agents of record have been withdrawn.

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

Further, a review of the file record indicates that Trevor K. Copeland does not have power of attorney in this patent application. In view of the present decision, Trevor K. Copeland as well as the attorneys being withdrawn, may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) the intervening assignee of the entire interest. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest under 37 C.F.R. § 3.71 at the first copied address below until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to Karen Creasy at 571-272-3208.

This application is being referred to Technology Center AU 2612.

Amelia Au
Petitions Examiner
Office of Petitions

cc:
**DAVID JOAQUIN SANDOVAL MORENO**
**PLAZA CIRCULAR, 9, 30008 MUCIA**
**SPAIN**

**ARENT FOX PLLC**
**RICHARD J. BERMAN**
**1050 CONNECTICUT AVENUE, NW**
**SUITE 500**
**WASHINGTON DC 20036**

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

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED

SEP 1 9 2002

OFFICE OF PETITIONS

In re Application of
Hendrix et al.
Application No.10/083050
Filed: February 26, 2002
Attorney Docket No. 8439M 1

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed June 10, 2002 (certificate of mailing date May 28, 2002), under 37 C.F.R. §1.47(a).

The petition under 37 C.F.R. §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 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 February 26, 2002, without an executed oath or declaration. Accordingly, on March 29, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set an extendable two-month period for reply of May 29, 2002.

In reply, applicant filed a Statement of Facts, the surcharge for late filing of the declaration, a copy of correspondence mailed to Marc Richard's legal representative and a partially executed declaration. A petition fee of $130.00 has been charged to deposit account 16-2480.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition does not satisfy requirement (1).

As to item (1), Rule 47 applicant has failed to show that legal representative of non-signing inventor refused to sign the declaration after having been presented with the application papers. Rule 47 applicant indicates, Marc Richard's legal representative, Susie Richards, refused to sign the declaration in a telephone conversation. However, rule 47 applicant did not indicate a copy of the application papers (specification, including claims, drawings, and oath or declaration) was presented to the legal representative of non-signing inventor. All that is indicated is that the Declaration with Power of Attorney, Global General Assignment and the Republic of China Oath & Assignment were presented. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the legal representative of non-signing inventor. See MPEP 409.03(d).

Thus on renewed petition, rule 47 applicant must establish the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventor's legal representative.

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

| | |
|---|---|
| By mail: | Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By FAX: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Crystal Plaza Four, Suite 3C23<br>2201 S. Clark Place<br>Arlington, VA 22202 |

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

E. Shuree Willes for

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 3/22/2007

DATE : March 14, 2007

TO SPE OF : ART UNIT 1712

SUBJECT : Request for Certificate of Correction for Appl. No. 10/083092 patent No.:7141303

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:** (1) Petition Decision has been GRANTED and will be mailed + scanned; also (2) an initialed IDS was sent out.

Randy Gulakowski

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

1712

**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

Mailed: 3-30-07

RPG
Paper No. March 22, 2007

*In re* Application of Timothy J. Clemens et al.
Serial No.: 10/083,092
Filed: February 26, 2002

**DECISION ON PETITION**
**UNDER** *37 CFR 1.48(b)*

For: PROTECTIVE ARTICLES

This is a decision on the PETITION TO DELETE CORRECTLY NAMED PERSONS WHO ARE NOT INVENTORS OF INVENTION NOW BEING CLAIMED (37 C.F.R. ∋ 1.48(b), filed February 6, 2006 to correct inventorship under 37 CFR 1.48(b) by deleting the names of Timothy M. Dietz and Mark D. Weigel from the present inventorship.

It is noted that the applicant has met the requirements of (1) a petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (2) the fee set forth in 37 CFR 1.17(i).

The petition is **GRANTED**.

The application file is being forwarded to the appropriate section of the Patent and Trademark Office for correction of the record.

Randy Gulakowski
Supervisory Patent Examiner
Art Unit 1712
Technology Center 1700

3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

UNITED STATES 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

MAY 12 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Application of
Pascal Chevalier, et al.
Application No. 10/083,127
Filed: February 27, 2002
For:

Decision on Petition

This is a decision on the petition filed October 27, 2005, pursuant to 37 C.F.R. §1.181.

The October 7, 2005 petition requests that the examiner acknowledge that reference AZ submitted with the Information Disclosure Statement (IDS), filed onMay 15, 2002, has been considered.

The petition is **DISMISSED AS MOOT**.

A review of the file finds that a copy of the intialed/dated Information Disclosure Statement (indicating consideration of references AW-AZ) was provided with the Notice of Allowance mailed September 2, 2005. Furthermore, a miscellaneous communication mailed December 20, 2005 provided another copy to applicant.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**MORGAN & FINNEGAN**
**3 WORLD FINANCIAL CENTER**
**NEW YORK NY 10281-2101**

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SEP 13 2005

**OFFICE OF PETITIONS**

In re Application of :
Tomi Heinonen et al :
Application No. 10/083,134 :
Filed: February 27, 2002 :
Attorney Docket No. 4208-4064 :

ON PETITION

This is a decision on the petition, filed September 12, 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 30, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 2145 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

Paper No. 10

**LEONARD WEISS**
**2300 W. SAHARA AVENUE, BOX 34**
**LAS VEGAS, NV 89102**

COPY MAILED

JUL 15 2005

OFFICE OF PETITIONS

In re Application of :
Burggraf, Allen :
Application No. 10/083,180 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. PA101-02 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 11, 2005, 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 submit formal drawings in a timely manner in reply to the Notice of Allowability mailed May 26, 2004, which set a non-extendable period for reply of three (3) months. Accordingly, the above-identified application became abandoned on August 27, 2004. A Notice of Abandonment was mailed on October 13, 2004.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:
(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

---

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

[2] See MPEP 711.03(c)(III)(C) and (D).

The instant petition lacks item (1). The response submitted by the petitioner with the instant petition was improper in view of the fact that prosecution for the above-identified application has been closed. Therefore, any amendments must be accompanied by a request for continued examination (RCE) in compliance with 37 CFR 1.114 (including the fee set forth in 37 CFR 1.17(e)) to re-open prosecution.

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

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

By hand: Customer Window located at:

U.S. Patent and Trademark Office
Customer Service Window Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206.

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

UNITED STATES 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

**LEONARD WEISS**
**2300 W. SAHARA AVENUE, BOX 34**
**LAS VEGAS NV 89102**

**COPY MAILED**

AUG 2 5 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Burggraf, Allen | : | |
| Application No. 10/083,180 | : | ON PETITION |
| Filed: February 25, 2002 | : | |
| Attorney Docket No. PA101-02 | : | |

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed August 16, 2005, to revive the above-identified application.

The petition is **GRANTED.**

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

The file is now being forwarded to Technology Center 3600 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**LEONARD WEISS**
**871 CORONADO CTR. DRIVE**
**HENDERSON NV 89052**

COPY MAILED

JAN 10 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Burggraf, Allen | : | |
| Application No. 10/083,180 | : | DECISION ON PETITION |
| Filed: February 25, 2002 | : | |
| Attorney Docket No. PA101-02 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 3, 2007, to revive the above-identified application.

The petition is **GRANTED**.

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

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

Liana Walsh
Petitions Examiner
Office of Petitions

Cc:

ALLEN BURGGRAF
899 HWY 70
ARLINGTON, TN 38002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

COPY MAILED

JUL 17 2008

OFFICE OF PETITIONS

In re Application of :
Shigefumi Odaohhara :
Application No. 10/083,186 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. JP920000465US1 :

This is a decision on the petition under 37 CFR 1.137(b), filed on February 27, 2008, to revive the above-identified application.

The application became abandoned for failure to timely respond to the Notice of Allowance and Fee(s) Due mailed February 21, 2006. A Notice of Abandonment was mailed on July 14, 2006.

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 so notify the Office.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of $1,440 for payment of the issue fee and $300 for payment of the publication fee; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

The Power of Attorney and Correspondence Address Indication Form filed on February 27, 2008 has been accepted and made of record. A Notification of Acceptance accompanies this decision.

This application file is being referred to the Office of Data Management to be processed into a patent.

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

Andrea Smith
Petitions Examiner
Office of Petitions

Enclosure: Notification of Acceptance of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/083,186 | 02/26/2002 | Shigefumi Odaohhara | JP920000465US1 |

**CONFIRMATION NO. 5140**

24955
ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

**POA ACCEPTANCE LETTER**

*OC000000031009519*

Date Mailed: 07/16/2008

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/27/2008.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/amsmith/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DAVID E. HUANG, ESQ.
CHAPIN & HUANG, LLC
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE
WESTBOROUGH, MA 01581

COPY MAILED

MAR 17 2005

OFFICE OF PETITIONS
ON PETITION

In re Patent No. 6,736,308 :
Issue Date: May 18, 2004 :
Application No. 10/083,195 :
Filed: February 26, 2002 :
Attorney Docket No. EMC02-01(00053) :

This is a decision on the petition filed December 15, 2004, which is being treated as a petition under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

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

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

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

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

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20050617

**DATE** : June 17, 2005

**TO SPE OF** : ART UNIT 3673

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,820,294

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

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

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

The Certificate of Correction removes an inventor who was deleted by a restriction requirement.

**SPE:** Heather Shackelford **Art Unit** 3673

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAWSON & WEITZEN, LLP
88 BLACK FALCON AVE
SUITE 345
BOSTON MA 02210

COPY MAILED

OCT 12 2006

OFFICE OF PETITIONS

In re Application of :
Darrow et al. :
Application No. 10/083,245 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket: U 013888-7 :

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed July 5, 2006.

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

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This above-identified application became abandoned for failure to timely file a proper reply to the final Office Action of October 12, 2005. An amendment was filed on December 9, 2005. This application became abandoned on January 13, 2006. A Notice of Abandonment was mailed on June 28, 2006.

Petitioner contends that the abandonment of the application should be withdrawn because Examiner Truong purportedly stated during an examiner initiated telephonic conference that she would issue an examiner's amendment and a Notice of Allowance.

Petitioner's argument has been considered but it is not convincing to establish the holding of abandonment should be withdrawn.

Pursuant to 37 CFR 1.2 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.

Petitioner was informed in the Final Office Action that the statutory time period for reply could not be extended beyond the six months from the mailing of the Final Office Action. Pursuant to 37 CFR 1.116 (b), the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. Further MPEP 711.03 (c) is clear that an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, when the applicant simply permits the maximum extendable statutory period for reply to expire while awaiting a notice of allowance or other action.

**Alternative Venue**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by the required reply, the required 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 pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

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

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

By delivery service:
(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 should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAWSON & WEITZEN, LLP
88 BLACK FALCON AVE
SUITE 345
BOSTON MA 02210

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APR 27 2007

OFFICE OF PETITIONS

In re Application of
Darrow et al.
Application No. 10/083,245
Filed: February 25, 2002
Attorney Docket: U 013888-7

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed October 20, 2006.

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

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This above-identified application became abandoned for failure to timely file a proper reply to the final Office Action of October 12, 2005. An amendment was filed on December 9, 2005. This application became abandoned on January 13, 2006. A Notice of Abandonment was mailed on June 28, 2006. A petition was dismissed on October 12, 2006

On renewed petition, petitioner reiterates the argument presented in the original petition. Petitioner states that the Applicants by right expected either an advisory action or a Notice of Allowance pursuant to MPEP §714.13 III.

Petitioner's argument has been considered but it is not convincing to establish the holding of abandonment should be withdrawn.

Pursuant to MPEP § 714.13 II, failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

(A) an amendment complying with 37 CFR 1.116;

(B) a Notice of Appeal (and appeal fee); or

(C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

Petitioner was informed in the Final Office Action that the statutory time period for reply could not be extended beyond the six months from the mailing of the Final Office Action. Pursuant to 37 CFR 1.116 (c), the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. Further MPEP 711.03 (c) is clear that an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, when the applicant simply permits the maximum extendable statutory period for reply to expire while awaiting a notice of allowance or other action.

Petitioner is reminded that it is applicants' responsibility to file not only a timely but proper reply to the outstanding Office action. This application was abandoned because petitioner failed to file a proper reply to the final Office action not because the Office did not mail a Notice of Allowance or advisory action.

**Alternative Venue**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by the required reply, the required 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 pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally

delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

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

| | |
|---|---|
| By mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (571) 273-8300 |
| By delivery service:<br>(FedEx, UPS, DHL, etc.) | U.S. Patent and Trademark Office<br>Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

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
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MAR 26 2008

**OFFICE OF PETITIONS**

In re Application of :
Darrow et al. :
Application No. 10/083,245 : DECISION ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. U 013888-7 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 1, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This above-identified application became abandoned for failure to file a proper reply to the final Office Action of October 12, 2005. The final Office Action set a three (3) month shortened statutory period for reply. An amendment after final Office was filed on December 9, 2005. An Advisory Action mailed on August 17, 2006 informed petitioner the application was not placed in condition for allowance. Accordingly, this application became abandoned on January 13, 2006. A Notice of Abandonment was mailed on June 28, 2006. Petitions under 37 CFR 1.181 were dismissed on October 12, 2006 and April 27, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1500.00, and (3) an adequate statement of unintentional delay.

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3215.

This application is being referred to Technology Center AU 1624 for appropriate action by the Examiner in the normal course of business on the reply received

Charlema Grant

Charlema Grant
Petitions Attorney
Office of Petitions

10-24-02

03CO
Box Seq

**DOCKET NO.: PANT-0301** **PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re Application of:**

Nielsen, et al.

**Serial No.:** 10/083,259 **Group Art Unit:** Not Yet Assigned

**Filing Date:** 10/19/2001 **Examiner:** Not Yet Assigned

**For: Modified Peptide Nucleic Acid (PNA) Molecules**

**EXPRESS MAIL LABEL NO: EL568089645US**
**DATE OF DEPOSIT:** 10-21-02

EL568089645US

**U. S. Patent and Trademark Office**
Box Sequence, P.O. Box 2327
Arlington, Virginia 22202

**RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURE**

In response to the "Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" dated 08/21/2002, a response to which is due 10/21/2002, enclosed herewith is:

- ☒ Statement to Support Filing and Submission in Accordance with 37 CFR §§1.821 through 1.825;
- ☒ Substitute pages of the Sequence Listing;
- ☒ Substitute copy of the computer readable form of amended Sequence Listing;
- ☒ Amendment Directing Entry of Sequence Listing into Specification is attached
- ☒ Copy of Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures;

☐ Other:

☐ Request is hereby made under 37 CFR 1.136(a) to extend the time for response to the Notice to File Missing Parts of Application of @@ to and through @@, comprising an extension of the shortened period of @@ months:

| | SMALL ENTITY | | NOT SMALL ENTITY | |
|---|---|---|---|---|
| | RATE | FEE | RATE | FEE |
| ☐ ONE MONTH EXTENSION OF TIME | $55 | $ | $110 | $ |
| ☐ TWO MONTH EXTENSION OF TIME | $200 | $ | $400 | $ |
| ☐ THREE MONTH EXTENSION OF TIME | $460 | $ | $720 | $ |
| ☐ FOUR MONTH EXTENSION OF TIME | $720 | $ | $1440 | $ |
| ☐ FIVE MONTH EXTENSION OF TIME | $980 | $ | $1960 | $ |
| TOTAL FEE DUE | | | | |

Applicant(s) has/have not been notified that the requested extension will not be permitted. The present application is not involved in an interference declared pursuant to 37 CFR 1.207.

Total fee required $0.00

The Commissioner is hereby authorized to charge any underpayment associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is attached in duplicate.

Date: October 21, 2002

John A Harrelson Jr

John A. Harrelson, Jr.
Registration No. 42,637

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

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OCT 2 1 2002
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UNITED STATES PATENT AND TRADEMARK OFFICE

JWC/PKL AC

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 |
|---|---|---|---|
| 10/083,259 | 10/19/2001 | Peter E. Nielsen | PANT-0301 |

CONFIRMATION NO. 3290

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

RECEIVED
AUG 2 3 2002
DOCKET DEPT.
WOODCOCK

FORMALITIES LETTER

*OC000000008658261*

Date Mailed: 08/21/2002

## NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- A request to transfer the computer readable form from another application on file at the U.S. Patent and Trademark Office has been submitted as permitted by 37 C.F.R. 1.821(e). However, the request cannot be complied with since there is no compliant CRF present at the United States Patent and Trademark Office. Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d).

**For questions regarding compliance to these requirements, please contact:**

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

---

***A copy of this notice MUST be returned with the reply.***

RECEIVED
AUG 2 6 2002
Woodcock Washburn Kurtz
Mackiewicz & Norris LLP

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 1 - ATTORNEY/APPLICANT COPY

# 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) |
|---|---|---|---|---|
| 6765493 | 2004-07-20 | 10083278 | 2002-02-25 | 148-6 |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

NOT Small Entity

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

Small Entity

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /ehk/ | Date (YYYY-MM-DD) | 2008-09-26 |
| Name | Edwin H. Keusey | Registration Number | 34361 |

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

# Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

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

In re Patent No. 6765493
Issue Date: July 20,2004
Application No. 10083278
Filed: February 25,2002
Attorney Docket No. 148-6

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

This is a decision on the electronic petition, filed September 26,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 26,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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**LOWRIE, LANDO & ANASTASI**
**RIVERFRONT OFFICE**
**ONE MAIN STREET, ELEVENTH FLOOR**
**CAMBRIDGE MA 02142**

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**OFFICE OF PETITIONS**

In re Application of :
Roy Martin :
Application No. 10/083,284 :
Filed: February 26, 2002 :
Attorney Docket No. S01364/70033PCL :

ON PETITION

This is a decision on the petition, filed December 8, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on November 5, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 1724 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

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Paper No. _____

Date : December 10, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of Application No. 10/083,284

Applicant(s) :Roy Martin
Application No. :10/083,284
Filed :February 26, 2002

The above-identified application has been assigned Patent No. 6,830,698 and an issue date of December 14, 2004.

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

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of December 14, 2004:

> "All reference to Patent No. 6,830,698 to Roy Martin of Illinois for FREE RADICAL GENERATOR AND METHOD appearing in the Official Gazette of December 14, 2004 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, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis (CDS), CM1-6A07
Tamara Greene, Crystal Park 3-908

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Paper No. 8

ARENT FOX KINTNER PLOTKIN & KAHN
1050 Connecticut Avenue, N.W.
Suite 400
Washington, D.C. 20036-5339

MAY 13 2004

In re Application of:
Chiharu Koshio et al.
Serial No.: 10/083,290
Filed: February 27, 2002
Attorney Docket No.: 107156-00092

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the "REQUEST TO WITHDRAW HOLDING OF ABANDONMENT" filed July 17, 2003. It is being treated as a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181. There is no fee for this petition.

The petition is **GRANTED**.

A Notice of Abandonment was mailed on July 3, 2003 holding the application to be abandoned for failure to timely file a response to the Office action mailed on October 4, 2002. However, it is apparent that there was no abandonment in fact. A review of the application file reveals that a timely response (i.e., a terminal disclaimer) to the Office action was filed on January 6, 2003. Although the original response is in the file, it was not entered into PALM (Patent Application Locating and Monitoring System) so there is no way of telling when the paper was actually matched with the application file.

The Notice of Abandonment mailed July 3, 2003 is **VACATED**.

The application is being forwarded to a paralegal for processing of the terminal disclaimer. The application will then be forwarded to the examiner for appropriate action in due course. Any inconvenience due to the inadvertent abandonment of the application is greatly regretted.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

Janice A. Falcone

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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ARENT FOX PLLC
1050 CONNECTICUT AVENUE NW
SUITE 400
WASHINGTON, DC 20036

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Chiharu Koshio et al | : | |
| Application No. 10/083,290 | : | DECISION GRANTING PETITION |
| Filed: February 27, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 107156-00092 | : | |

This is a decision on the petition, filed May 30, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on April 25, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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**FEDERAL RESERVE PLAZA**
**600 ATLANTIC AVENUE**
**BOSTON, MA 02210-2211**

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Roy Martin :
Application No. 10/083,315 :
Filed: February 26, 2002 :
Attorney Docket No. S01364/70034 PCL :

This is a decision on the petition, filed December 23, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on September 30, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

This matter is being referred to Technology Center AU 1724 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

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

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

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| | | |
|---|---|---|
| In re Application | : | |
| Soane, et al. | : | |
| Application No. 10/083,316 | : | DECISION ON APPLICATION |
| Filed: February 25, 2002 | : | FOR PATENT TERM ADJUSTMENT |
| Atty Docket No. 021674-000251US | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed March 29, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-seven (197) days to four hundred seventy-nine (479) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. However, applicants' request that an additional PTO delay of one hundred sixty (160) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On January 4, 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 one hundred ninety-seven (197) days. On March 29, 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 four hundred seventy-nine (497) days.

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

The Office initially determined a patent term adjustment of one hundred ninety-seven (197) days based on an adjustment for PTO delay of one hundred sixty-seven (167) 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)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by applicants' delay of one hundred twenty-two (122) days for filing a supplemental response (a terminal disclaimer), pursuant to 37 C.F.R. § 1.704(c)(8). The adjustment of one hundred twenty-two (122) days is at issue.

The adjustment of one hundred twenty-two (122) days has been found to be incorrect. Applicants should not have been assessed delay pursuant to 37 C.F.R. § 1.704(c)(8) for filing a supplemental reply (a terminal disclaimer) on August 5, 2004. A review of the application file reveals that the terminal disclaimer was in fact filed together with an Amendment on April 5, 2004, not August 5, 2004.

In addition, applicants assert additional PTO delay of one hundred sixty (160) days for the failure on the part of the Office to issue the patent within three years of its filing. However, the Office does not assess whether or not any additional PTA is accorded in this instance until the issue date is established.[2]

---

[1] PALM records indicate that applicant filed the PTA prior to payment of the issue fee.

[2] Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred nineteen (319) days** (319 (167+152) days of PTO delay and 0 days of applicant delay).

The $200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 20-1430, as authorized.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

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

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

Enclosure: Copy of Revised PAIR Screen

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SYRACUSE, NY 13261-7068

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OFFICE OF PETITIONS

In re Application of :
Kazumasa Yashiro, et al. :
Application No. 10/083,323 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. 791_187 :

This is a decision on the petition filed October 31, 2005, under 37 CFR 1.137(b) to revive the above-identified application for copendency with a continuing application.

The petition is **GRANTED**.

This application became abandoned for a failure to respond to a final Office action mailed December 28, 2004. A Notice of Abandonment was mailed August 1, 2005.

Petitioner seeks revival solely for obtaining copendency with continuing application No. 11/139,236 filed May 27, 2006, in that the necessary continuity inadvertently was not maintained at that time.

Since this application is being revived for purposes of continuity with application No. 11/139,236, and continuity having been established by this decision reviving the above-captioned application, the above-captioned application is again abandoned in favor of the continuing application.

The offer to make the belated payment of the 2-month extension of time fee under 37 CFR 1.136(a) is unnecessary. 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 $450 extension of time fee submitted with the petition is is being refunded to petitioner's deposit account as authorized.

This abandoned application is being forwarded to the Files Repository.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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Paper No. 6

Testa, Hurwitz & Thibeault, LLP
High Street Tower
125 High Street
Boston, MA 02110

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MAR 1 2 2004

Technology Center 2100

In re Application of:
Anatoliy PANASYUK, et al.
Application No. 10/083,324
Filed: February 26, 2002
For: SECURE TRAVERSAL OF NETWORK COMPONENTS

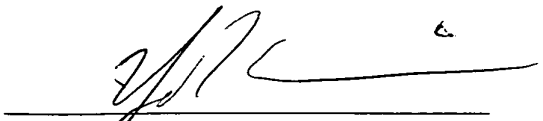
DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed February 27, 2004.

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

The request 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: John D. Lanza, Esq.
Lahive & Cockfield, LLP
28 State Street, 24th Floor
Boston, MA 02109-1784

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TWO INTERNATIONAL PLACE
BOSTON, MA 02110

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**OFFICE OF PETITIONS**

In re Application of :
Anatoliy Panasyuk, et al. :
Application No. 10/083,324 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. 2006579-0420 (CTX-079) :

This is a decision on the petition under 37 CFR 1.137(b), filed January 11, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the final Office action mailed June 13, 2006. This decision precedes the mailing of a Notice of Abandonment. On January 11, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and the submission required by 37 CFR 1.114; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

This application is being referred to Technology Center AU 3736 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Although the statement contained in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement will be construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

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Paper No. 14

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**1180 AVENUE OF THE AMERICAS**
**NEW YORK, NEW YORK 10036-8403**

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OFFICE OF PETITIONS

In re Application of
Ching Miao Wilson Wang
Application No. 10/083,331
Filed: February 25, 2002
Attorney Docket No. P/3987-29

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

This is a decision on the petition, filed August 26, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on August 11, 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 2851 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 23

OSTROLENK FABER GERB & SOFFEN LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

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APR 0 8 2004

OFFICE OF PETITIONS

In re Application of :
Ching Miao Wilson Wang :
Application No. 10/083,331 : DECISION GRANTING PETITION
Filed: February 25, 2002 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. P/3987-29 :

This is a decision on the petition, filed, March 31, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

**Petitioner is advised that the issue fee paid on January 15, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2851 for processing of the request for continued examination under 37 CFR 1.114.

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

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

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Paper No. 24

Date : April 8, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 10/083,331**

Applicant(s) : 10/083,331
Application No. : Ching Miao Wilson Wang
Filed : February 25, 2002

The above-identified application has been assigned Patent No. 6,719,464 and an issue date of April 13, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the applicant. Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of April 13, 2004:

**"All reference to Patent No. 6,719,464 to Ching Miao Wilson Wang of Hong Kong for PHOTOGRAPHIC FILM CARTRIDGE AND CAMERA INCLUDING SUCH appearing in the Official Gazette of April 13, 2004 should be deleted since no patent was granted."**

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

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis (CDS), CM1-6A07
Tamara K. Greene, PK3-910

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JJGJr: : 01-05

Paper __

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JAN 27 2005

OFFICE OF PETITIONS

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JAN 26 2005

OFFICE OF PETITIONS

ATTN: MCMR-JA (Ms. Elizabeth Arwine)
Office of the Staff Judge Advocate
U.S. Army Medical Research and Materiel
Command
504 Scott Street
Fort Detrick MD 21702-5012

In re Application of
Olson, et al :
Application No. 10/083,336 :
Filed: 27 February, 2002 : ON PETITION
Attorney Docket No.: 034047.016 (RIID01-58) :
/P67452 USO

This is a decision on the petition (with fees) filed on10 November, 2004, under 37 C.F.R. §1.183 to waive the provisions of 37 C.F.R. §1.48(a)(2) as to Ross D. LeClaire, whose name Petitioner seeks to delete from the inventive entity and so correct the statement of that entity.

The petition under 37 C.F.R. §1.183 for waiver is **GRANTED**.

And the petition under 37 C.F.R. §1.48 is **GRANTED**.

## BACKGROUND

The record reflects that:

- the instant application was filed on 27 February, 2002, and therein Ross D. LeClaire was listed as one of the named inventors;

- the assignment by Ross D. LeClaire (Mr. LeClaire) of his interests in the instant application was filed of record at Reel/Frame 015100/0342 on 2 September, 2004;

- the petition filed on 10 November, 2004, seeks to delete the name of Mr. LeClaire as an

inventor, and Petitioner herein Suzannah K. Sundby (Reg. No. 43,172) and the Counsel for the assignee Elizabeth Arwine (Reg. No. 45,867) have represented that assignee concurs with and approves of the deletion of Mr. LeClaire and that the prior inclusion of his name was done in error and without deceptive intent.

37 C.F.R. §1.48(a) requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

(4) The processing fee set forth in § 1.17(I); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 C.F.R. § 3.73(b)).

Petitioner has satisfied requirements (1), (3), (4) and (5) above. The petition specifically requests the deletion of Ross D. LeClaire. Petitioner has submitted a declaration pursuant to 37 C.F.R. §1.63 executed by all of the inventors (to wit, Mark A. Olson, Charles B. Millard, Michael P. Byrne and Robert W. Wannemacher) as required by 37 C.F.R. §1.48(a)(2). Petitioner has paid the processing fee. Finally, the petition includes a statement signed by Elizabeth Arwine, Patent Attorney and IP Counsel for assignee the U.S. Army Medical Research and Materiel Command.

However, Petitioner has not submitted the required statement by LeClaire as required by 37 C.F.R. §1.48(a)(2).

In order for a petition under 37 C.F.R. §1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules. In the "AFFIDAVIT OF ELIZABETH ARWINE" in support of the petition, Ms. Arwine attested Mr. LeClaire has refused to sign and submit a statement indicating the error of his inclusion after a copy of the statement was forwarded to him via Email (including his response to the request).

**Accordingly, the newly executed declaration filed on 10 November, 2004 will be entered, despite the fact that the requirement set forth in 37 C.F.R. §1.48(a)(2) that the inventor being deleted make a statement that the error in inventorship (i.e., his erroneous inclusion**

**in the inventive entity occurred without deceptive intent) has not been satisfied.**

The application file is being forwarded to Group Art Unit 1652 for further processing in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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FEB 24 2003

OFFICE OF PETITIONS

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

In re Application of :
Bulman, et al. :
Application No. 10/083,425 : DECISION GRANTING STATUS
Filed: February 25, 2002 : UNDER 37 CFR 1.47(a)
Atty. Dkt. No.: P/4112-43 :
For: OBJECT CUSTOMIZATION AND :
PRESENTATION SYSTEM :

This is in response to the petition under 37 CFR 1.47(a), filed November 13, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Brad Dahl has refused to join in the filing of the above-identified application after having been presented with the application papers.

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

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

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRAD DAHL
430 WEST 15TH STREET
VANCOUVER, BRITISH COLUMBIA V6B 2Z6
CANADA

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FEB 24 2003

OFFICE OF PETITIONS

In re Application of :
Bulman, et al. :
Application No. 10/083,425 : LETTER
Filed: February 25, 2002 :
Atty. Dkt. No.: P/4112-43 :
For: OBJECT CUSTOMIZATION AND :
PRESENTATION SYSTEM :

Dear Sir:

You are named as an 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 the undersigned 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).

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Arlington, VA 22313-1450
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Paper No. 17

Jonathan E. Grant
Suite 210
2120 L. Street, N.W.
Washington, DC 20037

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OFFICE OF PETITIONS

In re Application of :
Fischetti et al. :
Application No. 10/083,462 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. n/a :

This is a decision on the petition under 37 CFR 1.137(b), filed June 20, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed November 5, 2002, which set a shortened statutory period for reply of three (3) months. Extensions of time under the provisions of 37 CFR 1.136(a) have been obtained. Accordingly, the above-identified application became abandoned on April 8, 2003.

The application file is being forwarded to Technology Center AU 1616 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

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

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

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SEP 9 - 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Hidetoshi Mishima, et al.
Application Serial No.: 10/083,475
Filed: February 27, 2002
For: **DIGITAL VIDEO SIGNAL RECORD AND PLAYBACK DEVICE AND METHOD FOR SELECTIVELY REPRODUCING DESIRED VIDEO INFORMATION FROM AN OPTICAL DISK**

DECISION ON PETITION

This is a decision on the petition, filed on August 19, 2005 under 37 C.F.R. §1.181 requesting an expedited action on the merits. This petition has been considered a request to affirm that this application is under "special" status in accordance with 37 CFR 1.102.

Applicant has amended their application on February 27, 2002 to contain specific reference to earlier filed applications, e.g., SN. 09/520,283, filed March 6, 2000 which is a divisional of SN 09/329,333 (Patent No. 6,134,382) filed June 10, 1999 and that is a divisional of 08/877,875 filed on June 18, 1997 (Patent No. 6,009,236) which is a continuation of 08/533,109 filed September 25, 1996 (abandoned).

708.01 [R-2] List of Special Cases, states in part:
(I) Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years. See MPEP § 707.02. [emphasis added]

In accordance with MPEP section 708.01(I), applications which by relation to a prior United States application and pending over 5 years, are considered special. This application by virtue of its prolonged pendency is considered special in accordance with PTO policy.

Accordingly, the petition is **Granted**.

The examiner will be notified that this application should be considered as "special" and appropriate for expedited action.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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DORSEY & WHITNEY, LLP
555 CALIFORNIA STREET, SUITE 1000
SUITE 1000
SAN FRANCISCO, CA 94104

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**OFFICE OF PETITIONS**

In re Application of
Evgeny Nikiforov, et. al.
Application No. 10/083,491
Filed: February 27, 2002
Attorney Docket No. 12396.00

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed on January 9, 2006, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed March 9, 2005. A Notice of Abandonment was mailed on September 20, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

A review of the record fails to indicate that a change of address has been submitted. Since the address given on the petition differs from the address of record, a courtesy copy of this decision is being mailed to the address listed above. If appropriate, a change of address should be filed in accordance with MPEP 601.03. All future correspondence regarding this application will be directed solely to the address of record[1] until otherwise instructed.

The application file is being referred to Technology Center Art Unit 2613, 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

[1] Petitioner should note that correspondence sent to the address of record has been returned to the USPTO, on more than one occasion, as undeliverable.

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EDWARD N. BACHAND
DORSEY & WHITNEY LLP
US BANK CENTRE
1420 FIFTH AVENUE, SUITE 3400
SEATTLE, WA 98101-4010

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OFFICE OF PETITIONS

In re Application of :
Evgeny Alexeevich Nikiforov, et al. :
Application No. 10/083,491 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 12396.00 :

This is a decision in response to the petition, filed July 3, 2007, under the provisions of 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

This application was held abandoned for failure to timely pay the issue and publication fees on or before November 1, 2006, as required by the Notice of Allowance and Fee(s) Due (Notice), mailed August 1, 2006. A Notice of Abandonment was mailed on May 25, 2007.

Petitioner argues that the abandonment should be withdrawn since the issue and publication fees were timely submitted in response to the Supplemental Notice of Allowability mailed December 27, 2006. Petitioner suggest that the period for paying the issue fee was reset, noting that the Supplemental Notice of Allowability states that "Applicant has THREE MONTHS FROM THE 'MAILING DATE' of this communication *to file a reply complying with the requirements noted below*." Emphasis added.

It is initially pointed out that the "THREE MONTHS FROM THE 'MAILING DATE'" period within which the issue fee must be paid was set in the Notice of Allowance mailed August 1, 2006 and, because this period is prescribed by statute, it cannot be extended. See 35 U.S.C. 151. The Supplemental Notice of Allowability did not operate to reset the period for paying the issue fee. In fact, since no items were *noted below* on the Supplemental Notice of Allowability mailed December 27, 2006, a response to this communication was not necessary from Applicant at all.

In view of the above, the request to withdraw the holding of abandonment is dismissed.

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

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 $770 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

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

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

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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EDWARD N. BACHAND
DORSEY & WHITNEY LLP
US BANK CENTRE
1420 FIFTH AVENUE, SUITE 3400
SEATTLE, WA 98101-4010

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OFFICE OF PETITIONS

In re Application of
Evgeny A. Nikiforov, et al.
Application No. 10/083,491
Filed: February 27, 2002
Attorney Docket No: 12396.00

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 30, 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 1, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed August 1, 2006. It is noted that the issue and publication fees were paid on March 29, 2007. Thereafter, on May 26, 2007, a Notice of Abandonment was mailed. On July 3, 2007, a petition to withdraw the abandonment pursuant to 37 CFR 1.181 was filed; however, the petition was dismissed in a decision mailed November 16, 2007. In response, on November 30, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $700 and the publication fee of $300, (2) the petition fee of $770; and (3) an adequate statement of unintentional delay.

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

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON DC 20006

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OFFICE OF PETITIONS

In re Patent No. 7,123,941 :
Issue Date: October 17, 2006 :
Application No. 10/083,508 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 020242 :

This is a decision on the PETITION UNDER 37 CFR §1.183 filed December 20, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Petitioner states that the assignee was inadvertently identified as "KDDI R&D Laboratories Inc., Tokyo (JP)" on form PTOL-85B, and requests that a Certificate of Correction be issued identifying the correct assignee, "KDDI Corporation, Tokyo (JP)." Petitioner submits a "Certificate of Correction" for this purpose.

Both petitioner's evidence and Office records show that the assignment of the above-identified application to KDDI Corporation was submitted for recording in the Office on March 5, 2003 before issuance of the patent (Reel/Frame 013811/0216) on October 17, 2006. This was also prior to payment of the Issue Fee on September 6, 2006.

[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).

Receipt of the required $130 processing fee and the required $100 certificate of correction fee is acknowledged.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3219. 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 has been notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**UNDURTI NARASIMHA DAS**
**#321**
**13800 FAIRHILL ROAD**
**SHAKER HEIGHTS, OH 44120**

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MAR 0 5 2008

OFFICE OF PETITIONS

In re Application of :
**DAS,** Undurti Narasimha :
Application No. 10/083,529 : DECISION ON PETITION
Filed: February 27, 2002 : TO WITHDRAW
Attorney Docket No. **UND 99.02 D1** : 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 01, 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 Rama B. Nath has been revoked by the applicant of the patent application on January 28, 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 above-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
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**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**
**1250 CONNECTICUT AVENUE NW, SUITE 700**
**WASHINGTON DC 20036**

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JAN 12 2009

In re Application of :
Hiroshi **HASHIMOTO**, et al. :
Application No. 10/083,533 : DECISION GRANTING PETITION
Filed: February 27, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 020244 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 8, 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 October 1, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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. Michael J. Caridi 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 2814 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.*

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United States Patent and Trademark Office
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REED SMITH LLP
3110 FAIRVIEW PARK DRIVE, SUITE 1400
FALLS CHURCH, VA 22042

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FEB 15 2007

OFFICE OF PETITIONS

In re Application of :
Kazuhito Rokutan et al :
Application No. 10/083,550 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. ASAM.0051 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed February 3, 2006, which set a shortened statutory period for reply of three (3) months. Three-month extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 4, 2006.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on September 1, 2006.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matters is being referred to Technology Center AU 1631 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

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APR 13 2004

OFFICE OF PETITIONS

In re Application of :
Eishun Tsuchida :
Application No. 10/083,555 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 220114US0CONT :

This is a decision on the petition, filed April 5, 2004, under 37 CFR(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on January 15, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being forwarded to Technology Center AU 1711 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

Paper No. 6

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

In re Application of:
Linda H. Malkas, Robert J. Hickey,
Pamela E. Betchel, Min Park,
Derek C. Hoelz, Dragana Tomic and
Lauren Schnaper
Application No. 10/083,576
Filed: February 27, 2002
Title of Invention: METHOD FOR PURIFYING CANCER-SPECIFIC PROLIFERATING CELL NUCLEAR ANTIGEN

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the Petition Under 37 C.F.R. 1.47(a), filed August 16, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition is **granted**.

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

Petitioner has shown that the non-signing inventor, Pamela E. Betchel, refuses to sign the declaration after being presented with the above-identified application and declaration.

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

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

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**WHITEFORD, TAYLOR & PRESTON, LLP**
**ATTN: GREGORY M STONE**
**SEVEN SAINT PAUL STREET**
**BALTIMORE MD 21202-1626**

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APR 0 3 2007

**OFFICE OF PETITIONS**

In re Application of :
Linda H. Malkas et al. :
Application No. 10/083,576 : DECISION ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 80371/5 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 22, 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 February 17, 2006, which set a shortened statutory period for reply of three (3) months. A three (3) months extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 18, 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 an amendment, a Request for Continued Examination, and the $395 filing fee; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of February 17, 2006 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Jean F. Duverne at (571) 272-6051 or in his absence, the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU **2876** for appropriate action on the concurrently filed Request for Continued Examination and amendment.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. 9

**MORRIS E. COHEN**
**1122 CONEY ISLAND AVENUE, SUITE 217**
**BROOKLYN, NY 11230-2345**

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MAR 0 4 2004

**OFFICE OF PETITIONS**

In re Application of
Nouri E. Hakim
Application No. 10/083,656
Filed: February 25, 2002
Attorney Docket No. 4009.007.201

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 10, 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 **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on February 25, 2002, 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).

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

A 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 Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 3727 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications and for appropriate action on the reply received December 24, 2003, to the restriction requirement of June 24, 2003.

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

**ATTACHMENT**: Corrected Filing Receipt

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MORRIS E. COHEN
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BROOKLYN, NY 11230

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OFFICE OF PETITIONS

In re Application of :
Nouri E. Hakim :
Application No. 10/083,656 :
Filed: February 25, 2002 :
Attorney Docket No. 4009.007.201 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 7, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 17, 2004, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 18, 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 $510 extension of time submitted with the petition on December 7, 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.

This matter is being referred to Technology Center AU 3727 for further processing.

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

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Morris E. Cohen
1122 Coney Island Avenue, Suite 217
Brooklyn NY 11230-2345

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OFFICE OF PETITIONS

In re Application of :
Hakim :
Application No. 10/083,656 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 4009.007.201 :
For: NO-SPILL DRINKING CUP APPARATUS

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

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the August 5, 2005 non-final Office action. No response being received and no extensions of time being obtained, this application became abandoned on November 6, 2005. The filing of the present petition precedes the mailing of a Notice of Abandonment.

Applicant has submitted an amendment in reply to the August 5, 2005 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the August 5, 2005 non-final Office action, and the petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center AU 3727 for consideration of the amendment filed on February 13, 2006.

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

E. Shirene Willis

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

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Martha Ann Finnegan, Esq.
Cabot Corporation
157 Concord Road
Billerica, MA 01821-7001

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JAN 27 2006

OFFICE OF PETITIONS

In re Application of
Kitchell, et al.
Application No. 10/083,657
Filed: February 25, 2002
Attorney Docket No.01017CIP

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on January 19, 2005, to withdraw the holding of abandonment in the above-cited application.

The petition is **DISMISSED**.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed May 4, 2005, which set a shortened statutory period for reply of three-months from its mailing date. No response was received within the allowable period, and the application became abandoned on August 5, 2005. A Notice of Abandonment was mailed on December 30, 2005.

Petitioner argues that a reply the non-final Office action was transmitted via facsimile on August 3, 2005, and received by the Office. As evidence of the same, petitioner provides a copy of the certificate of transmittal under 37 CFR 1.8 noting twelve pages of an amendment sent on August 3, 2005, and a copy of the transmission sheet indicating that 12 pages were transmitted to the USPTO main facsimile.

The evidence is noted, but is lacking in one respect. Further to this point, Section 512 of the *Manual of Patent Examining Procedure* provides, in pertinent part, that

> 37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

The record reflects that the subject certificate under 37 CFR 1.8 was signed by Kim Blum, but that no statement of personal knowledge regarding the timely transmission of the amendment accompanied the petition document. It is further noted that the petition document did not explain how Mr. Kilyk—who signed the petition document—had firsthand knowledge of the transmission. The evidence provided with the petition is, therefore, insufficient. The petition is dismissed, accordingly. Any renewed petition filed must be accompanied by a statement from Ms. Blum or from Mr. Kilyk that complies with the guidance cited in MPEP § 512 cited above.

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

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

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

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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I.P. GROUP

Martha Ann Finnegan, Esq.
Cabot Corporation
157 Concord Road
Billerica, MA 01821-7001

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JAN 27 2006

OFFICE OF PETITIONS

In re Application of
Kitchell, et al.
Application No. 10/083,657
Filed: February 25, 2002
Attorney Docket No.01017CIP

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on January 19, 2005, to withdraw the holding of abandonment in the above-cited application.

The petition is **DISMISSED**.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed May 4, 2005, which set a shortened statutory period for reply of three-months from its mailing date. No response was received within the allowable period, and the application became abandoned on August 5, 2005. A Notice of Abandonment was mailed on December 30, 2005.

Petitioner argues that a reply the non-final Office action was transmitted via facsimile on August 3, 2005, and received by the Office. As evidence of the same, petitioner provides a copy of the certificate of transmittal under 37 CFR 1.8 noting twelve pages of an amendment sent on August 3, 2005, and a copy of the transmission sheet indicating that 12 pages were transmitted to the USPTO main facsimile.

The evidence is noted, but is lacking in one respect. Further to this point, Section 512 of the *Manual of Patent Examining Procedure* provides, in pertinent part, that

> 37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

The record reflects that the subject certificate under 37 CFR 1.8 was signed by Kim Blum, but that no statement of personal knowledge regarding the timely transmission of the amendment accompanied the petition document. It is further noted that the petition document did not explain how Mr. Kilyk—who signed the petition document—had firsthand knowledge of the transmission. The evidence provided with the petition is, therefore, insufficient. The petition is dismissed, accordingly. Any renewed petition filed must be accompanied by a statement from Ms. Blum or from Mr. Kilyk that complies with the guidance cited in MPEP § 512 cited above.

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

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions



PAGE 8/22 * RCVD AT 2/14/2006 9:29:48 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/26 * DNIS:2738300 * CSID:5404281721 * DURATION (mm-ss):08-12

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OFFICE OF PETITIONS

In re Application of

Kitchell, et al.

Application No. 10/083,657

Filed: February 25, 2002

Attorney Docket No. 01017CIP

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed February 14, 2006.

The renewed petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed May 4, 2005, which set a shortened statutory period for reply of three-months from its mailing date. No response was received within the allowable period, and the application became abandoned on August 5, 2005. A Notice of Abandonment was mailed on December 30, 2005.

Petitioner argues that a reply the non-final Office action was transmitted via facsimile on August 3, 2005, and received by the Office. As evidence of the same, petitioner provides a copy of the certificate of transmittal under 37 CFR 1.8 noting twelve pages of an amendment sent on August 3, 2005, and a copy of the transmission sheet indicating that 12 pages were transmitted to the USPTO main facsimile. The renewed petition is accompanied by a statement from Ms. Kim Blum recounting her personal knowledge of the transmission of the amendment.

Based on the aforementioned, it appears that the application improperly held abandoned as a bona fide response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

No petition fee is due.

The address as cite don the petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address cited on the petition, all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

The application file is being forwarded Technology Center 3700, GAU 3725, for further processing.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc:
Kilyk & Bowersox, PLLC
400 Holiday Court, Suite 102
Warrenton, VA 20186

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**CABOT CORPORATION**
**157 CONCORD ROAD**
**BILLERICA, MA 01821-7001**

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MAR 19 2007

OFFICE OF PETITIONS

In re Application of :
Ricky W. Kitchell et al :
Application No. 10/083,657 : DECISION ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 01017CIP :

This is a decision on the petition under 37 CFR 1.137(b), filed October 30, 2006, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely pay the issue and publication fees on or before October 23, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed July 21, 2006. Accordingly, the date of abandonment of this application is October 24, 2006. A Notice of Abandonment was mailed on March 5, 2007, subsequent to the filing of the present petition to revive.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,400 and the publication fee of $300, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fees are accepted as being unintentionally delayed.

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

This application is being referred to Publishing Division for appropriate processing in accordance with this decision on petition.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**1731 EMBARCADERO ROAD**
**SUITE 230**
**PALO ALTO CA 94303**

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| | | |
|---|---|---|
| In re Application of | : | |
| Wolfee et al. | : | |
| Application No. 10/083,682 | : | ON PETITION |
| Filed: October 24, 2001 | : | |
| Attorney Docket No. 8325-0015.20 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 29, 2008, to revive the above-identified application.

The petition is **GRANTED**.

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 1631 for processing of the RCE and Submission under 37 CFR 1.114 filed concurrently with the instant petition.

Liana Walsh
Petitions Examiner
Office of Petitions

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Washington, D.C. 20231
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Paper No. 7

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343-9185

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OCT 2 8 2002

OFFICE OF PETITIONS

In re Application of
Brucker et al.
Application No. 10/083,707
Filed: February 26, 2002
For: Bifurcated Stent and Delivery System

DECISION DISMISSING
PETITION UNDER
37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(b), filed on July 10, 2002 which has been treated as a petition under 37 CFR 1.47(a).[1]

The petition is **dismissed**.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

On February 26, 2002, applicants filed the above-identified application, without an executed oath or declaration, the statutory basic filing fee, and additional claim fees. On March 18, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring a properly signed oath or declaration and payment of the basic filing fees, additional claim fees, and a surcharge for the late filing. In response, on July 2, 2002, applicant submitted a request for a two-month extension to reply and paid the requisite fees. On July 10, 2002, applicants filed the present petition with an executed declaration.

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

[1] A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

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. Applicants lack items (1) and (2) as set forth above.

As to item (1), James M. Urzedowski stated that he mailed letters to inventor, Enrique Malaret, on May 1, 2002, May 23, 2002, and June 4, 2002, requesting that Mr. Malaret sign the Declaration and Assignment that was included with the letters. Mr. Urzedowski further indicated that he was notified by an attorney who claimed to represent Mr. Malaret, who stated that due to an existing disagreement between Mr. Malaret and the assignee, Mr. Malaret refused to sign the Declaration or Assignment.

Upon review, it does not appear that Mr. Malaret was presented with a copy of the application papers, including the specification, claims and drawing. Unless Mr. Malaret was presented with a complete copy of the application papers (specification, claims and drawings), he could not attest that he has "reviewed and understand the application papers" and, therefore, could not sign the Declaration which he was given. Accordingly, applicants failed to show or provide sufficient proof that the nonsigning inventor has refused to sign the Declaration. See MPEP 409.03(d). To establish that the inventor has refused to join in the application, applicants should show that a complete copy of the application papers was presented to Mr. Malaret himself or via his attorney and that he did not respond to the request that he sign the declaration. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events. Statements by a party not present when an oral refusal was made is not acceptable.

As to item (2), applicants have failed to submit a proper oath or declaration in compliance with 37 CFR 1.63. The declaration accompanying this petition does not properly and completely identify the residence (city and either state or foreign), the mailing address or post office address of each inventor. Rather, some of the copies of the declaration state the inventors' names but leave the information as to the residences and mailing addresses blank. A new declaration identifying the complete mailing address and/or residence for each inventor is required.

The $130.00 petition fee is being charged to Deposit Account No. 22-0350, as authorized by applicants.

Further correspondence with respect to this matter should be addressed as follows and to the **Attention of Senior Petitions Attorney Christina Tartera Donnell:**

| | |
|---|---|
| By mail: | Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By FAX: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Crystal Plaza Four, Suite 3C23<br>2201 S. Clark Place<br>Arlington, VA |

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343-9185

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JAN 0 3 2003

OFFICE OF PETITIONS

In re Application of
Brucker et al.
Application No. 10/083,707
Filed: February 26, 2002
For: Bifurcated Stent and Delivery System

DECISION GRANTING
PETITION UNDER
37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR 1.47(a), filed December 26, 2002.

The petition is granted.

Petitioner has shown that Enrique Malaret, 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 statement of facts of James M. Urzedowski establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration .

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 present petition. Notice of the filing of this application will also be published in the Official Gazette.

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

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Enrique Malaret
4935 Balsam Lane
Plymouth, MN 55442

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OFFICE OF PETITIONS

In re Application of
Brucker et al.
Application No. 10/083,707
Filed: February 26, 2002
For: Bifurcated Stent and Delivery System

LETTER

Dear Mr. Malaret:

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 Christina Tartera Donnell at (703) 306-5589. 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).

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343-9185

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

VIDAS, ARRETT & STEINKRAUS, P.A.
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SUITE 2000
MINNETONKA MN 55343-9185

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**DEC 0 5 2002**

**OFFICE OF PETITIONS**

In re Application of
Brucker et al.
Application No. 10/083,711
Filed: February 26, 2002
For: Bifurcated Stent and
Delivery System

DECISION DISMISSING
PETITION UNDER
37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(b), filed on July 9, 2002(certificate of mailing June 28, 2002), which has been treated as a petition under 37 CFR 1.47(a).[1]

The petition is **dismissed**.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

On February 26, 2002, applicants filed the above-identified application, without an executed oath or declaration, the statutory basic filing fee, and additional claim fees. On April 3, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring a properly signed oath or declaration and payment of the basic filing fees, additional claim fees, and a surcharge for the late filing. In response, on July 9, 2002, applicant submitted, *inter alia*, the present petition, an executed declaration, and an authorization to charge the Deposit Account for the requisite fees.

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

[1] A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

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. Applicants lack items (1) and (2) as set forth above.

As to item (1), James M. Urzedowski stated that he mailed letters to inventor, Enrique Malaret, on May 1, 2002, May 23, 2002, and June 4, 2002, requesting that Mr. Malaret sign the Declaration and Assignment that was included with the letters. Mr. Urzedowski further indicated that he was notified by an attorney who claimed to represent Mr. Malaret, who stated that due to an existing disagreement between Mr. Malaret and the assignee, Mr. Malaret refused to sign the Declaration or Assignment.

Upon review, it does not appear that Mr. Malaret was presented with a copy of the application papers, including the specification, claims and drawing. Unless Mr. Malaret was presented with a complete copy of the application papers (specification, claims and drawings), he could not attest that he has "reviewed and understand the application papers" and, therefore, could not sign the Declaration which he was given. Accordingly, applicants failed to show or provide sufficient proof that the nonsigning inventor has refused to sign the Declaration. See MPEP 409.03(d). To establish that the inventor has refused to join in the application, applicants should show that a complete copy of the application papers was presented to Mr. Malaret himself or via his attorney and that he did not respond to the request that he sign the declaration. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events. Statements by a party not present when an oral refusal was made is not acceptable.

As to item (2), applicants have failed to submit a proper oath or declaration in compliance with 37 CFR 1.63. The declaration accompanying this petition does not properly and completely identify the residence (city and either state or foreign), the mailing address or post office address of each inventor. Rather, some of the copies of the declaration state the inventors' names but leave the information as to the residences and mailing addresses blank. A new declaration identifying the complete mailing address and/or residence for each inventor is required.

As per applicant's request, the Deposit Account No. 22-0350 is being charged the following fees: $110.00 extension of time fee; $740.00 basic filing fee; $480.00 claim fees; and a $130.00 surcharge.

Further correspondence with respect to this matter should be addressed as follows and to the **Attention of Senior Petitions Attorney Christina Tartera Donnell:**

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

By FAX: (703) 308-6916
Attn: Office of Petitions

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

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 10

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343-9185

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OFFICE OF PETITIONS

In re Application of
Brucker et al.
Application No. 10/083,711
Filed: February 26, 2002
For: Bifurcated Stent and Delivery System

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

This is in response to the renewed petition under 37 CFR 1.47(a), filed December 26, 2002.

The petition is granted.

Petitioner has shown that Enrique Malaret, 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 statement of facts of James M. Urzedowski establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration .

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 present petition. Notice of the filing of this application will also be published in the Official Gazette.

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

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

Enrique Malaret
4935 Balsam Lane
Plymouth, MN 55442

In re Application of
Brucker et al.
Application No. 10/083,711
Filed: February 26, 2002
For: Bifurcated Stent and
Delivery System

LETTER

Dear Mr. Malaret:

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 Christina Tartera Donnell at (703) 306-5589. 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).

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

VIDAS, ARRETT & STEINKRAUS, P.A.
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Paper No. 10

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VIDAS, ARRETT, & STEINKRAUS P.A.

In re Application of
Brucker et al.
Application No. 10/083,711
Filed: February 26, 2002
For: Bifurcated Stent and Delivery System

DECISION GRANTING PETITION UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR 1.47(a), filed December 26, 2002.

The petition is granted.

Petitioner has shown that Enrique Malaret, 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 statement of facts of James M. Urzedowski establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration .

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 present petition. Notice of the filing of this application will also be published in the Official Gazette.

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

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

DNAX RESEARCH, INC.
LEGAL DEPARTMENT
901 CALIFORNIA AVENUE
PALO ALTO, CA 94304

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FEB 15 2005

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Patent No. 6,797,813 | DECISION ON APPLICATION |
| de Waal Malefyt et al. | FOR |
| Issue Date: September 28, 2004 | PATENT TERM ADJUSTMENT |
| Application No. 10/083,720 | and |
| Filed: February 28, 2002 | NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. DX0644KBK | CERTIFICATE OF CORRECTION |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)(b)," filed August 10, 2004. Patentees request that the initial determination of patent term adjustment be corrected from two hundred eighty-three (283) days to three hundred twenty-two (322) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred eighteen **(318)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Patentees are 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.

Prior to this decision being rendered, the application matured into a patent. The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a Patent Term Adjustment of three hundred eighteen **(318)** days.

On May 11, 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 283 days. On August 10, 2004, patentees timely[1] submitted an application for patent term adjustment (with required fee). Patentees dispute the reduction of 42 days attributed to applicants for failing to respond within three months to the Notice to File Missing Parts of Application mailed April 8, 2002. Patentees state that their response was received on July 11, 2002, and thus, a delay of 3 days should have been entered.

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

The reduction of 42 days has been found to be incorrect. A review of the application file reveals that applicants' responses to the Notice to File Missing Parts of Application mailed April 8, 2002, are of record in the application with dates of receipt by the Office of July 11, 2002 and July 15, 2002. In response to the Notice, applicants mailed separately responses to Box Missing Parts (declaration, filing fee, and surcharge) and to Box Sequence Listing (sequence listing). A complete reply was not received until receipt of the portion of the response received July 15, 2002. Thus, the Office should not have assessed applicants a delay of forty-two (42) days. The response was filed outside the three-month period under 37 CFR 1.704(b), but only by 7 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred eighteen (318) days (325 - 7).

A review of the application history confirms that, after the mailing of the notice of allowance, there were no delays on the part of the Office warranting an adjustment or on the part of the applicants warranting a reduction of the patent term. However, a period of reduction of 50 days was entered for the filing of this application of patent term adjustment. This reduction has been removed. See § 1.704(e).

In view thereof, the patent should have issued with a revised patent term adjustment of three hundred eighteen (318) days.

---

[1] PALM records show that the Issue Fee payment was also received in the Office on August 11, 2004.

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

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **THREE HUNDRED EIGHTEEN (318)** days.

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

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

Enclosure: Copy of DRAFT Certificate of Correction

Day : Monday
Date: 2/14/2005

PALM INTRANET

Time: 08:50:22

| PTA Calculations for Application: 10/083720 | | | |
|---|---|---|---|
| Application Filing Date: | 02/28/2002 | PTO Delay (PTO): | 325 |
| Issue Date of Patent: | 09/28/2004 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 92 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 318 |
| PTO Delay Adjustment: | 85 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 43 | 02/14/2005 | ADJUSTMENT OF PTA CALCULATION BY PTO | 85 | | |
| 38 | 09/28/2004 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 37 | 09/02/2004 | RECEIPT INTO PUBS | | | |
| 36 | 09/01/2004 | DISPATCH TO FDC | | | |
| 35 | 09/01/2004 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 34 | 08/11/2004 | MAILROOM DATE OF ISSUE FEE PAYMENT | | | |
| 33 | 08/10/2004 | MISCELLANEOUS INCOMING LETTER | | 50 | 33 |
| 32 | 08/13/2004 | RECEIPT INTO PUBS | | | |
| 31 | 08/11/2004 | ISSUE FEE PAYMENT RECORDED | | | |
| 30 | 06/02/2004 | SEQUENCE FORWARDED TO PUBS ON TAPE | | | |
| 29 | 05/24/2004 | WORKFLOW - FILE SENT TO CONTRACTOR | | | |
| 28 | 05/11/2004 | MAIL NOTICE OF ALLOWANCE | | | |
| 27 | 05/11/2004 | MAIL EXAMINER'S AMENDMENT | | | |
| 26 | 05/11/2004 | ISSUE REVISION COMPLETED | | | |
| 25 | 05/10/2004 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 24 | 05/10/2004 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 23 | 05/10/2004 | NOTICE OF ALLOWABILITY | | | |
| 22 | 04/08/2004 | DATE FORWARDED TO EXAMINER | | | |
| 21 | 04/01/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 20 | 03/18/2004 | MAIL RESTRICTION REQUIREMENT | 325 | | -1 |
| 19 | 03/17/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 18 | 03/01/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 17 | 02/17/2004 | PRELIMINARY AMENDMENT | | | |

| | | | | | |
|---|---|---|---|---|---|
| 16 | 10/08/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 15 | 04/10/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 14 | 07/16/2002 | PRELIMINARY AMENDMENT | | | |
| 13 | 08/20/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 12 | 08/19/2002 | APPLICATION IS NOW COMPLETE | | 42 | 7 |
| 10 | 07/15/2002 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 9 | 07/15/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 8 | 07/30/2002 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 7 | 04/08/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 5 | 03/29/2002 | CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE | | | |
| 4 | 03/27/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 3 | 02/28/2002 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 2 | 02/28/2002 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Jeffer, Mangels, Butler & Marmaro, LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067

MAILED

APR 14 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 5

In re application of
Edward J. Shoen et al.
Application No. 10/083,726
Filed: October 19, 2001
For: ONLINE MARKETPLACE FOR MOVING AND RELOCATION SERVICES

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the petition filed on December 30, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

The petition filed December 30, 2002 fails to adequately meet requirements (C) and (D) above. The petition states that a pre-examination search was made in all classes. However, the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. has not been listed. A copy of the document "www.move.com" has not been provided.

For the above stated reasons, the petition is **DISMISSED**.

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

**SUMMARY**: Petition to Make Special **DISMISSED**.

Applicant should promptly submit a renewed petition to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866
(703) 605-0586

KJD/tpl: 4/1/03

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P.O. BOX 145
ALEXANDRIA, VA 22313-145
www.uspto.go

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OCT 23 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Jeffer, Mangels, Butler & Marmaro, LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067

Paper No. 7

In re application of
Edward J. Shoen et al.
Application No. 10/083,726
Filed: October 19, 2001
For: ONLINE MARKETPLACE FOR MOVING AND RELOCATION SERVICES

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED**
: **EXAMINATION)**

This is in response to the resubmitted petition filed on June 13, 2003, and supplemented on October 19, 2003, to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are no directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

**SUMMARY**: Petition to Make Special **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/ekn 10/22/03

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005

**COPY MAILED**

JAN 21 2009

In re Application of :
David Needham : DECISION ON PETITION
Application No. 10/083,734 :
Filed: February 26, 2002 :
Attorney Docket No. 14514-00007-US1 :

This is a decision on the "PETITION UNDER 37 CFR 1.182 TO WITHDRAW TERMINAL DISCLAIMERS", filed October 3, 2008.

The petition under 37 CFR 1.182 is **DISMISSED**.

Applicants filed a terminal disclaimer on June 21, 2004, to overcome rejections of claims based on US Patent No. 6,200,598, and another terminal disclaimer on May 16, 2008, to overcome rejections of claims based on US Patent No. 6,726,925. Applicant has requested that the terminal disclaimers be withdrawn.

The Examiner has indicated that the claims in the issued patents still encompass the claims in the instant application, and therefore the double patenting rejections made before are still applicable. Any questions concerning this matter should be directed to Examiner Gollamudi Kishore at (571)272-0598.

Accordingly, the petition to withdraw the terminal disclaimers must be dismissed.

Receipt of the $400 petition fee is acknowledged.

There is no indication that applicant has paid the issue fee in response to the Notice of Allowance mailed on September 10, 2008.

The matter is being to Group Art Unit 1612 for further processing as a possibly abandoned application, in lieu of the apparent lack of an issue fee filing in response to the September 10, 2008 Notice of Allowance.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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JUL 15 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 3

Richard C. Jaworski
260 Stoney Ridge Drive
Alpharetta, GA 30022

In re Application of: Jaworski
Application No. 10/083,749
Filed: February 25, 2002
For: SYSTEM OF TESTING THE UPSTREAM CABLE MODEM CHANNEL

**DECISION ON PETITION TO MAKE SPECIAL UNDER M.P.E.P. §708.02(II): INFRINGEMENT**

This is a decision on the petition, filed April 20, 2004, 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. 1.17(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 pertinent prior art. Applicant ***must provide*** one copy of each of the ***references deemed most closely related*** to the subject matter encompassed by the claims [*emphasis added*].

Applicant's submission is deficient because no references have been submitted. Note, the petition filed April 20, 2004 merely sets forth a copy of the literature page of the alleged infringing device. Accordingly, the Petition is **DISMISSED**.

The application file will be returned to the examiner's docket and examined in its proper turn based on its effective filing date.

If petitioner desires further review of this decision, petitioner should file a Request for Reconsideration within two (2) months of the mailing date of this decision. Telephone inquiries should be directed to the undersigned at (703) 308-0885.

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

blj: 7/1/04

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AUG 2 4 2004

Technology Center 2100

Paper No. 5

Richard C. Jaworski
260 Stoney Ridge Drive
Alpharetta, GA 30022

In re Application of: Jaworski
Application No. 10/083,749
Filed: February 25, 2002
For: SYSTEM OF TESTING THE UPSTREAM CABLE MODEM CHANNEL

**DECISION ON PETITION TO MAKE SPECIAL UNDER M.P.E.P. §708.02(II): INFRINGEMENT**

This is a decision on the request for reconsideration (supplemental petition) filed on July 20, 2004. A petition to make special under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, was filed on April 20, 2004 and subsequently dismissed in the decision mailed on July 15, 2004.

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. §1.17(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 pertinent prior art. Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims.

The petition filed April 20, 2004 and request for reconsideration filed July 20, 2004, include all of the requirements set forth above and, therefore, the petition is **GRANTED**.

The application is being forwarded to the examiner to be advanced out of turn for examination in accordance with the procedures set forth in M.P.E.P. §708.02 and 37 C.F.R. §1.102.

Telephone inquiries should be directed to the undersigned at (703) 308-0885.

8/17/04

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

blj: 8/17/04

UNITED STATES PATENT AND TRADEMARK OFFICE

#14

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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MAR 1 : 2004

Office of the Director
Group 3600

Huey Thomas Crochet
P.O. Box 344
Onalaska, TX 77360

In re Application of: Huey Thomas Crochet
Serial No. 10/083,771
Filed: February 27, 2002
For: **Dynamic Snag-Resistant Fishing Weight**

**PETITION UNDER**

**37 C.F.R. 1.181**

The letter filed on November 25, 2003 has been treated as a petition under 37 C.F.R. 1.181 to invoke supervisory review to request the withdrawal of the Notification of Non-Compliance with 37 CFR 1.192(c) mailed November 3, 2003, paper no. 14.

In regards to the petition filed November 25, 2003, the petition has been **GRANTED.**

A review of the file record reveals the following:

1. A final office action was mailed on April 11, 2003 as paper no. 9.

2. A request for reconsideration entitled "Applicants Response to the Examiners Final Office Action Regarding Application 10,083,771 Filed 2/27/02 by Huey Thomas Crochet" was received on June 2, 2003, paper no. 10.

3. An Advisory Action was mailed on June 25, 2003, paper no. 11.

4. A Notice of Appeal was received on July 11, 2003, paper no. 12.

5. An Appeal Brief was received on August 12, 2003, paper no. 13.

6. A Notification of Non-Compliance with 37 CFR 1.192(c) was mailed on November 3, 2003, paper no. 14.

7. The current petition to invoke supervisory review under 37 CFR 1.181 was received on November 25, 2003, paper no. 15.

***MPEP 1206 "Appeal Brief Content" states in part:***

*Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c). See 37 CFR 1.192(d). Form paragraphs 12.76-*

*12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used to notify the appellant of the deficiency.*

***MPEP 1206 further states in part:***

*An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant pro se, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a pro se appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a pro se appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group.*

A review of the current application reveals that the Appeal Brief received on August 12, 2003 was filed by the applicant and the instant application is further being prosecuted by the applicant.

A further review of the Appeal Brief received on August 12, 2003 reveals that the applicant substantially complied with the requirements of items (1), (2) and (8) as specified in 37 CFR 1.192 ( c). Therefore in light of MPEP 1206, the Appeal Brief filed August 12, 2003 has been accepted and the Notification of Non-Compliance with 37 CFR 1.192 (c) mailed on November 3, 2003 has been withdrawn.

This application is being returned to Primary Examiner Rowan for consideration of the Appeal Brief filed August 12, 2003. With respect to applicant's remarks found on pages 1-8 of the instant petition, these remarks will be forwarded to Examiner Rowan as supplemental arguments for consideration.

Donald T. Hajec
Director
Technology Center 3600
(703) 306-4180
Facsimile: (703) 306-4598
Pmp: 3/3/04

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DEC 14 2005

TECHNOLOGY CENTER 3600

Huey Thomas Crochet
P.O. Box 344
Onalaska, TX 77360

In re Application of :
Huey Thomas Crochet : DECISION ON PETITIONS
Application No. 10/083,771 :
Filed: February 27, 2002 :
For: DYNAMIC SNAG RESISTANT FISHING WEIGHT

This is in response to the petitions filed on October 6, 2005, September 3, 2005, August 26, 2005, August 8, 2005 and July 12, 2005.

The petitions are **DISMISSED** in view of applicant's acceptance of the examiner's amendment mailed with the Notice of Allowance on October 18, 2005 that has placed the case in condition for allowance. No further action is deemed necessary by the Examiner and therefore the application is being forwarded to the Office of Publications.

Donald T. Hajec
Director, TC 3600
(571) 272-5150

pmp: 12/14/05

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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JUN 27 2006

TECHNOLOGY CENTER 3600

Huey Thomas Crochet
P.O. Box 344
Onalaska, TX 77360

In re application of
Huey Thomas Crochet
Application No. 10/083,771
Filed: February 27, 2002
Title: DYNAMIC SNAG RESISTANT FISHING WEIGHT

**DECISION ON PETITION TO WITHDRAW FROM ISSUE UNDER 37 CFR 1.313(a)**

This is in response to applicant's petition to withdraw the above-noted application from issue filed January 12, 2006 and subsequent papers filed February 11, 2006 and May 2, 2006.

The petition is **DISMISSED**.

A Notice of Allowability (PTOL-37) and attached Examiner's Amendment setting forth amendments agreed to by applicant were mailed on October 18, 2005. Accompanying the Notice of Allowability was a Notice of Allowance and Fee(s) Due (PTOL-85) that set a non-extendable three-month period within which applicant was required to pay the issue fee indicated on the form. On January 12, 2006, applicant submitted a petition to withdraw the application from issue. Since this petition was submitted prior to payment of the issue fee, the petition falls under paragraph (a) of 37 CFR 1.313 which permits applicant to petition for withdrawal of an application from issue prior to payment of the issue fee provided there are good and sufficient reasons warrant the withdrawal. A petition fee of $130 is required for processing such a petition (37 CFR 1.17(h)). A review of the file record has revealed that the petition fee was not submitted. Therefore, a decision on the merits of applicant's petition to withdraw cannot be rendered.

As noted above, the Notice of Allowance (PTOL-85) set a non-extendable three-month period from the mailing date of the Notice within which applicant must pay the issue fee to avoid abandonment of the application. This period expired on January 18, 2006. Since no issue fee was submitted within the allotted time period, this application stands **abandoned**, 35 USC §151.

If applicant wishes to reinstate the application to pending status, a petition to revive under 37 CFR 1.137 (a) or (b) will be required. Information on how to file such a petition can be provided by calling the Office of Petitions at (571) 272-3282.

Donald Hajec, Director
Patent Technology Center 3600
(571) 272-5150

DH:rar: 6/19/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO BOX 142950
GAINESVILLE FL 32614-2950

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MAY 3 0 2006

OFFICE OF PETITIONS

In re Patent No. 6,965,026 : LETTER REGARDING
Michael J. Zaworotko et al. : PATENT TERM ADJUSTMENT
Issue Date: November 15, 2005 :
Application No. 10/083,781 :
Filed: February 25, 2002 :
Atty Docket No. USF-104XC1 :

This is in response to the "COMMUNICATION", filed November 9, 2005, pursuant to patentees' duty of candor and good faith to the Office. Patentee states that the 342 days of patent term adjustment as indicated on the Issue Notification for the above-captioned application is incorrect.

The request for reconsideration of the patent term adjustment indicated on the patent is **DISMISSED**.

On November 15, 2005, the application matured into U.S. Patent No. 6,965,026, with a revised patent term adjustment of 342 days. While this communication was filed prior to the issuance of the patent and on the belief that the patent would be issued with an incorrect number of PTA days, no basis for entitlement to PTA days other than 342 has been provided.

A review of the application history reveals that the patent term adjustment of 342 days indicated on the Issue Notification and on the patent is correct. The 342 days of PTA was calculated as follows: After the initial determination of 292 days Patent Term Adjustment under 35 U.S.C. 154(b), 50 days were accorded for PTO delay in issuing the Patent on November 15, 2005, more than four months from the payment of the issue fee on May 26, 2005.

The application history reveals no further bases for adjustment or reduction of the term of the patent issuing from the above-identified application. Patentee has not stated the basis for his assertion that the PTA should be other than 342 days.

In view thereof, it is concluded that the patent correctly issued with a revised patent term adjustment of 342 days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

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

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Patricia Faison-Ball, at (571) 272-3212.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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A PROFESSIONAL ASSOCIATION
PO BOX 142950
GAINESVILLE FL 32614-2950

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SEP 21 2006

**OFFICE OF PETITIONS**

In re Patent No. 6,965,026 : LETTER REGARDING
Michael J. Zaworotko et al. : PATENT TERM ADJUSTMENT
Issue Date: November 15, 2005 : AND
Application No. 10/083,781 : NOTICE OF INTENT TO ISSUE
Filed: February 25, 2002 : CERTIFICATE OF CORRECTION
Atty Docket No. USF-104XC1 :

This is in response to the "COMMUNICATION IN REPLY TO LETTER REGARDING PATENT TERM ADJUSTMENT", filed June 14, 2006, pursuant to patentees' duty of candor and good faith to the Office. Patentee states that the 342 days of patent term adjustment as indicated on the above-identified Patent is incorrect.

The request for reconsideration of the patent term adjustment indicated on the patent is **GRANTED**.

On November 15, 2005, the application matured into U.S. Patent No. 6,965,026, with a revised patent term adjustment of 342 days. A communication filed November 9, 2005, prior to the issuance of the patent and on the belief that the patent would be issued with an incorrect number of PTA days, was dismissed in a decision mailed May 30, 2006 because no basis for entitlement to PTA days other than 342 days had been provided.

Patentee states that the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) of 342 days shown in the PAIR system was incorrect. Patentee's arguments are well taken.

A review of the application history confirms that the patent term adjustment of 342 days indicated in the PAIR database and on the patent is in error. After the initial determination of 292 days Patent Term Adjustment under 35 U.S.C. 154(b), 50 days were accorded for PTO delay in issuing the Patent on November 15, 2005, more than four months from the payment of the issue fee on May 26, 2005. Patentees assert that a "Petition for Color Drawings" was filed on April 1, 2005, after the mailing of the notice of allowance.

37 CFR § 1.704(c)(10) provides that:

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

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

or

(ii) Four months;

Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment should have been reduced by the number of days beginning on the date the "Petition for Color Drawings" was filed, April 4, 2005, and ending on the date of issuance of the patent, November 15, 2005. As this period exceeds four months, the patent term adjustment should have been reduced by the lesser period of 120 days.

In view thereof, the correct determination of PTA is two hundred twenty two (222) days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks Patentees for their good faith and candor in bringing this to the attention of the Office.

The patent file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. See 35 U.S.C. § 254 and 37 CFR § 1.322. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by two hundred twenty two (222) days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 6,965,026 B2

DATED : November 15, 2005

INVENTOR(S) : Zaworotko 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 (342) days

Delete the phrase "by 342 days" and insert – by 222 days--

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

Paper No. 5

Jeromy Johnson
806 Pretty Run Drive
North Augusta SC 29841

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JUL 2 1 2004

OFFICE OF PETITIONS

In re Application of :
Jeromy Johnson :
Application No. 10/083,783 :
Filed: February 25, 2002 : DECISION ON PETITION
Title: AUTOMATIC BALL MARK :
RETRIEVAL SYSTEM (ACCULINX) :

## BACKGROUND

This is a decision on the petition filed March 24, 2004 under 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn. A second copy of this petition was submitted on June 11, 2004.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (notice), mailed March 28, 2002, which indicated that substitute drawings were required and set a shortened statutory period for reply of two (2) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on May 29, 2002. A Notice of Abandonment was mailed January 26, 2004.

## THE RELEVANT PORTION OF THE CFR AND MPEP

37 CFR 1.4: Nature of correspondence and signature requirements.
(d)
(1) Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:
(i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or
(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or
(iii) Where an electronically transmitted trademark filing is permitted, the person who signs the filing must either
(A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; and print, sign and date in permanent ink, and maintain a paper copy of the electronic submission; or

(B) Sign the verified statement using some other form of electronic signature specified by the Commissioner.
(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).
(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.
(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

MPEP 502.02 Correspondence Signature Requirements:
Correspondence filed in the Office, which requires a person's signature, may be an original, or a copy thereof. The word original, as used herein, is defined as correspondence which is personally signed in permanent ink by the person whose signature appears thereon. Where copies of correspondence are acceptable, photocopies or facsimile transmissions may be filed. For example, a photocopy or facsimile transmission of an original of an amendment, declaration (e.g., under 37 CFR 1.63 or 1.67), petition, issue fee transmittal form, authorization to charge a deposit account or a credit card, may be submitted in a patent application. Where copies are permitted, second and further generation copies (i.e., copy of a copy) are acceptable. For example, a client may fax a paper to an attorney and the attorney may then fax the paper to the Office, provided the paper is eligible to be faxed (see MPEP § 502.01). The original, if not submitted to the Office, should be retained as evidence of proper execution in the event that questions arise as to the authenticity of the signature reproduced on the photocopy or facsimile-transmitted correspondence. If a question of authenticity arises, the Office may require submission of the original.
When a document that is required by statute to be certified must be filed (such as a certified copy of a foreign patent application pursuant to 35 U.S.C. 119 or a certified copy of an international application pursuant to 35 U.S.C. 365) a copy of the certification, including a photocopy or facsimile transmission, will not be acceptable. The requirement for an original certification does not apply to certifications such as required under 37 CFR 1.8 since these certifications are not required by statute.

## ANALYSIS

Unfortunately, Petitioner has failed to sign his petition. Pursuant to both 37 C.F.R. §1.4(d)(1) and MPEP §502.02, the petition cannot be accepted.

## CONCLUSION

As such, the petition under 37 C.F.R. §1.181 must be **DISMISSED**.

Any response to 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 response should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

Petitioner should note that the Office of Petitions does not have jurisdiction over petitions to withdraw the holding of abandonment, and therefore cannot render a decision on the merits.

The renewed petition should be submitted to the Office of Initial Patent Examination (OIPE) at:

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

After the mailing of this decision, the application file will be forwarded to OIPE.

Telephone inquiries regarding this decision should be directed to the Customer Service Branch of OIPE at 703-308-1202.

The phone number of the undersigned is (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria, and the telephone number for the undersigned will change to 571-272-3225.

Paul Shanoski

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States Patent and Trademark Office**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

Jeromy Johnson
806 Pretty Run Drive
North Augusta SC 29841

**COPY MAILED**

FEB 25 2005

**OFFICE OF PETITIONS**

In re Application of
Jeromy Johnson
Application No. 10/083,783
Filed: February 25, 2002
Title: AUTOMATIC BALL MARK RETRIEVAL SYSTEM (ACCULINX)

DECISION ON RENEWED PETITION

This is a decision on the renewed petition filed on August 26, 2004 under 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (notice), mailed March 28, 2002, which indicated that substitute drawings were required and set a shortened statutory period for reply of two (2) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on May 29, 2002. A Notice of Abandonment was mailed January 26, 2004.

The original petition was received on March 24, 2004, and was dismissed via the mailing of a decision on July 21, 2004, for failure to sign the petition as required by MPEP §502.02.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the holding of abandonment should be withdrawn.

Accordingly, the petition under 37 C.F.R. §1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

The application file is being forwarded to Technology Center 3700 for further processing, and for re-mailing of the notice of March 28, 2002.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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FOREST A HATCHER
PO BOX 1555
FLAGLER BEACH FL 32136

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MAR 0 9 2005

OFFICE OF PETITIONS

In re Application of :
Forest A. Hatcher :
Application No. 10/083,800 : ON PETITION
Filed: February 26, 2002 :
Title of Invention: FEED PORT FOR :
PNEUMATIC PROJECTILE DEVICE

This is a decision on the petition under 37 CFR 1.137(b),[1] filed February 22, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned May 30, 2002, for failure to timely reply to the Notice to File Corrected Application Papers mailed on March 29, 2002, which set a two (2) month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained prior to the abandonment. Accordingly, a Notice of Abandonment was mailed January 21, 2004.

Receipt of the claim fees and the abstract as required by 37 CFR 1.72(b) is acknowledged.

The petition fee in the amount of $750.00 and the fee for an additional claim in the amount of $100.00 have been charged to deposit account no. 50-2331. Please note that effective November 22, 2004, the fees were increased. See the Notice published in the Federal Register on September 21, 2004 and in the Official Gazette of the United States Patent and Trademark Office on October 12, 2004.

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

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

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

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

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Mailed: MAY 11 2004

spg
Paper Number 6

| | | |
|---|---|---|
| In re application of | : | |
| David Lin et al. | : | DECISION ON |
| Serial No. 10/083,851 | : | PETITION |
| Filed: February 25, 2002 | : | |
| For: METHOD FOR PROCESSING A FILM | : | |

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181 filed November 7, 2003. The petition requests that the abandonment, as set forth in the Notice of Abandonment of November 3, 2003, for failure to timely file a proper reply to the Office letter of April 3, 2003, be withdrawn since the applicants did timely file a response thereto on July 30, 2003 by facsimile transmission to the USPTO. (A copy of the papers filed July 30, 2003 and a copy of the Auto-Reply Facsimile Transmission indicating receipt of the facsimile transmission at the USPTO is attached to the instant petition.)

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the evidence presented reveals that applicant's response was properly filed on July 30, 2003 by facsimile transmission as evidenced by the properly completed Certification of Facsimile Transmission attached to applicant's response and by the copy of the Auto-Reply Facsimile Transmission report provided with the instant petition which indicates the successful transmission, to a USPTO facsimile telephone number (703-872-9310), of 11 pages. Therefore, the application was never in-fact abandoned and any holding of abandonment for failure to timely file a proper response to the Office letter mailed on April 3, 2003 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers originally filed July 30, 2003 by facsimile transmission and a copy of which is provided as an attachment to the instant petition.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

J.C. PATENTS
SUITE 250
4 VENTURE
IRVINE CA 92618

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JUL 2 8 2006

Director's Office
Office of Patent Publication

J C PATENTS, INC.
4 VENTURE, SUITE 250
IRVINE, CA 92618

In re Application of
LIN, DAVID, et al.
Application No. 10/083,851
Filed: February 25, 2002
Attorney Docket No. JCLA4539-CA

**DECISION ON PETITION**

This is a decision on the Petition To Withdraw Holding of Abandonment Under 37 CFR § 1.181, received in the United States Patent and Trademark Office (USPTO) via facsimile transmission on November 23, 2005, which is being treated under MPEP 711.03(c)II, Petition To Withdraw Holding Of Abandonment Based On Failure To Receive Office Action.

The petition is **GRANTED**.

The application was held abandoned for applicants failure to timely file a proper reply to the Office letter — Notice To File Corrected Application Papers (Notice)— mailed on May 5, 2005. The applicant was given 30 days to respond the Notice to avoid abandonment of the patent application. (Not extendable under 37 CFR 1.136). Accordingly, the Notice of Abandonment was mailed on October 7, 2005

Petitioner states in the second paragraph of their petition " ...we did receive the Notice To File Corrected Application Papers, but later states "The undersigned hereby states that the Notice To File Corrected Application Papers of May 5, 2005 was not received. Thus the petition argues non-receipt of an Office action.

In absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the practitioner did not receive the Office action, and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Action Are Not Received" MPEP 711.03(c) II

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

Petitioner submitted herewith a response to the Notice, which the Office will enter electronically (scan) in the application file. The application will be then forwarded for processing into a patent.

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

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

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FEB 0 9 2005

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| | | |
|---|---|---|
| In re Application of | : | |
| Gregg S. Sutton et al | : | |
| Application No. 10/083,866 | : | ON PETITION |
| Filed: February 26, 2002 | : | |
| Attorney Docket No. CRD-0992 | : | |

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**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 10, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 11, 2004.

Pursuant to petitioner's authorization, Deposit Account No. 10-0750 was charged -- $1,500.00 for the petition to revive an unintentionally abandoned application.

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

The file is being forwarded to Technology Center AU 3731.

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

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**DAVID A EINHORN**
**ANDERSON KILL & OLICK, P.C.**
**1251 AVENUE OF THE AMERICAS**
**NEW YORK, NY 10020**

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APR 13 2006
OFFICE OF PETITIONS

In re Application of :
Jae-Woo Roh et al :
Application No. 10/083,869 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. DE-1344 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 9, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-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 September 23, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on December 24, 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.

Pursuant to petitioner's authorization, Deposit Account No. 01-1944 was charged a total of $3,200.00 – $1,500.00 for the petition to revive an unintentionally abandoned application, $1,400.00 for the issue fee and $300 for the publication fee.

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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MOTOROLA, INC.
600 NORTH US HIGHWAY 45
W4 - 39Q
LIBERTYVILLE, IL 60048-5343

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OFFICE OF PETITIONS

In re Application of :
Kenneth Riordan :
Application No. 10/083,876 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. CS11457 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 6, 2009, to revive the above-identified application.

The application became abandoned for failure to file a reply to the non-final Office action mailed on June 23, 2008. A Notice of Abandonment was mailed on February 6, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 2455 for review of the amendment filed with the present petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

ZHONGZE BAI
14930 OKA ROAD #53
LOS GATOS, CA 95032

In re application of: :
Zhongze Bai :
Application No. 10/083,895 :
Filed: February 27, 2002 :
For: METHOD AND SYSTEM FOR LOCATING :
TARGET DISTINATIONS WITHIN SHORT RANGES :

DECISION ON REQUEST TO
WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as attorney/agent and change of correspondence address filed on September 26, 2005

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

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

All of the attorneys/agents associated with Customer Number 30781 have been withdrawn.

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

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

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Paper No. 6

Joseph N. Ziebert
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee WI 53202-5367

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OCT 14 2003
OFFICE OF PETITIONS

In re Application of
Uzodinma Okoroanyanwu et al.
Application No. 10/083,914
Filed: February 27, 2002
Attorney Docket No. 039153-0312 (F0799)
Title: SELF-ALIGNED PATTERN FORMATION USING DUAL WAVELENGTHS

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

This is a decision on the petition filed on September 15, 2003, pursuant to 37 C.F.R. §1.137(f), to revive the above-identified application.

A grantable petition pursuant to 37 CFR 1.137(f) must be accompanied by:

(1) Notification of the filing of an application in a foreign country or under a multinational treaty that requires 18 month publication[1];
(2) The petition fee as set forth in 37 C.F.R. § 1.17(m), and;
(3) A statement that the entire delay in filing the notice from the date that the notice was due under 35 U.S.C. §122(b)(2)(B)(iii) until the date the notice was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner states that the instant nonprovisional application is the subject of an application filed in either a foreign or an international application on February 21, 2003. However, the United States 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.

1 See PTO/SB/36 and paragraph on PTO/SB/64a for further information. Both may be downloaded at http://www.uspto.gov/web/forms/index.html.

On March 10, 2003, a Notice of Rescission of Nonpublication Request was filed with the Office. Unfortunately, notification of the filing of the international application did not accompany this filing.

In view of the above, this application became abandoned pursuant to 35 U.S.C. §1.22(b)(2)(B)(iii) and 37 C.F.R. §1.213(c) for failure to timely notify the Office of the filing of either a foreign application or an application under a multilateral international agreement that requires publication of applications 18 months after filing.

37 C.F.R. §1.137(f) requires a statement that the entire delay in filing the notice from the date that the notice was due under 35 U.S.C. §122(b)(2)(B)(iii) until the date the notice was filed was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(f), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.137(f) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

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

Petitioner has submitted the notification of either a foreign or an international filing, paid the petition fee, and has made a statement which is being construed as the proper statement of unintentional delay.

The instant petition has been found to be in compliance with 37 C.F.R. §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 C.F.R. §1.213(c) is accepted as having been unintentionally delayed.

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

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

Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

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Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 10

Ivor R. Elrifi, Esq.
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.
One Financial Center
Boston, MA 02111

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FEB 25 2003

OFFICE OF PETITIONS

In re Application of :
Sudhirdas Prayaga, :
Richard Shimkets, Kumud Majumder, :
Andrew Eisen, Corine Vernet, :
Steven Spaderna, Jason Baumgartner, :
Linda Gorman, Vladimir Gusev, :
Muralidhara Padigaru, :
Meera Patturajan, Velizar Tchernev, :
and Li Li :
Application No. 10/083,915 :
Filed: February 27, 2002 :
Attorney Docket No. 15966-575CIP :
(CURA-75CIP) :
Title: ENDOZEPINE-LIKE POLYPEPTIDES :
AND POLYNUCLEOTIDES ENCODING SAME :

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

This is in response to the "Petition for Filing Patent Application under 37 C.F.R. § 1.47(a)," filed November 22, 2002.

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

The above-identified application was filed on February 27, 2002, with an unexecuted declaration. Sudhirdas Prayaga, Richard Shimkets, Kumud Majumder, Andrew Eisen, Corine Vernet, Steven Spaderna, Jason Baumgartner, Linda Gorman, Vladimir Gusev, Muralidhara Padigaru, Meera Patturajan, Velizar Tchernev, and Li Li were named as joint inventors. Accordingly, on April 22, 2002, applicants were mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration, and a surcharge for its late filing. This Notice set a period for reply of two months, with extensions of time obtainable under § 1.136(a).

With the instant petition, petitioner submitted three separate declarations executed, in combination, by joint inventors Prayaga, Shimkets, Eisen, Vernet, Spaderna, Baumgartner, Gorman, Gusev, Padigaru, Patturajan, Tchernev and Li on behalf of themselves and on behalf of non-signing joint inventor Majumder; and paid the surcharge for late filing. To make this response timely, petitioner submitted a petition (and fee) for a extension of the period for response to November 22, 2002.

Applicant maintains that status under § 1.47(a) is proper because joint inventor Majumder has refused to join in the application. In support thereof, rule 47 applicants submit, *inter alia*:

- a copy of the cover letter dated October 25, 2002, transmitting the application papers to inventor Majumder by certified mail return receipt requested;

- a letter dated November 2, 2002, from inventor Majumder on the subject of signing patent applications and requesting payment for the time spent in processing the documents; and
- the petition signed by patent attorneys Ivor Elrifi and Christina Karnakis, which sets forth the circumstances of the presentation of the application papers and of the refusal of the inventor to join in the application and includes:
  - payment of the petition fee; and
  - a statement of the last known address of inventor Majumder.

The declarations filed November 22, 2002, have 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)[1].

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.

- The Notice mailed April 22, 2002, also required compliance with the requirements of 37 C.F.R. 1.821-1.825. In response to applicants' response filed November 22, 2002, on December 26, 2002, the Office mailed a "Notice to Comply with Requirements for Patent Applications containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures." This decision in no way extends the period for reply to the Notice mailed December 26, 2002.

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

Nancy Johnson
Petitions Attorney
Office of Petitions

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[1] 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.

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Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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DR. KUMUD MAJUMDER
2398 HIGH RIDGE RD.
STAMFORD, CT 06903

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FEB 25 2003

OFFICE OF PETITIONS

In re Application of
Sudhirdas Prayaga,
Richard Shimkets, Kumu
Andrew Eisen, Corine V
Steven Spaderna, Jason
Linda Gorman, Vladimir
Muralidhara Padigaru,
Meera Patturajan, Vel
and Li Li
Application No.
Filed: February 27, 2
Attorney Docket No. 1
(CURA-75CIP)
Title: ENDOZEPINE-LIK
AND POLYNUCLEOTIDES F

4

LETTER

Dear Dr. Majumder:

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
Petitions Attorney
Office of Petitions

Ivor R. Elrifi, Esq.
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.
One Financial Center
Boston, MA 02111
(617) 542-6000

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FISH & RICHARDSON PC
P.O. Box 1022
Minneapolis, MN 55440-1022

JUL 21 2006

In re Application of:
KALSI *et al.*
Serial No.: 10/083,927
Filed: February 27, 2002
Attorney Docket No.: **05770-170001 / AMSC-546**

*SUA SPONTE*
DECISION WITHDRAWING HOLDING OF ABANDONMENT

This is a decision, *sua sponte*, clarifying the record with respect to the Notice of Abandonment mailed September 08, 2004.

The application was held abandoned for failure to file an Appeal Brief after the receipt of the Notice of Appeal filed February 06, 2004.

A review of the written record indicates that at the time of mailing of the Notice of Abandonment, the maximum extendable time period in which to file the Appeal Brief Had not yet expired. A petition for a five (5) month extension of time, and a Request for Continued Examination were timely filed on September 09, 2004, that last day of the period. Accordingly, it appears that the Notice of Abandonment was mailed prematurely. Therefore, the application was not abandoned in fact.

For the above stated reason, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This decision merely clarifies the application file record, and does not have the effect of stopping, or starting any period for response. The examination of the application continues unabated.

Inquiries related to this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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

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|---|---|---|
| In re Application of | : | |
| Jonathan B. Rothbard et al | : | |
| Application No. 10/083,960 | : | DECISION ON PETITION |
| Filed: February 25, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 019801-000240US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 23, 2006.

The request is **NOT APPROVED**.

A review of the file record indicates that William B. Kezer and customer No. 20350 do not have power of attorney in this patent applications but has been employed or otherwise engaged in the proceedings in this patent application. However, the reason provided does not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one of the permissive reasons listed in 37 CFR 10.40(c). The reason set forth in the request is "Discontinuation of attorney/client relationship" do not meet any of the conditions set forth in 37 CFR 10.40.

Upon further review of the file record, there is no indication that a signed oath or declaration in compliance with 37 CFR 1.63 was filed within the two (2) months from the mail date of the Notice to File Missing Parts of Nonprovisional Application (Notice) mailed April 17, 2002. Therefore, this application became abandoned on June 18, 2002.

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

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

Amelia Au
Petitions Examiner
Office of Petitions

cc: ROBERT CERPA, PH.D
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304

UNITED STATES 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

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AUG 2 8 2006
OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO CA 94304-1018

In re Application of :
Jonathan B. Rothbard et al. :
Application No. 10/083,960 : DECISION ON PETITION
Filed: February 25, 2002 : UNDER 37 C.F.R. §1.181
Attorney Docket No.: 019801-000240US :
Title: COMPOSITIONS AND METHODS FOR ENHANCING DRUG DELIVERY ACROSS AND INTO OCULAR TISSUES :

This is a decision on the petition filed June 23, 2006, pursuant to 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed April 17, 2002, which set a shortened statutory period for reply of two months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on June 18, 2002.

The petition is further accompanied by a declaration, as well as a copy of applicants' postcard receipt acknowledging receipt of a "declaration" in the United States Patent and Trademark Office (Office) on June 24, 2002. It is noted that the submission contains a certificate of mailing dated June 17, 2002.

Upon review of the electronic record, the above-mentioned declaration has not been located among the application papers. However, the evidence is convincing that the declaration was

submitted to the Office on June 17, 2002, received on June 24, 2002, and subsequently misplaced in the Office.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the declaration was timely submitted.

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.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225[1]. 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

1 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 082604

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

SEP 15 2004

In re Application of:
STEVEN A. SUNSHINE
Serial No.: 10/083,984
Filed: February 27, 2002
Attorney Docket No.: **018564-002420US**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed March 08, 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 Joseph R. Snyder, on behalf of himself and all the attorneys/agents of record. There is no outstanding Office action at this time.

The request is **APPROVED**.

All future communications from the Office will be directed to Foley & Lardner, at the below address, until otherwise notified by applicant.

Inquiries related to this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Clayton E. LaBalle, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: FOLEY & LARDNER
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

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AUG 15 2005

OFFICE OF PETITIONS

MORGAN & FINNEGAN
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

In re Application of :
Akihiko Nagano :
Application No. 10/083,996 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 1232-4825 :

This is a decision on the petition, filed August 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 July 6, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 2878 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

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

Paper No. _____

Date : August 15, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Akihiko Nagano
Application No. :10/083,996
Filed :February 25, 2002

The above-identified application has been assigned Patent No. 6,936,804 and an issue date of August 30, 2005.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of August 30, 2005:

"All reference to Patent No. 6,936,804 to Akihiko Nagano of Japan for AN IMAGE SENSING ELEMENT WITH A PIXEL HAVING AT LEAST TWO LIGHT-RECEIVING REGIONS appearing in the Official Gazette of August 30, 2005 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
Tamara Greene, ST-8C13

**DO NOT SCAN! Please forward case and pap r to address shown below.**

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

Paper No.: _____

DATE : 6-01-06

TO SPE OF : ART UNIT 2878

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/083996 Patent No.: 7041950

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**

E. Ames

Please reply to IDS sent in by Applicant 8/15/05

**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:** IDS was already considered, signed & initialed copy mailed with Notice of Allowance to Applicant on 9/2/05.

Georgia Epps
SPE

2878
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

606/159,170,180
604/22

Paper No. 6

Perman and Green
425 Post Road
Fairfield, CT 06430

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MAR 1 9 2003

OFFICE OF PETITIONS

In re Application of :
Leonid Shturman, et al. :
Application No. 10/084,001 : ON PETITION
Filed: October 19, 2001 :
Attorney Docket No. 75-010455-US(PAR) :

This is in response to the petition under 37 CFR 1.47(a), filed October 30, 2002.

The petition is granted.

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

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

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

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

Telephone inquiries regarding this decision should be directed to Marianne Morgan at (703) 306-3475.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Leonid Shturman
26 Montgomery Lane
Greenwich, CT 06830

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MAR 1 9 2003

OFFICE OF PETITIONS

In re Application of
Leonid Shturman; Georgy Vasilevich Morov; and Michail Alekseevich Ermakov
Application No. 10/084,001
Filed: October 19, 2001
For: SELF-INDEXING COUPLING FOR ROTATIONAL ANGIOPLASTY DEVICE

Dear Leonid Shturman:

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

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

Telephone inquiries regarding this communication should be directed to Marianne Morgan at (703) 306-3475. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington, DC area).

Frances Hicks

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

cc: Perman & Green, LLp
425 Post Road
Fairfield, CT 06824

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20090925

**DATE** : September 25, 2009

**TO SPE OF** : ART UNIT 2611

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,502,406

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:**

Typo error only, there's no change in the scope of the claims.

/David C. Payne/
Supervisory Patent Examiner, Art Unit 2611

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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MAY 19 2005

Law Offices of Brian S. Steinberger
101 Brevard Avenue
Cocoa, FL 32922

Paper No. 8

| | | |
|---|---|---|
| In re Application of | : | DECISION ON PETITION |
| Charles Crosby et al | : | TO WITHDRAW |
| Serial No. : 10/084,008 | : | HOLDING OF |
| Filed : February 27, 2002 | : | ABANDONMENT |
| For : Pulse Cam | : | |

This is a decision on petitioner's request filed May 12, 2005, to review the holding of abandonment mailed August 13, 2004, for failure to respond to the Office action mailed November 5, 2003. There is no fee required for this petition.

In support of the request, petitioner has provided a statement that on February 5, 2004 a response to the Office action mailed November 5, 2003 was filed in accordance with the procedures set forth in 37 CFR 1.8. The communications included a Certificate of First Class Mailing dated February 5, 2004. A true copy of the February 5, 2004 communication has been provided.

In view of the above, 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, processing and consideration of the communication mailed February 5, 2004.

Summary: Holding of Abandonment Withdrawn.

/Richard A Bertsch/

Richard A. Bertsch, Director
Technology Center 3700
Phone: (571) 272-3750

ak/05/13/05

#20
DW

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JUN 16 2004

MAILED

JUN 16 2004

OFFICE OF THE DIRECTOR
TC 3600

Fox Rathschild O'Brien & Frankel, LLP
Tenth Floor
2000 Market Street
Philadelphia, PA 19103

In re Application of
Stephen B. Maguire
Application No. 10/084,030
Filed: February 27, 2002
For: VACUUM LOADING SYSTEM

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is in response to the Petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on May 12, 2004.

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

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____.

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

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

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

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

☒ Originally sent response filed April 23, 2004 has been found and matched with the application.

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

KJD/vdb: 6/03/04

KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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GIFFORD, KRASS, GROH, SPRINKLE &
CITKOWSKI, P.C.
PO BOX 7021
TROY MI 48007-7021

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JAN 12 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bernadino J. Payone | : | |
| Application No. 10/084,045 | : | DECISION GRANTING PETITION |
| Filed: February 22, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 65,160-040 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed September 5, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Nonfinal Rejection of March 10, 2005, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 3624.

/Karen Creasy/

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

GIFFORD, KRASS, SPRINGER,
ANDERSON & CITKOWSKI, P.C.
P.O. BOX 7021
TROY, MI 48007-7021

In re Application of :
Bernadino J. PAYONE :
Application No. 10/084,045 : DECISION ON PETITION
Filed: February 22, 2002 : TO WITHDRAW
Attorney Docket No. 65,160-040 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 8, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney given to Mark D. Schneider has been revoked by the applicant of the patent application on January 23, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

There is an outstanding Office action mailed April 16, 2007 that requires a reply by the applicant.

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

April Wise
Petitions Examiner
Office of Petitions

cc: BERNADINO PAVONE
3995 LAKELAND LANE
BLOOMFIELD HILLS, MI 48302

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Paper No. 22

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

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SEP 17 2004

OFFICE OF PETITIONS

In re Application of :
David Whitmore et al :
Application No. 10/084,049 : DECISION ON PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. P21585

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 2, 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;
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on February 28, 2002, 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, and the Application Data Sheet (ADS) as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after

expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

A 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 Irvin Dingle at (703) 306-5684.

This application is being forwarded to Technology Center Art Unit 2666 for appropriate action on the amendment filed March 2, 2004, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional 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
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Paper No. 8

PENNIE & EDMONDS LLP
1667 K STREET NW
SUITE 1000
WASHINGTON DC 20006

MAILED

FEB 0 4 2003

Technology Center 2600

In re Application of :
Pak Shing Cho et al :
Application No. 10/084,057 : DECISION ON REQUEST TO
Filed: February 28, 2002 : WITHDRAW AS ATTORNEY
For: **METHOD AND SYSTEM FOR MITIGATING NONLINEAR TRANSMISSION IMPAIRMENTS IN FIBER-OPTIC COMMUNICATIONS SYSTEMS** :

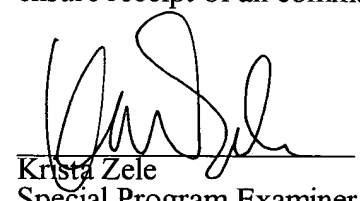
This is a decision on the request to withdraw as attorney/agent of record filed on January 14, 2003.

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

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application are removed from record.

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



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

cc: Isaac Shpantzer, Ph. D.
Chief Technical Officer
CeLight, Inc.
12200 Tech Road, Suite 300
Silver Spring, MD 20904

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAPAN

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OFFICE OF PETITIONS

In re Application of :
Kiichi Yatani :
Application No. 10/084,072 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. N/A :

This is a decision on the papers filed June 23, 2005 and June 30, 2005, which have been treated as a petition under 37 CFR 1.181, to withdraw the holding of abandonment. The papers were recently forwarded to this office for review.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

This application became abandoned for failure to timely file a proper reply to the non-final Office action mailed March 8, 2004. Accordingly, this application became abandoned on June 9, 2004. A Notice of Abandonment was mailed on May 17, 2005.

Please note, an Office communication was mailed on May 26, 2004, in response to applicants' April 12, 2004 and April 20, 2004 submissions. Furthermore, an Office communication was mailed on March 23, 3005, in response to applicants' October 15, 2004 submission.

Petitioner has not provided any argument or documentary support for a request to withdraw the holding of abandonment. As such, the petition must be dismissed.

Petitioner should consider filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137. The Manual of Patent Examining Procedure, Section 711.03(c), provides a general discussion of the procedures for filing the aforementioned petitions. A copy of the section is forwarded herewith for your information.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

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

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

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

Attachments:
Copy of MPEP 711.03(c)
Form PTO/SB/61
Form PTO/SB/64

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Notice regarding Section 508 of the **Workforce Investment Act of 1998**. Section 508 of the Workforce Investment Act of 1998 requires all United States Federal Agencies with websites to make them accessible to individuals with disabilities. At this time, the MPEP [HTML] files below do not meet all standards for web accessibility. Until changes can be made to make them fully accessible to individuals with disabilities, the USPTO is providing access assistance via telephone. MPEP Interim Accessibility Contact: 571-272-8813.

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## 711.03(c) Petitions Relating to Abandonment [R-3] - 700 Examination of Applications

**711.03(c) Petitions Relating to Abandonment [R-3]**

**37 CFR 1.135 Abandonment for failure to reply within time period.**

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

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

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

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**37 CFR 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.**

(a) *Unavoidable.* If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ **1.550(d)** or **1.957(b)** or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § **1.17(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 paragraph (d) of this section.

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ **1.550(d)** or **1.957(b)** or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § **1.17(m)**;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

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

(c) *Reply.* 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 include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) *Terminal disclaimer.*

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § **1.321** dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § **1.321** dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. **120**, **121**, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. **120**, **121**, or **365(c)** to the application for which revival is sought.

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(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.<

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § **1.136** for an abandoned application or lapsed patent;

(2) The provisions of § **1.550(c)** for a terminated *ex parte* reexamination proceeding filed under § 1.510; or

(3) The provisions of § **1.956** for a terminated *inter partes* reexamination proceeding filed under § **1.913**.

(f) *Abandonment for failure to notify the Office of a foreign filing*: A nonprovisional application abandoned pursuant to 35 U.S.C. **122(b)(2)(B)(iii)** for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived only pursuant to paragraph (b) of this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications:* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. **119(e)(3)** and **§ 1.7(b)**, a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

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**37 CFR 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

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

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

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(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § **41.3** of this title.<

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

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## I. PETITION TO WITHDRAW HOLDING OF ABANDONMENT

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under **37 CFR 1.181(a)** requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under **37 CFR 1.137** (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

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

### A. *Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action*

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( **35 U.S.C. 151**) or for failure to prosecute ( **35 U.S.C. 133**).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

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).

### B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 CFR **1.10**(c) through **1.10**(e) >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 CFR **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 CFR **1.8**, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR **1.8**(b) and MPEP § **512**. As stated in 37 CFR **1.8**(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR **1.8**).

>37 CFR **1.8**(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 CFR **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**.<

### C. Treatment of Untimely Petition To Withdraw Holding of Abandonment

37 CFR **1.181**(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR **1.181**) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR **1.181** (f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR **1.181**(f), the Office may require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.

#### 1. 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:

(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.

Form PTO/SB/62 is the appropriate terminal disclaimer to be used.

**(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.

Form PTO/SB/62 is the appropriate terminal disclaimer to be used.

**2. Utility and Plant Applications Filed on or After June 8, 1995 but Before May 29, 2000**

In utility and plant applications filed on or after June 8, 1995, but before May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. However, the Office of Patent Legal Administration (OPLA) must be consulted in such situations if the holding of abandonment involves a period during: (A) appellate review by the Board of Patent Appeals and Interferences; (B) an interference proceeding under 35 U.S.C. **135**(a), including any suspension due to an interference proceeding; or (C) which the application was in a sealed condition or prosecution was suspended due to a secrecy order under 35 U.S.C. **181**. This is because it is necessary to effect (if appropriate) a reduction of patent term extension under the "due diligence" provisions of 37 CFR **1.701**(d)(2).

**3. Utility and Plant Applications Filed on or After May 29, 2000**

In utility and plant applications filed on or after May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. This is because any patent term adjustment is automatically reduced under the provisions of 37 CFR **1.704**(c)(4) in applications subject to the patent term adjustment provisions of the American Inventors Protection Act of 1999 (AIPA) if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, and if applicant does not receive the notice of abandonment, any patent term adjustment is reduced under the provisions of 37 CFR **1.704**(a) by a period equal to the period of time during which the applicant "failed to engage in reasonable efforts to conclude prosecution" (processing or examination) of the application.

Where the record indicates that the applicant intentionally delayed the filing of a petition to withdraw the holding of abandonment, the Office may simply dismiss the petition as untimely (37 CFR **1.181** (f)) solely on the basis of such intentional delay in taking action in the application without further addressing the merits of the petition. Obviously, intentional delay in seeking the revival of an abandoned application precludes relief under 37 CFR **1.137**(a) or (b) (discussed below).

**II. PETITIONS TO REVIVE AN ABANDONED APPLICATION, OR ACCEPT LATE PAYMENT OF ISSUE FEE**

**37 CFR 1.137** provides for the revival of abandoned applications and lapsed patents for the failure:

(A) to timely reply to an Office requirement in a provisional application;

(B) to timely prosecute in a nonprovisional application;

(C) to timely pay the issue fee for a design application;

(D) to timely pay the issue fee for a utility or plant application; and

(E) to timely pay any outstanding balance of the issue fee (lapsed patents).

A petition under **37 CFR 1.137(a)** requires:

(A) the required reply, unless previously filed;

(B) the petition fee as set forth in **37 CFR 1.17(l)**;

(C) a showing to the satisfaction of the Director of the USPTO 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

(D) any terminal disclaimer required pursuant to **37 CFR 1.137(d)**.

A petition under **37 CFR 1.137(b)** requires:

(A) the required reply, unless previously filed;

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

(C) 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

(D) any terminal disclaimer required pursuant to **37 CFR 1.137(d)**.

The Director of the USPTO may require additional information where there is a question whether the delay was unintentional.

**A. Reply Requirement**

Unlike a petition to withdraw the holding of abandonment, a petition to revive under **37 CFR 1.137** must be accompanied by, *inter alia*, the required reply. See *Ex parte Richardson*, 1906 Dec. Comm'r Pat. 83 (1905) ("This Office has no authority to revive a case upon which no action has been taken within [the period for reply], but merely has authority to determine after an action is taken whether the delay in presenting it was unavoidable."). Generally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed. A petition for an extension of time under 37 CFR **1.136** and a fee for such an extension of time are not required to be included with the reply.

37 CFR **1.137(c)** applies to the reply requirement for petitions under 37 CFR **1.137(a)** and (b). 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 (RCE) in compliance with 37 CFR **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 include payment of the issue fee or any outstanding balance. In an application,

abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. See below for more details on the reply requirement in specific situations of abandonment.

**1. Abandonment for Failure To Pay the Issue Fee or Publication Fee**

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in **37 CFR 1.137**, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive. See *Brenner v. Ebbert*, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968). **35 U.S.C. 151** authorizes the acceptance of a delayed payment of the issue fee, if the issue fee "is submitted ... and the delay in payment is shown to have been unavoidable." **35 U.S.C. 41(a)**(7) likewise authorizes the acceptance of an "unintentionally delayed payment of the fee for issuing each patent." Thus, **35 U.S.C. 41(a)**(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Therefore, the filing of a continuing application without payment of the issue fee or any outstanding balance thereof is not an acceptable reply in an application abandoned or patent lapsed for failure to pay the issue fee or any portion thereof.

The Notice of Allowance requires the timely payment of the issue fee in effect on the date of its mailing to avoid abandonment of the application. In instances in which there is an increase in the issue fee by the time of payment of the issue fee required in the Notice of Allowance, the Office will mail a notice requiring payment of the balance of the issue fee then in effect. See *In re Mills*, 12 USPQ2d 1847, 1848 (Comm'r Pat. 1989). The phrase "for failure to pay the issue fee or any portion thereof" applies to those instances in which the applicant fails to pay either the issue fee required in the Notice of Allowance or the balance of the issue fee required in a subsequent notice. In such instances, the reply must be the issue fee then in effect, if no portion of the issue fee was previously submitted, or any outstanding balance of the issue fee then in effect, if a portion of the issue fee was previously submitted.

In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. Even if an application abandoned for failure to pay the publication fee is being revived solely for purposes of continuity with a continuing application, the petition to revive under 37 CFR **1.137** must include payment of the publication fee.

**2. Abandonment for Failure To Reply in a Nonprovisional Application**

**(a) Abandonment for Failure To Reply to a Non-Final Action**

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR **1.111**;

(B) the filing of a continuing application under 37 CFR **1.53(b)** (or a continued prosecution application (CPA) under 37 CFR **1.53(d)** if the application is a design application).

The grant of a petition under 37 CFR **1.137** is not a determination that any reply under 37 CFR **1.111** is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under **37 CFR 1.135(c)** for correction of the error or omission. Extensions of time under 37 CFR **1.136(a)** are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

**(b) Abandonment for Failure To Reply to a Final Action**

A reply under 37 CFR **1.113** to a final action must include a request for continued examination (RCE) under 37 CFR **1.114** or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR **1.116** that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance;

(C) the filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR **1.111** and the requisite fee) under 37 CFR **1.114** for utility or plant applications filed on or after June 8, 1995 (see paragraph **(d)** below); or

(D) the filing of a continuing application under 37 CFR **1.53(b)** (or a CPA under 37 CFR **1.53(d)** if the application is a design application).

When a notice of appeal is the reply filed pursuant to 37 CFR **1.137(a)(1)** or **1.137(b)(1)**, the time period under 37 CFR ***>41.37<** for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

An application subject to a final action in which a proposed amendment under 37 CFR **1.116** is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. *>Form< PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection. For Image File Wrapper (IFW) processing, see IFW Manual.

**(c) Abandonment for Failure To File an Appeal Brief**

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR **1.137(a)(1)** or **1.137(b)(1)** must be either:

(A) an appeal brief in compliance with 37 CFR *>41.37 **(c)<** and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR **1.114** for utility or plant applications filed on or after June 8, 1995 (see paragraph **(d)** below); or

(C) the filing of a continuing application under 37 CFR **1.53(b)** (or a CPA under 37 CFR **1.53(d)** if the application is a design application).

**(d) Filing an RCE as the Required Reply**

For utility or plant applications abandoned for failure to reply to a final Office action or for failure to file an appeal brief, the required reply may be the filing of an RCE accompanied by a submission and the requisite fee. When an RCE is the reply filed pursuant to 37 CFR **1.137(a)(1)** or **1.137(b)(1)**

to revive such an application, the submission accompanying the RCE must be a reply responsive within the meaning of 37 CFR **1.111** to the last Office action. Consideration of whether the submission is responsive within the meaning of 37 CFR **1.111** to the last Office action is done without factoring in the "final" status of such action. The submission may be a previously filed amendment after final or a statement that incorporates by reference the arguments in a previously filed appeal or reply brief. See MPEP § **706.07(h)**, paragraph II.

The petition may be granted if the submission appears to be a *bona fide* attempt to provide a complete reply to the last Office action. After revival of the application, the examiner may, upon a more detailed review, determine that the reply is lacking in some respect. In this limited situation, the examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR **1.135 (c)** for correction of the error or omission. Extensions of time under 37 CFR **1.136(a)** are permitted. If the applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

**(e) A Continuing Application or RCE May Be Required by the Office**

The Office may require the filing of a continuing application or an RCE (if the prosecution prior to abandonment was closed) (or request for further examination pursuant to **37 CFR 1.129(a)**) to meet the reply requirement of **37 CFR 1.137(a)**(1) (or **37 CFR 1.137(b)**(1)) where, under the circumstances of the application, treating a reply under **37 CFR 1.111** or 1.113 would place an inordinate burden on the Office. Exemplary circumstances of when treating a reply under **37 CFR 1.111** or 1.113 may place an inordinate burden on the Office are where:

(A) an application has been abandoned for an inordinate period of time;

(B) an application file contains multiple or conflicting replies to the last Office action; or

(C) the reply or replies submitted under **37 CFR 1.137(a)**(1) (or **37 CFR 1.137(b)**(1)) are questionable as to compliance with **37 CFR 1.111** or 1.113.

**3. Abandonment for Failure To Notify the Office of a Foreign Filing After the Submission of a Non-Publication Request**

If an applicant makes a nonpublication request upon filing with the appropriate certifications, the utility or plant application filed on or after November 29, 2000 will not be published under 35 U.S.C. **122(b)(1)**. See 35 U.S.C. **122(b)(2)(B)(i)**. If an applicant makes a nonpublication request and then rescinds, pursuant to 35 U.S.C. **122**(b)(2)(B)(ii), the nonpublication request before or on the date a counterpart application is filed in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, the nonpublication request will be treated as annulled and the application will be treated as if the nonpublication request were never made. See MPEP § **1123** and § **1124**. An applicant who has made a nonpublication request, but who subsequently files an application directed to the invention disclosed in the U.S. application in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication before the nonpublication request is rescinded, must, in addition to the rescission, notify the Office of such filing within forty-five days after the date of such filing. The requirement in 35 U.S.C. **122**(b)(2)(B)(iii) for notice of the foreign filing is in addition to any rescission of the nonpublication request under 35 U.S.C. **122**(b)(2)(B)(ii). If an applicant files a counterpart application in a foreign country after having filed an application in the USPTO with a nonpublication request, filing a rescission of the nonpublication request under 35 U.S.C. **122**(b)(2)(B)(ii) without also providing a notice of the foreign filing in a timely manner will result in the abandonment of the U.S. application under 35 U.S.C. **122** (b)(2)(B)(iii). 35 U.S.C. **122(b)(2)(B)(iii)**, however, also provides that an application abandoned as a result of the failure to timely provide such a notice to the Office is subject to revival if the "delay in submitting the notice was unintentional."

35 U.S.C. **122(b)(2)(B)(iii)** provides for revival only on the basis of unintentional delay, and not on the basis of unavoidable delay. Therefore, a nonprovisional application abandoned pursuant to 35 U.S.C. **122(b)(2)(B)(iii)** for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires eighteen-month publication may be

revived only on the basis of unintentional delay pursuant to 37 CFR **1.137(b)**. The reply requirement of 37 CFR **1.137(c)** is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under 37 CFR **1.137(b)** will not operate to stay any period for reply that may be running against the application. Since the Office cannot ascertain whether an application is abandoned under 35 U.S.C. **122(b)(2)(B)(iii)**, the Office may continue to process and examine the application until the Office is notified of applicant's failure to meet the forty-five days notice requirement of 35 U.S.C. **122(b)(2)(B)(iii)**. Therefore, the filing of a petition under 37 CFR **1.137(b)** to revive such an application will not operate to stay any period for reply that may be running against the application. Applicants may use form PTO/SB/64a to file a petition for revival under **37 CFR 1.137**(b).

**B. Petition Fee Requirement**

**35 U.S.C. 41(a)**(7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in **37 CFR 1.17(m)**, unless the petition is filed under **35 U.S.C. 133** or 151 (on the basis of unavoidable delay), in which case the fee is set forth in **37 CFR 1.17(l)**. Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

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

The phrase "unless the petition is filed under [35 U.S.C.] 133 or 151" signifies that petitions to revive filed on the basis of "unavoidable" delay (under **35 U.S.C. 133** or 151) are a subset of petitions to revive filed on the basis of unintentional delay. That is, "unavoidable" delay and "unintentional" delay are not alternatives; "unavoidable" delay is the epitome of "unintentional" delay. Any petition to revive an abandoned application or lapsed patent must meet the minimal "unintentional" delay threshold, and an applicant need only pay the fee specified in **37 CFR 1.17(l)** (rather than the fee specified in **37 CFR 1.17(m)**) if the petition is also accompanied by an adequate showing 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.

**C. Unintentional and Unavoidable Delay**

Petitions under 37 CFR **1.137**(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file and are evaluated under the less stringent "unintentional delay" standard. Applicants determining whether to file a petition to revive an application under 37 CFR **1.137**(b) or **1.137**(a) should take the following into account:

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR **1.137**(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR **1.137**(b). This is because the applicant is obligated under 37 CFR **10.18** to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR **1.137**(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent resulting from the application. See *Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished)(patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that

the abandonment was unintentional).

Even if the Office requires further information in a petition under 37 CFR **1.137**(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR **1.137**(a). The Office is almost always satisfied as to whether "the entire delay.was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § **711.03**(c)(III)(C)(2). In addition, a petition under 37 CFR **1.137**(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR **1.137**(a) end up being granted under 37 CFR **1.137**(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR **1.137**(a).

Since the requirements of 37 CFR **1.137**(a) are more exacting than the corresponding requirements of 37 CFR **1.137**(b), a petition under 37 CFR **1.137**(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR **1.137**(b). The Office usually must render a number of interlocutory decisions dismissing a petition under 37 CFR **1.137**(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR **1.137**(a) than it would have been if the petition were under **37 CFR 1.137**(b).

#### 1. Unintentional Delay

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), reveals that the purpose of **35 U.S.C. 41(a)**(7) is to permit the Office to have more discretion than in **35 U.S.C. 133** or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion stating that "[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of **37 CFR 1.137(b)**.

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of **37 CFR 1.137(b)**. See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of **37 CFR 1.137(b)** because:

(A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;

(B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;

(C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;

(D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or

(E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

In order to expedite treatment, applicants filing a petition under 37 CFR **1.137**(b) to revive an abandoned application are advised to include the statement "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," even if applicant chooses to include a statement of the facts concerning the delay. Applicants may use the forms provided by the Office (PTO/SB/64, PTO/SB/64a, or PTO/SB/64PCT).

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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 *Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (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).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988). For 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:

(A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see **MPEP § 403**); or

(C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *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). For example, as **37 CFR 1.116** and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, 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. Likewise, as a "reasonably prudent person" would file papers or fees in compliance with **37 CFR 1.8** or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with **37 CFR 1.8** and 1.10 does not constitute "unavoidable" delay. See *Krahn*, 15 USPQ2d at 1825. Finally, 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: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO'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).

**35 U.S.C. 133** and 151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See *In re Application of Takao*, 17 USPQ2d 1155 (Comm"r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under **37 CFR 1.137(a)** to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under **37 CFR 1.137(a)** "promptly" upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show 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 removal of the language in **37 CFR 1.137(a)** requiring that any petition thereunder be "promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment" should **not** be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment of the application, to delay the filing of a petition under **37 CFR 1.137(a)**; or (B) changing (or modifying) the result in *In re Application of S*, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under **37 CFR 1.137(a)** was denied due to the applicant's deliberate deferral in filing a petition under **37 CFR 1.137**. An applicant who deliberately chooses to delay the filing of a petition under **37 CFR 1.137** (as in *Application of S*, 8 USPQ2d at 1632) will not be able to show 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" or even make an appropriate 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 dismissal or denial of a petition under **37 CFR 1.137(a)** does not preclude an applicant from obtaining relief pursuant to **37 CFR 1.137(b)** on the basis of unintentional delay (unless the decision dismissing or denying the petition under **37 CFR 1.137(a)** indicates otherwise). In such an instance, a petition under **37 CFR 1.137(b)** may be filed accompanied by the fee set forth in **37 CFR 1.17(m)**, the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to **37 CFR 1.137(b)** was unintentional, and any terminal disclaimer required by **37 CFR 1.137(c)**.

Form PTO/SB/61 or PTO/SB/61PCT may be used to file a petition for revival of an unavoidably abandoned application.

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

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

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

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of **37 CFR 1.137(b)**, where the applicant deliberately permits the application to become abandoned. See *Application of G*, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of **37 CFR 1.137(b)**. An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

(A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;

(B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or

(C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to **37 CFR 1.137**. See *Maldague*, 10 USPQ2d at 1478.

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to **37 CFR 1.137(a)** or (b), when such petition is filed: (A) within 3 months of the date the applicant is first notified that the application is abandoned; **and** (2) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to **37 CFR 1.137** within 3 months of the first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application).

Where a petition pursuant to **37 CFR 1.137(a)** or (b) is not filed within 3 months of the date the applicant is first notified that the application is abandoned, the Office will consider there to be a question as to whether the delay was unavoidable or unintentional. In such instances,

(A) the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a **37 CFR 1.137(a)** petition was filed was "unavoidable"; or

(B) the Office may require further information as to the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a **37 CFR 1.137(b)** petition was filed, and how such delay was "unintentional."

To avoid delay in the consideration of the merits of a petition under **37 CFR 1.137(a)** or (b) in instances in which such petition was not filed within 3 months of the date the applicant was first notified that the application was abandoned, applicants should include a showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under **37 CFR 1.137** was (A) "unavoidable" in a petition under

**37 CFR 1.137(a)**; or (B) "unintentional" in a petition under **37 CFR 1.137(b)**.

Where a petition pursuant to **37 CFR 1.137(a)** or (b) is not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment) the Office will require:

(A) further information as to when the applicant (or the applicant's representative) first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative) (see *Pratt*, 1887 Dec. Comm'r Pat. at 32-33).

To avoid delay in the consideration of the merits of a petition under **37 CFR 1.137(a)** or (b) in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

(A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under **37 CFR 1.137(a)** or **37 CFR 1.137(b)**, regardless of the circumstances that originally resulted in the abandonment of the application.

#### E. Party Whose Delay Is Relevant

The question under **37 CFR 1.137** is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under **37 CFR 1.137**, unless the third party has reassigned the application to the applicant prior to the due date for the reply. *Id.*

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

#### F. Burden of Proof To Establish Unavoidable or Unintentional Delay

**37 CFR 1.137(a)**(3) requires a showing to the satisfaction of the Director of the USPTO 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. Therefore, the Office will require the

applicant in every petition under **37 CFR 1.137(a)** to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unavoidable. See *Haines*, 673 F. Supp. at 316-17, 5 USPQ2d at 1131-32.

**37 CFR 1.137(b)**(3) requires that a petition under **37 CFR 1.137(b)** must be accompanied by a statement that the entire delay in providing 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, but also provides that "[t]he Director may require additional information where there is a question whether the delay was unintentional." While the Office will generally require only the statement that the entire delay in providing 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 Office may require an applicant to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of **35 U.S.C. 41(a)**(7) and **37 CFR 1.137(b)** where there is a question whether the entire delay was unintentional. See *Application of G*, 11 USPQ2d at 1380.

**G. Terminal Disclaimer Requirement**

**37 CFR 1.137(d)** requires that a petition under either **37 CFR 1.137(a)** or 1.137(b) be accompanied by a terminal disclaimer (and fee), regardless of the period of abandonment, in:

(A) a design application;

(B) a nonprovisional utility application >(other than a reissue application)< filed before June 8, 1995; or

(C) a nonprovisional plant application >(other than a reissue application)< filed before June 8, 1995.

In addition, a terminal disclaimer (and fee) is also required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order. The reason being that utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. **154**(b) (as a result of the Uruguay Round Agreements Act (URAA)). See **35 U.S.C. 154(b)** (1999); see also **37 CFR 1.701**. If such an application is abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order, the patentee of a patent issuing from such an application is eligible for patent term extension for the entire period of abandonment. The requirement for a terminal disclaimer for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public. For utility and plant applications filed on or after May 29, 2000, a terminal disclaimer (and fee) is not required since the period of abandonment is reduced from the patent term adjustment pursuant to **37 CFR 1.704**.

The terminal disclaimer submitted in a design application must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer submitted in either a utility or plant application filed before June 8, 1995 must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of: (1) the period of abandonment of the application; or (2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. **120**, **121**, or **365(c)**, from the date on which the earliest such application was filed. The terminal disclaimer must also apply to any patent granted on any continuing utility or plant application filed before June 8, 1995, or any continuing design application, entitled under 35 U.S.C. **120**, **121**, or **365(c)** to the benefit of the filing date of the application for which revival is sought. The terminal disclaimer requirement of 37 CFR **1.137(d)** does not apply to >(A)< applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, **>(B)< lapsed patents>, (C) reissue applications, or (D) reexamination proceedings<.

The Office cannot determine (at the time a petition to revive is granted) the period disclaimed (i.e., which period is lesser: the period of abandonment of the application, or the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. **120**, **121**, or **365(c)**, from the date on which the earliest such application was filed). Therefore, the Office will not indicate the period disclaimed under 37 CFR **1.137(d)** in its decision granting a petition to revive an abandoned application.

The filing of a terminal disclaimer is not a substitute for unavoidable or unintentional delay. See *Application of Takao*, 17 USPQ2d at 1159. The requirement that the entire delay have been unavoidable ( **37 CFR 1.137(a)**) or at least unintentional ( **37 CFR 1.137(b)**) is distinct from the requirement for a terminal disclaimer. Therefore, the filing of a terminal disclaimer cannot excuse an intentional delay in filing a petition or renewed petition to revive an abandoned application. Likewise, an unavoidable or unintentional delay in filing a petition or renewed petition to revive an abandoned application will not warrant waiver of the terminal disclaimer requirement of **37 CFR 1.137(d)**.

In the event that an applicant considers the requirement for a terminal disclaimer to be inappropriate under the circumstances of the application at issue, the applicant should file a petition under **37 CFR 1.183** (and petition fee) to request a waiver of this requirement of **37 CFR 1.183**. Such a petition may request waiver of this requirement *in toto*, or to the extent that such requirement exceeds the period considered by applicant as the appropriate period of disclaimer. The grant of such a petition, however, is strictly limited to situations wherein applicant has made a showing of an "extraordinary situation" in which "justice requires" the requested relief. An example of such a situation is when the abandonment of the application caused no actual delay in prosecution (e.g., an application awaiting decision by the Board of Appeals and Interferences during period of abandonment).

Forms PTO/SB/62 and PTO/SB/63 may be used when filing a terminal disclaimer in accordance with **37 CFR 1.137(d)**.

**>

revive an abandoned application or lapsed patent must be filed within 2 months of the decision refusing to revive or within such time as set in the decision. **37 CFR 1.137(e)** further provides that, unless a decision indicates otherwise, this time period for requesting reconsideration or review may be extended under the provisions of **37 CFR 1.136**.

**37 CFR 1.137(e)** specifies a time period within which a renewed petition pursuant to **37 CFR 1.137** must be filed to be considered timely. Where an applicant files a renewed petition, request for reconsideration, or other petition seeking review of a prior decision on a petition pursuant to **37 CFR 1.137** outside the time period specified in **37 CFR 1.137(e)**, the Office may require, *inter alia*, a specific showing as to how the entire delay was "unavoidable" ( **37 CFR 1.137(a)**) or "unintentional" ( **37 CFR 1.137(b)**). As discussed above, a delay resulting from the applicant deliberately choosing not to persist in seeking the revival of an abandoned application cannot be considered "unavoidable" or "unintentional" within the meaning of **37 CFR 1.137**, and the correctness or propriety of the decision on the prior petition pursuant to **37 CFR 1.137**, the correctness of the applicant's (or the applicant"s representative"s) decision not to persist in seeking revival, the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision to not persist in seeking revival are immaterial to such intentional delay caused by the deliberate course of action chosen by the applicant.

**I. Provisional Applications**

**37 CFR 1.137** is applicable to a provisional application abandoned for failure to reply to an Office requirement. A petition under **37 CFR 1.137(a)** or (b) must be accompanied by any outstanding reply to an Office requirement, since **37 CFR 1.137(a)**(1) and 1.137(b)(1) permit the filing of a continuing application in lieu of the required reply only in a nonprovisional application.

**35 U.S.C. 111(b)**(5) provides that a provisional application shall be regarded as abandoned 12 months after its filing date and shall not be subject to revival after such 12-month period. 37 CFR **1.137(g)** provides that a provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to 37 CFR **1.137**, however a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances. Note that the pendency of a provisional application is extended to the next succeeding secular or business day if the day that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See **35 U.S.C. 119(e)(3)**.

A provisional application may be abandoned prior to 12 months from its filing date for failure to reply to an Office requirement (e.g., failure to submit the filing fee and/or cover sheet). Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than 12 months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than 12 months from the filing date of the provisional application but only to revive the application for the 12-month period following the filing of the provisional application. Thus, even if the petition were granted to establish the pendency up to the end of the 12-month period, the provisional application would not be considered pending after 12 months from its filing date.

**browse after**

PTO/SB/61 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a) | Docket Number (Optional) |
|---|---|

First Named Inventor: Art Unit:

Application Number: Examiner:

Filed:

Title:

Attention: Office of Petitions
**Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United Sates Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.**

NOTE: A grantable petition requires the following items:
(1) Petition fee.
(2) Reply and/or issue fee.
(3) Terminal disclaimer with disclaimer fee-required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
(4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☐ Small entity – fee $_____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $_____ (37 CFR 1.17(l)).

2. Reply and/or fee

A The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):

☐ has been filed previously on _____ .

☐ is enclosed herewith.

B The issue fee of $ _____

☐ has been filed previously on _____ .

☐ is enclosed herewith.



This collection of information is required by 37 CFR 1.137(a). 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 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

**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.**

_____ Signature

_____ Date

_____ Typed or printed name

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

Enclosure
☐ Fee Payment
☐ Reply
☐ Terminal Disclaimer Form
☐ Additional sheets containing statements establishing unavoidable delay
☐ _____

**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ Date

_____ Signature

_____ Typed or printed name of person signing certificate

PTO/SB/61 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

| | |
|---|---|
| Signature | Date |
| Typed or printed name | Registration Number, if applicable |

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

*(Please attach additional sheets if additional space is needed.)*

## Privacy Act Statement

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

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

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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**D. Delay Until the Filing of a Grantable Petition**

There are three periods to be considered during the evaluation of a petition under **37 CFR 1.137**:

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KIICHI YATANI
11-24 HONDEN-1 NISHIKU
OASAKA
JAPAN

In re Application of
Kiichi Yatani
Application No. 10/084,072
Filed: February 27, 2002
Attorney Docket No. N/A

ON PETITION

This is a decision on the papers filed June 23, 2005 and June 30, 2005, which have been treated as a petition under 37 CFR 1.181, to withdraw the holding of abandonment. The papers were recently forwarded to this office for review.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

This application became abandoned for failure to timely file a proper reply to the non-final Office action mailed March 8, 2004. Accordingly, this application became abandoned on June 9, 2004. A Notice of Abandonment was mailed on May 17, 2005.

Please note, an Office communication was mailed on May 26, 2004, in response to applicants' April 12, 2004 and April 20, 2004 submissions. Furthermore, an Office communication was mailed on March 23, 3005, in response to applicants' October 15, 2004 submission.

Petitioner has not provided any argument or documentary support for a request to withdraw the holding of abandonment. As such, the petition must be dismissed.

Petitioner should consider filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137. The Manual of Patent Examining Procedure, Section 711.03(c), provides a general discussion of the procedures for filing the aforementioned petitions. A copy of the section is forwarded herewith for your information.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

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

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

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

Attachments:
Copy of MPEP 711.03(c)
Form PTO/SB/61
Form PTO/SB/64

UNITED STATES 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 H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

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JUL 29 2005

OFFICE OF PETITIONS

In re Application of :
Cok et al. :
Application No. 10/084,119 : DECISION
Filed: October 7, 2002 : ON PETITION
Title of Invention: :
IMAGE DISPLAY SYSTEM WITH BODY :
POSITION COMPENSATION :

This is a decision on the Petition to Revive an Unintentionally Abandoned Application Under 37 CFR 1.137(b), and in the Alternative to Withdraw the Holding of Abandonment in View of Certificate of Mailing Practice Under 37 CFR 1.8, filed December 20, 2004. The delay in treating this petition is regretted[1].

The petition is **granted.**

Background

The above-identified application became abandoned for failure to timely and properly reply to the Ex parte Quaye action Office communication, mailed August 22, 2003. The Office communication set a two (2) month period for reply. No response having een filed, this application became abandoned on October 22, 2003. A Notice of Abandonment was mailed June 8, 2004.

Applicant files the instant petition and asserts that a timely response in the form of an Amendment was filed on October 9, 2003 (Certificate of Mailing dated October 7, 2003). In support of this assertion, Applicant provides a copy of the Amendment that includes a Certificate of Mailing dated October 7, 2003. In further support, applicant provides a copy of a return-

[1] A review of the Application file reveals that Applicant filed a Request for Reconsideration and Withdrawal of Holding of Abandonment in View of Certofocate of Mailing Practice Under 37 CFR 1.8 on June 14, 2004. The apparent petition was inadvertently entered in Office records as a letter and apparently not acted upon.

receipt postcard that contains a USPTO date-stamp dated October 9, 2003, which acknowledges receipt by this Office of an Amendment on October 9, 2003.

In view of the above, the petition to withdraw the holding of abanmdonment is improper and the holding of abandonment is hereby withdrawn.

A refund of the petition fee, $1500.00, has been credited to deposit account 05-0225, as authorized in the Petition.

The application file is being referred to Technology Center Art Unit 2851 for processing of the Amendment, filed October 7, 2003, and for continued examination in due course.

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

Derek L. Woods
Petitions Attorney
Office of Petitions

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Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester NY 14650-2201

SEP - 8 2005

In re Application of: COK et al
Application No. 10/084119
Filed: 02/27/02
Attorney Docket No. **82161ATHC**

NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR δ 1.313

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR δ 1.313.

The above-identified application is hereby withdrawn from issue. The Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed 08/09/2005, are hereby vacated.

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

If the issue fee has been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a Deposit Account.

Telephone inquires should be directed to Judy Nguyen at (571) 272-2258.

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

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

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GAZDZINSKI & ASSOCIATES PC
11440 WEST BERNARDO COURT
SUITE 375
SAN DIEGO CA 92127

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MAR 12 2010

OFFICE OF PETITIONS

In re
Bogursky, et al.
Application No. 10/084,125
Filed: February 28, 2002
Patent No. 6,700,079
Issued: March 2, 2004

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed January 4, 2010.

The fee deficiency submission under 37 CFR 1.28 of $580 is hereby **accepted**.

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080821

**DATE** : August 21, 2008

**TO SPE OF** : ART UNIT 1657

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7045321

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:**

/JON WEBER/
Supervisory Patent Examiner.Art Unit 1657

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

Mail Date: 08/04/2010

| | | |
|---|---|---|
| **Applicant** | : Frances Jiang | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647389 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/084,174 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/28/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **974** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Mailed: 5/17/05

dss
Paper Number _____

In re application of :
Junji Nakanishi et al. DECISION ON
Serial No.10/084,182 : PETITION
Filed: February 28, 2002 :
For: CHEMICALLY AMPLIFYING TYPE POSITIVE RESIST
COMPOSITION :

This is a response to the RESPONSE TO NOTICE OF ABANDONMENT AND CONDITIONAL PETITION TO REVIVE, filed June 04, 2004 and resubmitted February 14, 2005. The response asks that the abandonment, as set forth in the Notice of Abandonment of April 05, 2004, be withdrawn since the applicant did timely file a response on February 13, 2004. (Copies of the papers filed February 13, 2004 are attached to the instant petition as well as a copy of the USPTO date stamped postcard receipt.)

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response were properly filed on February 13, 2004 in view of the fact that the originally filed papers having a Patent and Trademark Office date stamp of February 13, 2004 thereon have been located in the USPTO application file. Accordingly, any holding of abandonment is hereby vacated, and the application has been returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers filed February 13, 2004.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Andre D. Meikle
Birch, Stewart, Kolasch & Birch LLP
P.O. Box 747
Falls Church, VA 22040-0747

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TC 3600

Paper No 5

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

In re Application of
Kashiwagi Shinichirou
Application No.10/084187
Filed: February 28, 2002
For: BEARING DEVICE

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

The paper filed July 23, 2003 has been treated as a Petition to Withdrawal the Holding of Abandonment.

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

☒ Postcard receipt being dated December 23, 2002

☐ USPTO return facsimile receipt dated _____.

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

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

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

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated_____.

This application is being forwarded to the examiner for appropriate action.

en/10/24/03

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
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**DAVID W. LYNCH**
**CHAMBLISS, BAHNER & STOPHEL**
**1000 TALLAN SQUARE-S**
**TWO UNION SQUARE**
**CHATTANOOGA TN 37402**

**COPY MAILED**

APR 12 2007

**OFFICE OF PETITIONS**

In re Application of :
Bian Dennis McKean et al. :
Application No. 10/084,214 :
Filed: February 25, 2002 :
Attorney Docket No. SJO920010056US1 :
**(0549)**

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 21, 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 April 06, 2006, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 07, 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 an amendment, a Request for Continued Examination, and the $790 filing fee; (2) the petition fee of $1,500; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of April 06, 2006 is accepted as having been unintentionally delayed.

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

the filing of a grantable petition pursuant of 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Jean F. Duverne at (571) 272-6051 or in his absence, the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 2195 for appropriate action on the concurrently filed Request for Continued Examination and amendment.

David Bucci
Petitions Examiner
Office of Petitions

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

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6698422 | 2004-03-02 | 10084215 | 2002-02-25 | 107P001 |

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 | /George R. McGuire/ | Date (YYYY-MM-DD) | 2008-05-03 |
| Name | George R. McGuire | Registration Number | 36603 |

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

# Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 6698422
Issue Date: March 2,2004
Application No. 10084215
Filed: February 25,2002
Attorney Docket No. 11830/4

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

This is a decision on the electronic petition, filed May 3,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 3,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in 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

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**MAIL**

JUN 2 4 2005

**DIRECTOR OFFICE**
**TECHNOLOGY CENTER 2100**

Mark Friedman
The Polkinghorns
9003 Florin Way
Upper Marlboro, MD 20772

In re Application of: Dov Moran
Application No. 10/084,226
Attorney Docket No. M01/23
Filed: February 28, 2002
For: DEVICE, SYSTEM AND METHOD FOR DATA EXCHANGE

**DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR §1.181**

This is a decision on the petition, filed March 23, 2005, requesting the Withdrawal of the Holding of Abandonment of the above-identified application, under 37 CFR §1.181. The instant application was effectively held abandoned for failure to timely respond to the final Office action mailed September 16, 2004. The three-month statutory period for response expired on December 16, 2004. A notice of abandonment has not yet been mailed.

According to the MPEP §711.03(c), the showing required to establish non-receipt of an Office action includes the following:

*1) a statement from practitioner that the Office action was not received,*
*2) a statement from practitioner that the file jacket and docket records were searched,*
*3) a copy of the docket record at the address of record, and*
*4) a reference to the docket record in the practitioner's statement.*

In support of the petition, applicants' representative provides a Declaration from Mr. Bill Polkinghorn at the address of record, indicating that all the mail he receives from the USPTO, was personally packaged by him and forwarded by courier to Dr. Mark Friedman at his Tel Aviv address. In addition, Petitioner provides a statement that the final Office action was not received and that a search of the file jacket and docket records has been performed. Petitioner has also submitted a copy of the docket record as well as a reference to the docket record in practitioner's statement.

Petitioner has established non-receipt of the Office action according to the requirements set forth above. Accordingly, the petition is **GRANTED**.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to withdraw the holding of abandonment, before **redating and remailing the Final Office Action to the applicant**.

6/22/05

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

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NOV 09 2007

OFFICE OF PETITIONS

In re Patent No. 6,776,051 :
Issue Date: August 14, 2004 :
Application No. 10/084,249 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. SUZUKI29 :

This is a decision on the petition under 37 CFR 1.182 filed on August 30, 2007, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **DISMISSED**.

Office records show that petitioner submitted $130 for treatment of the instant petition. However, a petition under 37 CFR 1.182 requires a $400 petition fee. Consequently, before the Office issues a duplicate Letters Patent, the difference of $270 must be submitted.

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

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

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

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SUITE 300
WASHINGTON, DC 20001-5303

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JAN 31 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,776,051 | : | |
| Issue Date: August 17, 2004 | : | |
| Application No. 10/084,249 | : | DECISION ON PETITION |
| Filed: February 28, 2002 | : | |
| Attorney Docket No. SUZUKI-29 | : | |

This is a decision on the renewed petition under 37 CFR 1.182, filed January 9, 2008, 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 duplicate Letters Patent.

As authorized, the fee deficiency of $270 has been charged to petitioner's credit card.

A copy of this decision is being forwarded to the Office of Data Management for issuance of the duplicate Letters Patent. The patent file is being forwarded to the Files Repository.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3226. Any questions concerning issuance of the duplicate Letters Patent should be directed to Krystal Paige at (703) 308-9250 ext 139.

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Krystal Paige, P/OPPD, South Tower 8th Floor, Room C32 (FAX 571-270-9937)

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P.O. Box 1450
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NEEDLE & ROSENBERG, P.C.
THE CHANDLER BUILDING, SUITE 1200
127 PEACHTREE STREET, N.E.
ATLANTA, GA 30303-1811

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JUL 11 2005

OFFICE OF PETITIONS

In re Application of :
Raymond Barry et al :
Application No. 10/084,256 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 2000-0241.02 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 9, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 7, 2004, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 8, 2004.

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

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2853 for further processing.

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

cc:

Needle & Rosenberg, P.C.
999 Peachtree Street, Suite 1000
Atlanta, GA 30309-3914

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

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OFFICE OF PETITIONS

In re Application of :
Huang, et al. :
Application No. 10/084,257 : DECISION ON PETITION
Filed: February 25, 2002 : TO WITHDRAW
Attorney Docket No. 005306.P064 : 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 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.

There is an outstanding Office action mailed October 12, 2005 that requires a response by the applicant.

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: SAM CAMPBELL
CAMPBELL, STEPHENSON ASOCOLESE, LLP
4807 SPICEWOOD SPRING ROAD
BLDG. 4, SUITE 201
AUSTIN, TX 78759

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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| SERIAL NUMBER | REQUEST DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/084,262 | 3/18/02 | DRAKE | FSCOP002 |

Title:
**METHOD AND APPARATUS FOR CONTINUOUSLY FORMING DYE SUBLIMATION IMAGES IN SOLID SUBSTRATES**

| Art Unit | Paper Number |
|---|---|
| | |

Correspondence Address:
MICHAEL LEE
BEYER WEAVER & THOMAS, LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 528,517

Grant Date: 18-Mar-02

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such aplication or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lesson the responsibility of the 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 respecct to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Adminstration, Department of Commerce; and the Department of Energy.

## LICENSE FOR FOREIGN FILING

**[Title 35, United States Code (1952) Sections 184, 185, 186]**

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Paper No. 5

**TERRY L. WILES**
**POPOVICH & WILES, PA**
**IDS CENTER, SUITE 1902**
**80 SOUTH 8TH STREET**
**MINNEAPOLIS, MN 55402**

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AUG 0 6 2002

OFFICE OF PETITIONS

In re Application of :
Richard S. Kusleika et al :
Application No. 10/084,263 : NOTICE
Filed: February 27, 2002 :
Attorney Docket No. MVA1002USC2 :

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 3731.

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
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Paper No. 9

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

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NOV 0 5 2003

OFFICE OF PETITIONS

In re Application of :
Fotinos :
Application No. 10/084,264 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 1581/130 :

This is a decision on the petition filed September 15, 2003, to accord the above-identified application a filing date of February 27, 2002, instead of February 26, 2002.

The petition is **granted**.

37 CFR 1.10(c) states,

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

All of the above requirements have been met. Therefore, the application will be accorded a filing date of February 27, 2002.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of February 27, 2002.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 11

BROMBERG & SUNSTEIN
125 SUMMER STREET
BOSTON, MA 02110-1618

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JAN 2 0 2004

OFFICE OF PETITIONS

In re Application of :
Spiros Fotinos :
Application No. 10/084,264 : NOTICE
Filed: February 26, 2002 :
Attorney Docket No. 1581/130 :

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 1617.

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

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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#5

Jeffrey A. Berkowitz, Esquire
Finnegan, Henderson, Farabow, Garrett
& Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

MAILED

JAN 15 2003

Office of the Director
Group 3600

In re application of
Michael Clark, et. al.
Application No. 10/084,313 :
Filed: February 28, 2002 :
For: METHODS AND SYSTEMS FOR ROUTING MOBILE VEHICLES :

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on December 13, 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).

10/084,313

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition (A) above.

As to condition (A), it is not clear if Debbie Segers of Sabre, Inc is withdrawing. She is listed in the original Power of Attorney but is not part of the firm of Finnegan, Henderson, Farabow, Garrett and Dunner. The request states that the attorneys and agents of the firm of Finnegan, Hendrson, Farabow, Garrett & Dunner listed on the Power of Attorney are withdrawing.

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

Rjb:1/3/03

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**GREENBLUM & BERNSTEIN**
**1950 ROLAND CLARKE PLACE**
**RESTON, VA 20191**

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Hiroshi Minagawa et al :
Application No. 10/084,322 :
Filed: February 28, 2002 :
Attorney Docket No. P21975.DC2.DOC :

This is a decision on the petition, filed January 28, 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 January 3, 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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2671 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

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

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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TECHNOLOGY CENTER 3600

ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

In re application of
Vincent Armentano et al.
Application No. 10/084,326 : DECISION ON REQUEST
Filed: February 28, 2002 : FOR WITHDRAWAL OF
For: METHOD AND SYSTEM FOR : ATTORNEY
ENHANCED MEDICAL TRIAGE

This is a decision on the request filed on August 28, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

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

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

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition (A) above. The attorneys listed as being withdrawn do not match those appointed in Customer No. 27510. Therefore, some attorneys originally appointed would still be of record if the request were approved. It does not appear that that is the intent of the request. If only certain attorneys are withdrawing, then it must be so stated.

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

KJD/slb: 11/09/04

cc: George T. Marcou
Kilpatrick Stockton LLP
Suite 900
607-14th Street N.W.
Washington, D.C. 20005

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JC997 U.S. PTO
10/084389
02/25/02

Foley & Lardner
402 W. Broadway, 23rd Floor
San Diego, CA 92101

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In re Application of :
Dershem et al :
Application No. 09/580,026 : DECISION GRANTING
Filed: May 26, 2000 :STATUS UNDER 37 CFR 1.47(a)
Attorney Docket No: QUANT1190-2 :
:

This is in response to the petition filed by facsimile transmission on October 12, 2001, requesting reconsideration of a decision mailed August 13, 2001, which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is granted.

Petitioner has shown that the nonsigning inventors (Dennis B. Patterson and Jose Osuna) have refused to join in the filing of the above-identified application.

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

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

This application is being forwarded to the Office of Initial Patent Examination Division for preexamination processing.

Frances Hicks
Petitions Examiner
Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy

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San Diego, CA 92101

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In re Application of :
Dershem et al :
Application No. 09/580,026 : DECISION GRANTING
Filed: May 26, 2000 :STATUS UNDER 37 CFR 1.47(a)
Attorney Docket No: QUANT1190-2 :
:

This is in response to the petition filed by facsimile transmission on October 12, 2001, requesting reconsideration of a decision mailed August 13, 2001, which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is granted.

Petitioner has shown that the nonsigning inventors (Dennis B. Patterson and Jose Osuna) have refused to join in the filing of the above-identified application.

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

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

This application is being forwarded to the Office of Initial Patent Examination Division for preexamination processing.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy

Received from < > at 6/5/02 4:45:49 PM [Eastern Daylight Time]

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FEB - 8 2005

GREGORY GENE STEINER
1676 ALA MOANA BLVD, # 104
HONOLULU, HI 96815

| | | |
|---|---|---|
| In re Application of | : | |
| Gregory Gene Steiner | : | |
| Serial No.: 10/084,391 | : | PETITION DECISION |
| Filed: February 26, 2002 | : | |
| Attorney Docket No.: | : | |

This is in response to the telephone interview and informal petition under 37 CFR 1.181 and earlier status inquiries, from January, 2005, requesting withdrawal of abandonment based, in part, on an incorrect mailing address.

A review of the file history shows that this application was filed by applicant on February 26, 2002, and contained as a correspondence address PO BOX 61515, Honolulu, HI 96389. The examiner mailed a first Office action to this address on February 7, 2003, setting a three month shortened statutory period for reply. Applicant replied on March 4, 2003, by filing an amendment to the specification and claims. Unfortunately, due to Rules changes from the previous year, applicant's amendment was not in acceptable form. On June 5, 2003, the Office mailed a Notice of Non-Compliant Amendment to applicant setting a one month period for reply. A change of address was received on June 16, 2003. Applicant replied on July 21, 2003, by filing a new amendment. However, applicant did not request or pay for a one month extension of time. Applicant was not notified of the fee deficiency until February, 2004, at which time a request and fee for a one month extension of time was submitted. A Notice of Abandonment was mailed to applicant on March 25, 2004, indicating that no reply to the Office action of February 7, 2003, had been received.

It is noted that applicant is prosecuting his own application and is likely not completely familiar with Rules changes for prosecution before the Office. It is also noted that the Office has changed its Rules for submission of amendments to the claims and specification at least three times since 2001. In view of these changes, it is understandable that applicant was not aware of the most recent Rule change for submitting amendments and the error in submission can be excused. It is also noted that applicant has attempted to reply to Office actions promptly, usually within a month of mailing thereof. That applicant did not reply within one month to the Notice of Non-Compliant Amendment may be due to the change of address which likely crossed in the mail with the Notice. However, the Office should not have delayed three months from receipt of the amendment to the mailing of the Notice of Non-Compliant Amendment, nor delayed over six

months after receipt of the revised amendment before notifying applicant that the amendment was defective in that it lacked an extension of time request and fee. Such delay, in effect, mandated abandonment of the application.

In view of the Office delays and errors and, applicant's status as *pro se*, the petition is **GRANTED**. This application is restored to pending status with the mailing of this decision.

**Applicant's remarks filed March 7, 2003, will be considered responsive to the Office action of February 7, 2003, and the examiner will act in accordance therewith.**

It is, however, noted that applicant's last amendment remains non-compliant with current Rules for amendments. Current Rules require that any amendment to the specification (other than the addition or deletion of 5 or fewer characters) be made by reproducing the entire paragraph and showing the changes by underlining (for additions) and strikethrough (for deletions). In addition when any claim is amended in reply to an Office action a complete listing of claims must be presented with changes shown as noted above. Further each claim must be preceded by an identifier such as: new, amended, previously amended, original, canceled, etc. Applicant is urged to review these Rules on the Office website to ensure compliance therewith. **The reply to the next Office action will require compliance with current Rules for amendments.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

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**MERCHANT & GOULD PC**
**P.O. BOX 2903**
**MINNEAPOLIS, MN 55402-0903**

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OFFICE OF PETITIONS

In re Application of :
Neng-Hui Yang et al :
Application No. 10/084,398 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 13078.22US01 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 8, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 5, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 6, 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 $950.00 extension of time submitted with the petition on June 8, 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 Wan Laymon at (703) 306-5685.

This matter is being referred to Technology Center 1763.

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

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OFFICE OF PETITIONS

In re Application of :
Harry M. Meade et al. :
Application No. 10/081,400 : ON PETITION
Filed: February 20, 2002 :
Attorney Docket No.: 10275-041002 :

This is a decision on the petition filed March 22, 2005 to change the order of the names of the inventors. The petition is treated under 37 CFR 1.182.

The petition is **GRANTED**.

The order of the names of the inventors will be changed as follows:

1. Harry M. Meade
2. Michael Young
3. Ian Krane

A corrected filing receipt reflecting the correct order of the names of the inventors is attached.

A petition fee is however due for the required change and thus, pursuant to the authorization contained in the petition, deposit account no. 50-2092 has been charged in the amount of $400.00.

This matter is being referred to Technology Center 1632 for further examination.

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

ATTACHMENT: Corrected Filing Receipt

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LEGAL DEPT. DL 429 INTELLECTUAL PROPERTY ADMIN.
P.O. BOX 7599
LOVELAND, CO 80537

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OFFICE OF PETITIONS

In re Application of :
David Finlay Taylor, et al. :
Application No. 10/084,498 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 4481.045 :

This is a decision on the petition under the provisions of 37 CFR 1.181, filed October 17, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is **DISMISSED.**

A review of the record discloses that the application became abandoned for failure to timely pay the issue and publication fees on or before July 14, 2006 as required by the Notice of Allowance and Fee(s) Due, mailed April 14, 2006. Accordingly, the date of abandonment of this application is July 15, 2006. The petition states that the credit card form indicated the incorrect application number and attorney docket number. Unfortunately, because the information was incorrect on the credit card form the Office had no way correctly match the issue and publication fee to the correct application. Consequently, the error was deemed to be that of the petitioner, so the petition under 37 CFR 1.137(b) is deemed necessary.

This is also a decision on petition under 37 CFR 1.137(b) to revive the above-identified application, filed October 17, 2006.

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

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

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. 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 April Wise at (571) 272-1642.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: ALLAN M. LOWE
LOWE HAUPTMAN BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

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Paper No. 6

O'MELVENY & MYERS, LLP
400 SOUTH HOPE STREET
LOS ANGELES, CA 90071-2899

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OFFICE OF PETITIONS

In re Application of :
Zulfigar, et al. :
Application No. 10/084,559 : ON PETITION
Filed: February 25, 2002 :
Attorney Docket No. 0037203-15 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 17, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed April 8, 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 June 9, 2002.

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 $980.00 extension of time submitted with the petition on December 17, 2002 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-9200.

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

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BIOMERIEUX, INC.
PATENT DEPARTMENT
100 RODOLPHE STREET
DURHAM NC 27712

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**OFFICE OF PETITIONS**

In re Application of
James L. Digiuseppie et al.
Application No. 10/084,578
Filed: February 27, 2002
Attorney Docket No.: 9250-29

ON PETITION

This is a decision on the petition filed September 8, 2009, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED**.

This application was held abandoned on October 27, 2008 and a Notice of Abandonment was mailed on February 5, 2009, for failure to timely respond to the Final Office Action mailed July 24, 2008.

In response thereof, petitioner has submitted a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 1797 for processing of the RCE.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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27526
HUSCH BLACKWELL SANDERS LLP
4801 Main Street
Suite 1000
Kansas City, MO 64112

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**OFFICE OF PETITIONS**

In re Application of
CASHMAN *et al*
U.S. Application No.: 10/084,592
Filing Date: February 25, 2002
Priority Date: 23 January 2002
Attorney Docket No.: 56510.10002
For: METHOD AND COMPOSITION FOR DELIVERY OF MEDICANTS TO ANIMALS

**DECISION**

This decision is in response applicants' petition under 37 CFR 1.137(a), or in the alternative petition under 37 CFR 1.137(b) filed on March 12, 2007.

## BACKGROUND

On February 25, 2002, applicants filed the subject utility application. No fees or declaration was submitted.

On April 18, 2002, a Notice to File Missing Parts requesting the basic filing fee and surcharge fee was mailed.

On November 26, 2003, a Notice of Abandonment Under 37 CFR 1.53(f) or (g) was mailed for failing to reply to the Notice to File Missing Parts.

On October 7, 2005, a revocation of power of attorney and change of a correspondence address was submitted via facsimile.

On March 12, 2007, applicants filed a petition to revive under 37 CFR 1.137(a), or in the alternative 37 CFR 1.137(b) which was accompanied by authorization to charge any required fees to Deposit Account No. 11-0160.

On April 9, 2008, at the request of the undersigned, applicants filed supplemental evidence in support of the petition filed March 12, 2007.

## DISCUSSION

Applicants request that the subject application be revived pursuant to 37 CFR

1.137(a), or in the alternative 37 CFR 1.137(b).

**Petition to Revive an Unavoidably Abandoned Application Under 37 CFR 1.137(a)**

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 filed an appropriate response by paying the proper basic filing fee, search fee, examination fee and surcharge fee for a small entity. These fees have been charged to Deposit Account No. 11-0160 as authorized. A terminal disclaimer is not required. The petition fee has been paid.

As such, items (1), (3) & (4) of 37 CFR 1.137(a) are complete

Regarding item (2), applicants claim that the delay in responding to the Office Action resulted from a deliberate deception by the former counsel. Applicants submitted evidence showing that the former counsel may have intentionally misled them on the status of the application after the above-captioned application became abandoned on November 26, 2003.

However, applicants have not provided sufficient evidence showing that the delay in responding to the Notice to File Missing Parts mailed April 18, 2002 prior to the receipt of the Notice of Abandonment was unavoidable.

Therefore, the requirement in item (2) of 37 CFR 1.137(a) that applicants show that the entire delay in entering the national stage was unavoidable has not been met.

For the reason listed above, applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice.

**Petition to Revive an Unintentionally Abandoned Application Under 37 CFR 1.137(b)**

Applicants' petition to revive under 37 CFR 1.137(b) filed in the alternative is hereby **GRANTED** as follows:

The required petition fee for a small entity has been charged to Deposit Account No. 11-0160 as authorized. Applicants make the required statement pursuant to 37 CFR 1.137(b)(3). A terminal disclaimer is not required.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

This application is being forwarded to the Office of Patent Application Processing for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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CHICAGO IL 60610

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SEP 27 2005

**OFFICE OF PETITIONS**

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|---|---|
| In re | : DECISION ON APPLICATION |
| Buehler, et al. | : FOR PATENT TERM ADJUSTMENT |
| Application No. 10/084,607 | : AND NOTICE OF INTENT |
| Filed: February 27, 2002 | : TO ISSUE |
| Patent No. 6,863,467 | : CERTIFICATE OF CORRECTION |
| Issued: March 8, 2005 | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)", filed May 3, 2005. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from one (1) day to one hundred eighty-three (183) days.

The application for patent term adjustment 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 eighty-three (183)** days.

On March 9, 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 was one hundred fifty-one (151) days. On March 8, 2005, the above-identified application matured into U.S. Patent No. 6,863,467. The patent issued with a Patent Term Adjustment of one (1) days.

Patentees state that the patent is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of one (1) 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 sixty (60) days pursuant to 35 U.S.C. 154(b)(1)(B)(iii) and 37 C.F.R. §1.703(a)(6), reduced by applicants' delays of ninety (90) 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)(iii) and 37 C.F.R. § 1.704(c)(10). The PTO delay of 151 and applicant delay of 120 days have been reviewed and found to be correct. The adjustments of 90 and 60 days are at issue.

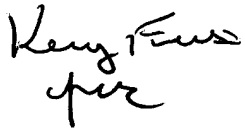
A Notice of Allowance was mailed on March 9, 2004. A review of the record reveals that the issue fee was timely paid on June 7, 2004, not September 7, 2004. Accordingly, applicants should not have been assessed applicant delay of 90 days. As the application did not issue until March 8, 2005, PTO delay of one hundred fifty-two (152) days should have been assessed, not 60 days.

In view thereof, issuance of a certificate of correction pursuant to 35 U.S.C. §254 and 37 C.F.R. §1.322 is appropriate. The determination of patent term adjustment is one hundred eighty-three (183) days (303 (152+151) days of PTO delay, reduced by 120 days of applicant delay).

The $200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 23-1925, as authorized.

The application file is being forwarded to the Certificate of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 CFR 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **one hundred eighty-three (183)** 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: draft Certificate of Correction

Day : Monday
Date: 9/26/2005

PALM INTRANET

Time: 14:02:30

## PTA Calculations for Application: 10/084607

| | | | |
|---|---|---|---|
| Application Filing Date: | 02/27/2002 | PTO Delay (PTO): | 211 |
| Issue Date of Patent: | 03/08/2005 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 210 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 183 |
| PTO Delay Adjustment: | 182 | | |

### File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 47 | 09/26/2005 | ADJUSTMENT OF PTA CALCULATION BY PTO | 182 | | |
| 43.5 | 02/16/2005 | PTA 36 MONTHS | | | |
| 43 | 03/08/2005 | PATENT ISSUE DATE USED IN PTA CALCULATION | 60 | | 39 |
| 42 | 02/09/2005 | RECEIPT INTO PUBS | | | |
| 41 | 02/08/2005 | DISPATCH TO FDC | | | |
| 40 | 02/08/2005 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 39 | 09/07/2004 | ISSUE FEE PAYMENT VERIFIED | | 90 | 26 |
| 38 | 02/03/2005 | MAIL RESPONSE TO 312 AMENDMENT (PTO-271) | | | |
| 37 | 02/02/2005 | RESPONSE TO AMENDMENT UNDER RULE 312 | | | |
| 36 | 12/07/2004 | RECEIPT INTO PUBS | | | |
| 35 | 10/20/2004 | RECEIPT INTO PUBS | | | |
| 34 | 06/07/2004 | REFERENCE CAPTURE ON IDS | | | |
| 33 | 06/07/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | |
| 32 | 06/07/2004 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 120 | 38 |
| 31 | 06/07/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 30 | 06/07/2004 | ISSUE FEE PAYMENT RECEIVED | | | |
| 29 | 05/07/2004 | RECEIPT INTO PUBS | | | |
| 28 | 03/31/2004 | RECEIPT INTO PUBS | | | |
| 27 | 03/30/2004 | WORKFLOW - FILE SENT TO CONTRACTOR | | | |
| 26 | 03/09/2004 | MAIL NOTICE OF ALLOWANCE | | | |
| 25 | 03/09/2004 | MAIL EXAMINER'S AMENDMENT | | | |
| 24 | 03/05/2004 | ISSUE REVISION COMPLETED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 23 | 03/05/2004 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 22 | 03/05/2004 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 21 | 03/05/2004 | NOTICE OF ALLOWABILITY | | | |
| 20 | 02/11/2004 | MAIL RESTRICTION REQUIREMENT | | | |
| 19 | 02/06/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 18 | 01/20/2004 | IFW AMENDED CASE PROCESSING COMPLETE | | | |
| 17 | 01/20/2004 | DATE FORWARDED TO EXAMINER | | | |
| 16 | 01/02/2003 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 15 | 09/30/2003 | MAIL NON-FINAL REJECTION | 151 | | 16 |
| 14 | 09/22/2003 | NON-FINAL REJECTION | | | |
| 13 | 09/12/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 05/28/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 05/28/2002 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 10 | 09/06/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 06/19/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 8 | 06/07/2002 | APPLICATION IS NOW COMPLETE | | | |
| 7 | 05/28/2002 | PAYMENT OF ADDITIONAL FILING FEE/PREEXAM | | | |
| 6 | 05/28/2002 | AN ASSERTION THAT THE NATURE OF THE LEGAL ENTITIES HAVING PROPERTY RIGHTS TO THE PATENT AUTHORIZES T | | | |
| 5 | 05/28/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 4 | 05/28/2002 | APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS | | | |
| 3 | 03/21/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 2 | 03/06/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 02/27/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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SALT LAKE CITY, UT 84110

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OCT 20 2004

OFFICE OF PETITIONS

In re Application of
Dinerstein, et al.
Application No.: 10/084,609
Filed: February 27, 2002
Attorney Docket No: 2792-5178US

ON PETITION

This is a decision on the petition under 37 CFR 1.28(c), filed October 4, 2004.

The petition is **GRANTED.**

The record reflects that the filing fee, surcharge, and claims fee were paid at the small entity rate. Petitioner later discovered that the inventive entity did not qualify as a small entity and filed the instant petition, accordingly.

Petitioner has remitted the deficient amount of $585.00.

Pursuant to 37 CFR 1.28(d), the payment of the deficient amount will be treated under 37 CFR 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

The application file will be directed to Technology Center 2600 for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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**BARNES & THORNBURG LLP**
**P.O. BOX 2786**
**CHICAGO IL 60690-2786**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Babich, Michael | : | |
| Application No. 10/084,638 | : | ON PETITION |
| Filed: February 27, 2002 | : | |
| Attorney Docket No. 21511/92177 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed July 18, 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 Notice of Appeal (with fee); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

**The Notice of Appeal filed July 18, 2006, has been entered and made of record. Accordingly, the 2-month period for filing the appeal brief accompanied by the fee required by law, runs from the date of this decision.**

This matter is being referred to Technology Center 1600 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington, VA 22201

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SEP 1 2 2002

OFFICE OF PETITIONS

In re Application of
Crossland, et al.
Application No. 10/084,652
Filed: February 28, 2002
Docket No.: 124-930
For: SPACERS FOR CELLS HAVING SPACED OPPOSED SUBSTRATES

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed July 31, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed February 28, 2002 without an executed oath or declaration and naming Timothy D. Wilkinson, William A. Crossland and Tat C.B. Yu as joint inventors. Accordingly, on April 16, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring filing fees, an executed oath or declaration, and a surcharge.

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 USC 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition lacks requirement (1) stated above. Petitioner has failed to establish that the inventor cannot be reached or located to execute the declaration. Petitioner alleges that the inventor cannot be found and has included the declaration of Philip Davies. While the declaration indicates that the application papers were mailed to the inventor at the inventor's last known address, the declaration fails to indicate what efforts have been made to locate the non-signing inventor.

Where inability to locate a non-signing inventor is alleged, diligent effort to locate the non-signing inventor must be undertaken. Petitioner is required to undertake additional effort to locate the non-signing inventor and provide the non-signing

inventor with a complete copy of the patent application (specification, claims, drawings, and oath or declaration). Any renewed petition should be accompanied by detailed supporting evidence in the form of a declaration or affidavit by one having first hand knowledge of the information contained therein of attempts to locate the non-signing inventor. Petitioner may wish to consult employee records, telephone directories, the internet, national registries, etc., in effort to locate the non-signing inventor.

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

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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COMMISSIONER FOR PATENT
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JJGJr.11-02

Paper 8

NIXON & VANDERHYE P.C.
8TH FLOOR
1100 NORTH GLEBE ROAD
ARLINGTON VA 22201

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NOV 1 2 2002

OFFICE OF PETITIONS

In re Application of :
Crossland, et al : DECISION ON PETITION
Application No. 10/084,652 :
Filed: 28 February, 2002 :
Attorney Docket No. 124-930 :

This is a decision on the paper styled "Supplemental Information" filed via FAX on 1 October, 2002, following the dismissal of an earlier petition, and therefore considered as a renewed petition under ¶(a) of 37 C.F.R. §1.47.[1]

The renewed petition is **GRANTED**.[2]

Petitioner has shown that, while inventor William A. Crossland and Timothy D. Wilkinson have signed the oath/declaration, the non-signing inventor **Tat C.B. Yu** (Mr. Yu) has failed to sign and so join in the filing of the above-identified application after having been presented with the application papers, or could not be found after diligent search.

Specifically, the declaration/statement/submission of facts of/by Stanley C. Spooner (Reg. No. 27,393), who advanced to the Office as valid correspondence/statements/declarations (having satisfied his duty of candor by properly investigating them) of Linda Bruckshaw and Philip

---

[1] The regulations at 37 C.F.R. §1.47 provide:

**§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(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, 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, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

© The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

[2] Pursuant to Petitioner's authorization, the petition fee ($130.00) is charged to Deposit Account 14-1140.

Davies, establish(es) that the non-signing inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond positively to the request that he sign the declaration or in fact sign said declaration.

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and petitioner has shown 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(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

As provided under 37 C.F.R. §1.47(a), the 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 also will be published in the Official Gazette.

This file is being forwarded to OIPE for processing as necessary to reflect the instant decision, and then forwarded for examination in due course.

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

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 10/10/07

**Paper No.:** _____

**TO SPE OF** : **Technology Center** 2833

10/084652J

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7257007 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:**

/renee s luebke/
Renee Luebke
SPE - AU 2833

**Art Unit**

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Johannes Bartholomaeus | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572463 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/084,674 | : OF WYETH |
| **Filed** | : 02/28/2002 | : |
| | | : |

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.

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

Mail Date: 05/18/2010

**Applicant** : Johannes Bartholomaeus
**Patent Number** : 7572463
**Issue Date** : 08/11/2009
**Application No**: 10/084,674
**Filed** : 02/28/2002

: NOTICE CONCERNING IMPROPER
: DISMISSAL OF THE REQUEST
: FOR RECALCULATION OF
: PATENT TERM ADJUSTMENT
: IN VIEW OF WYETH

The United States Patent and Trademark Office (USPTO) discovered that in processing the recent recalculation decisions mailed in response to patentee's filed Request for Recalculation of Patent Term Adjustment in view of Wyeth, the USPTO mistakenly dismissed a small number of requests as ineligible. The dismissals involve requests that were filed on February 9-12, 2010, for patents that were granted on August 11, 2009. Any request that was filed on February 8, 2010 was properly deemed eligible for patent term adjustment (PTA) and was recalculated.

Patents meeting the above criteria were eligible because the USPTO was closed February 8-11, 2010, due to a snowstorm. See Closing of the United States Patent and Trademark Office from Monday February, 8, 2010, through Thursday, February 11, 2010, 1352 *Off. Gaz. Pat. Office* 146 (March 16, 2010). The Office considered each day from Monday, February 8, 2010, through Thursday, February 11, 2010, to be a "Federal holiday within the District of Columbia" under 35 U.S.C. § 21(b) and 37 CFR 1.6, 1.7, 1.9, 2.2(d), 2.195 and 2.196. Any actions that were due from Monday, February, 8, 2010, through Thursday, February 11, 2010, (or the preceding Saturday (February 6, 2010) or Sunday (February 7, 2010)) will be considered timely if the action was taken on the next succeeding business day on which the USPTO was open, which was February 12, 2010.

This notice **VACATES** the previous mailed decision in the patented file that deemed patentee ineligible for the request for recalculation. Patentee's request for recalculation is GRANTED.

The patent term adjustment has been determined to be **585** 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** from the mail date of this notice, whichever is longer, to file a request for reconsideration of this PTA calculation. See 35 U.S.C. § 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4).

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

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

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FEB 4 2005

Chiron Corporation
Intellectual Property R338
PO Box 8097
Emeryville CA 94662-8097

| | |
|---|---|
| In re Application of | : |
| Todd Seeley | : |
| Serial No.: 10/084,700 | : PETITION UNDER 37 CFR 1.136(b) |
| Filed: February 27, 2002 | : |
| Attorney Docket No.: PP-10406.004 | : |

This is in response to applicant's petition filed January 18, 2005, to request a two (2) month extension of time to provide a showing a prior invention under 37 CFR 41.202(d).

The petition is **GRANTED**. Applicant is hereby given an additional two (2) months from the date of the Office Action mailed December 3, 2004 to make a showing under 37 CFR 41.202(d).

Should there be any questions with regard to this letter please contact Anthony C. Caputa by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0829 or by facsimile transmission to the general Office facsimile number.

Bruce Kisliuk
Director
Technology Center 1600

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PO BOX 902
EL SEGUNDO CA 90245

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JUN 16 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gabor Devenyi | : | DECISION ON PETITION |
| Application No. 10/084,704 | : | |
| Filed: February 26, 2002 | : | |
| Attorney Docket No. 01W120 | : | |

This is a decision on the petition filed April 11, 2005, pursuant to 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned as a result of petitioner's failure to timely file an Appeal Brief (and fee) within the time period provided in 37 CFR 1.192(a). A final Office action was mailed on March 8, 2004, which set a shortened statutory period for reply of three months. Petitioner filed an amendment on April 8, 2004. However, in an Advisory Action mailed on May 14, 2004, petitioner was informed that the amendment did not *prima facie* place the application in condition for allowance. Petitioner then obtained a three month extension of time and filed a Notice of Appeal on August 27, 2004. Accordingly, the two month period of time (extendable under 37 CFR 1.136(a)) for filing the Appeal Brief started to run from August 27, 2004. No Appeal Brief having been filed, the above-

identified application became abandoned on October 28, 2004. A Notice of Abandonment was mailed on April 6, 2005.

With the instant petition, the petitioner paid the petition fee, made the proper statement of unintentional delay, and filed an Appeal Brief in triplicate.

The application file is being forwarded to Group Art Unit 3682 for consideration of the Appeal Brief filed April 11, 2005.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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**JUN 16 2005**

**OFFICE OF PETITIONS**

In re Application of :
Gabor Devenyi : DECISION ON PETITION
Application No. 10/084,704 :
Filed: February 26, 2002 :
Attorney Docket No. 01W120 :

This is a decision on the petition filed April 11, 2005, pursuant to 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned as a result of petitioner's failure to timely file an Appeal Brief (and fee) within the time period provided in 37 CFR 1.192(a). A final Office action was mailed on March 8, 2004, which set a shortened statutory period for reply of three months. Petitioner filed an amendment on April 8, 2004. However, in an Advisory Action mailed on May 14, 2004, petitioner was informed that the amendment did not *prima facie* place the application in condition for allowance. Petitioner then obtained a three month extension of time and filed a Notice of Appeal on August 27, 2004. Accordingly, the two month period of time (extendable under 37 CFR 1.136(a)) for filing the Appeal Brief started to run from August 27, 2004. No Appeal Brief having been filed, the above-

identified application became abandoned on October 28, 2004. A Notice of Abandonment was mailed on April 6, 2005.

With the instant petition, the petitioner paid the petition fee, made the proper statement of unintentional delay, and filed an Appeal Brief in triplicate.

The application file is being forwarded to Group Art Unit 3682 for consideration of the Appeal Brief filed April 11, 2005.

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

Cliff Congo
Petitions Attorney
Office of Petitions

U.S. Patent No. 7,266,215 B2
Attorney Docket No.: 05058/16305

Ok to enter
/DD/
6/16/08

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re U. S. Patent No.: | 7,266,215 B2 |
| Issued: | September 4, 2007 |
| By: | Yoshikazu IKENOUE |
| For: | IMAGE FORMING APPARATUS AND COPY MANAGEMENT SYSTEM |
| U.S. Serial No.: | 10/084,708 |
| Filing Date: | February 21, 2002 |

Certificates of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

**REQUEST FOR CERTIFICATE OF CORRECTION**

It is respectfully requested that a Certificate of Correction be issued for U.S. Patent No. 7,266,215 B2 issued September 4, 2007 for the purpose of correcting an error that occurred in the printing of the patent.

Attached is Form PTO-1050 (PTO/SB/44), which is suitable for printing.

The printing error contained in U.S. Patent No. 7,266,215 B2 is set forth below:

Title page, (75) Inventors, "Yoshikazu Ikenoue, Toyohashi (JP)" was incorrectly printed as "Yoshikazu Ikenoue, Toyohashi (JP); Hideo Kumashiro, Toyokawa (JP); Munehiro Nakatani, Toyohashi (JP)" (See page 2, of the Amendment to Change

Inventorship Pursuant to 37 C.F.R. 1.48(b) dated July 24, 2007 and filed with the PTO on July 30, 2007).

The foregoing error occurred in the printing of the patent, and thus constitutes an error by the Patent and Trademark Office.

Please issue a Certificate of Correction and transmit the Certificate to the attorney whose signature and address appear below.

Respectfully submitted,

By:/Thomas N. Tarnay/ Reg. No. 41,341
Thomas N. Tarnay
Registration No. 41,341
Attorney for Patentee

TNT/llb
SIDLEY AUSTIN LLP
717 North Harwood, Suite 3400
Dallas, Texas 75201
(214) 981-3388 Direct
(214) 981-3300 Main
(214) 981-3400 Facsimile
September 21, 2007

PTO/SB/44 (05-03)
Approved for use through 01/31/2004. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

PATENT NO : 7,266,215 B2
APPLICATION NO: 10/084,708
DATED : September 4, 2007
INVENTOR(S) : Yoshikazu Ikenoue



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

Title Page:
(75) Inventors, delete "Yoshikazu Ikenoue, Toyohashi (JP); Hideo Kumashiro, Toyokawa (JP); Munehiro Nakatani, Toyohashi (JP)" and insert -- Yoshikazu Ikenoue, Toyohashi (JP) --.

MAILING ADDRESS OF SENDER:

Sidley Austin LLP
717 North Harwood, Suite 3400
Dallas, Texas 75201

PATENT NO. 7,266,215 B2

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: Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080616

**DATE** : October 22, 2007

**TO SPE OF** : ART UNIT 2624

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7266215 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

**SPE:** Brian P. Werner Art Unit 2624

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) |
|---|---|---|---|---|
| 6,746,179 | 2004-06-08 | 10084734 | 2002-02-26 | 100325 |

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 F. Westerman/ | Date (YYYY-MM-DD) | 2010-03-12 |
| Name | William F. Westerman | Registration Number | 29988 |

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. 6746179
Issue Date: June 8,2004
Application No. 10084734
Filed: February 26,2002
Attorney Docket No. KERD99A

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 12,2010 ,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 March 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE: A. Fischer

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/20/07

TO SPE OF : ART UNIT 3621

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/084,744 Patent No.: 7222101

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**Lamonte M. Newsome**
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

---

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

_____

_____

_____

_____

_____ 3621
**SPE** **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK NY 10020-1105

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FEB 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Tran, et al. :
Application No.: 10/084,757 :
Filing Date: October 19, 2001 :
Attorney Docket No. : ON PETITION

This is a decision on the petition under 37 CFR 1.47 filed January 11, 2005. The petition will be treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.175 and accept the supplemental reissue declaration with the signature of inventor Li.

The petition is **granted**.

Petitioner requests that the supplemental reissue declaration be accepted without the signature of inventor Li, as inventor Li is unavailable. It is noted, that in this case, 37 CFR 1.175 requires the filing of a supplemental reissue declaration signed by all named inventors, yet petitioner has demonstrated that inventor Li is unavailable. In such a case, Section 1414.01 of the *Manual of Patent Examining Procedure* (MPEP) provides that:

> [if] a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the non-signing inventor.

Accordingly, the instant petition will be treated as petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.175 so as to accept the supplemental reissue declaration filed January 11, 2005, without the signature of inventor Li. The petition is granted, the requirement of 37 CFR 1.175 that all named inventors execute the supplemental reissue declaration is waived, and the supplemental reissue declaration without the signature of inventor Li is acknowledged and made of record.

The fee for the petition under 37 CFR 1.183 is $400.00 as per 37 CFR 1.183 and 1.17(f). The amount of $200.00 for petition related fees. This amount will be use towards the satisfaction of the instant petition fee, and deposit account 06-1075 will be charged an additional $200.00.

The application file will be forwarded to Technology Center 2800 for further processing.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

AUG - 4 2003

Paper No. 7

In re Application of
Howard F. Gokey
Application No. 10/084,786
Filed: June 14, 2002
For: Bar Clamp Corner
Squaring Fixture

: DECISION ON PETITION

The papers filed on July 7, 2003 are construed as a petition under Section 1.181 of the Code of Federal Regulations (37 CFR 1.181) to withdraw the abandoned status of this application. It is noted that although a Notice of Abandonment has not been mailed, the application is technically abandoned for failure to file a reply to the Office letter dated December 11, 2002. There is no fee required for the petition.

The petition is granted.

A review of the application file shows that a reply to the Office letter in question was in fact filed on February 5, 2003, and was mailed with a 37 CFR 1.8(a) certificate of mailing dated January 27, 2003. Since this reply is clearly timely, the application is obviously not abandoned.

Accordingly, the abandoned status of this application is withdrawn, and the application is restored to pending status. The application is being forwarded to the examiner for action on the reply filed on January 27, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

HOWARD F. GOKEY
25 EDWARD ST.
MALONE, NY 12953

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

HOWARD F. GOKEY
25 EDWARD ST.
MALONE, NY 12953

COPY MAILED

APR 10 2006

OFFICE OF PETITIONS

In re Application of :
Howard Francis Gokey :
Application No. 10/084,786 : DECISION
Filed: June 14, 2002 : ON PETITION
For: BAR CLAMP CORNER :
SQUARING FIXTURE :

This is a decision in response to the correspondence filed July 18, 2005. The correspondence is properly treated as a Petition to Withdraw Holding of Abandonment under 37 CFR 1.181.

The petition is **dismissed.**

Background

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

**Background**

The above-identified application became abandoned for failure to timely and properly respond to the final Office action, mailed April 22, 2004. The Office action set a three (3) month period for reply. Extensions of time under 37 CFR 1.136(a) were available. No response having been received, the application became abandoned July 23, 2004. A Notice of Abandonment was mailed April 26, 2005.

The instant petition

Applicant files the instant petition wherein Applicant avers that a timely reply to the Office action was filed on July 19, 2004, and was received by this Office as evidenced by Applicant's receipt of an Advisory action mailed January 12, 2005. Applicant further

provides that in response to the Advisory Action he filed correspondence on March 21, 2005. In view of the foregoing, Applicant requests that the holding of abandonment be withdrawn.

Applicable Statute, Rules and MPEP

A proper reply to a final rejection, as stated in 35 U.S.C. § 113 "is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116."

The guidance provided in 37 CFR 1.135(b) proves instructive.

> 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. (Emphasis supplied).

The reply to a final rejection must be both complete and proper. Here, Applicant timely filed a reply, however, the reply was not complete, to wit - the reply failed to place the application in condition for allowance.

Applicant was so notified in an Advisory Action, mailed January 12, 2005[1]. It is Applicant's responsibility to file a complete and proper reply as the condition of the case requires. Having failed to file a complete and proper reply by the due date for the reply, the application became abandoned. Thereafter, the reply to the Advisory Action filed on March 21, 2005, was moot. The application was abandoned and required revival and a proper reply.

Accordingly, the petition is dismissed.

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317

---

[1] Applicant is advised that the mailing of the Advisory Action by this Office is a courtesy. As provided in 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).

(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).

Applicant is further advised to contact the Office of Independent Inventors, at 703-306-5568, or seek the services of a registered practitioner, for assistance in prosecuting his patent application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

05012005

CHARLES DOUGLAS MURPHY
601 LINDEN PLACE #210
EVANSTON IL 60202

JUN 08 2005

In re Application of
Charles MURPHY
Application No. 10/084,803
Filed: February 28, 2002
Title: SHARED PARALLEL DIGITAL-TO-ANALOG CONVERSION

DECISION ON PETITION

This is a decision on the communication filed December 15, 2003, requesting that Notice of Abandonment be withdrawn. The communication has been treated as a petition requesting that the holding of abandonment in the above-identified application be withdrawn.

The petition to withdraw the holding of abandonment is GRANTED.

This application was held abandoned for failure to timely reply the Notice of Non-Compliant Amendment mailed May 22, 2003, setting forth a one-month period of response. A Notice of Abandonment was mailed on November 26, 2003.

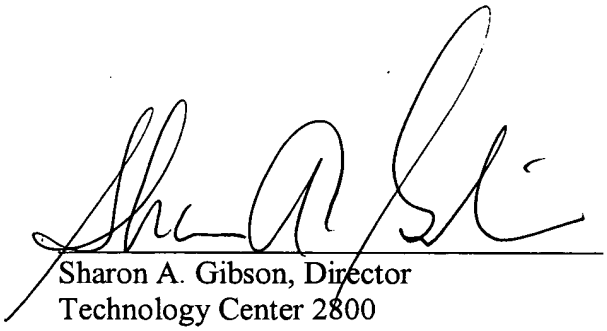
Petitioner asserts that an Amendment B was prepared in response to the Notice of Non-Compliant Amendment and was timely mailed to the Patent and Trademark Office (USPTO) on June 3, 2003. This is evidenced by the certificate of mailing attached to the response, a copy of the response and the post card receipt indicating receipt of the papers in the USPTO on June 6, 2003.

The Amendment B acknowledged as having been received in the USPTO on June 6, 2003 is not of record in the application file and cannot be located. However, M.P.E.P. §503 states, "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the Amendment B prepared in response to the Notice of Non-Compliant Amendment was timely received in the USPTO but lost after receipt thereof.

For the above reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. Inconvenience to petitioner is regretted.

The application file is being forwarded to the technical support staff for processing the Amendment B response to the Notice of Non-Compliant Amendment. From there, it will be returned to the examiner for further prosecution.

Questions regarding this decision should be directed to Jose' G. Dees at 571-272-1569.



Sharon A. Gibson, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 5

JOHN DAN MACKINNON
1266 BRYDGES ST. APP. 7
LONDON ON N5W 2C3 CA CANADA

COPY MAILED

MAR 1 1 2003

OFFICE OF PETITIONS

In re Application of
John Dan Mackinnon
Application No. 10/084,805
Filed: February 28, 2002
Title: PULL HANDLE FOR INVALID WALKERS

DECISION ON PETITION

This is a decision on the letter[1] received on January 27, 2003, requesting that the above-identified application be accorded a filing date of October 9, 2002.

The application was filed on February 28, 2002. On January 27, 2003, petitioner submitted a letter which states, in its entirety:

> My filing date of 02/28/2002 seems correct, however you sent my application and filing date by mail seven or eight months late. The date you mailed my notice was 10/09/2002. I've already sent a utility application so I lost eight months or more. I feel cheated of this time and I was then rushed to finish the patent process. Concluding this time period I also was pressed for time to raise the funds and ready myself to advertize and sell my patent. **I wish to make the date of 10/09/2002 the new filing date.** Please refer to the letter that you sent with a mailing date of 10/09/2002 with a confirmation no. of 8488.

It is noted that petitioner has made the somewhat unusual request of requesting a *later* filing date, on the grounds that the Office did not mail his filing receipt until over eight (8) months from the filing of the application.

Section 503 of the MPEP sets forth that OIPE mails a filing receipt to the applicant for each application filed which meets the minimum requirements to receive a filing date. The filing receipt includes the application number, filing date, a confirmation number, a suggested class in the U.S. Patent Classification System (see MPEP § 902.01), and the number of an art unit where the application is likely to be examined. The filing receipt also includes other information about the application as applicable, such as continuing

1 This is properly treated as a petition under 37 CFR 1.53(b).

data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. 122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). A nonprovisional application, other than a CPA filed under 37 CFR 1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 CFR 1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 CFR 1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

The filing receipt serves merely as an identifier of the serial number, filing date, art unit, and continuity data. In no way would the failure to receive a filing receipt impair or "cheat" an applicant. Applicants are free to raise funds and promote their inventions without the physical possession of a filing receipt.

Therefore, 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)."

The reply to this letter may be submitted by mail[2], hand-delivery[3], or facsimile[4].

The petition fee of $130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

After this decision is mailed, the application will be forwarded to Technology Center 3600 for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

2 Commissioner for Patents, Box DAC, Washington, DC 20231.

3 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

4 (703) 308-6916, Attn: Office of Petitions.

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Paper No. 5

JOHN DAN MACKINNON
1266 BRYDGES ST. APP. 7
LONDON ON N5W 2C3 CA CANADA

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OFFICE OF PETITIONS

In re Application of
John Dan Mackinnon
Application No. 10/084,805
Filed: February 28, 2002
Title: PULL HANDLE FOR INVALID WALKERS

DECISION ON PETITION

This is a decision on the letter[1] received on January 27, 2003, requesting that the above-identified application be accorded a filing date of October 9, 2002.

The application was filed on February 28, 2002. On January 27, 2003, petitioner submitted a letter which states, in its entirety:

> My filing date of 02/28/2002 seems correct, however you sent my application and filing date by mail seven or eight months late. The date you mailed my notice was 10/09/2002. I've already sent a utility application so I lost eight months or more. I feel cheated of this time and I was then rushed to finish the patent process. Concluding this time period I also was pressed for time to raise the funds and ready myself to advertize and sell my patent. **I wish to make the date of 10/09/2002 the new filing date.** Please refer to the letter that you sent with a mailing date of 10/09/2002 with a confirmation no. of 8488.

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1 This is properly treated as a petition under 37 CFR 1.53(b).

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data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. 122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). A nonprovisional application, other than a CPA filed under 37 CFR 1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 CFR 1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 CFR 1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

The filing receipt serves merely as an identifier of the serial number, filing date, art unit, and continuity data. In no way would the failure to receive a filing receipt impair or "cheat" an applicant. Applicants are free to raise funds and promote their inventions without the physical possession of a filing receipt.

Therefore, 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)."

The reply to this letter may be submitted by mail[2], hand-delivery[3], or facsimile[4].

The petition fee of $130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

After this decision is mailed, the application will be forwarded to Technology Center 3600 for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

2 Commissioner for Patents, Box DAC, Washington, DC 20231.

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JOHN DAN MACKINNON
1266 BRYDGES ST. APP. 7
LONDON ON N5W 2C3 CA CANADA

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OFFICE OF PETITIONS

In re Application of
John Dan Mackinnon
Application No. 10/084,805
Filed: February 28, 2002
Title: PULL HANDLE FOR INVALID WALKERS

DECISION ON PETITION

This is a decision on the letter[1] received on January 27, 2003, requesting that the above-identified application be accorded a filing date of October 9, 2002.

The application was filed on February 28, 2002. On January 27, 2003, petitioner submitted a letter which states, in its entirety:

> My filing date of 02/28/2002 seems correct, however you sent my application and filing date by mail seven or eight months late. The date you mailed my notice was 10/09/2002. I've already sent a utility application so I lost eight months or more. I feel cheated of this time and I was then rushed to finish the patent process. Concluding this time period I also was pressed for time to raise the funds and ready myself to advertize and sell my patent. **I wish to make the date of 10/09/2002 the new filing date.** Please refer to the letter that you sent with a mailing date of 10/09/2002 with a confirmation no. of 8488.

It is noted that petitioner has made the somewhat unusual request of requesting a *later* filing date, on the grounds that the Office did not mail his filing receipt until over eight (8) months from the filing of the application.

Section 503 of the MPEP sets forth that OIPE mails a filing receipt to the applicant for each application filed which meets the minimum requirements to receive a filing date. The filing receipt includes the application number, filing date, a confirmation number, a suggested class in the U.S. Patent Classification System (see MPEP § 902.01), and the number of an art unit where the application is likely to be examined. The filing receipt also includes other information about the application as applicable, such as continuing

1 This is properly treated as a petition under 37 CFR 1.53(b).

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data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. 122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). A nonprovisional application, other than a CPA filed under 37 CFR 1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 CFR 1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 CFR 1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

The filing receipt serves merely as an identifier of the serial number, filing date, art unit, and continuity data. In no way would the failure to receive a filing receipt impair or "cheat" an applicant. Applicants are free to raise funds and promote their inventions without the physical possession of a filing receipt.

Therefore, 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)."

The reply to this letter may be submitted by mail[2], hand-delivery[3], or facsimile[4].

The petition fee of $130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

After this decision is mailed, the application will be forwarded to Technology Center 3600 for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
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for Patent Examination Policy

2 Commissioner for Patents, Box DAC, Washington, DC 20231.

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1266 BRYDGES ST. APP. 7
LONDON ON N5W 2C3 CA CANADA

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**OFFICE OF PETITIONS**

In re Application of
John Dan Mackinnon
Application No. 10/084,805
Filed: February 28, 2002
Title: PULL HANDLE FOR INVALID WALKERS

LETTER

This is a decision on the letter received on October 14, 2004, which sets forth that the above identified application is not abandoned.

The above-identified application became abandoned for failure to file a proper response to the Restriction Requirement, mailed December 1, 2003, which set a shortened statutory period to reply for one (1) month. On December 30, 2003, a one-month extension of time was received. No further extensions of time under the provisions of 37 CFR 1.136(a) were received. Accordingly, the above-identified application became abandoned on February 2, 2004. A Notice of abandonment was mailed on September 21, 2004.

Petitioner asserts that several responses were sent subsequent to December 1, 2003. The electronic record has been reviewed, and it is clear that three responses were received subsequent to December 1, 2003. On December 30, 2003, the above-mentioned extension of time was received. Two more responses were received subsequent to the abandonment of this application; on March 29, 2004, a letter was received which referred to the Examiner as a "terrible terrible person" and demanded that this letter be distributed to every Office employee, and on March 31, 2004, a letter was received which discussed a discrepancy in financial matters. At no time prior, or subsequent to the abandonment of this application, has Petitioner submitted the proper response to the restriction requirement, in that Petitioner has failed to elect a single species for examination.

In order to revive this application, Petitioner must:

1. Elect either group 1 or group 2, as set forth in the restriction requirement of December 1, 2003, and
2. File a petition under either 37 C.F.R. §§1.137(a) or 1.137(b).

Petitioner may read about these two types of petitions here:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c.

See portion 2(c), entitled "Unintentional and Unavoidable Delay."

The forms for these two types of petitions may be downloaded here: http://www.uspto.gov/web/forms/index.html.

See forms PTO/SB/61 and PTO/SB/64, respectively.

The fees associated with the filing of these petitions, for a small entity, are $130 for a petition under 37 C.F.R. §1.137(a) and $685 for a petition under 37 C.F.R. §1.137(b).

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

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ROBINS & PASTERNAK LLP
1731 EMBARCADERO ROAD
SUITE 230
PALO ALTO, CA 94303

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AUG 1 9 2005

OFFICE OF PETITIONS

In re Application of
Alan P. Wolffe, et al.
Application No. 10/084,826
Filed: October 24, 2001
Attorney Docket No. 8325-0014.20

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.10(c) filed May 4, 2005, requesting that the above-identified application be accorded a filing date of October 24, 2001, instead of the presently accorded date of February 24, 2002.

Petitioner alleges that the application was deposited in "Express Mail" service with the United States Postal Service (USPS), on October 24, 2001. In support, petitioners provide, *inter alia*, a copy of the Express Mail label, receipt No. EL873907305US. The same Express Mail receipt number was referred to in the original transmittal letter found in the file.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. The evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on October 24, 2001.

The petition is **GRANTED**.

The application is being referred to the Office of Initial Patent Examination (OIPE) for correction of the filing date to **October 24, 2001** and for issuance of a corrected filing receipt.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Akron, OH 44316-0001

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In re Application of :
Georges Marcel Victor Thielen, et al. :
Application No. 10/084,890 : DECISION ON PETITIONS
Filed: February 27, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. DN2001057 : AND UNDER 37 CFR 1.78(a)(6)

This is a decision on the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed May 3, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petitions are **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. 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 petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., (August 2001), Section 201.11, Reference to First Application. The amendment filed fails to comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable.

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and a substitute amendment[a[1]] to correct the above matter is required.

Further, it is noted that a claim for priority of provisional Application No. 60/276,588 appears in the specification submitted on filing. However, petitioner did not include the claim for priority of this provisional application in the amendment filed April 30, 2004. For the record, petitioner needs to clarify whether or not a claim for priority of provisional Application No. 60/276,588 is still desired and if so, the substitute amendment filed in response to this decision should also include the claim for priority of provisional Application No. 60/276,588. Applicant is reminded that if it is stated that the claim for priority of this provisional application is no longer desired, the rights thereto would be forever lost.

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

---

a[1] See 37 CFR 1.121.

**By fax:** (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Andrea Smith at (703) 308-6711[b[2]].

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances Hicks
Lead Petitions Examiner

b[2] Effective September 27, 2004, the telephone number will be 571-272-3226.

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Commissioner for Patents
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Patent & Trademark Department - D/823
1144 East Market Street
Akron, OH 44316-0001

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**OFFICE OF PETITIONS**

In re Application of :
Georges Marcel Victor Thielen, et. al. : DECISION ON PETITIONS
Application No. 10/084,890 : UNDER 37 CFR 1.78(a)(3) AND
Filed: February 27, 2002 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. DN2001057 :

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed September 3, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional 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. 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 petition fails to comply with item (1) above.

The amendment submitted concurrently with the instant petition as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the instant petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

In view of the above, the amendment to add a priority claim to the first line of the specification, which is physically embedded in the instant petition, is not acceptable. Accordingly, a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3), must be submitted.

Since a petition under 37 CFR 1.78(a)(3) does not require a renewed petition fee, the $1,330 submitted on September 3, 2004 will be credited to petitioner's deposit account.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (703) 872-9306<br>ATTN: Office of Petitions |

Any questions concerning this matter may be directed to Andrea Smith at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances Hicks
Lead Petitions Examiner

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The Goodyear Tire & Rubber Company
Intellectual Property Law Department D/823
1144 East Market Street
Akron OH 44316-0001

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| | | |
|---|---|---|
| In re Application of | : | |
| Thielen et al. | : | DECISION GRANTING PETITION |
| Application No. 10/084,890 | : | UNDER 37 CFR 1.78(a)(3) and (a)(6) |
| Filed: February 27, 2002 | : | |
| Attorney Docket No. DN2001057X01 | : | |

This is a decision on the renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6), filed March 1, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 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, a 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 applications, 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 instant pending nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) in that (1) a reference to the prior-filed applications has been included in an amendment to the first sentence of the specification following the title as provided by 37 CFR 1.78(a)(2)(iii) and 1.78(a)(5)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains an adequate statement of unintentional delay.[1] Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 119(e) to the prior-filed applications satisfies the conditions of 37 CFR 1.78(a)(3) and 1.78(a)(6), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 1.78(a)(1) and (a)(2) and under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. 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 applications, accompanies this decision on petition.

---

[1] 37 CFR 1.78(a)(3) and 1.78(a)(6) require 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. In the instant petition, petitioners stated that "the entire delay between the date required for claim to benefit of the filing date of Serial No. 09/264,937, now U.S. 6,469,104 under 37 C.F.R. Section 1.78(a)(2) until the filing of a grantable petition under 37 C.F.R. Section 1.78(a)(3) was unintentional." The statement contained in the instant petition varies from the language required by 37 CFR 1.78(a)(3) and (a)(6); however, the statement is being construed as "the entire delay between the date the claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed applications, Nos. 09/264,937 and 60/276,588, 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." If this is not a correct interpretation of the statement, petitioners must notify the Office of Petitions immediately.

Any questions concerning this matter may be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

Frances Hicks
Lead Paralegal
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COPY MAILED

JAN 17 2006

OFFICE OF PETITIONS

In re Application of :
Phillip King Parell, et al. :
Application No. 10/084,895 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 581 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 27, 2005, to revive the above-identified application.

The petition is **GRANTED.**

A Notice of Non-Compliance was mailed on September 8, 2004. The Notice indicated that the Amendment filed June 15, 2004 was considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, June 30, 2003). Petitioner was given a time period of one (1) month or thirty (30) days from the mailing date of the notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment of the application. Accordingly, the application became abandoned at midnight on October 8, 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 October 27, 2005 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 3700, Art Unit 3726 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
WASHINGTON, D.C. 20231
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**MAIL**

Paper No. 3

APR 0 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Wilmer, Cutler & Pickering
2445 M Street, NW
Washington, DC 20037

In re Application of: Thomas Matthews, et al. )
Application No. 10/084,913 ) **DECISION ON REQUEST FOR**
Filed: March 1, 2002 ) **WITHDRAWAL AS ATTORNEY**
For: NETWORK MANAGEMENT )
METHOD AND TOOL )

This is a decision on the Request To Withdraw from Representation filed March 17, 2003.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Attn: Thomas P. Matthews
President and CEO
Inciscent Inc.
2735 Hartland Road
Suite 200
Falls Church, VA 22043

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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06262006

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

JUL 11 2006

*In re* Application of Stefan Jansen :
Application No.: 10/084,981 : **WITHDRAWAL FROM ISSUE**
Filed: March 01, 2002 : *37 CFR 1.313*
For: **MULTILAYER PCB ANTENNA** :

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue due to unpatentability of one or more claims pursuant to 37 C.F.R. § 1.313.

The U.S. Patent and Trademark Office records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Fee(s) Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Fee(s) Due. If the application is abandoned, applicant may request either a refund or a credit to a Deposit Account.

Any question regarding this communication should be directed to Minsun Harvey, Supervisory Patent Examiner, at (571) 272-1835.

The application is being returned to the examiner for taking appropriate action.

Janice A. Falcone

for Robert Oberleitner, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

SEP 17 2002

Director's Office
Group 3700

John Russell Uren, P. Eng.
Suite 202
1590 Bellevue Avenue
West Vancouver, BC V7V 1A7
CANADA

In re application of
Homer L. Spencer

Application Number: 10/084986
Filed: February 27, 2002

**DECISION ON PETITION TO MAKE SPECIAL UNDER 37 CFR. 1.102(c)**

For: **SEALING METHOD AND APPARATUS FOR OIL AND GAS WELLS**

This is a decision on the petition filed on August 19, 2002, under 37 CFR. 1.102(c) to make special the above identified application because of the age/health of the applicant. Since the requirements of the M.P.E.P Section 708.02 IV have been met, the petition will be GRANTED.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if Petitioner makes a prompt bona-fide effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the Examiner to accomplish this purpose.

**Summary:** Decision on Petition **GRANTED**.

Richard A. Bertsch
Director
Technology Center 3700
(703) 308-0975

rt: 9/16/02

JOHN RUSSELL UREN
1337 Gulf Road, P.O. Box 1304
Point Roberts, Washington 98281-1304
Tel. (360) 945-3411 - Fax (360) 945-1113

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TRADEMARKS
UNITED STATES PATENT AND
TRADEMARK OFFICE
WASHINGTON, D.C. U.S.A. 20231
BOX: DAC

In re the Application of: HOMER L. SPENCER
Serial No.: 10/084,986
Filed: February 27, 2002
Title: IMPROVED SEALING METHOD AND APPARATUS FOR OIL AND GAS WELLS

---

PLEASE DATE STAMP AND RETURN TO ACKNOWLEDGE RECEIP
OF: Petition to Make Special, Declaration.

Date Mailed: August 9, 2002 Atty Docket: TES1210

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Kristofer E. Elbing
187 Pelham Island Road
Wayland MA 01778

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FEB 09 2005

OFFICE OF PETITIONS

In re Application of :
Kollias et al. :
Application No. 10/085,011 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. M0001-003002 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 22, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to reply timely to the nonfinal Office action mailed May 27, 2004, which set a three-month shortened statutory period to respond. No extensions of time were obtained pursuant to 37 CFR 1.136(a). Accordingly, this application became abandoned on August 28, 2004. A Notice of Abandonment was mailed on December 28, 2004.

The application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of continuation application, No. 11/018,387, filed December 20, 2004.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 11

ANTONELLI TERRY STOUT & KRAUS
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209

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AUG 0 5 2003

OFFICE OF PETITIONS

In re Application of :
Akihiko Satoh et al :
Application No. 10/085,037 :
Filed: March 1, 2002 :
Attorney Docket No. 501.41262X00 :

ON PETITION

501.41262X00

This is a decision on the petitions under 37 CFR 1.137(b) and 37 CFR 1.313(c)(2), filed July 31, 2003, to revive the above-identified application and to withdraw the above-identified application from issue after payment of the issue fee.

The petitions are **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 March 25, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on June 26, 2003.

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 31, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.

The application is being forward to Technology Center AU 2824 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the currently filed Amendment.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AUG 7 2003

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, L.L.P.
1300 I STREET, NW
WASHINGTON, DC 20005

In re Application of :
Joseph C. Cauthen :
Serial No.: 10/085,040 : DECISION ON PETITION
Filed: March 1, 2002 :
For: Intervertebral Disc Annulus Stent :

This is in response to applicants' petition filed June 26, 2003, to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on the age of the applicant.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, IV. Therefore the petition is **GRANTED**.

**The application will be forwarded to the examiner for action on the merits commensurate with this decision.**

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, Washington, DC 20231, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director,
Technology Center 3700/2900

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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BIRCH STEWART KOLASCH & BIRCH LLP
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

| | | |
|---|---|---|
| In re Application of | : | |
| Daniel S. Sitar et al | : | |
| Application No. 10/085,051 | : | DECISION ON PETITION |
| Filed: March 1, 2002 | : | |
| Attorney Docket No. 0030-0206P | : | |

This is a decision on the paper filed August 30, 2005, which is being treated as a petition under 37 CFR 1.182, to correct the spelling of the name of inventor "Daneil S. Sitar" to "Daniel S. Sitar."

The petition is **GRANTED**.

Office records have been corrected to reflect the correct spelling of the above-named inventor. A corrected Filing Receipt, which sets forth the correct spelling of the above-named inventor, accompanies this decision on petition.

Any questions concerning this matter may be directed to Irvin Dingle at (571) 272-3210.

The matter is being referred to the Certificate of Correction Branch for correcting the October 11, 2005 Certificate of Correction.

Irvin Dingle
Petition Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPL NO. | FILING OR 371(c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|
| 10/085,051 | 03/01/2002 | 1651 | 778 | 0030-0206P | 11 | 2 |

**CONFIRMATION NO. 8155**

**CORRECTED FILING RECEIPT**

*OC000000025119128*

2292
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

Date Mailed: 07/31/2007

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)**

Daniel S. Sitar, Winnipeg, CANADA;
Alvaro P. Bras, Winnipeg, CANADA;

**Power of Attorney:**

Mark Nuell--36623

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/272,322 03/02/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 03/27/2002

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/085,051**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

** SMALL ENTITY **

**Title**

METHOD FOR ASSAYING NON-SPERMINE/SPERMIDINE ACTIVITY OF SPERMIDINE/SPERMINE N1-ACETYLTRANSFERASE (SSAT)

**Preliminary Class**

435

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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## LICENSE FOR FOREIGN FILING UNDER
## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted

under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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ROBERT E BUSHNELL
SUITE 330
1522 K STREET N W
WASHINGTON DC 20005-1202

| | | |
|---|---|---|
| In re: | LYNN G. HILDEN et al. | : Decision on Petition for |
| Serial No. | 10/085,069 | : Review of a Requirement |
| Filed : | March 01, 2002 | : for Restriction |

For: RAPID DEFLAGRATION CORD (RDC)
ORDINANCE TRANSFER LINES

This is a decision on the petition under 37 CFR 1.144, received on December 8, 2006 for review of the May 19, 2006 restriction requirement.

The applicant's petition is **DENIED**.

## BACKGROUND

The statement of facts can be found on pages 2-6 of applicants petition. In particular, the following is pointed out as being material to this decision.

Claim 33 as amended and subject to the final office action mailed on September 8, 2006 is as follows:

33 (previously presented): An ordnance energy transfer system, comprising:

a rapid deflagrating cord extending from a first end and a second end of a transfer line, said rapid deflagrating cord having a burn a rate of 1000 to1500 feet per second; and

a first metal tubing hermetically encapsulating said rapid deflagrating cord from said first end to said second end of said transfer line, said first metal tubing being crimped at each end thereof, onto said transfer line at said first and second ends of said transfer line, to hold said rapid deflagration cord in place in said first metal tubing

Claim 54 as presented and subject to the final office action mailed on September 8, 2006 is as follows:

54. (previously presented) An ordnance energy transfer system, comprising a transfer line, said transfer line including:

an aluminum tube;

a rapid deflagrating material filing said aluminum tube, said rapid deflagrating material having a burn a rate of 1000 to1500 feet per second;

a semi-flexible stainless steel tube centrally disposed over said aluminum tube, said stainless steel tube being shorter in length than said aluminum tube, each end portion of said stainless steel tube being crimped onto said aluminum tube to hold said aluminum tube in place, wherein in inner surface area of the non-crimped portion of said stainless steel tube is separated from said aluminum tube by 0.006 inches.

Additionally, it is noted that the examiners response to applicant's traversal is found in the final rejection mailed on September 8, 2006. It is further noted that the examiner had made the restriction requirement final in that Office action.

## ARGUMENTS

Applicant argues that claim 33 should have been examined on the merits during the examination of claim 54, alleging that claim 33 is generic.

This argument is unclear since claim 33 was *restricted* from claim 54, not subject to an *election*. The examiner set forth a combination/subcombination restriction between these two groupings of claims. See page 2 of the restriction requirement mailed May 19, 2006. A proper argument to this restriction requirement would be to address the examiners reasoning of separating the inventions via combination/subcombination. Not withstanding the fact that an election of species was not made, a review of claim 33 cannot be considered to be generic to claim 54 for at least the following reason: In claim 33 the metal tubing is crimped onto the transfer line whereas in claim 54 there is no mention of either of the two tubes being crimped onto the transfer line. Additionally, claim 54 does not require a "deflagration cord" and would read on the deflagration material being directly applied within the aluminum tube.

Applicant argues that claim 66 should be examined as well, however, claim 66 is dependent from claim 33. Applicant must first overcome the restriction requirement discussed above.

Applicant argues that the examiner has not shown a prima facie case indicating a serious burden to the applicant in that the examiner previously searched claim 33 and that the examiner did not explain why other cited subclasses would have to be searched.

In response, it has been noted that claim 33 as currently presented is broader than claim 33 as previously searched. Note claim 33 not longer requires the details of the fittings over each end of the transfer line, the ferrule or the closure cup. Therefore, the art disregarded during the first search would need to be reexamined in light of the broader claim.

With respect to the examiner not explaining why other subclasses would have to be searched is not recognized as a requirement for burden. An examiner's statement of what areas are to be searched are taken at face value, absent evidence to the contrary by the applicant, of which none has been provided.

The petition is **DENIED**.

The requirement for restriction of May 19, 2006 is seen as being proper and thus the application remains finally rejected as per the final rejection mailed September 9, 2006.

Any questions or comments with respect to this decision should be forwarded to Michael J. Carone at (571) 272-6873.

Donald T. Hajec, Director
Technology Center 3600
(571) 272-5150

mc/snm: 2/21/07
SM

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TECHNOLOGY CENTER 3600

ROBERT E BUSHNELL
SUITE 300
1522 K STREET N W
WASHINGTON DC 20005-1202

| | | |
|---|---|---|
| In re: | LYNN G. HILDEN | : Decision on Petition for |
| Serial No. | 10/085,069 | : Review of a Requirement |
| Filed : | March 01, 2002 | : for Restriction |

For: RAPID DEFLAGRATION CORD (RDC)
ORDINANCE TRANSFER LINES

This is a decision on the renewed petition under 37 CFR 1.144, received on March 2, 2007 for review of the restriction requirement mailed May 19, 2006.

The applicant's petition is DISMISSED.

## BACKGROUND

On December 8, 2006, applicant filed a petition under 37 CFR 1.144 for review of the restriction requirement. The petition included reasoning as to why claims 33 and 66 should have been examined.

On February 23, 2007, the Office mailed a decision denying applicants petition.

On March 2, 2007, applicant filed an amendment canceling all non-elected claims, including claims 33 and 66.

Also on March 2, 2007, the instant renewed petition was filed providing additional reasons why the non-elected claims should be examined.

DECISION

In that the non-elected claims have been cancelled by applicant and all pending claims have been allowed as evidenced by the Notice of Allowability and Notice of Allowance mailed March 14, 2007, the issues have thereby been rendered Moot.

Applicant's petition therefore must be DISMISSED.

Any questions or comments with respect to this decision should be forwarded to Michael J. Carone at (571) 272-6873.

Donald T. Hajec, Director
Technology Center 3600
(571) 272-5150

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : August 25, 2006

**TO SPE OF** : ART UNIT 3742

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/085092patent No.: 7,075,037

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.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** COC is approved. Requested changes do not introduce new matter, nor change the scope of the claims

SJ 5/1/07

3742

**SPE** **Art Unit**

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SAGRES DISCOVERY INC.
INTELLECTUAL PROPERTY - R440
P.O. BOX 8097
EMERYVILLE, CA 94662-8097

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MAY 17 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of: | : | |
| Morris et al. | : | |
| Application No. 10/085,117 | : | DECISION ON |
| Filed: February 27, 2002 | : | PETITION |
| Atty Docket Number: 529452000121 | : | |

This is a decision in response to the Petition under 37 CFR 1.137(b), filed March 20, 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 Office Communication mailed June 1, 2005. The Office Communication required Application to respond make a restriction/election. The Restriction/Election requirement set a one (1) month period for reply, and also provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned July 2, 2005. A Notice of Abandonment was mailed January 27, 2006.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). A Response to the Restriction/Election requirement is filed with the instant petition. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 1642 for processing of the Response to the Restriction/Election requirement.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : May 21, 2008

**TO SPE OF:** ART UNIT 1637 Gary Benzion

**SUBJECT:** Request for Certificate of Correction for Appl. No.: 10/085,134 Patent No.: 6,699,670

Please respond to this request for 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**.

Should the dependency in claim 4 be changed to "3"?

Antonia Johnson

**Thank You For Your Assistance**

**Certificates of Correction Branch**
**703-308-9390 ext.** 111

**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:**

Stacy Benzion SPE AU 1637

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

TAT YU
UNIVERSITY OF CAMBRIDGE
DEPARTMENT OF ENGINEERING
TRUMPINGTON STREET
CAMBRIDGE CB2 1 PZ
UNITED KINGDOM
AIR-MAIL

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SEP 1 9 2002

OFFICE OF PETITIONS

In re Application of :
Crossland, et al. :
Application No. 10/085,140 :
Filed: March 1, 2002 : LETTER
Title: ACTIVE SEMICONDUCTOR BACPLANES :

Dear Mr. Yu:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 USC 116 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

Stanley C. Spooner
Nixon & Vanderhye, P.C.
1100 North Glebe Road
8th Floor
Arlington, Virginia 22201-4714
(703)816-4000

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 6

NIXON & VANDERHYE PC
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201

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SEP 1 9 2002

OFFICE OF PETITIONS

In re Application of :
Crossland, et al. :
Application No. 10/085,140 : DECISION ACCORDING STATUS
Filed: March 1, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 124-931 :

This is in response to the petition under 37 CFR 1.47(a), filed July 31, 2002.

The petition under 37 CFR 1.47(a) is **GRANTED**.

The above-identified application was filed on March 1, 2002. On March 21, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring, *inter alia*, an executed oath or declaration (and a surcharge for its late filing). This Notice set a two-month period for reply.

In reply, applicant filed the instant petition, and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a three month extension of time.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Accompanying the petition were, *inter alia*, (1) a declaration executed by inventor William A. Crossland, but with the signature block for inventor Tat Yu left blank; (2) a declaration in support of petition from attorney Philip Davies; and (3) a copy of a letter from Davies to Yu, transmitting the application papers to Yu's last known address. Furthermore, the petition states that to date no executed declaration from Yu has been received.

The declaration filed July 31, 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.

E. Shirene Willis for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin NJ 08830

MAILED

FEB 10 2009

OFFICE OF PETITIONS

In re Application of :
Mangalvedhekar :
Application No. 10/085,218 : DECISION ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 075635.0104 :

This is a decision on the petition, filed January 22, 2009, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file an Appeal Brief after a Notice of Appeal was filed on March 27, 2008. Applicant filed a Notice of Appeal and a Pre-Appeal Brief Request for Review on March 27, 2008.

Per 1296 O.G. 67 (July 12, 2005): The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater.

Applicant's representative is a participant in the Office's E-Notification program, wherein applicant's representative receives a once daily e-mail notification of all applications in which outgoing Office correspondence has been issued. Applicant's representative asserts that he did not receive notification regarding the April 9, 2008 Notice of Panel Decision from Pre-Appeal Brief Review. Therefore, petitioner argues the application is not abandoned.

A review of the official record indicates that e-mail notification of the April 9, 2008 Notice of Panel Decision from Pre-Appeal Brief Review was not sent.

In view of the above, the petition under 37 CFR 1.181 is **granted** and the holding of abandonment is withdrawn.

No petition fee has been or will be charged in connection with this matter.

This application is being referred to the Technology Center AU 2442's technical support staff for **re-mailing** the April 9, 2008 Notice of Panel Decision from Pre-Appeal Brief Review. The period for filing a proper Appeal Brief will be reset to be one month from the re-mailing of the April 9, 2008 Notice of Panel Decision from Pre-Appeal Brief Review.

Telephone inquiries pertaining to this decision 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

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

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Sunit B. Mangalvedhekar | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7660876 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/085,218 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1082** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

#3

SEP 20 2002

BRIAN L. BUCKWALTER, PH.D.
MATHEWS, COLLINS, SHEPHERD & MCKAY, P.A.
SUITE 306
100 THANET CIRCLE
PRINCETON NJ 08540

| | | |
|---|---|---|
| In re Application of | : | |
| Sham Chopra | : | |
| Serial No.: 10/085,234 | : | PETITION TO MAKE SPECIAL |
| Filed: February 28, 2002 | : | |
| Attorney Docket No.: 4769-102 | : | |

This is in response to applicant's petition filed February 28, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, VIII. Therefor the petition is **GRANTED**.

**The following condition applies to the grant of this petition: If, upon examination, it is determined that a restriction requirement is necessary because of multiple inventions being claimed, applicant will be required to make an election without traverse of a single invention to be prosecuted.**

**Applicant has indicated in the petition that if election is required, Claim 1 and those claims grouped with it will be elected without traverse.** This satisfies the above requirement.

**The application will be forwarded an the examiner for action on the merits commensurate with this decision.**

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**January 8, 2008**

**Patrick H. Higgins**
**Fox Rothschild, LLP**
**997 Lenox Drive**
**Building 3**
**Lawrenceville, NJ 08648**

Patent No.: 6,960,357 B2
Application No.: 10/085234
Inventor(s): Sham Chopra
Issued: November 1, 2005
Title: **CHEMICAL DELIVERY DEVICE**

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 matter, 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<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-0025<br>ATTN: Office of Petitions |

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

**Virginia Tolbert**
For Mary Diggs, Supervisor
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 113**

vt

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**FARJAMI & FARJAMI LLP**
**26522 LA ALAMEDA AVENUE,**
**SUITE 360**
**MISSION VIEJO CA 92691**

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MAR 10 2009

OFFICE OF PETITIONS

In re Patent No. 6,821,713
Issue Date: November 23, 2004
Application No. 10/085,242
Filed: February 27, 2002
Attorney Docket No. M-12360 US

ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed January 21, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on November 24, 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 maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

The patent file is being referred to Files Repository.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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**BUCKNAM AND ARCHER**
**1077 NORTHERN BOULEVARD**
**ROSLYN NY 11576**

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| | | |
|---|---|---|
| In re Application of | : | |
| Yean-Kuen Fang, et al. | : | |
| Application No. 10/085,256 | : | NOTICE |
| Patent No. 6,877,385 | : | |
| Filed: October 22, 2001 | : | |
| Attorney Docket No. BA-22772 | | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **LOWE HAUPTMAN HAM & BERNER, LLP**
**1700 Diagonal Road, Suite 310**
**Alexandria, VA 22314**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 5

David S. Bir
Brooks & Kushman P.C.
22nd Floor
1000 Town Center
Southfield, MI 48075-1351

COPY MAILED

JUL 1 7 2002

OFFICE OF PETITIONS

In re Application of :
Hansen :
Application No. 10/085,287 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. KLH 0105 PUS :

This is a decision on the petition filed June 6, 2002, requesting, in effect, that page 7 of the drawings (Figure 11) filed on June 6, 2002, be entered as part of the original disclosure.

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 NOT permitted. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The application was filed on February 28, 2002. On March 26, 2002, the Office of Initial Patent Examination mailed a Notice stating that the application had been accorded a filing date of February 28, 2002, and advising applicants that Figure 11 appeared to have been omitted.

In response, the present petition was filed. Petitioner alleges Figure 11 was filed with the original application.

All the evidence present in the file has been carefully considered, but is not persuasive that Figure 11 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 ....

While petitioner apparently believes that Figure 11 was filed on February 28, 2002, the file of application No. 10/085,287[1] shows that Figure 11 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 evidence presented with the petition does not have more probative value than the official government record of what was actual received in the USPTO on February 28, 2002.

---

[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.

It is for this reason that the USPTO has established a practice of providing a receipt for papers filed in the USPTO to any applicant desiring a receipt. The practice, which was has been in existence for many years and is well publicized, requires that any paper for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. See section 503, Manual Of Patent Examining Procedure (MPEP 503).

Petitioner has only demonstrated an intent to file Figure 11 and has not established that the Figure 11 was actually filed. Unfortunately, patent applicants and their representatives, who intend to file complete applications, occasionally file applications which are missing one or more pages, due to clerical error, a copying machine error (such as papers sticking together), papers falling out of a file, or another reason. A demonstration of an intent to included a page or pages does not establish the actual receipt of such pages by the Office.

Since applicants have not filed a petition under 37 CFR 1.182 requesting June 6, 2002, the date the missing pages were filed, as the filing date, Figure 11 filed on June 6, 2002, will not be entered.

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 and the matter was incorporated by reference.

It is noted that the first paragraph of the specification cites an application and a patent and states, "the disclosures of which are hereby incorporated by reference in their entirety." MPEP 201.06(c) states that:

> . . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

The file will be returned to the Office of Initial Patent Examination for further processing with a filing date of February 28, 2002, using only the application papers filed on that date.

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

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Paper No. 9

EMERSON & SKERIOTIS
One Cascade Plaza, Fourteenth Floor
Akron, OH 44308

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of :
Englehart :
Application No. 10/085,301 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No.: 0613.0015 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 28, 2003, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned October 18, 2002 for failure to timely file a proper response to the non-final Office action mailed July 17, 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 January 24, 2003.

Receipt of the amendment submitted herewith is acknowledged.

This application will be forwarded to Technology Center 3600 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

9/22/05
APPROVED

RECEIVED
CENTRAL FAX CENTER
MAY 25 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| IN RE APPLICATION OF | : | Richard J. Englehart |
| FOR | : | **LOG AND SCREW PIN BUILDING SYSTEM** |
| SERIAL NO. | : | 10/085,301 |
| FILED | : | February 27, 2002 |
| LAST OFFICE ACTION | : | January 24, 2005 |
| EXAMINER | : | Chi Q. Nguyen |
| GROUP ART UNIT | : | 3635 |
| ATTORNEY DOCKET NO. | : | 30613.30015 |

Akron, Ohio 44311-4407
March 8, 2005

**********

**CERTIFICATE OF MAILING**

I hereby certify that this **APPLICATION TO WITHDRAW AS ATTORNEY OF RECORD ACCORDING TO 35 C.F.R. § 1.36** 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, on the following date:

3-11-05
Date

Connie J. Nutter
Connie J. Nutter

**********

**APPLICATION TO WITHDRAW AS ATTORNEY OF RECORD ACCORDING TO 35 C.F.R. § 1.36**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 35 C.F.R. § 1.36, the undersigned, Roger D. Emerson, hereby requests permission to withdraw as attorney herein.

The reasons for my requested withdrawal are contained in detail in the enclosed letter to Mr. Richard J. Englehart, but can be summarized as (1) the applicant has not paid me for the services he has requested I perform; (2) the applicant has consistently and deliberately disregarded agreements and obligations he has made to me, especially concerning reimbursement for expenses and payment of my fees; and (3) by his conduct the applicant is making it unreasonably difficult for me to carry out my representation of him and employment by him, effectively.

I have delivered to the client all files for which I was responsible and information he has given to me. Thereby, I have effectively empowered him to carry on his own prosecution of the application, whether pro se or by hiring another intellectual property attorney. The time for response in the application is greater than thirty days. As such, I believe I have left the applicant in a condition to carry on the prosecution of his application without me. Therefore, I believe I have complied with all the obligations placed upon me by the U.S. Patent and Trademark Office to allow such withdraw and believe I am entitled to the application I request.

I hereby revoke all Associate Powers of Attorney previously granted.

Please send all further correspondence directly to the inventor at the address below:

Mr. Richard J. Englehart
President
Englehart Products EPI
4014 E. 116 St.
Cleveland, OH 44105

Respectfully yours,

BROUSE MCDOWELL

050310
Date

Roger O. Emerson, Esq.
Reg. No. 33,169
500 First National Tower
Akron, Ohio 44308-1136

Telephone No.: (330) 535-5711
Fax No.: (330) 253-8601

604195.1

BROUSE McDOWELL
A LEGAL PROFESSIONAL ASSOCIATION

John M. Skeriotis
Attorney at Law
jskeriotis@brouse.com

388 S. Main Street
Suite 500
Akron, OH 44311-4407
Office: 330.535.5711
Fax: 330.253.8601

1001 Lakeside Avenue
Suite 1600
Cleveland, OH 44114-1151
Office: 216.830.6830
Fax: 216.830.6807

www.brouse.com

March 9, 2005

Mr. Richard J. Englehart
President
Englehart Products EPI
4014 E. 116 St.
Cleveland, OH 44105

VIA CERTIFIED MAIL

Re: Withdrawal of Representation
Before the U.S. Patent and Trademark Office for:
**LOG AND SCREW PIN BUILDING SYSTEM**
Our Ref.: 30613.30015

Dear Richard:

Currently, you have an outstanding balance with Brouse McDowell in the amount of $2,682.10. No attempts have been made with our accounting department in order to rectify this situation. Please note that I will be asking the Commissioner of Patents to allow me to withdraw in representing you in this case. I have directed the Commissioner of Patents to send all future correspondence and telephone inquiries to you at the above-referenced address.

Enclosed, please find a copy of all of the information I have sent to the Patent and Trademark Office on your behalf. Should you hire another attorney to represent you in this matter or if you would like to do it yourself, please feel free to call me for assistance. I would be happy to cooperate with whomever you may choose to represent you.

Very truly yours,

BROUSE McDOWELL

John M. Skeriotis

JMS/cjn
Enclosures
604104.1

RECEIVED
CENTRAL FAX CENTER
MAY 2 5 2005

BROUSE McDOWELL
A LEGAL PROFESSIONAL ASSOCIATION

388 S. Main Street
Suite 500
Akron, Ohio 44311-4407
Telephone: 330.535.5711
Facsimile: 330.253.8601
Internet: www.brouse.com

# Facsimile Transmittal Cover Sheet

| | | | |
|---|---|---|---|
| **To:** | | **From:** | Connie J. Nutter |
| **Company:** | U.S. Patent and Trademark Office | **Date:** | May 25, 2005 |
| **Phone:** | | **Re:** | |
| **Fax:** | 703-872-9306 | **Total pages (Including cover sheet):** | 5 |
| **CC:** | | | |

☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ FYI

Comments:

Please find attached an Application to Withdraw as Attorney of Record that was filed with your office on March 11, 2005. I am requesting a status at this time. Please call me upon receipt of this facsimile with a status of this application.

**If problems arise during transmission, please contact Office Services at 330.535.5711, ext. 349.**

This faxed transmission contains confidential information from the law firm of Brouse McDowell, a Legal Professional Association. This information may be covered by the attorney-client privilege or constitute attorney work product. Information contained in this fax is intended solely for the person or entity named above. If you are not the intended recipient of this communication, you hereby are notified that any dissemination, distribution, or copying of the contents is strictly prohibited. In addition, you are strictly prohibited from taking any action in reliance on the contents of this fax. If you have received this communication in error, please notify the sender immediately and destroy all copies. Thank you for your cooperation.

UNITED STATES 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

RICK MARTIN
PATENT LAW OFFICES OF RICK MARTIN, PC
416 COFFMAN STREET
LONGMONT, CO 80501

**COPY MAILED**

**SEP 0 8 2003**

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of<br>Sunthankar et al.<br>Application No. 10/085,312<br>Filed: February 28, 2002<br>Attorney Docket No. RM534 | DECISION GRANTING PETITION<br>UNDER 37 CFR 1.137(f) |

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed June 30, 2003. This petition is properly treated as a petition to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f). This petition is considered in light of the supplement to petition filed by facsimile transmission on September 5, 2003 to provide the specific date of the foreign filing.

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of a corresponding PCT application (No. PCT/US03/06164) filed on February 27, 2003. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the foreign or international application.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(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

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 to show the projected publication date of December 18, 2003 accompanies this decision on petition.

The application is being forwarded to Technology Center 1753 for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

**DAVID A. HALL**
**HELLER EHRMAN WHITE & McAULIFFE**
**7TH FLOOR**
**4350 LA JOLLA VILLAGE DRIVE**
**SAN DIEGO, CA 92122-1246**

COPY MAILED

AUG 2 7 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Simon Mellor et al | : | |
| Application No. 10/085,340 | : | NOTICE |
| Filed: February 27, 2002 | : | |
| Attorney Docket No. 21860-6061 | : | |

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 2682.

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

HELLER EHRMAN LLP
4350 LA JOLLA VILLAGE DRIVE #700
7TH FLOOR
SAN DIEGO CA 92122

COPY MAILED

DEC 29 2006

OFFICE OF PETITIONS

In re Application of
Simon Mellor, et al.
Application No. 10/085,340
Filed: February 27, 2002
Attorney Docket No. 42792-6061

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed October 3, 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, "instructions from assignee Powerwave Technologies, Inc., to transfer this application to new counsel", do not meet any the conditions set forth in 37 CFR 10.40.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary

evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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 on September 28, 2006 that requires a response by the applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: DAVID HENTY
MYERS, DAWES, ANDRAS & SHERMAN
19900 MACARTHUR BLVD.
SUITE 1150
IRVINE, CA 92612

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HELLER EHRMAN LLP
4350 LA JOLLA VILLAGE DRIVE #700
7TH FLOOR
SAN DIEGO CA 92122

COPY MAILED

FEB 15 2007

OFFICE OF PETITIONS

In re Application of :
Simon Mellor, et al. :
Application No. 10/085,340 : DECISION ON PETITION
Filed: February 27, 2002 : TO WITHDRAW
Attorney Docket No. 42792-6061 : FROM RECORD
:

This is a decision on the renewed petition to Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 4, 2007.

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, "the assignee has requested a transfer of this application", do not meet any the conditions set forth in 37 CFR 10.40.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being

submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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: DAVID HENTY
MYERS, DAWES, ANDRAS & SHERMAN
19900 MACARTHUR BLVD.
SUITE 1150
IRVINE, CA 92812

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 7

PAULA D. MORRIS & ASSOCIATES, PC
2925 BRIARPARK DRIVE, SUITE 930
HOUSTON, TX 77042-3728

COPY MAILED

OCT 2 3 2002

OFFICE OF PETITIONS

In re Application of :
Mary C. Marshall et al :
Application No. 10/085,358 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. SWRI-2098-08 :

This is in response to the communication filed September 9, 2002, which is being treated as a petition under 37 CFR 1.47(a).

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

As to item (1), rule 47 applicant must demonstrate with documented evidence that an inventor refuses to join in the application after having been presented with the application papers (specification, claims, drawings and oath or declaration). There is no indication in the present case whether joint inventor John G. Franjione was ever presented with a copy of the complete application papers for the instant nonprovisional application. From the evidence of record, it

only appears that the Combined Declaration and Assignment documents were sent to joint inventor Franjione, with no mention being made of a copy of the application papers. If joint inventor Franjione was not presented with a copy of the application papers for the instant nonprovisional application, then Mr. Franjione could not attest that he has "reviewed and understands the application papers" and could not execute the declaration he was requested to sign. Did inventor Franjione receive a copy of the application papers? Unless petitioner can show that a copy of the application papers was presented to inventor Franjione, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to inventor Franjione's last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. **The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc.** See MPEP 409.03(d).

The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. If the inventor orally refuses to join in the application, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 petitioner that an omitted 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 must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

**In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to submit the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Irvin Dingle.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
P.O. Box 2327
Mail Stop DAC
Arlington, VA 22202

Or

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

PAULA D. MORRIS & ASSOCIATES PC
2925 BRIARPARK DRIVE, SUITE 930
HOUSTON, TX 77042-3728

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NOV 2 5 2002

OFFICE OF PETITIONS

In re Application of
Mary C. Marshall et al
Application No. 10/085,358
Filed: February 28, 2002
Attorney Docket No: SWRI-2098-08

: DECISION GRANTING
:STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed November 12, 2002, requesting reconsideration of a decision mailed October 23, 2002 which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is granted.

Petitioner has shown that the nonsigning inventor (John G. Franjione) has refused to join in the filing of the above-identified application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the nonsigning inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-8680.

This application is being forwarded to the Office of Initial Patent Examination for pre-examination processing.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

**John G. Franjione**
**50 Maynard Street**
**Apt. 117**
**Attleboro, MA 02703**

COPY MAILED

NOV 2 5 2002

OFFICE OF PETITIONS

In re Application of
Mary C. Marshall; John G. Franjione; Christopher J. Freitas; William T. Roberds; Gordon D. Pollard and Jill Blake
Application No. 10/085,358
Filed: February 28, 2002
For: APPARATUS FOR CONTAMINANT REMOVAL USING NATURAL CONVECTION FLOW AND CHANGES IN SOLUBILITY CONCENTRATIONS BY TEMPERATURE

Dear Mr. Franjione:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-8680. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington D.C. area).

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Paula D. Morris & Associates PC
2925 Briarpark Drive, Suite 930
Houston, TX 77042-3728

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**McDERMOTT WILL & EMERY**
**600 13TH STREET NW**
**WASHINGTON, DC 20005-3096**

**COPY MAILED**

JUN 28 2005

**OFFICE OF PETITIONS**

In re Application of :
Paul Albats Jr. et al :
Application No. 10/085,373 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. HO-P02029US1 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 13, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed September 20, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 21, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination (RCE); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of September 20, 2004 is accepted as having been unintentionally delay.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2878.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,969,844 | 2005-11-29 | 10/085,373 | 2002-02-28 | 04106.000110. |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

| | Fee | Code |
|---|---|---|
| ◉ | 3 ½ year | (1551) |
| ○ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (2553) |

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Jonathan Berschadsky/ | Date (YYYY-MM-DD) | 2010-06-11 |
| Name | Jonathan Berschadsky | Registration Number | 46551 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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In re Patent No. 6969844
Issue Date: November 29,2005
Application No. 10085373
Filed: February 28,2002
Attorney Docket No. HO-P02029US1

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 11,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 11,2010 . 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.

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Paper No. 3

TROUTMAN SANDERS LLP
Bank of America Plaza, Suite 5200
600 Peachtree Street, NE
Atlanta, GA 30308

MAILED

MAR 3 1 2004

Technology Center 2100

In re Application of:
Michelle SHORES, et al.
Application No. 10/085,376
Filed: February 28, 2002
For: SYSTEM AND METHOD FOR IMPROVED VALIDATION FOR CLAIMS COMPLIANCE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed November 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.**

There is no indication that Applicant has been notified of the request for withdrawal. Accordingly, the request is **DENIED.**

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

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Paper No. 5

James E. Schutz
TRAUTMAN SANDERS LLP
Attorneys At Law
Bank of America Plaza
600 Peachtree street, N.E. – Suite 5200
Atlanta, GA 30308-2216

MAILED

APR 21 2004

Technology Center 2100

In re Application of:
Shores, Michele
Application No. 10/085,376
Filed: February 28, 2002
For: SYSTEM AND METHOD FOR IMPROVED VALIDATION FOR CLAIMS COMPLIANCE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed April 15, 2004.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed April 15, 2004 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthew

JM Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

cc: Michelle Shores
EMSI, INC.
167 Mangum Street, N.W.
Atlanta, GA 30313

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 03/15/06

**TO SPE OF** : ART UNIT 3762

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **10/085386** Patent No.: **6775573**

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

_____

**Certificates of Correction Branch**

**703-308-9390 ext.** _____

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

_____

_____

_____

_____

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

**SPE**

3762

**Art Unit**

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# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



PATENT NO. : 6,775,573

APPLICATION NO.: 10/085,386

ISSUE DATE : August 10, 2004

INVENTOR(S) : Eleanor L. Schuler, Claude K. Lee

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 6, lines 58 and 61, "respiratory" should be changed to --gastrointestinal--.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Francis Law Group
1942 Embarcadero
Oakland, CA 94606

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.*

MAR. 8 2005

vided by the device **10'** during treatment should not exceed 20 volts nor 2 amps for each signal.

The computer **20** is used to store the unique waveform signals, which are complex and unique to each organ and function of such organ or organ system. It is a waveform signal(s) selected from the stored library of waveforms in the computer **20** that is transmitted to the control module **14'** and used for treatment of a patient.

The waveform signals, and their creation, are described in greater detail in U.S. patent application Ser. No. 10/000005, filed on Dec. 4, 2001, and entitled "Device and Method to Record, Store, and Broadcast Specific Brain Waveforms to Modulate Body Organ Functioning," the disclosure of which is incorporated herein by reference. Such application contains representative types of waveforms that are also operative in the control of human or animal gastrointestinal processes. Such waveforms or any combination of segments of the waveforms presented in the above mentioned patent application are representative of the kinds of signals operating with the neuron circuits emanating from the medullopontine region of the brain. Such waveforms can be used to modulate either afferent or efferent nerves that play a part in the control or fine-tuning of gastrointestinal processes. Such waveform signals are similar to those naturally produced by the brain stem structures for modulating gastrointestinal processes, as described in detail in the immediately above-identified incorporated application.

The invention further includes a method, as shown in FIG. **3**, for using the device **10, 10'** to control autonomic nerve stimulation of the gastrointestinal tract. The method begins at step **22** by selecting one or more stored coded electrical waveform signals from a menu of cataloged waveform signals. The waveform signals selected control and stimulate gastrointestinal functions. Such waveform signals are similar to those naturally produced by the brain stem structures for controlling and stimulating gastrointestinal processes. Once selected, the waveform signals may be adjusted, in step **24**, to perform a particular function in the body. Alternatively, if it is decided that the waveform signals do not need to be adjusted, step **24** is skipped and the process proceeds directly with step **26**. At step **26**, the waveform signal is transmitted to the treatment member **12, 12'** of the device **10, 10'**.

Upon receipt of the waveform signals, the treatment member **12, 12'** broadcasts the waveform signals to the appropriate location, as shown in step **28**. The device **10, 10'** utilizes appropriate waveform signals to stimulate or control gastrointestinal action via conduction or broadcast of electrical signals into selected nerves or components of gastrointestinal system. It is believed that target organs can only uniquely "hear" their own individual waveform. As a result, the body is not in danger of having one organ perform the function of another organ simply because the first organ received the second organ's waveform.

In one embodiment of the invention, the process of broadcasting by the treatment member **12, 12'** is accomplished by direct conduction or transmission through unbroken skin in a selected appropriate zone on the neck, head, or torso. Such zone will approximate a position close to the nerve or nerve plexus onto which the signal is to be imposed. The treatment member **12, 12'** is brought into contact with the skin in a selected target area that allows the transport of the signal to the target nerve. Otherwise, connections are made internally at appropriate points.

In an alternate embodiment of the invention, the process of broadcasting the waveform is accomplished by direct conduction via attachment of an electrode to the receiving nerve or nerve plexus. This requires a conventional surgical intervention as required to physically attach the electrode to the selected target nerve.

In yet another embodiment of the invention, the process of broadcasting is accomplished by transposing the waveform into a seismic form where it is sent into a region of the head, neck, or torso in a manner that allows the appropriate "nerve" to receive and to obey the coded instructions of such seismic signal. The treatment member **12, 12'** is pressed against the unbroken skin surface using an electrode conductive gel or paste medium to aid conductivity.

Various features of the invention have been particularly shown and described in connection with the illustrated embodiments of the invention. However, it must be understood that these particular products, and their method of manufacture, do not limit but merely illustrate, and that the invention is to be given its fullest interpretation within the terms of the appended claims.

We claim:

**1**. A method for controlling autonomic nerve stimulation of the gastrointestinal tract comprising the steps of:

a. selecting from a storage area one or more waveforms generated in the body and carried by neurons in the body;

b. transmitting or conducting the selected waveforms to a treatment member in contact with the body; and

c. broadcasting the selected waveforms from the treatment member to an organ in the body.

**2**. The method according to claim **1**, in which step "a" further includes selecting said waveforms from a storage area in a computer.

**3**. The method according to claim **1**, in which step "b" further comprises transmitting the selected waveforms remotely to the treatment member.

**4**. The method according to claim **1**, in which step "b" further comprises transmission of the selected waveforms.

**5**. An apparatus for controlling autonomic nerve stimulation of the gastrointestinal tract, comprising:

a. a source of collected waveforms indicative of body organ functioning;

b. a treatment member in direct contact with the body;

c. means for transmitting one or more of the collected waveforms to the treatment member; and

d. means for broadcasting the collected waveforms from the treatment member to a body organ to stimulate organ function.

**6**. The apparatus according to claim **5**, in which said transmitting means includes a digital to analog converter.

**7**. The apparatus according to claim **5**, in which said source comprises a computer having collected waveforms stored in digital format.

**8**. The apparatus according to claim **7**, in which said computer includes separate storage areas for collecting waveforms of different respiratory functional categories.

**9**. The apparatus according to claim **5**, in which the treatment member comprises an antenna for broadcasting respiratory signals.

**10**. The apparatus according to claim **5**, in which the treatment member comprises an electrode.

* * * * *

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Paper No. 8

**JOHN L. KNOBLE**
**KNOBLE & YOSHIDA, LLC**
**EIGHT PENN CENTER**
**1628 JOHN F. KENNEDY BLVD.**
**PHILADELPHIA, PA 19103**

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OFFICE OF PETITIONS

In re Application of
Batoff, Jeffrey
Application No. 10/085,394
Filed: February 28, 2002
Attorney Docket No. NEXP-0005

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 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 Corrected Application Papers (Notice) mailed March 18, 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 May 19, 2002. A Notice of Abandonment was mailed on January 22, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

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 $740.00 extension of time fee submitted with the petition on February 20, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

The file is now being forwarded to 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

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KNOBLE, YOSHIDA & DUNLEAVY
EIGHT PENN CENTER
SUITE 1350
1628 JOHN F. KENNEDY BLVD
PHILADELPHIA PA 19103

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OFFICE OF PETITIONS

In re Application of :
Jeffrey Batoff :
Application No. 10/085,394 : DECISION ON PETITION
Filed: 28 February, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. NEXP-0005 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on 13 April, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. PCT/US01/30002, filed on 26 September, 2001, as set forth in the accompanying amendment.

The petition is **DISMISSED.**

A petition for acceptance of a claim for late priority under 37 CFR § 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii). In addition, the petition under 37 CFR § 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR § 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The benefit claim as stated is improper. The instant nonprovisional application cannot claim priority to the stated provisional applications because the instant application was not filed within twelve (12) months of the filing date of the provisional applications. However, petitioner may

wish to assert a claim of priority from the prior-filed PCT application to the filing date of the provisional applications.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a proper amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)), which properly states the relationship of the prior-filed applications to this application, are required.

Further correspondence with respect to this matter should be addressed as follows:

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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 Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Frances Hicks

Frances Hicks
Lead Paralegal
Office of Petitions

## AMENDMENTS TO THE SPECIFICATION

**On page 1, after the title, please amend the following paragraph:**

CROSS REFERENCE TO RELATED APPLICATIONS

The present application is a continuation of U.S. Application Serial No. 10/620,692, filed on July 17, 2003, which in turn is a continuation application of U.S. Application Serial No. 09/793,131 filed on February 27, 2001 (now U.S. Patent No. 6,996,041, granted February 7, 2006), which claims priority under 35 U.S.C. 119 to the following foreign application: Japanese Application No. 2000-058081, dated March 3, 2000, the disclosures of which [[is]] are incorporated by reference in [[its]] their entirety.

## REMARKS

The specification has been amended to refer to prior applications. Applicants file concurrently herewith a Petition to Accept and Correct an Unintentionally Delayed Claim for Priority under 37 C.F.R. § 1.78(a)(3) together with the surcharge set forth under § 1.17(t).

A corrected filing receipt indicating the benefit of the filing date of February 27, 2001 (i.e., the filing date of U.S. Application Serial No. 09/793,131, now U.S. Patent No. 6,996,041) is solicited.

Allowance of the application is solicited.

Dated: April 3, 2006

Respectfully submitted,

By _____

Mark J. Thronson
Registration No.: 33,082
Gabriela I. Coman
Registration No.: 50,515
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L Street NW
Washington, DC 20037-1526
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Attorneys for Applicants

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PHILADELPHIA PA 19103

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**OFFICE OF PETITIONS**

In re Application of :
Jeffrey Batoff :
Application No. 10/085,394 : DECISION ON PETITION
Filed: 28 February, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. NEXP-0005 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed on 28 September, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. PCT/US01/30002, filed on 26 September, 2001, as set forth in the amendment filed with the petition.

The petition is again **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 item (1) above.

The reference to add the above-noted, prior-filed international application in the first sentence of the specification on page one following the title is not acceptable as drafted since it improperly incorporates by reference the prior-filed international application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after

its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. §§ 120 and 365(c) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. §§ 120 and 365(c) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

If reconsideration of this decision is desired, a renewed petition under 37 CFR § 1.78(a)(3) and 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:

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By fax:
(571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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| In re Application of | : | |
| Jeffrey Batoff | : | |
| Application No. 10/085394 | : | DECISION ON PETITION |
| Filed: 02/28/2002 | : | UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. NEXP-0005 | : | |

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed on 23 April, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. PCT/US01/30002, filed on 26 September, 2001, as set forth in the accompanying amendment.

The petition is **GRANTED.**

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

**(2)** the surcharge set forth in § 1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. §§ 120 and 365(c) is accepted as being unintentionally delayed.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the application is entitled to the benefit of the prior-filed application. In order for the application to be entitled to the***

***benefit of the prior-filed application, all other requirements under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the examiner of Technology Center Art Unit 3627 for consideration of applicant's entitlement to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the above-noted, prior-filed PCT application.

Christina Tartera Donnell

Christina Tartera Donnell
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
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPL NO. | FILING OR 371(c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|
| 10/085,394 | 02/28/2002 | 3627 | 2275 | NEXP-0005 | 10 | 2 |

**CONFIRMATION NO. 8067**

**CORRECTED FILING RECEIPT**

*OC000000024574074*

21302
KNOBLE, YOSHIDA & DUNLEAVY
EIGHT PENN CENTER
SUITE 1350, 1628 JOHN F KENNEDY BLVD
PHILADELPHIA, PA 19103

Date Mailed: 06/28/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

**Applicant(s)**

Jeffrey Batoff, Penn Valley, PA;

**Power of Attorney:** The patent practitioners associated with Customer Number **21302**.

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/235,367 09/26/2000
and claims benefit of 60/268,854 02/15/2001
and is a CIP of PCT/US01/30002 09/26/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 03/16/2002

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/085,394**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**** SMALL ENTITY ****

**Title**

Inventory control and balancing 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).

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## LICENSE FOR FOREIGN FILING UNDER
## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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EIGHT PENN CENTER
SUITE 1350, 1628 JOHN F KENNEDY BLVD
PHILADELPHIA, PA 19103

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JUN 30 2010

OFFICE OF PETITIONS

In re Application of Batoff :
Application No. 10/085,394 :
Filing Date: February 28, 2002 :
Attorney Docket No. NEXP-0005 :

On Application For
Patent Term Adjustment

This is in response to the "Request for Recalculation of Patent Term Adjustment" filed February 17, 2010. Applicant submits the correct patent term adjustment to be indicated on the patent is two thousand five hundred seventy-eight (2,578) days, not one thousand four hundred twenty (1,420) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant appears to request the increase in patent term adjustment solely on the basis that the Office will take in excess of three years to issue this patent.[1]

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 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

[1] The petition fails to clearly identify the basis for the requested increase in the patent term adjustment. However, in view of the citation to *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the basis appears to be the fact the Office will take more than three years to issue the patent.

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, an applicant 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.[2]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

[2] 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.

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1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE
P.O. BOX 3791
ORLANDO FL 32802-3791

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MAR 31 2008

OFFICE OF PETITIONS

In re Application of :
Flick :
Application No. 10/085,403 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No.: 58122 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 7, 2007, to revive the above-identified application.

The petition under 37 CFR 1.137(b) is GRANTED.

The request for refund is DISMISSED.

This application became abandoned April 21, 2007 for failure to timely submit an appeal brief within the time period set for said submission in response to the Notice of Panel Decision from Pre-Appeal Brief, mailed March 16, 2007. Notice of Abandonment was mailed October 5, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied: (1) the reply in the form of an appeal brief, (2) the required petition fee, and (3) a proper statement of unintentional delay.

As to petitioner's contention that the Notice of Panel Decision from Pre-Appeal Brief, mailed March 16, 2007, was inaccurate and incomplete, petitioner is reminded that the preappeal conference program is a pilot program, as stated in § 8 of the Official Gazette Notice 1296 O.G. 67 (OG Notice). The decision of the panel is not petitionable. Applicant's petition would require a determination of the propriety of the decision and not merely a procedural matter and as such, this issue is not petitionable.

There are four numbered boxes (numbered 1 - 4) on the form titled "Notice of Panel Decision From Pre-Appeal Brief Review". Petitioner's complaint is that box number 2 was not checked. In order to determine the issue here it would be necessary to determine if any of the other boxes should have been checked to the exclusion of box 2 and thus this would require a determination of the propriety of the Panel Decision in contravention to the OG Notice. The response that is appropriate after the filing of a Notice of Appeal is the filing of a Brief on Appeal. The appeal

brief was due on April 16, 2007, subject to extensions of time under 37 CFR 1.136(a). An appeal brief was not filed within the periods prescribed by the rules; therefore, the application was properly abandoned.

The petition fee will not be refund as payment of the petition fee is a pre-requisite prior to treatment on the merits of any petition submitted pursuant to 37 CFR 1.137.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

This application is being referred to Technology Center Group Art Unit 3629 for appropriate action by the Examiner in the normal course of business on the reply received November 7, 2007.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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CARLSON, GASKEY & OLDS, P.C.
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM MI 48009

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DEC 20 2004

OFFICE OF PETITIONS

In re Application of :
Joseph F. McDonald, et al :
Application No. 10/085,421 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 67,023-008 :

This is a decision on the petition, filed July 22, 2004, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "**Renewed Petition under 37 CFR 1.137(b)**." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

The application became abandoned for failure to timely file a reply within the meaning of 37CFR 1.113 to the final Office action of October 9, 2003. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee as required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted with the instant petition does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee) or the filing of a continuing application. See attached Advisory Action.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

By facsimile: (703) 872-9306
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3213.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 0 2 2005

**OFFICE OF PETITIONS**

In re Application of :
Joseph F. McDonald, et al :
Application No. 10/085,421 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 67,023-008 :

This is a renewed decision on the petition, filed January 31, 2005, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed October 14, 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 January 15, 2004.

The application file is being forwarded to Technology Center 2800, Art Unit 2856 for consideration.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3213.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

December 2005

Carlson, Gaskey, & Olds, P.C.
400 West Maple Road
Suite 350
Birmingham, MI 48009

In re Patent No. 6,962,090
Issue Date: 08 November 2005
WILLIAM MARTIN SILVIS ET AL.
Serial No.: ~~11/006,649~~ 10/085,421
Filed: 28 February 2002

Title: HEATED STAINLESS STEEL EMISSIONS CANISTER

**DECISION GRANTING PETITION TO CORRECT INVENTORSHIP 37 C.F.R. § 1.324**

This is a decision on the petition filed on June 25, 2004, to correct the inventorship under 37 C.F.R. § 1.48(b). As the application has been patented with the petition outstanding, the petition will be treated as a petition under 37 C.F.R. § 1.324 under the procedure set forth in MPEP 1481.02.

The petition to make the application special 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.

Edward Lefkowitz, Supervisory Patent Examiner
Art Unit 2855
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

EDWARD LEFKOWITZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

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JUN 20 2005

OFFICE OF PETITIONS

WILLIAM M. FESQ
143 CRANE CIRCLE
NEW PROVIDENCE, NJ 07974

In re Application of :
William McBride Fesq, et al. :
Application No. 10/085,425 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. None :

This is a decision on the petition, filed March 17, 2005, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is DISMISSED since it is not properly executed. The petition is signed by only one of the two joint inventors.

37 CFR 1.33(b) states that:

Amendments and other papers filed in the application must be signed by:

(1) An attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;

(4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or

**(5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.**

This is **not** final agency action within the meaning of 5 U.S.C. § 704. 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 include a ratification of the unsigned petition. No further petition fee is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop PETITION
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(703) 872-9306**.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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WILLIAM M. FESQ
143 CRANE CIRCLE
NEW PROVIDENCE, NJ 07974

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SEP 2 8 2005

**OFFICE OF PETITIONS**

In re Application of :
William McBride Fesq, et al. :
Application No. 10/085,425 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. None :

This is a decision on the renewed petition, filed August 19, 2005, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed June 1, 2004. This decision precedes the mailing of a Notice of Abandonment. On March 17, 2005, applicant submitted, *inter alia*, a petition to revive under 37 CFR 1.137(b), an amendment and a 3-month petition for extension of time. The petition was dismissed in a decision mailed June 20, 2005, since the petition was not properly signed. In response, on August 19, 2005, a ratification of the unsigned petition was filed.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Although the statement contained in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the original petition, in conjunction with renewed petition, will be construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the petition.

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. Since, no extension of time fees are due on a petition for revival, the $510 extension fees are refundable. Any request for refund must included a copy of this decision and be mailed to Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450 or faxed to the Customer Service Help Desk at (571) 273-6500.

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 2162 for consideration of the amendment filed March 17, 2005.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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DREIER LLP
Susan Formicola
499 PARK AVE
NEW YORK NY 10022

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AUG 01 2008

In re Application of:
**FESQ** et al.
Application No. 10/085,425
Filed: February 28, 2002
Attorney Docket No. **602470-002**

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed February 11, 2008, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of August 8, 2005. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is November 9, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $770.00; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Brian W. Brown at (571) 272-5338.

This application is being referred to Technology Center AU 2162 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Brian W. Brown
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

**HAROLD C. MOORE**
**MAGINOT MOORE & BOWMAN**
**111 MONUMENT CIRCLE, SUITE 3000**
**BANK ONE CENTER/TOWER**
**INDIANAPOLIS, IN 46204-5115**

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**FEB 2 6 2004**

**OFFICE OF PETITIONS**

In re Application of
Brett Holle et al
Application No. 10/085,426
Filed: February 28, 2002
Attorney Docket No. 2002P03394US (1505-0112)
For: ELECTRICAL SERVICE DISCONNECT HAVING TAMPER DETECTION

ON PETITION

This is a decision on the petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a), filed January 26, 2004, to revive the above-identified application and to accept a declaration signed by less than all the inventors in view of the refusal of one of the inventors to join in the application for patent.

The petitions are **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice) mailed March 15, 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 May 16, 2002.

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 concerning this decision should be directed to Wan Laymon at (703) 306-5685.

The application file is being forwarded to the Office of Initial Patent Examination for preexamination processing.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Albert S. KING & PARTNERS, PLC
F/B/O/ GENTEX CORPORATION
170 COLLEGE AVENUE, SUITE 230
HOLLAND MI 49423

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FEB 14 2006

OFFICE OF PETITIONS

In re Application of :
Tonar et al. :
Application No. 10/085,434 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. GEN-001323C3 :

This is a decision on the "Petition To Withdraw Holding Of Abandonment Based Upon Failure To Receive Office Action Under 37 C.F.R. § 1.181," filed on April 1, 2005, and resubmitted on January 23, 2006. The petition was recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience to petitioner.

On June 2, 2004, the Office mailed a final Office action, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application became abandoned on September 3, 2004. On February 8, 2005, the Office mailed a Notice of Abandonment.

In the present petition, petitioner requested that the Office withdraw the holding of abandonment due to non-receipt of the final Office action mailed on June 2, 2004. The practitioner attested that a search of the file jacket and docket records indicated that the original final Office action was not received. In support of his assertion, the practitioner submitted a print out of the docket record for this application, indicating that no entry exists for the Office action. The practitioner asserted that no reply period existed in the docketing system because the final Office action, which included allowed claims, was never received. The practitioner further explained that the lack of any such data in the section entitled "Reminder List for this Case" indicated that the Office action was not received.

A review of the record indicates no irregularity in the mailing of the final Office action of June 2, 2004, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where

the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three-month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action.

The showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time. Unfortunately, it is not readily apparent from the documentary evidence submitted on petition that the Office action was not received. The print out of the docket record submitted by the practitioner does not contain any entries of any replies docketed in this application. Therefore, the practitioner should provide additional documentary evidence to establish non-receipt of the final Office action, such as a copy of the outside of the file jacket maintained by the practitioner. Additionally, the practitioner may wish to further explain the system for docketing USPTO communications.

The petition to withdraw the holding of abandonment 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, petitioner 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 and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

| | |
|---|---|
| By mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By FAX: | (571) 273-8300<br>Attn: Office of Petitions |
| By hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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HOLLAND MI 49423

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OFFICE OF PETITIONS

In re Application of :
Tonar et al. :
Application No. 10/085,434 : DECISION ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. GEN-001323C3 :

This is a decision on the renewed petition under 37 CFR 1.181, filed May 19, 2005 (certificate of mailing dated Monday, May 15, 2006), to withdraw the holding of abandonment.[1]

On June 2, 2004, the Office mailed a final Office action, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application became abandoned on September 3, 2004. On February 8, 2005, the Office mailed a Notice of Abandonment.

Petitioner requested that the Office withdraw the holding of abandonment due to non-receipt of the final Office action mailed on June 2, 2004. The practitioner attested that a search of the file jacket and docket records indicated that the original final Office action was not received. In support of his assertion, the practitioner submitted a print out of the docket record for this application, indicating that no entry exists for the Office action. The practitioner asserted that no reply period existed in the docketing system because the final Office action, which included allowed claims, was never received. The practitioner stated that the lack of any such data in the section entitled "Reminder List for this Case" indicated that the Office action was not received. Moreover, the practitioner provided an explanation of the system for docketing USPTO communication.

Upon further review, the petition to withdraw the holding of abandonment is **GRANTED**.

Technology Center Art Unit 1712 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for mailing of a new final Office Action. The three (3) month shortened statutory time period for responding to the final Office Action will be set to run from the mailing date of the new final Office Action.

[1] Petitioner submitted a request for an extension of time for response within the first month and paid the necessary fee. Therefore, the renewed petition is filed timely

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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MAY 30 2007

**OFFICE OF PETITIONS**

In re Application of
Tonar et al.
Application No. 10/085,434
Filed: February 28, 2002
Attorney Docket No. GEN-001323C3

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed April 26, 2007, to withdraw the holding of abandonment.

On June 2, 2004, the Office mailed the original final Office action, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application became abandoned on September 3, 2004. On February 8, 2005, the Office mailed a Notice of Abandonment. On May 19, 2006, petitioner filed a petition to withdraw the holding of abandonment, which was granted by the decision dated June 28, 2006. On August 25, 2006, the USPTO mailed a new final Office action, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application became abandoned again on November 26, 2006. On March 20, 2007, the Office mailed a Notice of Abandonment.

In the present petition, petitioner requested that the Office withdraw the holding of abandonment due to non-receipt of the final Office action mailed on August 25, 2006. The practitioner attested that a search of the file jacket and docket records indicated that the final Office action was not received. In support of his assertion, the practitioner submitted a print out of the docket record for this application, indicating that no entry exists for the Office action. The practitioner asserted that no reply period existed in the docketing system because the final Office action was never received.

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

A review of the record indicates no irregularity in the mailing of the final Office Action, and in the absence of any irregularity in the mailing, there is a strong presumption that the final Office Action was properly mailed to the address of record. This presumption may be overcome by a showing that the final Office action was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where

the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See MPEP 711.03(c)(I)(A). For example, if a three-month period for reply was set in the non-received Office communication, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office communication must be submitted as documentary proof of non-receipt of the Office communication. **The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail (*e.g.* if the practitioner has a history of not receiving Office communications).**

After reviewing the documents submitted on petition, the Office concludes that the showing of record is sufficient to warrant withdrawal of the holding of abandonment. As petitioner presented the required showing under 37 CFR 1.181, the petition is **GRANTED**. No petition fee is required.

Technology Center Art Unit 1712 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for mailing of a new final Office Action. The three (3) month shortened statutory time period for responding to the final Office Action will be set to run from the mailing date of the new final Office Action.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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MAY 06 2009

OFFICE OF PETITIONS

KING & PARTNERS, PLC
170 COLLEGE AVENUE
SUITE 230
HOLLAND, MI 49423

In re Application of
William L. Tonar, et al.
Application No. 10/085,434
Filed: February 28, 2002
Attorney Docket No. GEN-001323C3

: 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 March 13, 2009, 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) and (iii) of the prior-filed application(s), unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

[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 granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1796 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.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Attachment: Corrected Filing Receipt

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/085,434 | 02/28/2002 | 1796 | 1968 | GEN-001323C3 | 2 | 2 |

**CONFIRMATION NO. 4510**

**CORRECTED FILING RECEIPT**

30981
King & Partners, PLC
170 College Avenue
SUITE 230
HOLLAND, MI 49423

Date Mailed: 05/05/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

William L. Tonar, Holland, MI;
Harlan J. Byker, Holland, MI;
Kathy E. Roberts, East Grand Rapids, MI;
John S. Anderson, Holland, MI;
Kevin L. Ash, Grand Rapids, MI;

**Power of Attorney:** The patent practitioners associated with Customer Number 30981

**Domestic Priority data as claimed by applicant**

This application is a CON of 09/883,650 06/18/2001 ABN
which is a CON of 09/361,923 07/27/1999 PAT 6,248,263
which is a CON of 08/616,967 03/15/1996 PAT 5,928,572

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 04/02/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/085,434**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Electrochromic layer and devices comprising same

**Preliminary Class**

252

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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**MAR 16 2005**

**OFFICE OF PETITIONS**

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 15, 2002 (certificate of mailing date November 11, 2002) and supplemented on May 7, 2004 (certificate of mailing date May 4, 2004), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or

more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application.

The amendment filed May 7, 2004 (certificate of mailing date May 4, 2004) fails to state the relationship of Application No. 29/133,861, filed December 8, 2000, to the instant application.

Accordingly, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute amendment (complying with 37 CFR 1.121) stating the relationship of the prior-filed application to the instant application is required.

Further correspondence with respect to this matter should be addressed as follows:

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401 Dulany Street
Alexandria, VA 22314

By fax:
(703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE

: DECISION ON PETITION
: UNDER 37 CFR §1.78(a)(3)

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed March 21, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in §1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1)

37 CFR §1.78(a)(2)(i) requires that any a nonprovisional application claiming the benefit of a prior-filed copending nonprovisional application be amended to contain a reference to the prior-

filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship between the applications.

The substitute amendment filed with this petition complies with 37 CFR §1.78(a)(2)(i) with respect to the relationship of the instant application to application no. 29/133,861.

However, it is noted that petitioners have altered the original 35 U.S.C.§119(e) benefit claim to provisional application no. 60/306,743. Petitioners now are requesting **a 35 U.S.C. §120 benefit** of provisional application no. 60/306,743 by including a relationship between application no. 10/085,454 and application no. 60/306,743. Such a claim may have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. §154(a)(2).

Accordingly, before the petition under 37 CFR §1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and, if appropriate, a substitute amendment (complying with 37 CFR §1.121) setting forth the entire replacement paragraph and clarifying whether petitioners desire a 35 U.S.C.§ 119(e) benefit of provisional application no. 60/306,743 or a 35 U.S.C. § 120 benefit of provisional application no. 60/306,743 is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:
Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand:
Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax:
(703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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SIDLEY AUSTIN BROWN & WOOD LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS TX 75201

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JUL 0 1 2005

OFFICE OF PETITIONS

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE

: DECISION ON PETITION
: UNDER 37 CFR §1.78(a)(3)

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed May 23, 2005 (certificate of mailing date May 20, 2005), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, 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.

While the instant petition complies with the above-listed requirements for a grantable petition under 37 CFR 1.78(a)(3), a closer review of the two applications in question, application No. 10/085,454 and application No. 29/133,861, reveals that **the two applications do not have an**

**inventor in common**. The inventors for application no. 10/085,454 are: Nelms, Schick, and Wilson. The inventor for application no. 29/133,861 is Hochschild.

As stated in MPEP 201.11 Continuity Between Applications: the Benefit of an Earlier Filing Date, Section IV. SAME INVENTOR OR INVENTORS, " The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. §119(e) or §120 be filed by an inventor or inventors named in the previously filed application or provisional application."

Because application no. 10/085,454 and application no. 29/133,861 do not have an inventor in common, the petition cannot be granted. The Office regrets not uncovering this fatal flaw in the previous petitions. Nevertheless, the statute cannot be waived.

Petitioner should submit a replacement paragraph [0001] reiterating the claim for benefit under 37 CFR §119(e) of U.S. Provisional Application Serial No. 60/306,743, filed July 20, 2001, which was incorporated by reference.

Further correspondence with respect to this matter should be addressed as follows:

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Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax:
(703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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AUG 25 2005

OFFICE OF PETITIONS

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE

: DECISION ON PETITIONS
: UNDER 37 CFR §1.78(a)(3) &
: 37 CFR §1.48(a)

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed July 29, 2005 (certificate of mailing date July 27, 2005), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment. In addition, the decision will address the petition under 37 CFR 1.48(a), filed November 15, 2002 (certificate of mailing date November 11, 2002).

The petition under 37 CFR 1.48(a) is **GRANTED**.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

**PETITION UNDER 37 CFR 1.48(a)**

An executed declaration in compliance with 37 CFR 1.63 was filed on June 6, 2002. The executed declaration listed three inventors – Nelms, Schick, and Wilson. The instant Rule 48(a) petition was filed to correct the inventorship by adding Roger C. Hochschild as a joint inventor.

37 CFR 1.48(a) requires that an amendment to the named inventive entity 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.

Petitioners have satisfied the above-listed requirements. The petition under 37 CFR 1.48(a) is granted.

**PETITION UNDER 37 CFR 1.78(a)(3)**

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

**(2)** the surcharge set forth in §1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application – application no. 29/133,861, filed December 8, 2000 -- has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. In addition, application No. 10/085,454 and application No. 29/133,861 now have an inventor in common since the Rule 48(a) petition was granted. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

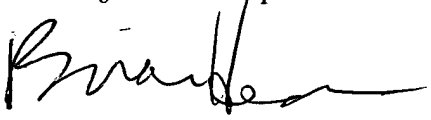
***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of***

***priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application and lists Roger C. Hochschild as a joint inventor, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3611 for appropriate action on the amendment filed July 29, 2005 (certificate of mailing date July 27, 2005), including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.



Brian Hearn
Special Projects Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

**ATTACHMENT**: Corrected Filing Receipt

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Mailed: 6/7/05

| | | |
|---|---|---|
| In re application of | : | |
| Fred S. Cannon et al. | : | DECISION ON |
| Serial No. 10/085,469 | : | PETITION |
| Filed: February 28, 2002 | : | |
| For: Method of Heat Treating Activated Carbon To Enhance Absorption of Taste And Odor Compounds And Total Organic Carbons From Water | : | |

This is a decision on the petition filed on April 6, 2005. The petition requests to remail the Office Action of December 1, 2004 and restart the response period.

**DECISION**

The Instant PETITION is accepted as a petition under 37 CFR 1.181(no fee).

A review of the application record indicates that a change of address was filed on August 19, 2004. The Office Action of December 1, 2004 was not sent to the new address of record.

The petition is **GRANTED.**

The office action will be resent and the time period for reply restarted. It is noted that another change of address was filed on December 15, 2004. The office action will be sent to that address.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Jason A. Bernstein
Powell Goldstein LLP
One Atlantic Center
1201 West Peachtree Street, NW
Atlanta, Georgia 30309

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ONE ATLANTIC CENTER
FOURTEENTH FLOOR
1201 WEST PEACHTREE STREET, NW
ATLANTA, GA 30309-3488

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MAY 12 2006

**OFFICE OF PETITIONS**

In re Application of :
Fred S. Cannon et al :
Application No. 10/085,469 : DECISION ON PETITION
Filed: February 28, 2002 : TO WITHDRAW
Attorney Docket No. 823.0115USU : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed November 1, 2005.

The request is **APPROVED**.

A review of the file record discloses that, in response to a Notice to File Missing Parts of Nonprovisional Application, mailed March 25, 2002, an executed oath or declaration by all the inventors was filed on June 18, 2002, appointing Paul D. Greeley and Charles N. J. Ruggiero as the attorneys of record. Subsequently, on November 19, 2002, the Office received a "Revocation and Substitute Power of Attorney," appointing Jason A. Bernstein and Pamela A. Ruest to prosecute the application. This revocation and power of attorney was accepted on December 10, 2002. However, the revocation and power of attorney was improperly accepted since the signing party failed to comply with the provisions of 37 CFR 3.73(b). Accordingly, the Notice of Acceptance of Power of Attorney mailed December 10, 2002 is vacated, leaving as attorneys of record Paul D. Greeley and Charles N. J. Ruggiero.

In view of the above, Jason A. Bernstein and Pamela A. Ruest: (1) do not have power of attorney in this patent application; but (2) have been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Jason A. Bernstein and Pamela A. Ruest, as well as the attorneys associated with Customer No. 25207, have been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

As noted above, Paul D. Greeley and Charles N. J. Ruggiero remain as attorneys of record in this application and all future communications from the Office will be directed these attorneys at the below-listed address of record.

A final Office action in this application was mailed to the law firm of Powell, Goldstein, Frazer & Murphy on March 10, 2006, setting a three (3) month shortened statutory period for reply, with extensions of time being available pursuant to the provisions of 37 CFR 1.136(a). A copy of this Office action is being mailed herewith to the below-listed correspondence address. Failure to timely file a proper reply to this Office action will result in the abandonment of the application.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

Conferee: df

cc:

Paul D. Greeley
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

ATTACHMENT TO CC: Copy of Office action mailed March 10, 2006

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GROOVER & HOLMES
BOX 802889
DALLAS TX 75380-2889

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MAR 0 7 2005

**OFFICE OF PETITIONS**

In re Application of :
Baldwin :
Application No. 10/085,487 :
Filed: February 27, 2002 :
Attorney Docket No. TD-171 :
For: TILE RELATIVE ORIGIN FOR PLANE EQUATIONS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed February 1, 2005 (certificate of mailing date January 28, 2005), to revive the above-identified application.

This application became abandoned for failure to timely pay the issue fee and publication fee within three (3) months of the mailing of the October 20, 2004 Notice of Allowance and Fee(s) Due. Accordingly, this application became abandoned on January 21, 2005. The filing of the instant petition precedes the mailing of A Notice of Abandonment.

Applicant has submitted a reply in the form of the issue fee, publication fee, and the PTOL-85, an acceptable statement of the unintentional nature of the delay in responding to the October 20, 2004 Notice of Allowance and Fee(s) Due, and the petition fee.

The petition is **granted**.

This application is being forwarded to Technology Center GAU 2671, so that the examiner of record may address the January 13, 2005 Printer Rush.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**JOHN M. JOHNSON**
**KAYE SCHOLER LLP**
**425 PARK AVENUE**
**NEW YORK, NY 10022**

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JUL 15 2004

OFFICE OF PETITIONS

In re Application of :
Gary Dommer et al : DECISION ON PETITION
Application No. 10/085,489 : UNDER 37 CFR 1.55(c)
Filed: February 26, 2002 :
Attorney Docket No. 46522-1101 :

This is a decision on the petition, filed May 2, 2003,[1] which is being treated as a petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 119(a)-(d) for the benefit of a prior-filed foreign application; namely Great Britain Application No. 0104781.9, filed February 27, 2001.[2]

The petition is **DISMISSED**.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date in either an oath or declaration or in an Application Data Sheet (*see* 37 CFR 1.63(c)(2) and 37 CFR 1.76(b)(6)

---

[1] The Office sincerely apologizes for the delay in replying to the instant petition and any inconvenience caused petitioner by this delay.

[2] Receipt is acknowledged of the certified copy of this application.

(3) the surcharge as set forth in 37 CFR 1.17(t);
(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant petition fails to comply with items (2) and (4). In this regard, the claim for foreign priority must be either set forth in an oath or declaration in accordance with 37 CFR 1.63(c)(2) or in an application data sheet in accordance with 37 CFR 1.76(b)(6). Additionally, the statement of unintentional delay should state: "The entire delay between the date the claim under 37 CFR 1.55(a)(1) was due and the date the claim was filed was unintentional."

Accordingly, before the petition can be granted, compliance with items (2) and (4) above must be satisfied. The above items should be submitted under a cover letter entitled "Renewed Petition under 37 CFR 1.55(c) to Accept a Late Claim for Foreign Priority," and addressed as follows:

By mail: Mail Stop PETITIONS
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Post Office Box 1450
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By hand: Customer Window located at:

U.S. Patent and Trademark Office
220 20th Street S
Customer Window, Mail Stop Petitions
Crystal Plaza Two Lobby, Room 1B03
Arlington, VA 22202

By fax: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.

As authorized, the $1,300 fee due for the instant petition will be charged to Deposit Account No. 50-0988 as authorized.

This application is being forwarded to Technology Center AU 2173 for examination in due course.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of
Gary Dommer et al
Application No. 10/085,489
Filed: February 26, 2002
Attorney Docket No. 46522-1101

: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.55(c)

This is a decision on the renewed petition under 37 CFR 1.55(c), filed October 25, 2004, for acceptance of an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of a prior-filed foreign application; namely, Great Britain foreign Application No. 0104781.9, filed February 27, 2001.

The petition is again **dismissed**.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in **an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6)**;

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant petition still fails to comply with item (2) above, as set out in the decision mailed July 15, 2004 dismissing the first petition under 37 CFR 1.55(c).

The decision of July 15, 2004 stated that the petition could not be granted since it failed to include an oath or declaration or an Application Data Sheet (ADS) in accordance with 37 CFR 1.76(b)(6) which sets forth therein the claim for foreign priority. The renewed petition was not accompanied by either an oath or declaration complying with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6). Instead, the instant renewed petition was accompanied by a "Declaration Under 37 CFR 1.131." The declaration under 37 CFR 1.131 also requests that the Office amend the instant application to incude a reference to the foreign priority claim. However, neither the submission of a declaration under 37 CFR 1.131 nor a request to amend the application is a proper reference for claiming priority to a foreign application. Unless provided in an application data sheet, 37 CFR 1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP 201.14, page 200-77 (Rev. 2, May 2004), last paragraph, second column.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to Great Britain foreign Application No. 0104781.9. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

Further correspondence with respect to this matter should be addressed as follows:

By mail:
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401 Dulany Street
Alexandria, VA 22314

By fax:
(703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 3218.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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**KAYE SCHOLER LLP**
**425 PARK AVENUE**
**NEW YORK, NY 10022**

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OFFICE OF PETITIONS

In re Application of
Gary Dommer et al
Application No. 10/085,489
Filed: February 26, 2002
Attorney Docket No. 46522-1101

DECISION GRANTING PETITION
UNDER 37 CFR 1.55(c)

This is a decision on the renewed petition under 37 CFR 1.55(c), filed July 15, 2005, for acceptance of an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of the filing date of a foreign Great Britain application; namely, Application No. 0104781.0, filed February 27, 2001.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date **and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);**

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant pending nonprovisional application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

The above-identified pending nonprovisional application was filed on February 26, 2002, which is after November 29, 2000 and within 12 months of February 27, 2001 (the filing date of the foreign application to which benefit is now being claimed). On July 15, 2005, an Application Data Sheet was received which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee of $1,300 was received on May 2, 2003. Lastly, petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 119(a)-(d) is **granted**.

A Corrected Filing Receipt which reflects the above-noted foreign application accompanies this decision on petition.

This application is being forwarded to Technology Center AU 2611 for examination in due course and for consideration by the examiner of record of the foreign priority claim under 35 U.S.C. § 119(a)-(d).

Any inquiries directly pertaining to this matter may be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

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900 Washington Avenue
P.O. Box 1470
Waco TX 76701

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APR 2 6 2006

OFFICE OF PETITIONS

In re Application of :
Vantroostenberghe :
Application No. 10/085,493 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. MALE URINARY SYSTEM :

This is a decision on the petition under 37 CFR 1.137(b), filed on December 30, 2005(certificate of mailing date December 27, 2005) to revive the above-identified application. The Office apologizes for the delay in addressing this petition.

The above-identified application became abandoned for failure to reply in a timely manner to the April 15, 2005 final Office action which set an extendable three (3) month period for reply. No extensions of time having been obtained pursuant to 37 CFR 1.136(a) and no reply being received in the Office, this application became abandoned on July 16, 2005. A Notice of Abandonment was mailed on October 31, 2005.

Petitioner has submitted an amendment in response to the April 15, 2005 final Office action that *prima facie* places the application in condition for allowance, an acceptable statement of the unintentional nature of the delay in responding to the April 15, 2005 final Office action, and the petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be returned to Technology Center 3761.

Telephone inquiries pertaining to this decision may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER CO 80301

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DEC 12 2006

OFFICE OF PETITIONS

In re Application of
Tschiegg et al.
Application No. 10/085,497
Filed: February 26, 2002
Attorney Docket No. 398624
Title of Invention: Risk Management Information Interface System and Associated Methods

DECISION ON PETITION

This is in response to the petition for waiver under 37 CFR 1.183 of requirement for supplemental Declaration under 37 CFR 1.67 filed September 15, 2006.[1]

The petition is **Granted**.

The above-identified application was filed on February 26, 2002. A fully executed declaration was submitted on January 5, 2004.

Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather the remedy for treating an inventor's refusal to sign a supplemental declaration is waiver of 37 CFR 1.67. See MPEP 603. Nevertheless, it is appropriate to apply the principles of 37 CFR 1.47 thereof to the situation at hand. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate and on behalf of the non-signing inventor. See MPEP 409.03(a).

In order for a petition under 37 CFR 1.183 to be granted to waive this requirement that joint inventor Sutherland sign the supplemental declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On petition, applicants have set forth the steps taken to obtain inventor Sutherland

[1] 37 CFR 1.47 only applies when an inventor refuses to sign the original 37 CFR 1.63 oath or declaration.

signature on the supplemental declaration. Applicants have shown that a bona fide attempt was made to present the application papers. The non-signing inventor's conduct constitutes refusal to execute the supplemental declaration.

The declaration presented is signed by four inventors on behalf of Basset. Under the circumstances, it is concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

The $400.00 petition fee will be charged to deposit account no. 12-0769.

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the present petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper.

This application is being forwarded to Technology Center 2168 for further processing. Office of Patent Publication for issuance into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

cc: David Huntley
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

UNITED STATES PATENT AND TRADEMARK OFFICE

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DW 10-02

Paper No. 5

BLACK LOWE & GRAHAM
816 SECOND AVE.
SEATTLE WA 98104

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Ian A. Stewart | : | |
| Application No. 10/085,524 | : | DECISION REFUSING STATUS |
| Filed: 26 February, 2002 | : | UNDER 37 CFR 1.47(b) |
| Attorney Docket No. WRLD-1-1013 | : | |

This is in response to the petition filed on 3 June, 2002, under 37 CFR 1.47(b)[1].

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 26 February, 2002, without an executed oath or declaration.

Accordingly, on 25 March, 2002, Initial Patent Examination Division mailed a Notice To File Missing Parts of Nonprovisional Application requiring an executed oath or declaration and a

[1]A petition under 37 CFR 1.47(a) is inappropriate in this instance since no inventor has signed the declaration. A petition under 37 CFR 1.47(a) is only appropriate where some of the named inventors signed the declaration and one or more of the named inventors refuses to sign or cannot be found.

surcharge for its late filing.

In response, on 3 June, 2002 (certificate of mailing date 24 May, 2002), the present petition was filed, accompanied by the late filing surcharge.

Petitioner asserts that the inventor has refused to sign the declaration.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (2), (4), (5), and (6).

In regards to item (1), petitioners must supply proof that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.[2] The showing of record is that only the declaration was ever sent to the inventor. Petitioners should submit a copy of the cover letter transmitting the application papers to the non-signing inventor 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 to sign can be alleged, petitioners must show that the application papers were sent or given to the non-signing inventor. If the inventor refuses to sign the declaration in writing after being sent or given the application, a copy of that written refusal should be supplied 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.

As to item (2), an oath or declaration for the patent application

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[2]MPEP 409.03(d).

in compliance with 37 CFR 1.63 and 1.64 has not been presented. The oath or declaration must identify the residence, mailing address, if the inventor lives at a different location from where he or she customarily receives mail, as well as the citizenship of the inventor. The oath or declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration, as well as his/her mailing address, residence, if the applicant lives at a different location from where he or she customarily receives mail, as well as the citizenship of individual signing on behalf of the non-signing inventor. If the oath or declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.[3]

As to item (4), petitioner must provide the last known address of the non-signing inventor.[4]

In regards to item (5), petitioner must show proof of proprietary interest. Petitioner may make this showing by providing a copy of any employment agreement between the non-signing inventor and the Rule 1.47(b) applicant (employer); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

As to item (6), petitioner must provide a statement that the filing is necessary to prevent irreparable damage or to preserve the rights of the parties.[5]

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

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[3]MPEP 409.03(b).

[4]MPEP 409.03(e).

[5]MPEP 409.03(g).

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.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

BLACK LOWE & GRAHAM
816 SECOND AVE.
SEATTLE WA 98104

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**NOV 2 1 2002**

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Ian A. Stewart | : DECISION NOTING JOINDER OF |
| Application No. 10/085,524 | : INVENTOR AND PETITION UNDER |
| Filed: 26 February, 2002 | : 37 CFR 1.47(b) MOOT |
| Attorney Docket No. WRLD-1-1013 | : |

Papers filed on 13 November, 2002, in reply to the "Decision Refusing Status Under 37 CFR 1.47(b)" mailed on 11 October, 2002, included a Declaration signed by the previously nonsigning inventor in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(b) is moot; this application does not have any Rule 1.47(b) status and no such status should appear on the file wrapper. This application need not be returned to this office for any further consideration under 37 CFR 1.47(b).

The petition fee submitted on 13 November, 2002, will be credited to counsel's deposit account, No. 50-1050 as authorized in the petition filed on 3 June, 2002.

This application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

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OFFICE OF PETITIONS

In re Application of :
Ian A. Stewart :
Application No. 10/085,524 : ON PETITION
Filed: February 26, 2002 :
Attorney Docket No. WRLD-1-1013 :

This is a decision in response to the petition, filed August 14, 2006, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to an Office action mailed September 28, 2005. A Notice of Abandonment was mailed on April 20, 2006. In response, on August 14, 2006, 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 $750.00; and (3) the requisite statement of unintentional delay.

The application is being referred to Technology Center AU 2131 for consideration of the amendment filed August 14, 2006.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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PO BOX 37428
RALEIGH, NC 27627

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OFFICE OF PETITIONS

In re Application of :
Helmut Heide, et al.
Application No. 10/085,526 : LETTER
Filed: February 26, 2002 :
Attorney Docket No. 930008-2066 :

This is in response to the paper filed February 22, 2006, which is being treated under 37 CFR 1.27(g)(2) requesting that status as a Small Entity be removed.

In accordance with the February 22, 2006 request, status a Small Entity has been removed.

This file is being referred to Publication Division for further processing.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3201.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/09/10

TO SPE OF : ART UNIT 2123

SUBJECT : Request for Certificate of Correction for Appl. No.: 10085528 Patent No.: 7643968

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**

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**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:** _____

PAUL RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

SPE 2123 Art Unit

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FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Mark W. Lambert | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7643968 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/085,528 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/25/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1225** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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Alexandria, Virginia 22313-1450
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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Takahiro Unno | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7587315 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/085,548 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2158** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

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SEP 0 5 2002

OFFICE OF PETITIONS

In re Application of :
Marco Guida, Jeff Hall, :
William Petros, James Vredenburgh, :
Oliver Colvin and Jeffrey Marks :
Application No. 10/085,612 :
Filed: February 26, 2002 :
Title: METHODS FOR EVALUATING THE :
ABILITY TO METABOLIZE :
PHARMACEUTICALS AND COMPOSITIONS :
THEREFOR :

DECISION ACCORDING STATUS
UNDER 37 C.F.R. §1.47(a)

This is a decision on the "Petition under 37 C.F.R. §1.47(a) and Request for Status under 37 CFR 1.42," filed July 8, 2002.

The petition under §1.47(a) is **GRANTED**.

Petitioner is advised that no consideration has been given to the "Request for Status under 37 CFR 1.42," referenced in the petition title. Petitioner has submitted no fee for such consideration. More significantly, petitioner has submitted no arguments or evidence in support of a conclusion that any of the inventors, including non-signing inventor Guida, are deceased. Accordingly, it is presumed that the reference to §1.42 in the petition title is a clerical error. **If this presumption is incorrect, petitioner must file a new petition under §1.42 for such consideration.** Petitioner is further advised that §1.47 is not applicable as a means for accepting a declaration without the signature of a deceased inventor.

The above-identified application was filed on February 26, 2002, without an executed oath or declaration. Marco Guida, Jeff Hall, William Petros, James Vredenburgh, Oliver Colvin and Jeffrey Marks were named as joint inventors. Accordingly, on April 8, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, and a surcharge for late filing. This Notice set a period for reply of two months from the mailing date of the notice, with extensions of time obtainable under §1.136(a).

On July 8, 2002, applicants responded with the instant petition, made timely by an accompanying petition (and fee) for extension of time for response within the first month; two declarations executed in combination by joint inventors Hall, Petros, Vredenburgh, Colvin and Marks on behalf of themselves and on behalf of non-signing inventor Guida; and payment of the surcharge for late filing of the declaration.

Rule 47 applicant maintains that status under 37 CFR 1.47(a) is proper because joint inventor Marco Guida refuses to join in the application for patent. 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.

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. On petition, patent attorney Robert Traver provides the last known address of inventor Guida and states that the inventor has been presented the application papers by certified mail and has by his conduct in not responding refused to sign the declaration. Attorney Traver has made of record a copy of the certified mail letter transmitting all of the application papers to the inventor, along with a Federal Express return envelope; as well as, a copy of the certified mail return receipt signed by inventor Guida on June 7, 2002.

The declaration filed July 8, 2002, 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 returned to the Office of Initial Patent Examination for completion of pre-examination processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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**FEB 08 2005**

**OFFICE OF PETITIONS**

In re Application :
Kazunori Gotoh :
Application No. 10/085,643 : DECISION ON APPLICATION
Filed: February 28, 2002 : FOR PATENT TERM ADJUSTMENT
Atty Docket No. 9281-4297 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed August 19, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to three hundred eighty (380) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred eighty **(380)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 18, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. The period of adjustment of 386 days for Office delay was reduced by 530 days for applicant delay. On August 19, 2004, applicants timely[1] submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 380 days. Applicants dispute the reduction of 530 days attributed to their delay in responding to the Notice to File Missing Parts of Application mailed April 10, 2002. Applicants state that their response was received in the Office on July 16, 2002, and thus, the delay should have led to a reduction of 6 days, not 530 days. In support thereof, applicants submit a copy of their properly itemized and date-stamped postcard.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants are correct. Their response to the Notice to File Missing Parts of Application mailed April 10, 2002, is of record

[1] PALM records indicate that the Issue Fee was received in the Office on August 20, 2004.

in the application with a date of receipt by the Office of July 16, 2002. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 530 days. However, the response was filed outside of the three-month period under 37 CFR 1.704(b), three months and 6 days later. Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application, but only by 6 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred eighty (380) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 4

SCHNADER HARRISON SEGAL & LEWIS, LLP
1600 MARKET STREET
SUITE 3600
PHILADELPHIA PA 19103

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FEB 2 8 2003

OFFICE OF PETITIONS

In re Application of
Jenny
Application No. 10/085,695
Filed: February 28, 2002
Attorney Docket No. 1015-02
For: PROCESS TO REMOVE ORGANIC IMPURITIES FROM BAYER PROCESS LIQUOR USING OZONE

: DECISION REFUSING
: STATUS UNDER
: 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed October 15, 2002 (certificate of mailing date October 8, 2002).

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on February 28, 2002 without an executed oath or declaration. Accordingly, on April 8, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on October 15, 2002 (certificate of mailing date October 8, 2002), a petition for a four month extension of time and required fee, the surcharge, and the instant petition were filed. The petition sets forth the last known address of the non-signing inventor, Mr. Rudolf Jenny, and explains that Mr. Jenny approved the application papers in February 2002, but did not respond to the subsequent multiple requests that he sign the declaration for the patent application.

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.

Applicant lacks item (1), (2), (5) and (6) set forth above.

As to item (1), Applicant has failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. Applicant allegedly reviewed the patent application in February 2002. At some later time, petitioner asked Mr. Jenny to sign a declaration and assignment for the application. The petition states, "The attorney who filed the application immediately thereafter requested a signed Declaration and Assignment." The Office cannot ascertain when the request to sign the declaration was made in relation to when Mr. Jenny reviewed the application. The e-mail exhibit between Joseph Giannone and Rudolf Jenny is not clear as to the title of the "last patent-version" that was reviewed.

Mr. Jenny's signature on the Declaration would obligate him, under penalty of "fine or imprisonment, or both" to particulars to which Mr. Jenny can only attest after having had the opportunity to review the subject patent application. If months transpired between his reading of the application and the request to sign the declaration, Mr. Jenny might not have had sufficient memory of the details of the application to join in the application. Mr. Jenny must have the opportunity to review the application contemporaneously, or at a point close in time to the presentation of the declaration for signature.

The attorney (Mr. Giannone?) who presented Mr. Jenny with the application and subsequently attempted to obtain a signed declaration from Mr. Jenny should provide a statement as to when these events transpired. If these events occurred close in time to each other, then petitioner will have proved the inventor refused to sign the declaration. The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

If the review of the application and the presentation of the declaration for signature occurred far apart in time from each other, petitioner must send Mr. Jenny a copy of the as filed above-identified application with a request that the sign the enclosed declaration. See MPEP 409.03(d). If Mr. Jenny does not respond, then petitioner will establish refusal.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. There is no declaration in the application file. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of Inventor Jenny is REQUIRED. See MPEP 409.03(b). The declaration must include information for Mr. Jenny and for the individual signing the declaration on behalf of Ozonia A.G.. The Office requires a declaration listing the inventor and the signer's name, title ( if any), the address where he/she normally receives mail, his/her residence, and his/her citizenship. As stated in the MPEP 409.03(b), where an oath is signed by a registered attorney on behalf of a corporation, either proof of the attorney's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney may simply state that he is authorized to sign on behalf of the corporation.

As to item (5), Rule 47 applicant failed to show or provide proof that Ozonia A. G., has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant, a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant;

As to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Pursuant to petitioner's authorization, deposit account no. 13-3405 will be charged the $130.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Assistant Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By facsimile: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Office of Petitions<br>2201 South Clark Place<br>Crystal Plaza 4, Suite 3C23<br>Arlington, VA 22202 |

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 12

FRANK CHAU , ESQ.
F.CHAU & ASSOCIATES , LLP
1900 HEMPSTEAD TURNPIKE
SUITE 501
EAST MEADOW, NY 11554

COPY MAILED

JUL 2 8 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Stouffer, et al. | :DECISION DISMISSING |
| Application No. 10/085,791 | :PETITION UNDER § 1.48(a) |
| Filed: February 28, 2002 | : |
| Attorney Docket No. 111483.1060C1 | : |

This is in response to the "Amendment And Petition To Delete An Erroneously Named Inventor In An Application Under 37 CFR 1.48(a)," filed April 5, 2004.

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 1.48(a)."

The above-identified application was filed on February 28, 2002. Peter Stouffer, David Rupert, David Showalter, Michael Schroeder, Richard Graham, Mark Cohrs, Ralph Girardin, Joseph Allio, Michael Foy, Steven Schroeder, Anthony Whitehead, Gregg Gagnon, Mark LaPointe and Valeriy Bodrov were named as joint inventors. On August 27, 2002, the Office of Initial Patent Examination mailed "Notice to File Missing Parts of Nonprovisional Application (Notice), that states the signature of inventor Mark LaPointe was missing from the oath or declaration. On April 5, 2004, the instant request under 37 CFR 1.48(a) was filed to correct the inventorship and delete joint inventor, Mark LaPointe.

37 CFR 1.48(a) requires:

> (1) A request to correct the inventorship that sets forth the desired inventorship change;
>
> (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
>
> (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
>
> (4) The processing fee set forth in § 1.17(i); and
>
> (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

The instant petition does not satisfy requirements (4) and (5) above.

As to item (4):
The required processing fee set forth in § 1.17(i) has not been submitted.

As to Item (5):
The written consent of the existing assignee of the original named inventors has not been submitted.

Accordingly, the petition must be dismissed.

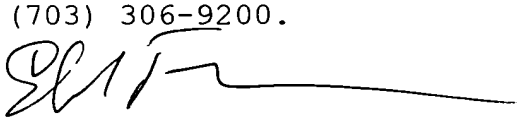
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: Customer Service Window
2011 South Clark Place
Crystal Plaza Two (left side entrance of building)
Arlington, VA

Telephone inquiries should be directed to the undersigned at (703) 306-9200.



Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 13

FRANK CHAU , ESQ.
F.CHAU & ASSOCIATES , LLP
1900 HEMPSTEAD TURNPIKE
SUITE 501
EAST MEADOW, NY 11554

COPY MAILED

JUL 2 9 2004

OFFICE OF PETITIONS

In re Application of :
Stouffer, et al. :
Application No. 10/085,791 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 111483.1060C1 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 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. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed August 27, 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 October 28, 2002. A Notice of Abandonment was mailed on February 6, 2004.

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 pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application, 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 require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (1) above.

The reply submitted in response to the Notice, the petition under 37 CFR 1.48(a), filed April 5, 2004, was dismissed on July 28, 2004. As such, a proper reply to the Notice has not been submitted. Accordingly, the petition must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: Customer Service Window
2011 South Clark Place
Crystal Plaza Two (left side entrance of building)
Arlington, VA

Telephone inquiries should be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 18

F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11797

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SEP 2 2 2004

OFFICE OF PETITIONS

In re Application of :
Stouffer, et al. :
Application No. 10/085,791 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 8002A-82CON :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 27, 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 August 27, 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 October 28, 2002. A Notice of Abandonment was mailed on February 6, 2004.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 19

F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11797

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Stouffer, et al. | :DECISION GRANTING |
| Application No. 10/085,791 | :PETITION UNDER § 1.48(a) |
| Filed: February 28, 2002 | : |
| Attorney Docket No. 111483.1060C1 | : |

This is in response to the "Renewed Petition Under 37 CFR 1.48(a)," filed August 27, 2004.

The petition is **granted.**

The above-identified application was filed on February 28, 2002. Peter Stouffer, David Rupert, David Showalter, Michael Schroeder, Richard Graham, Mark Cohrs, Ralph Girardin, Joseph Allio, Michael Foy, Steven Schroeder, Anthony Whitehead, Gregg Gagnon, Mark LaPointe and Valeriy Bodrov were named as joint inventors. On August 27, 2002, the Office of Initial Patent Examination mailed "Notice to File Missing Parts of Nonprovisional Application (Notice), that states the signature of inventor Mark LaPointe was missing from the oath or declaration. On April 5, 2004, a request under 37 CFR 1.48(a) was filed to correct the inventorship and delete joint inventor, Mark LaPointe.

In view of the papers filed April 5, 2004 and August 27, 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 the deletion of joint inventor Mark LaPointe.

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.

Telephone inquiries should be directed to the undersigned at (571)272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 6

**BAE SYSTEMS INFORMATION AND
ELECTRONIC SYSTEMS INTEGRATION, INC.
65 SPIT BROOK ROAD
P.O. BOX 868 NHQ1-719
NASHUA, NH 03061-0868**

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**MAR 0 2 2004**

**OFFICE OF PETITIONS**

In re Application of
Osborn et al.
Application No. 10/085,794
Filed: February 28, 2002
Attorney Docket No. D-4423 CIP

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 23, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed April 15, 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 June 16, 2002. A Notice of Abandonment was mailed on December 4, 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
Washington, D.C. 20231
www.uspto.gov

Yanming Liu
3 Granger Pond Way
Lexington, MA 02420

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SEP 13 2002

OFFICE OF PETITIONS

In re Application of :
Berkey et al. :
Application No. 10/085,798 :
Filed: February 26, 2002 : LETTER
Attorney Docket No. SP02-042 :
For: Broadband Access :
Optimized Fiber and Method of :
Making :

Mr. Liu:

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 Christina Tartera Donnell at (703) 306-5589. 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).

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CORNING INCORPORATED
SP-TI-3-1
CORNING NY 14831

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

CORNING INCORPORATED
SP-TI-3-1
CORNING NY 14831

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Berkey et al. | : | |
| Application No. 10/085,798 | : | DECISION GRANTING |
| Filed: February 26, 2002 | : | PETITION UNDER |
| Attorney Docket No. SP02-042 | : | 37 CFR 1.47(a) |
| For: Broadband Access | : | |
| Optimized Fiber and Method of | : | |
| Making | : | |

This is in response to the petition under 37 CFR 1.47(b), filed July 9, 2002 (certificate of mailing July 2, 2002), which has been treated as a petition under 37 CFR 1.47(a).[1] Petitioner has obtained a one-month extension of time to reply. Therefore, the petition is filed timely.

The petition is granted.

Petitioner has shown that Yanming Liu, 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, William J. Chervenak, Patent Agent, indicated in the record that Mr. Liu was in possession of a copy of the application papers but refused to sign the declaration without compensation. Mr. Chervenak further indicated that an agreement between Corning and Mr. Liu as to the amount of compensation could not be reached.

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 present petition. Notice of the filing of this application will also be published in the Official Gazette.

---

[1] A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

The petition fee and extension of time fee, totaling $240.00, have been charged to Deposit Account No. 03-3325, as authorized in the petition.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
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

EXXONMOBIL CHEMICAL COMPANY
P O BOX 2149
BAYTOWN TX 77522-2149

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MAR 2 2 2004

OFFICE OF PETITIONS

In re Application of
Kendrick et al.
Filed: February 28, 2002
Application No. 10/085,809
Attorney Docket No.: 98B014E

DECISION GRANTING
PETITION

This is a decision on the request for resealing, filed May 12, 2003, and the petition to expunge filed July 16, 2003.

The request for resealing has been treated as a request to place the papers in compliance with Manual of Patent Examining Procedure (MPEP), Section 724.02, and is granted.

The petition to expunge is granted-in-part.

On July 12, 2002, applicant filed a six page Information Disclosure Statement (IDS). One of the references submitted was a proprietary document, a declaration signed by Scott T. Roger. This proprietary document was cited on the IDS.

On July 16, 2003, petitioner filed a new IDS. Petitioner also filed a supplemental IDS and one page listing that cites only the proprietary document, and includes the Roger declaration in a sealed, labeled envelope in accordance with MPEP § 724.02.

Petitioner requests that the IDS filed July 12, 2002, along with the IDS and the proprietary document be expunged from the record and returned to Applicant, explaining that these were intended to be submitted in compliance with the MPEP. Petitioner further requests that all other references which accompanied the submission filed July 12, 2002, remain in the file. The request to "reseal" is not granted, because the originally filed application papers do not reflect an intention for the Roger declaration to be maintained in confidence because the procedures set forth in the MPEP were not followed. Moreover, since the original documents were not "sealed" they cannot be "resealed". The declaration has been removed from the stack of references and discarded. A duplicate copy was supplied in compliance with the MPEP. The petition to expunge is granted in part because rather than being expunged and returned, the first copy of the Roger declaration has been expunged and destroyed.

The listing submitted July 12, 2002 will remain in the file to preserve the prosecution history. Both Information Disclosure Statements filed July 16, 2003, have been made of record in the file.

After mailing of this decision, the application will be forwarded to Technology Center 3600 for examination in due course. The petition fee set forth in 37 CFR § 1.17(i) will be charged to petitioner's deposit account 19-0089.

Telephone inquiries concerning this communication should be directed to Terry J. Dey at (703) 308-1201.

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

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DW

JUN 16 2004

MAILED

JUN 16 2004

OFFICE OF THE DIRECTOR
TC 3600

Neal P. Pierotti
Dority & Manning, Attorneys at Law, P.A.
P.O. Box 1449
Greenville SC 29602

In re Application of
Steven James Wojcik et al.
Application No. 10/085,813
Filed: February 28, 2002
For: CENTER/SURFACE REWINDER AND WINDER

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office, on April 1, 2004.

The petition is **DISMISSED**.

The application was held abandoned for failure to timely respond to the non-final Office action mailed August 5, 2003 and a Notice to that effect was mailed March 22, 2004.

The petitioner states that a response was filed by mail with a Certificate of Mailing dated January 5, 2004.

Any petition to withdraw the holding of abandonment based upon a Certificate of Mailing must provide the following:

(1) A copy of the original response bearing a signed Certificate of Mailing which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of mailing the original response on the date indicated on the Certificate of Mailing (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above, the petition fails under requirement (2) to provide a proper statement under 37 CFR 1.8(b)(3) attesting to personal knowledge of mailing the original response on the date indicated on the certificate, by the person who signed the certificate. Although a statement has been provided by Mr. Pierotti, he is not the person who signed the certificate.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/mjz: 6/3/04

UNITED STATES PATENT AND TRADEMARK OFFICE

#12
DW

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

AUG 16 2004

MAILED

AUG 16 2004

OFFICE OF THE DIRECTOR
TC 3600

Neal P. Pierotti
Dority & Manning, Attorneys at Law, P.A.
P.O. Box 1449
Greenville, SC 29602

In re Application of
Steven James Wojcik et al.
Application No. 10/085,813
Filed: February 28, 2002
For: CENTER/SURFACE REWINDER AND WINDER

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to applicant's renewed petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on June 30, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on January 5, 2004 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.

SNM/vdb: 8/09/04

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

APPLIED MATERIALS, INC.
2881 SCOTT BLVD. M/S 2061
SANTA CLARA, CA 95050

COPY MAILED

DEC 3 0 2004

OFFICE OF PETITIONS

In re Application of :
Srinivas Gandikota, et al. :
Application No. 10/085,822 : ON PETITION
Filed: February 27, 2002 :
Atty Docket No. AMAT/6346/CPI/COPPER/PJS :

This is a decision on the petition, filed December 27, 2004, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee. See 1233 *Official Gazette* 54 (April 11, 2000).

It does not appear that the instant petition is signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Keith M. Tackett appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. A courtesy copy of this decision is being mailed to Mr. Tackett, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The petition is **GRANTED**.

Petitioner requests that the application be withdrawn from issue for express abandonment. See 37 CFR 1.313(c)(3). The application is withdrawn from issue, and the abandonment is hereby recognized.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3204.

In accordance with the Letter of Express Abandonment filed December 29, 2004, the application is being referred to the Files Repository an abandoned file.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: KEITH M. TACKETT
MOSER, PATTERSON & SHERIDAN, LLP
3040 POST OAK BLVD., SUITE 1500
HOUSTON, TX 77056

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 27 2007

OFFICE OF PETITIONS

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

In re Application of
Jay Son, et al.
Application No. 10/085,828
Filed: February 27, 2002
Attorney Docket No. 21046-0301

ON PETITION

This is a decision in response to the petition, filed October 2, 2006, to revive the above-identified application under the provisions of 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. However, in accordance with 37 CFR 1.34(a), the signature of Wilson Daniel Swayze, Jr. 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. However, if Mr. Swayze desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record.

A review of the record discloses that the application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed August 2, 2005. A Notice of Abandonment was mailed on July 6, 2006. In response, on October 2, 2006, the present petition was filed.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While it is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition is **GRANTED**.

The application is being referred to Technology Center AU 3625 for consideration of the amendment filed October 2, 2006.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: WILSON DANIEL SWAYZE, JR.
3804 CLEARWATER COURT
PLANO, TX 75025

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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INTEL/BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 05/17/2010

| | | |
|---|---|---|
| **Applicant** | : Michael A. Kozuch | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7631196 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/085,839 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/25/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1137** 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
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Paper No. 8

**DR. V. SAHADEVAN**
**DAG HAMMARSKJOLD CANCER TREATMENT CENTER**
**155 DRY HILL ROAD**
**BECKLEY, WV 25801**

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MAY 0 6 2004

OFFICE OF PETITIONS

In re Application of :
Sahadevan, Velayudhan :
Application No. 10/085,840 :
Filed: February 27, 2002 :
Title: Hormonal Implants Treatment Of The Breast Cancer :

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 21, 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, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on January 4, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to Technology Center 1600 for further examination on the merits.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 11

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RALEIGH, NC 27606

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FEB 0 2 2004

OFFICE OF PETITIONS

In re Application of :
Smith et al. :
Application No. 10/085,854 :
Filed: February 27, 2002 :
Attorney Docket No. RDS-001 :

This is a decision in response to the petition under 37 CFR 1.137(b), filed January 14, 2004, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed December 13, 2002. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). A reply, filed March 21, 2003 did not constitute a proper reply, or a bona fide attempt at a proper reply to non-final Office action. No proper reply having been received, the application became abandoned on March 14, 2003. A Notice of Abandonment was mailed on August 1, 2003.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). An Amendment in response to the December 13, 2002 Office action is filed with the instant petition. Accordingly, the petition is granted.

The Power of Attorney or Authorization of Agent has been entered and made of record.

This application is being forwarded to Technology Center Art Unit 2859 for processing of the Amendment, filed January 14, 2004, in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 5

MARY M. KRINSKY, Ph. D., J.D.
PATENT ATTORNEY
79 TRUMBULL STREET
NEW HAVEN, CT 06511

COPY MAILED

JUL 1 7 2002

OFFICE OF PETITIONS

In re Application of
Perricone
Application No. 10/085,864
Filed: February 27, 2002
Attorney Docket No. NP-22 (acne)

DECISION GRANTING PETITION

This is a decision on the petition filed April 8, 2002, to establish that page 10 of the specification was part of the originally filed application.

On February 27, 2002, the application was filed.

On March 21, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of February 27, 2002, and advising applicants that page 10 of the specification appeared to have been omitted.

In response, the present petition was filed alleging that page 10 was deposited on February 27, 2002. In support, petitioner has submitted a postcard receipt which acknowledges receipt of "specification (28) pgs" on February 27, 2002.[1] Petitioner has also submitted a copy of the missing documentation- page 10 of the specification.

Upon review of the record, page 10, deposited on February 27, 2002, has not been located. However, the evidence is convincing that the application papers deposited on February 27, 2002, included page 10, and that page 10 was subsequently misplaced in the PTO.

In view of the above, the petition is **granted**. The copy of page 10 submitted with the petition will be used for examination purposes.

The petition fee will be credited to petitioner's deposit account.

The Notice mailed March 21, 2002 was sent in error and is hereby vacated.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of February 27, 2002, using the application papers filed on February 27, 2002, and the copy of page 10 of the specification filed on April 8, 2002.

---

[1] Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self addressed post card properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the post card in the outgoing mail. "A post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." M.P.E.P. § 503.

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 & TRADEMARK OFFICE**
**Washington, D.C. 20231**

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 10/085,864 | 2 Serial/Patent # 10/085,864

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| | Extension of Time | | | $ |
| | Notice of Appeal/Appeal | | | $ |
| X | Petition | 4 | 4-8-02 | $ 130 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND: $ 130

8 TO BE REFUNDED BY:

| | |
|---|---|
| | Treasury Check |
| X | Credit Deposit A/C #: |

9 5 0 -- 0 2 1 2

10 REASON:

| | |
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| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Proves we lost paper

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Steven Bradley TITLE: Pattons Atty

SIGNATURE: [signature] PHONE: 306-5683

OFFICE: Pattons

**********

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APPROVED: [signature] DATE: 7/12/02

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FORM PTO-1577
(01/90)

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30

Image DA-C#1

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date set forth below as First Class Mail in an envelope addressed to: Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450.

Date of Signature and Deposit: 3-22, 2004

Sara D. Vinarov

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Frederick R. Blattner
Rodney A. Welch
Valerie D. Burland

Date: 3-22, 2004

Serial No.: 10/085,959

Group Art Unit:

Filed: 03/01/2002

Examiner:

Title: NOVEL SEQUENCES OF E. COLI CFT073

File No.: 960296.97648

**PETITION FOR CORRECTION OF FILING DATE UNDER 37 C.F.R. 1.10**

Commissioner for Patents
Attention: Office of Patent Legal Administration
P O Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby respectfully petition for correction of the filing date from "March 1, 2002" to --October 19, 2001-- based on the following remarks and evidence submitted herewith.

**Remarks**

The error was discovered on the original and the updated official filing receipts (copies attached). The return postcard (copy attached) shows the same error on the bar code label.

As evidence of the October 19, 2001 filing date applicants submit herewith the following:

1) A true copy of the express mail filing receipt from the U.S. Postal Service. The Express Mail label shows that the subject non-provisional patent application papers were deposited by Express Mail on October 19, 2001 at 4:58 p.m. The acceptance of the package was initialed by the U.S. Postal Service clerk.

03/26/2004 CNGUYEN 00000096 170055 10085959
01 FC:1460 130.00 DA

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2) The patent application papers necessary for receiving a filing date, including items a) through d) having Express Mail No. ET943407105US:

a) a utility transmittal sheet,

b) a fee sheet,

c) a specification (including at least 1 claims),

d) "Sequence Listing Statement" attached to the specification, and

e) fully executed Declaration (timely filed in response to a Notice of Missing Parts on July 5, 2002).

3) The U.S. PTO log book page for October 19, 2001 from the Madison Office of Quarles & Brady LLP indicating that the U.S. patent application was filed on that date.

Notwithstanding the proper procedures followed by applicants, the subject application still received a filing date as of the date it was received in the U.S. PTO, which was March 1, 2002, nearly five months after the "Express Mail" filing date.

Applicants have been advised that presumably due to the anthrax problem, quite a bit of mail directed to the U.S. PTO during the last two weeks of October, 2001, was delayed in the U.S. Postal Office in Washington D.C.

Therefore, based on this evidence, it is respectfully requested that the filing date be corrected to October 19, 2001 and that a new filing receipt be issued.

This Petition is accompanied by the petition fee (37 CFR 1.17(h)). However, it is not believed that any fee is due for this petition. In the event that the Office determines that a fee is due, the Commissioner is hereby authorized to charge any fee or credit any overpayment to Quarles & Brady LLP deposit account 17-0055.

Respectfully submitted,

Sara D. Vinarov
Reg. No.: 48,524
Attorney for Applicants
QUARLES & BRADY LLP
P.O. Box 2113
Madison, WI 53701

TEL 608/251-5000
FAX 608/251-9166

OIPE JC
MAR 25 2004
PATENT & TRADEMARK OFFICE

Express Mail No.

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 | 10/085,959 |
| Filing Date | 10/19/2001 |
| First Named Inventor | Frederick R. Blattner |
| Examiner Name | |
| Art Unit | 1632 |
| Attorney Docket No. | 960296.97648 |

## METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☑ Deposit Account:

Deposit Account Number: 17-0055

Deposit Account Name: Quarles & Brady LLP

**The Director is authorized to:** *(check all that apply)*

☑ Charge fee(s) indicated below ☑ Credit any overpayments

☑ Charge any additional fee(s) or any underpayment of fee(s)

☐ 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 | | = 0.00 |
| Independent Claims | -3** = | X | | = 0.00 |
| 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 | 86 | 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 Examiner 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 | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | 130 |
| 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)* | Sara D. Vinarov | *Registration No. (Attorney/Agent)* | 48,524 | *Telephone* | 608/251-5000 |
| *Signature* | | | | *Date* | 3-22, 2004 |

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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.**

373465

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

OIPE JC
MAR 25 2004
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Blattner, et al.
For: NOVEL SEQUENCES OF E.COLI CFT073

Date: October 19, 2001
Docket: 960296.97648

Commissioner for Patents:
Please acknowledge receipt by applying the Patent and Trademark Office receipt stamp and the serial number hereto and returning the same to me.

Express Mail Letter No. ET943407105US
Utility Patent Application Transmittal
Fee Transmittal (2 copies)
Application, 6 pages of specs
2 pages of claims (11 claims)
1 page abstract
0 pages of drawings
~~756 pages sequence listing~~
~~Declaration and Power of Attorney~~
~~Diskette Containing Sequence Listing~~
~~Statement Under 37 C.F.R. 1.821(f)~~

JC986 U.S. PTO
10/085959
03/01/02

2002 MAR 19

Bennett J. Berson, 37,094

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| Weight: lbs. 7 oz. 11.0 | Int'l Alpha Country Code: | COD Fee: / Insurance Fee: |
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Commissioner for Patents
Box: Patent Application
Washington, DC 20231

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|---|
| 10/085,959 | 03/01/2002 | 1632 | 908 | 960296.97648 | | 11 | 5 |

**CONFIRMATION NO. 4213**

**FILING RECEIPT**

*OC000000007794683*

Nicholas J. Seay
One South Pinckney Street, Stuite 600
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Madison, WI 53701-2113

Date Mailed: 04/04/2002

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**Applicant(s)**

Frederick R. Blattner, Madison, WI;
Rodney A. Welch, Madison, WI;
Valerie D. Burland, Cross Plains, WI;

**Domestic Priority data as claimed by applicant**

**Foreign Applications**

**If Required, Foreign Filing License Granted** 04/04/2002

**Projected Publication Date:** To Be Determined - pending completion of Missing Parts

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Novel sequences of E. coli CFT073

**Preliminary Class**

435

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WASHINGTON, D.C. 20231
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| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|---|
| 10/085,959 | 03/01/2002 | 1632 | 1038 | 960296.97648 | | 11 | 5 |

**CONFIRMATION NO. 4213**

**UPDATED FILING RECEIPT**

*OC000000008506281*

Nicholas J. Seay
One South Pinckney Street, Stuite 600
P.O. Box 2113
Madison, WI 53701-2113

Date Mailed: 07/24/2002

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Rodney A. Welch, Madison, WI;
Valerie D. Burland, Cross Plains, WI;

**Domestic Priority data as claimed by applicant**

**Foreign Applications**

**If Required, Foreign Filing License Granted** 04/04/2002

**Projected Publication Date:** 09/04/2003

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Novel sequences of E. coli CFT073

**Preliminary Class**

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# UTILITY PATENT APPLICATION TRANSMITTAL

*(Only for new nonprovisional applications under 37 CFR 1.53(b))*

| | |
|---|---|
| *Attorney Docket No.* | 960296.97648 |
| *First Inventor* | Fredrick R. Blattner |
| *Title* | NOVEL SEQUENCES OF E.COLI CFT073 |
| *Express Mail Label No.* | ET943407105US |

## APPLICATION ELEMENTS

*See MPEP chapter 600 concerning utility patent application contents.*

1. [✔] Fee Transmittal Form (e.g., PTO/SB/17) *(Submit an original and a duplicate for fee processing)*
2. [ ] Applicant claims small entity status. See 37 CFR 1.27.
3. [✔] Specification [*Total Pages* 765 ] *(preferred arrangement set forth below)*
   - Descriptive title of the invention
   - Cross Reference to Related Applications
   - Statement Regarding Fed sponsored R & D
   - Reference to sequence listing, a table, or a computer program listing appendix
   - Background of the Invention
   - Brief Summary of the Invention
   - Brief Description of the Drawings *(if filed)*
   - Detailed Description
   - Claim(s)
   - Abstract of the Disclosure
4. [ ] Drawing(s) *(35 U.S.C. 113)* [ *Total Sheets* ]
5. Oath or Declaration [ *Total Pages* ]
   a. [✔] New UNSIGNED
   b. [ ] Copy from a prior application (37 CFR 1.63 (d)) *(for continuation/divisional with Box 18 completed)*
      i. [ ] DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. [ ] Application Data Sheet. See 37 CFR 1.76

*ADDRESS TO:* Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231

7. [ ] CD-ROM or CD-R in duplicate, large table or Computer Program *(Appendix)*
8. Nucleotide and/or Amino Acid Sequence Submission *(if applicable, all necessary)*
   a. [✔] Computer Readable Form (CRF)
   b. Specification Sequence Listing on:
      i. [ ] CD-ROM or CD-R (2 copies); or
      ii. [✔] paper
   c. [✔] Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. [ ] Assignment Papers (cover sheet & document(s))
10. [ ] 37 CFR 3.73(b) Statement *(when there is an assignee)* [ ] Power of Attorney
11. [ ] English Translation Document *(if applicable)*
12. [ ] Information Disclosure Statement (IDS)/PTO-1449 [ ] Copies of IDS Citations
13. [ ] Preliminary Amendment
14. [✔] Return Receipt Postcard (MPEP 503) *(Should be specifically itemized)*
15. [ ] Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
16. [ ] Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. [ ] Other: .....

18. If a CONTINUING APPLICATION, *check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:*

[ ] Continuation [ ] Divisional [ ] Continuation-in-part (CIP) of prior application No.: _____/_____

*Prior application information:* *Examiner* _____ *Group Art Unit:* _____

**For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.**

## 19. CORRESPONDENCE ADDRESS

[ ] *Customer Number or Bar Code Label* [redacted] or [✔] *Correspondence address below*

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|---|---|---|---|---|---|
| *Name* | Nicholas J. Seay | | | | |
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| *City* | Madison | *State* | WI | *Zip Code* | 53701-2113 |
| *Country* | US | *Telephone* | 608-251-5000 | *Fax* | 608-251-9166 |

| | | | |
|---|---|---|---|
| *Name (Print/Type)* | Bennett J. Berson | *Registration No. (Attorney/Agent)* | 37,094 |
| *Signature* | [signature] | *Date* | October 19, 2001 |

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# FEE TRANSMITTAL for FY 2002

*Patent fees are subject to annual revision.*

| TOTAL AMOUNT OF PAYMENT | ($) 908.00 |
|---|---|

| Complete if Known | |
|---|---|
| Application Number | |
| Filing Date | |
| First Named Inventor | Frederick R. Blattner |
| Examiner Name | |
| Group Art Unit | |
| Attorney Docket No. | 960296.97648 |

## METHOD OF PAYMENT

1. ☑ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 17-0055

Deposit Account Name: Quarles & Brady LLP

☑ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status. See 37 CFR 1.27

2. **Payment Enclosed:** ☐ Check ☐ Credit card ☐ Money Order ☐ Other

## FEE CALCULATION

### 1. BASIC FILING FEE

| Large Entity Fee Code | Large Entity Fee ($) | Small Entity Fee Code | Small Entity Fee ($) | Fee Description | Fee Paid |
|---|---|---|---|---|---|
| 101 | 740 | 201 | 370 | Utility filing fee | 740.00 |
| 106 | 330 | 206 | 165 | Design filing fee | |
| 107 | 510 | 207 | 255 | Plant filing fee | |
| 108 | 740 | 208 | 370 | Reissue filing fee | |
| 114 | 160 | 214 | 80 | Provisional filing fee | |

SUBTOTAL (1) ($) 740.00

### 2. EXTRA CLAIM FEES

| | Extra Claims | | Fee from below | | Fee Paid |
|---|---|---|---|---|---|
| Total Claims | 11 | -20** = 0 | X 18.00 | = | 0.00 |
| Independent Claims | 5 | - 3** = 2 | X 84.00 | = | 168.00 |
| Multiple Dependent | | | | = | |

| Large Entity Fee Code | Large Entity Fee ($) | Small Entity Fee Code | Small Entity Fee ($) | Fee Description |
|---|---|---|---|---|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 84 | 202 | 42 | Independent claims in excess of 3 |
| 104 | 280 | 204 | 140 | Multiple dependent claim, if not paid |
| 109 | 84 | 209 | 42 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) ($) 168.00

**or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

| Large Entity Fee Code | Large Entity Fee ($) | Small Entity Fee Code | Small Entity Fee ($) | Fee Description | Fee Paid |
|---|---|---|---|---|---|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for *ex parte* reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 400 | 216 | 200 | Extension for reply within second month | |
| 117 | 920 | 217 | 460 | Extension for reply within third month | |
| 118 | 1,440 | 218 | 720 | Extension for reply within fourth month | |
| 128 | 1,960 | 228 | 980 | Extension for reply within fifth month | |
| 119 | 320 | 219 | 160 | Notice of Appeal | |
| 120 | 320 | 220 | 160 | Filing a brief in support of an appeal | |
| 121 | 280 | 221 | 140 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,280 | 241 | 640 | Petition to revive - unintentional | |
| 142 | 1,280 | 242 | 640 | Utility issue fee (or reissue) | |
| 143 | 460 | 243 | 230 | Design issue fee | |
| 144 | 620 | 244 | 310 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 740 | 246 | 370 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 149 | 740 | 249 | 370 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 179 | 740 | 279 | 370 | Request for Continued Examination (RCE) | |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | |
| Other fee (specify) | | | | | |

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) ($)

| SUBMITTED BY | | | | Complete (if applicable) | |
|---|---|---|---|---|---|
| Name (Print/Type) | Bennett J. Berson | Registration No. (Attorney/Agent) | 37,094 | Telephone | 608-251-5000 |
| Signature | | | | Date | October 19, 2001 |

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316476.1

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# NOVEL SEQUENCES OF *E. COLI* CFT073

## CROSS-REFERENCE TO RELATED APPLICATION

**[0001]** Not applicable.

## STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT

**[0002]** This invention was made with United States government support awarded by the following agency: NIH A144387. The United States has certain rights in this invention.

## BACKGROUND OF THE INVENTION

**[0003]** *Escherichia coli* is a common enteric bacterial strain that has both laboratory and human health importance. One particular strain of *E. coli*, designated CFT073 is a human pathogen that causes urinary tract infections. Urinary tract infections are common in various populations throughout the human life span. Infant boys, women of childbearing years, and aged people of both sexes have relatively high incidences of this infection. Acute pyelonephritis, a bacterial infection of the kidneys, is a common complication of such infections. Acute pyelonephritis often requires hospitalization for treatment, and the disease can be severe including complications or life threatening conditions.

**[0004]** Various strains of *E. coli* are associated with urinary tract infections and are commonly found in the urine of patients with pyelonephritis. Certain phenotypes of *E. coli* are found more often in such association. The strains associated with acute pyelonephritis often include a set of gene functions which, as a unit, have been thought to form a set of virulence factors that allow specific clones of *E. coli* to cause pyelonephritis.

**[0005]** Accordingly to investigate diagnosis or treatment of this disease, it is appropriate to focus the inquiry on the presumptive virulence factors. Most, if not all, of those virulence factors are present in the strain CFT073, which is known to be the among the most virulent of all of the *E. coli* strains associated with these diseases. The strain CFT073 has been previously shown to contain a pathogenicity island associated with uropathogenicity. Kao, JS et al., *Infect Immun.* 65:7, pp.2812-2920 (1997).

**[0006]** Modern geneticists have been working to resolve the genetic code of many organisms. Great efforts have been made to sequence the human genome. The effort to sequence the genomes of whole organisms began with an effort to sequence the genome of *E. coli.* For the original effort to sequence the *E. coli* genome, a useful and common laboratory strain, designated K-12, was chosen. The entire genome of that strain was sequenced and published. *Science*, 277:1453-1462 (1997). Since the genes which are responsible for the pathogenicity of *E. coli* CFT073 are missing from strain K-12, the sequence of the K-12 genome is of limited help in developing tools to detect, hinder or destroy *E. coli* CFT073.

## BRIEF SUMMARY OF THE INVENTION

**[0007]** It is an object of the present invention to provide the DNA sequence present in *E. coli* CFT073 which is not present in non-pathogenic *E. coli* to enable detection, diagnosis, prophylaxis and therapeutic tools to combat bacterial infections.

**[0008]** It is another object of the present invention to provide a means to detect *E. coli* CFT073 in an infection of an environmental sample.

**[0009]** It is yet another object of this invention to provide a means for the early diagnosis of humans and livestock infected with CFT073.

**[0010]** Another object of the present invention is to provide a means of treating humans and livestock infected with CFT073.

**[0011]** It is a further object of the present invention to provide a means for the prevention of infection by CFT073.

**[0012]** The present invention includes many DNA sequences that are unique to *E. coli* CFT073.

**[0013]** One aspect of the present invention is two CFT073 DNA sequences that encode hemagglutinin-like proteins that are important for host cell adhesion.

**[0014]** Another aspect of the present invention is two CFT073 DNA sequences that encode for autotransporters.

**[0015]** Another aspect of the present invention is a CFT073 DNA sequence that encodes for a RTX-like protein.

**[0016]** Still another aspect of the present invention is a method for detecting *E. coli* CFT073 and distinguishing the strain from other strains of *E. coli* by genetic analysis and testing.

**[0017]** It is a feature of the invention disclosed here that virtually the entire genome of *E. coli* CFT073 is set forth in the data contained here, combined with the information already published in the field.

## BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWINGS

**[0018]** Not applicable.

## DETAILED DESCRIPTION OF THE INVENTION

**[0019]** The investigators here have sequenced virtually the entire genome of *E. coli* CFT073. Presented in this specification is essentially all the DNA sequence which is contained in the genome of *E. coli* strain CFT073 and not found in the previously sequenced non-pathogenic laboratory *E. coli* strain K-12. The genome sequence is essentially complete, lacking only an occasional presumably small sequence linkage between established long sequences known. The availability of the sequence data presented here will enable intelligent design of diagnostic detection, prophylaxis and therapeutic tools for disease and infections caused by this organism.

**[0020]** The sequence of *E. coli* CFT073 was, in brief, performed by shotgun cloning and duplicative random sequence analysis followed by computer assembly into contigs. The contigs determined by shot gun clone sequencing were assembled using computer software designed for that purpose.

**[0021]** An important analysis which has begun on this sequence data is the identification of genetic sequences associated with the pathogenesis of infection, which sequences provide information essential to the diagnosis, treatment, and prevention of infection by uropathogenic *E. coli* strains. In order to facilitate the identification of genes involved in the pathogenesis of infection by uropathogenic *E. coli* strains for use in detection of the pathogen, and in the diagnosis, treatment, and prevention of uropathogenic infection, the entire genomic DNA sequence of *E. coli* CFT073 was compared with that of *E. coli* K-12, a nonpathogenic laboratory strain as published in *Science*, 277:1453-62 (1997).

**[0022]** Attached to this patent application is a sequence listing containing essentially all of the DNA sequence in the CFT073 genome, represented by the contigs mentioned above, that are not present in the K-12 genome. This sequence is present in the sequence listing as SEQ ID NO:1 through SEQ ID NO:251 and SEQ ID NO:254.

**[0023]** By definition, the genetic material in the sequences disclosed in this invention is sufficient for pathogenicity in humans since strain CFT073 is highly pathogenic while K-12 is not. In addition, analysis of the open reading frames (ORFs) and computer comparisons to sequences from other pathogens have allowed identification of several of the ORFs which code for proteins specifically associated with pathogenicity. We provide five examples of such ORFs. The first one (ORF1) is between nucleotide 12003 and nucleotide 20509 of SEQ ID NO:251. ORF1 is a putative member of the ShlA/HecA/Fha exoprotein family that shows a 25% identity over 2,311 residues to a probable hemagglutinin (the nucleotide sequence GenBank accession number for the probable hemagglutinin is AE004443). The second one (ORF2) is between nucleotide 31940 and nucleotide 34668 of SEQ ID NO:254. ORF2 is a member of the Shl/Fha/Hpm family and amino acids 33-907 of ORF2 shows a 26% identity to amino acids 1,912-2,818 of hemagglutinin/hemolysin-related protein (the amino acid sequence and the nucleotide sequence GenBank accession numbers are AAG03431 and AE002405, respectively). Both ORF1 and ORF2 are believed to be important for host cell adhesion and thus infection.

**[0024]** The third one (ORF3) is the complementary sequence between nucleotide 1008 and nucleotide 1885 of SEQ ID NO:85. ORF3 is a member of the autotransporter family and is 57% identical over 292 residues to a putative beta-barrel outer membrane protein (the nucleotide sequence GenBank accession number is AE005210). The fourth one (ORF4) is the complementary sequence between nucleotide 1996 and nucleotide 5607 of SEQ ID NO:85. ORF4 is also a member of the autotransporter family. ORF4 has a 31% identity over 1103 residues to YapD protein (the nucleotide sequence GenBank accession number is AJ277627) and a 27% identity over 2952 residues to YapH protein (the nucleotide sequence GenBank accession number is AJ277631). Both ORF3 and ORF4 as autotransporters are believed to be important virulence factors of CFT073.

**[0025]** The fifth one (ORF5) is between nucleotide 40329 and nucleotide 44950 of SEQ ID NO:251. ORF5 is similar to RTX family members and is 23% identical over 1,461 residues to a putative RTX family exoprotein (the nucleotide sequence GenBank accession number is AE005229). ORF5 is believed to be an exotoxin like RTX.

**[0026]** In addition to the diagnostic value, the DNA sequences of ORF1-5 are also useful for treatment and prevention purposes. For example, antisense oligonucleotides can be designed given the knowledge of these sequences to block the expression of the corresponding proteins. One of ordinary skill knows how to design and use antisense oligonucleotides. Along the

same line, the corresponding amino acid sequences of ORF1-5 or an immunogenic fragment thereof are also valuable for diagnosis, treatment and prevention of uropathogenic *E. coli* strains. For example, the corresponding amino acid sequences or an immunogenic fragment thereof can be used to generate antibodies that can be used for diagnosis, treatment and prevention purposes. One of ordinary skill in the art knows how to produce antibodies to the proteins encoded by ORF1-5. Vaccines may also be produced using the amino acid sequence information. It is well within the knowledge of a skilled artisan to generate vaccines.

**[0027]** The specific CFT073 strain from which the sequence data is derived is available from ATCC as ATCC 700928. One wishing to practice the present invention using one of the disclosed DNA sequences can do so by isolating the sequence from ATCC 700928 using knowledge of the nucleotide sequence and standard methods known to one of ordinary skill in the art.

**[0028]** It is expected that minor sequence variations in *E. coli* CFT073-specific nucleotide sequences associated with nucleotide additions, deletions, and mutations, whether naturally occurring or introduced *in vitro*, would not interfere with the usefulness of these sequences in the detection of uropathogenic *E. coli*, in methods for preventing urinary tract infection, and in methods for treating pyelonephritis. Therefore, the scope of the present invention is intended to encompass minor variations in the claimed sequences, which include both DNA and RNA and can also contain non-standard bases such as inosine.

**[0029]** Another utility enabled by the disclosure here is the detection of pathogenic *E. coli* strains by nucleic acid hybridization assays. Such assays, using techniques well known in the art, are made possible by the sequence information contained here, which enables the selection of CFT073-specific probes. By an *E. coli* CFT073-specific nucleotide probe, it is meant a sequence that is able to hybridize to *E. coli* CFT073 target DNA present in a sample containing *E. coli* CFT073 under suitable hybridization conditions and which does not hybridize with DNA from other *E. coli* strains or from other bacterial species. In particular, a CFT073 specific probe will bind to CFT073 DNA but not to DNA from K-12. This permits the intelligent design of DNA probes for use in hybridization assays for the presence of CFT073 strains. It is well within the ability of one skilled in the art to determine suitable hybridization conditions, based on probe length, G+C content, and the degree of stringency required for a particular application.

**[0030]** The probe may be RNA or DNA. Depending on the detection means employed, the probe may be unlabeled, radiolabeled, or labeled with a dye. The probe may be hybridized

with a sample that has been immobilized on a solid support such as nitrocellulose or a nylon membrane, or the probe may be immobilized on a solid support, such as a silicon chip.

**[0031]** The sample to be tested may include blood, urine, feces, or other materials from a human or a livestock animal. Alternatively, the sample may include food intended for human consumption. The sample may be tested directly, or may be treated in some manner prior to testing. For example, the sample may be subjected to PCR amplification using appropriate oligonucleotide primers.

**[0032]** Any means of detecting DNA-RNA or DNA-DNA hybridization known to the art may be used in the present invention.

**[0033]** Again, presented in this specification is a sequence listing constituting essentially all of the DNA sequence in the CFT073 genome that do not appear in strain K-12, which is presented as SEQ ID NO:1 to SEQ ID NO:251 and SEQ ID NO:254. Since all of these sequences are diagnostic of CFT073, as compared to K-12, sequence information from any of these sequences can be used to design diagnostic probes useful to distinguish strain CFT073 from strain K-12 using molecular techniques. To have reasonable assurance of success under conditions of variable stringency, it is preferred that such diagnostic probes use sequences which are at least 25 nucleotides or longer in length. Any 25-mer selected from amongst any of the sequences in any of SEQ ID NO:1 through SEQ ID NO:251 and SEQ ID NO:254 may be used for such a probe.

## CLAIMS

WE CLAIM:

1. An isolated nucleic acid molecule comprising a nucleotide sequence or its complement, the nucleotide sequence is identical to at least twenty-five continuous nucleotides contained in DNA sequences selected from the group consisting of SEQ ID NO:1 to SEQ ID NO:251 and SEQ ID NO:254.

2. A recombinant nucleic acid construction comprising the isolated nucleic acid molecule of Claim 1.

3. A host cell comprising the recombinant nucleic acid construction of Claim 2.

4. A method for distinguishing *E. coli* bacteria of strain CFT073 from strain K-12 comprising analyzing the genome of the bacteria for the presence of any DNA sequence claimed in Claim 1.

5. A method for detecting *E. coli* CFT073 in a sample comprising the steps of:

a) providing an *E. coli* CFT073-specific nucleotide probe, the probe comprising a sequence or its complement, the sequence is selected from the group consisting of SEQ ID NO:1 through SEQ ID NO:251 and SEQ ID NO:254;

b) contacting the probe with a sample of test material under suitable hybridization conditions; and

c) detecting hybridization of the probe to a complementary nucleotide sequence in the sample.

6. An isolated nucleic acid molecule comprising a nucleotide sequence or its complement, the nucleotide sequence is selected from the group consisting of the complementary sequence between nucleotide 1008 and nucleotide 1885 of SEQ ID NO:85, the complementary sequence between nucleotide 1996 and nucleotide 5607 of SEQ ID NO:85, the sequence between nucleotide 12003 and nucleotide 20509 of SEQ ID NO:251, the sequence between nucleotide 40329 and nucleotide 44950 of SEQ ID NO:251, and the sequence between nucleotide 31940 and nucleotide 34668 of SEQ ID NO:254.

7. A recombinant nucleic acid construction comprising the isolated nucleic acid molecule of Claim 6.

8. A host cell comprising the recombinant nucleic acid construction of Claim 7.

9. An isolated polypeptide comprising an amino acid sequence encoded by a DNA sequence selected from the group consisting of the complementary sequence between nucleotide 1008 and nucleotide 1885 of SEQ ID NO:85, the complementary sequence between nucleotide 1996 and nucleotide 5607 of SEQ ID NO:85, the sequence between nucleotide 12003 and nucleotide 20509 of SEQ ID NO:251, the sequence between nucleotide 40329 and nucleotide 44950 of SEQ ID NO:251, and the sequence between nucleotide 31940 and nucleotide 34668 of SEQ ID NO:254.

10. An isolated polypeptide comprising an immunogenic fragment of an amino acid sequence encoded by a DNA sequence selected from the group consisting of the complementary sequence between nucleotide 1008 and nucleotide 1885 of SEQ ID NO:85, the complementary sequence between nucleotide 1996 and nucleotide 5607 of SEQ ID NO:85, the sequence between nucleotide 12003 and nucleotide 20509 of SEQ ID NO:251, the sequence between nucleotide 40329 and nucleotide 44950 of SEQ ID NO:251, and the sequence between nucleotide 31940 and nucleotide 34668 of SEQ ID NO:254.

11. An antibody that specifically binds to the polypeptide of Claim 9.

## ABSTRACT OF THE DISCLOSURE

The entire genome of pathogenic *E. coli* strain CFT073 has been sequenced. Nearly all of the genomic DNA sequences present in CFT073 and absent in the previously sequenced laboratory strain K-12 are presented here.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Applicants: Frederick R. Blattner
RodneyA. Welch
Valerie D. Burland

Date: October 19, 2001

Serial No.:

Art Unit:

Filed: Herewith

Examiner:

For: NOVEL SEQUENCES OF E.COLI CFT073

Docket: 960296.97648

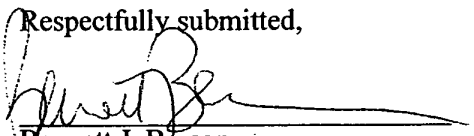
STATEMENT UNDER 37 C.F.R. 1.821(f)

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The undersigned, an attorney registered to practice before the U.S. Patent and Trademark Office and representing the applicants in the above-identified patent application does hereby state and affirm that the content of the printed computer listing contained within the above-identified patent application and the content of the sequence listing attached hereto in computer readable form are the same.

Respectfully submitted,



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Madison WI 53701-2113
TEL (608) 251-5000
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OIPE JC4
MAR 25 2004
PATENT & TRADEMARK OFFICE

| | | |
|---|---|---|
| 10/19/01 | Chapter-a-Day<br>281677.900.8<br>75/943,579 | Response |
| 10/19/01 | 960296.97648<br>WARF<br>Blattner, et al.<br>ET943407105US<br>10/085959<br>3/01/02 | Express Mail Letter<br>Utl. Pat. App. Trans.<br>Fee Transmittal (2)<br>application (6 pg; Spec. 2 pages of claims (11)<br>1 pg abstract<br>0 pp. drawings<br>758 pages sequence listing<br>Declaration + Power of Atty<br>Diskette (containing Sequence listing)<br>Statement under 37 C.F.R. § 1.821(f) |
| 10/19/01 | 960296.97648<br>WARF PCT<br>Blattner, et al.<br>ET943407096US<br>PCT/US01/46833 | PCT Int'l App. Trans. Ltr<br>PCT Request<br>PCT Fee Calculation<br>~~Desp~~ Description (6 pg)<br>Claims (2 pg)<br>Abstract (1 pg)<br>Drawings (none)<br>Sequence Listing (758) |
| 10/22/01 | Warf<br>960296.96544<br>09/522,030 | Fee transmittal<br>Supplemental IDS<br>Form PTO-1449 w/attachments |
| 10/24/01 | Warf<br>960296.97290<br>PCT/US01/19638 | Response to Invitation<br>Power of Attorney<br>Copy of Signature Authority Resolution |

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date set forth below as First Class Mail in an envelope addressed to: Commissioner for Patents, P O Box 2327, Arlington, VA 22202.

Date of Signature and Deposit: July 5, 2002

Nicholas J Seay

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Frederick R. Blattner
Rodney A. Welch
Valerie D. Burland

Date: July 5, 2002

Serial No.: 10/085,959

Group Art Unit:

Filed: 03/01/2002

Examiner:

Title: NOVEL SEQUENCES OF E. COLI CFT073

File No.: 960296.97648

RESPONSE TO NOTICE TO FILE MISSING PARTS
OF NONPROVISIONAL APPLICATION
FILED UNDER 37 CFR 1.53(b)
*Filing Date Granted*

Commissioner For Patents
Initial Patent Examination Division
Customer Service Center
P O Box 2327
Arlington, VA 22202

Dear Sir:

By a Notice mailed April 4, 2002 in the file of the above-identified application, the Patent and Trademark Office informed the applicants, through the undersigned, of the necessity of completing the filing of this application by filing a Declaration signed by the inventors. Enclosed herewith is a Declaration and Power of Attorney made out to the undersigned executed by all the inventors of this application. This Declaration was specifically attached to a complete copy of the specification and claims of this application at the time it was executed by the inventors and refers to the application by the same attorney docket number that makes specific reference to this patent application.

Wherefore it is believed that the filing particularities with regard to the filing of this application are completed. Examination on the merits in due course is respectfully requested.

A petition for extension of time for one month, plus the required surcharge is submitted herewith by a fee transmittal which accompanies this document.

Respectfully submitted,

Nicholas J. Seay
Reg. No.: 27,386
Attorney for Applicants
QUARLES & BRADY LLP
P.O. Box 2113
Madison, WI 53701

TEL 608/251-5000
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PTO/SB/01 (6-95)
Approved for use through 9/30/98. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Please type a plus sign (+) inside this box [+]

0010/PTO Rev. 6/95 — U.S. Department of Commerce Patent and Trademark Office

# DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION

[X] Declaration Submitted with Initial Filing OR [ ] Declaration Submitted after Initial Filing

| | |
|---|---|
| Attorney Docket Number | 960296.97648 |
| First Named Inventor | Frederick R. Blattner |
| *COMPLETE IF KNOWN* | |
| Application Number | |
| Filing Date | |
| Group Art Unit | |
| Examiner Name | |

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

NOVEL SEQUENCES OF E. COLI CFT073

*(Title of the Invention)*

the specification of which

[X] is attached hereto

OR

[ ] was filed on (MM/DD/YYYY) [ ] as United States Application Number or PCT International Application Number [ ] and was amended on (MM/DD/YYYY) [ ] (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed.

| Prior Foreign Application Number(s) | Country | Foreign Filing Date (MM/DD/YYYY) | Priority Not Claimed | Certified Copy Attached? YES | NO |
|---|---|---|---|---|---|
| | | | [ ] | [ ] | [ ] |
| | | | [ ] | [ ] | [ ] |
| | | | [ ] | [ ] | [ ] |
| | | | [ ] | [ ] | [ ] |
| | | | [ ] | [ ] | [ ] |
| | | | [ ] | [ ] | [ ] |

[ ] Additional foreign applications numbers are listed on a supplemental priority sheet attached hereto:

I hereby claim the benefit under Title 35, United States Code §119(e) of any United States provisional application(s) listed below.

| Application Number(s) | Filing Date (MM/DD/YYYY) |
|---|---|
| 60/242,412 | 10/19/2000 |

[ ] Additional provisional application numbers are listed on a supplemental priority sheet attached hereto.

Burden Hour Statement: This form is estimated to take .4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231. QBMAD\316560.1

Please type a plus sign (+) inside this box [+]

# DECLARATION



I hereby claim benefit under Title 35, United States Code §120 of any United States application(s), or §365(C) of any PCT International application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application or PCT international application in the manner provided in the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

| U.S. Parent Application Number | PCT Parent Number | Parent Filing Date (MM/DD/YYYY) | Parent Patent Number *(if applicable)* |
|---|---|---|---|
| | | | |

[ ] Additional U.S. or PCT international application numbers are listed on a supplemental priority sheet attached hereto

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and all continuation and divisional applications based thereon, and to transact all business in the Patent and Trademark Office connected therewith:

[ ] Firm Name OR [ ] Customer Number or label

[X] List attorney(s) and/or agent(s) name and registration number below

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|---|---|---|---|
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| Barry E. Sammons | 25,608 | Michael A. Jaskolski | 37,551 |
| Charles W. Jirauch | 26,186 | Richard T. Roche | 38,599 |
| Nicholas J. Seay | 27,386 | Terri S. Flynn | 41,756 |
| George E. Haas | 27,642 | John T. Pienkos | 42,997 |
| Michael J. McGovern | 28,326 | Daniel G. Radler | 43,028 |
| Carl R. Schwartz | 29,437 | Gregory M. Smith | 43,136 |
| Keith M. Baxter | 31,233 | Steven J. Wietrzny | 44,402 |
| John D. Franzini | 31,356 | Paul D. Amrozowicz | 45,264 |
| Janine R. Novatt | 32,593 | David M. Kettner | 45,598 |
| Jean C. Baker | 35,433 | Adam J. Forman | 46,707 |
| David G. Ryser | 36,407 | Zhibin Ren | 47,897 |

[ ] Additional attorney(s) and/or agents named on a supplemental priority sheet attached hereto

Please direct all correspondence to [ ] Customer Number or label | OR [X] Fill in correspondence address below

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 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.

Name of Sole or First Inventor: [ ] A petition has been filed for this unsigned inventor

| Given | Frederick | Middle | R. | Family | Blattner | Suffix | |
|---|---|---|---|---|---|---|---|

Inventor's Signature: Frederick R Blattner Date: Nov 27 2001

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|---|---|---|---|---|---|---|---|

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| City | Madison | State | WI | Zip | 53711 | Country | US | Applicant Authority | |
|---|---|---|---|---|---|---|---|---|---|

[X] [ ] Additional inventors are being named on supplemental sheet(s) attached hereto

Please type a plus sign (+) inside this box [+]

| DECLARATION | ADDITIONAL INVENTOR(S) Supplemental Sheet |
|---|---|

**Name of Additional Joint Inventor, if any:** ☐ A petition has been filed for this unsigned inventor

| Given | Middle | Family | Suffix |
|---|---|---|---|
| Rodney | A | Welch | |

Inventor's [signature] Date 11/27/01

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| City | State | Zip | Country | Applicant Authority |
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**Name of Additional Joint Inventor, if any:** ☐ A petition has been filed for this unsigned inventor

| Given | Middle Initial | Family Name | Suffix |
|---|---|---|---|
| Valerie | D. | Burland | |

Inventor's Valerie Burland Date 11-19-01

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|---|---|---|---|---|
| Cross Plains | WI | 53528 | US | |

**Name of Additional Joint Inventor, if any:** ☐ A petition has been filed for this unsigned inventor

| Given | Middle | Family | Suffix |
|---|---|---|---|
| | | | |

Inventor's Date

| Residence: | State | Country | Citizenship |
|---|---|---|---|
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Post Office:

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| City | State | Zip | Country | Applicant Authority |
|---|---|---|---|---|
| | | | | |

**Name of Additional Joint Inventor, if any:** ☐ A petition has been filed for this unsigned inventor

| Given | Middle | Family | Suffix |
|---|---|---|---|
| | | | |

Inventor's Date

| Residence | State | Country | Citizenship |
|---|---|---|---|
| | | | |

Post Office:

Post Office:

| City | State | Zip | Country | Applicant Authority |
|---|---|---|---|---|
| | | | | |

☐ Additional inventors are being named on supplemental sheet(s) attached hereto

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AUG 10 2004

Director's Office
Group 3700

In re Application of
Gerald D. Eckstein *et al*
Application No. 10/085,966
Filed: February 28, 2002
Attorney Docket No. 8266-0823

DECISION ON PETITION

This is a decision on the petition, apparently resubmitted on April 9, 2004 after having been originally facsimile transmitted on January 23, 2004 (with a 37 CFR 1.8(a) certificate of transmission affixed thereto), requesting supervisory review of, and relief from, the examiner's refusal to enter the amendment after final action that was filed on December 29, 2003. There is no fee for the petition.

The petition is granted.

A review of the arguments presented in the petition, and of the file history, shows that there is no adequate basis in the record for refusing to enter the amendment in question, since at a minimum, it places the application in better form for appeal. The rationale for this conclusion is identical to that presented by petitioners, it being noted that the advisory action dated January 12, 2004 does not state any rationale at all in support of the conclusion that the proposed amendments change the scope of the claim (item 2 of the advisory action).

Accordingly, the application file is being forwarded to the Supervisory Patent Examiner (SPE) of Art Unit 3754 who will have the amendment in question entered. It is noted that an appeal brief was filed on January 26, 2004. The SPE should review the claims in the appendix of the brief. To the extent that the claims in the appendix of the appeal brief, and the arguments in the appeal brief, are no longer addressed to the claims of record in the application due to entry of the amendment filed on December 29, 2003, the SPE will have the examiner promulgate a letter requiring a supplemental appeal brief, setting a TWO MONTH period, subject to the extension of time provisions of 37 CFR 1.136(a), for filing the supplemental appeal brief. After entry of the amendment filed on December 29, 2003 and filing of the supplemental appeal brief, if such is necessary, the application will be forwarded to the examiner for appropriate action.

PETITION GRANTED.

Richard A. Bertsch, Director
Technology Center 3700

Bose McKinney & Evans, LLP
Intellectual Property Group
2700 First Indiana Plaza
135 North Pennsylvania Street
Indianapolis, IN 46204

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Adam H. Masia
BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO IL 60690

MAY 22 2008

In re Application of: HUGHES-BAIRD et al. :
Appl. No.: 10/086,014 : DECISION ON PETITION
Filed: February 28, 2002 :
For: GAMING DEVICE HAVING IMPROVED OFFER :
AND ACCEPTANCE GAME WITH MASKED OFFERS :

This is a decision on the petition filed on April 9, 2008 by which petitioner requests entry of the Reply Brief filed January 28, 2008 and entry of the Amendment to Cancel Claims filed concurrently therewith. Petitioner was notified of the denial of entry of the Reply Brief and Amendment in the Advisory Action mailed March 19, 2008. The petition is stylized as submitted under 37 CFR 1.181, is considered timely, and no fee is due.

The petition is GRANTED.

Review of the application shows application claims 1-10, 18 and 20 were finally rejected by the Office on October 13, 2006. Claims 11-17, 21 and 22 stand allowed. Petitioner filed a Notice of Appeal on January 9, 2007, followed by a Brief on March 9, 2007. This Brief was held non-compliant by the Office on July 9, 2007. A compliant Brief was submitted by petitioner on July 20, 2007. The Office promulgated and Examiner's Answer on November 27, 2007. Responsive thereto, petitioner filed a Reply Brief and Amendment on January 28, 2008. Petitioner's Amendment proposed to cancel dependent claims 6, 7, 9 and 10 only.

In the Advisory action of March 19, 2008 the examiner denies entry of the Reply Brief and Amendment stating "the proposed cancellation of claims 6, 7, 9, and 10 would alter the claim scope of the language "directly and individually" in the remaining claims and therefore is improper for entry." The advisory action fails to explain how the deletion of the particular dependent claims would affect the meaning of the language "directly and individually" in the remaining non-related dependent claims or in the independent claim. This position can not be supported.

*37 CFR 41.33 (b)(1) [in pertinent part] states:*
***§ 41.33 Amendments and affidavits or other evidence after appeal.***
...
*(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 maybe admitted:*
*(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or*
... .

*37 CFR 1.75 [in pertinent part] states:*

***§ 1.75 Claim(s).***

*(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.*

*(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.*

*(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.*

...

*Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.*

... .

Petitioner submits cancellation of each of dependent claims 6, 7, 9 and 10, each separately dependent individually from independent claim 1, does not affect the scope of any other pending claim in the proceeding and therefore the amendment cancelling these claims is allowed entry under 37 CFR 41.33 (b)(1) and therefore seeks entry of the amendment and Reply Brief. Petitioner points to specific reasoning for this position, particularly with respect to claims 9 and 10 being set forth in the Reply Brief accompanying the allegedly offending amendment.

Looking to the claims, the language in question of claim 1 includes: "...(a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections, ...". This claim covers at least one disclosed embodiment shown in Figs 3a and 3b and discussed at least at page13 lines 3-5 of the specification, and said embodiment includes each offer associated with a separate selection. Claim 7 recites in pertinent part "...associate one of said offers with each of said selections." Claim 9 recites in pertinent part "...each of said offers is only associated with one selection." Claim 10 recites in pertinent part "...said offers may be associated with a plurality of selections". As can be appreciated, each of claims 7, 9 and 10 fails to meaningfully further limit claim 1 as each repeats an offer associated with one selection, and therefore cancellation thereof under 37 CFR 41.33 (b)(1) is permissible.

Claim 6 recites in pertinent part "...the number of offers is less than the number of selections.". This is disclosed on page 13, lines 1-3 with respect to the same embodiment that claim 1 appears directed to. This means that the while the player may be presented with a total of five offers, the values associated with each offer have been selected from a pool of selections containing greater than five values. The language of claim 6 appears to further limit claim 1 in that claim one is silent with respect to the number of offers or the number of selections (note claim one merely defines the *association* such that each offer is associated with a separate one of the selections). When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). Office personnel must also avoid reading limitations from other claims into a particular claim as much as they must guard reading limitations from the specification into the claims. In the instant application, cancellation of claim 6 does not alter the scope of claim 1 or any other pending claim. Therefore, cancellation thereof under 37 CFR 41.33 (b)(1) is permissible.

Cancellation of claims 6, 7, 9 and 10 is therefore allowed under 37 CFR 41.33 (b)(1). Further, petitioner's Reply Brief of January 28, 2008 is timely and ripe for entry under 37 CFR 41.41 (a)(1). Jurisdiction of the file is returned to the primary examiner for acknowledgement of the cancellation of claims 6, 7, 9 and 10 and entry/consideration of the Reply Brief.

Any inquiry regarding this decision may be directed to J. Harrison at 571-272-4449.

PETITION GRANTED

Karen M. Young

Karen M. Young, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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OVERLAND PARK KS 66251-2100

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OFFICE OF PETITIONS

In re Application of :
Pawan Chaturvedi et al. :
Application No. 10/086,017 : DECISION ON PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 1814 :
Title: METHOD AND SYSTEM FOR :
PROVIDING DIAL-UP DATA SESSIONS :
WITH DISTRIBUTED SERVICE :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 12, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the Application Data Sheet (ADS), filed concurrently with the present petition.

The petition is **DISMISSED AS MOOT**.

The petition is accompanied by an application data sheet (ADS) which includes a reference to the prior-filed application. The reference to the prior-filed nonprovisional application was included in the ADS which was received on filing, although it incorrectly set forth that the present application is a continuation of the prior-filed application, instead of a continuation-in-part. Nevertheless, the reference was included in the ADS which was filed with the application.

As such, no petition will be required to accept a late claim for priority. The priority data will be corrected so as to reflect the correct continuity information, as contained in the ADS as submitted June 2, 2003.

The petition fee will be refunded to Petitioner's Deposit Account, as authorized in the petition.

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 2616 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.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

Frances Hicks
Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|---|
| 10/086,017 | 02/28/2002 | 2616 | 1298 | 1814 | 9 | 37 | 6 |

**CONFIRMATION NO. 1162**

**CORRECTED FILING RECEIPT**

*OC000000020443860*

28005
SPRINT
6391 SPRINT PARKWAY
KSOPHT0101-Z2100
OVERLAND PARK, KS 66251-2100

Date Mailed: 09/15/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

**Applicant(s)**

Pawan Chaturvedi, Overland Park, KS;
Brian L. Senogles, Kansas City, MO;

**Power of Attorney:** The patent practitioners associated with Customer Number **028005**.

**Domestic Priority data as claimed by applicant**

This application is a CIP of 09/893,137 06/27/2001 PAT 7,106,706

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 04/10/2002

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/086,017**

**Projected Publication Date:** Request for Non-Publication Acknowledged

**Non-Publication Request:** Yes

**Early Publication Request:** No

**Title**

Method and system for providing dial-up data sessions with distributed service

**Preliminary Class**

370

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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## LICENSE FOR FOREIGN FILING UNDER
## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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FALLS CHURCH VA 22042-7195

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**NOV 19 2008**

**OFFICE OF PETITIONS**

In re Application of:
Shalati, et al.
Application No. 10/086,020
Filed: February 27, 2002
Attorney Docket No. 00307.0044.NPUS00

ON PETITION

This is a decision on the petition to remove/close erroneously filed documents, filed October 24, 2008. The petition will be treated under 37 CFR 1.59, as a request that the Office expunge a portion of the application file.

The petition is **granted**.

Petitioners request the removal of a reissue patent application inadvertently filed in the present application file.

Petitioners have established to the satisfaction of the Office that removal of all documents pertaining to the reissue patent application is appropriate.

The following documents have been expunged from the present application file: Transmittal Reissue Application; Specification; Claims; Abstract; Oath or Declaration; Power of Attorney; Consent of Assignee; Preliminary Amendment; Claims; Applicant Arguments/Remarks Made in an Amendment; Fee Worksheet; EFS Acknowledgement Receipt.

Deposit account no. 08-3038 will be charged the required $200.00 petition to expunge fee. The same deposit account will be refunded a $310.00 basic filing fee - reissue, a $510.00 reissue search fee; a $620.00 reissue examination fee, a $200.00 reissue claims in excess of 20 fee, and a $210.00 reissue independent claims in excess of 3 fee.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 29, 2006

TO SPE OF : ART UNIT 2861

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/086035 Patent No.: 7,079,168 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:** _____

_____

_____

_____

_____

_____ 2861

**SPE** **Art Unit**

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KAREN J. MESSICK
KOS PHARMACEUTICALS
1001 BRICKELL BAY DRIVE
25TH FLOOR
MIAMI FL 33131

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JUL 0 6 2005

OFFICE OF PETITIONS

In re Application of
Jose Guttierez-Rocca et al.
Application No. 10/086,059
Filed: February 27, 2002
Attorney Docket No. 540591-7095.1

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 18, 2005, to revive the above identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Final Office Action mailed April 16, 2004. A shortened statutory period of three months was set for replying Final Office Action. No extensions of time having been filed, the application became abandoned July 17, 2004. The instant petition and this decision on petition precede the mailing of the Notice of Abandonment.

Petitioner files the instant petition and request for continued examination under 37 CFR 1.137(b). [1]

---

[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)).

In response to the Final Office Action mailed April 18, 2005, petitioner has submitted a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 1617 for processing of the RCE and submission.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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Karen J. Messick
Kos Pharmaceuticals
1001 Brickell Bay drive
25th floor
Miami, FL 33131

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OFFICE OF PETITIONS

In re Application of

Gutierrez-Rocca, et al. :

Application No. 10/086,059

: DECISION ON PETITION

Filed: February 27, 2002

:

Attorney Docket No. 540591-7095.1

This is a decision on the petition under 37 CFR 1.137(b), filed January 27, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 14, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on October 15, 2005.

The amendment filed January 27, 2006, is noted.

The request for an extension of time within the third month, filed January 27, 2006, is noted but cannot be granted as the request was made outside the maximum statutory period for reply and the application was already in an abandoned status. The amount of $510.00 will be refunded, in due course.

The application is being forwarded to Technology Center 1600, GAU 1617 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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**JENNIFER M. PHELPS**
**MCCUTCHEN DOYLE BROWN & ENERSEN**
**18TH FLOOR, THREE EMBARCADERO CENTER**
**SAN FRANCISCO, CA 94111**

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DEC 29 2004

OFFICE OF PETITIONS

In re Application of :
Laurie DeLeve :
Application No. 10/086,072 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. 13761-7065 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 2, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed February 23, 2004, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The reply submitted on May 24, 2004 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed June 22, 2004. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 24, 2004.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center 1617 for processing of the request for continued examination under 37 CFR 1.114.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO IL 60601-6780

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MAR 3 0 2006

OFFICE OF PETITIONS

In re Application of :
Tetsuya Ikemoto et al. :
Application No. 10/086,076 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No: 215851

This is a decision on the petition filed July 27, 2005 under 37 CFR 1.182, for withdrawal of terminal disclaimer filed September 3, 2002.

The petition is **GRANTED**.

The examiner responsible for the above-identified application has indicated that the terminal disclaimer filed September 3, 2002, does not apply to any of the claims as currently amended. Accordingly, on petition the terminal disclaimer is withdrawn.

Petitioner is advised that the fee for petition under 37 CFR 1.182 is authorized under 37 CFR 1.17(f). The fee for the instant petition is, therefore, $400.00. Deposit account 12-1216 will be charged an additional $270.00, accordingly.

This matter is being referred to Technology Center 1621 to correct the records related to the terminal disclaimer filed September 3, 2002, consistent with this decision.

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

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BELL BOYD & LLOYD LLC
PO BOX 1135
CHICAGO IL 60690-1135

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DEC 2 0 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 6,942,567 | : |
| Baerlocher, et al. | : DECISION REGARDING |
| Issue Date: September 13, 2005 | : PATENT TERM ADJUSTMENT |
| Application No. 10/086,078 | : AND |
| Filed: February 27, 2002 | : NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. 112300/747 | : CERTIFICATE OF CORRECTION |

This letter is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(d)", filed November 11, 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 **three hundred eleven (311)** days.

On September 13, 2005, the above-identified application matured into U.S. Patent No. 6,942,567. The patent issued with a Patent Term Adjustment of one hundred ninety-one (191) days. Patentees state that they were erroneously assessed applicant delay of one hundred twenty (120) days for the filing of drawings on March 23, 2005.

The one hundred twenty (120) days of applicant delay assessed for drawings on March 23, 2005 is incorrect. Applicant did not file drawings after the Notice of Allowance.

Accordingly, issuance of a certificate of correction pursuant to 35 U.S.C. 254 and 37 CFR § 1.322 is appropriate.

Receipt of the $200 fee under 37 CFR §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 CFR 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **three hundred eleven (311)** 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

Enclosure: Copy of Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

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INTELLECTUAL PROPERTY & STANDARDS
1109 MCKAY DRIVE, M/S-41SJ
SAN JOSE, CA 95131

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OFFICE OF PETITIONS

In re Application of :
Vishal Anand, et al. :
Application No. 10/086,096 : ON PETITION
Filed: February 27, 2002 :
Attorney Docket No. US 028017 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 14, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed August 6, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 8, 2004.

The Change of Correspondence Address has been accepted and recorded.

The petition satisfies the requirement of 37 CFR 1.137 (b) in that petitioner has supplied (1) the reply in the form of an Amendment; (2) the petition fee of $1500; and (3) the required statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 2100, Art Unit 2182 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

**Thomas M. Isaacson**
**AT & T Corporation**
**P.O. Box 4110**
**Middletown, NJ 07748**

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MAY 2 3 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Paul Glor HOWARD | : | |
| Application No. 10/086,102 | : | DECISION GRANTING PETITION |
| Filed: February 28, 2002 | : | UNDER 37 CFR 1.137(f) |
| Attorney Docket No. 2001-0370 | : | |

This is a decision on the petition, filed May 14, 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 February 21, 2003. 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 Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of August 28, 2003 was mailed on May 23, 2003.

Any inquiries concerning this decision may be directed to B. Dayoan at (703) 308-3865 or, in her absence, to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2621 for examination in due course.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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AUG 30 2004

| | | |
|---|---|---|
| In re Application of | : | |
| Ronald W. Reynolds | : | |
| Serial No. 10/086,153 | : | DECISION ON PETITION |
| Filed: February 26, 2002 | : | TO MAKE SPECIAL |
| For: LOW-MASS ROLLER OR PULLEY | : | |

Applicant's petition, filed January 2, 2003, seeks to have this application made special based upon the Energy Conservation Program.

The petition is GRANTED.

The petition has been reviewed and is found to be in compliance with the requirements for special status as set forth in Section 708.02(VI) of the Manual of Patent Examining Procedure (MPEP).

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Howison and Arnott, LLP
P.O. Box 741715
Dallas, TX 75374-1715

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COMMISSIONER FOR PATENTS
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John S. Pratt, Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street
Atlanta, GA 30309

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OFFICE OF PETITIONS

In re Application of :
Todd Hembrough, et al. :
Application No. 10/086,176 :
Filed: February 28, 2002 :
Attorney Docket No. 05213-0296 (43170-266780) :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 20, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being forwarded to Technology Center 1600.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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PO BOX 1022
MINNEAPOLIS MN 55440-1022

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,460,863 | : | |
| Ryan S. Steelberg | : | DECISION ON |
| Issue Date: December 2, 2008 | : | REQUEST FOR RECONSIDERATION |
| Application No. 10/086,193 | : | OF |
| Filed: February 27, 2002 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 16113-1177001 / GP-883-22 | : | |

This is a decision on the "**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(d)**," filed February 2, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from twenty-seven hundred (27) days to five hundred (500) days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On December 2, 2008, the above-identified application matured into U.S. Patent No. 7,460,863 with a patent term adjustment of 27 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 1.705(d).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees request recalculation of the patent term adjustment based on the decision in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to *Wyeth*, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentees request recalculation of the patent term adjustment to include a 473 day period of adjustment pursuant to 37 C.F.R. §1.703(b). Patentees maintain entitlement to a period of

adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 473 days and the period of adjustment due to other examination delay, pursuant to 37 CFR §1.702(a), of 501 days. Patentees argue that only one day, June 9, 2005 overlaps.

The 474 day period is calculated based on the application having been filed under 35 U.S.C. §111(a) on February 27, 2002, and a request for continued examination (RCE) having been filed in this application on June 16, 2006, three years and 474 days later. Patentees assert that in addition to this 474 day period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), totalling 501 days. This 501 day period is the sum of:

- a period of delay of 500 days for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), pursuant to § 1.702(a)(1);
- a period of delay of 1 day for the failure by the Office to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed, pursuant to § 1.702(a)(2);

Under 37 CFR § 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR §1.702 reduced by the period of time equal to the period of time during which applicants failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR §1.704. In other words, the period of Office delay reduced by the period of applicant delay. The period of reduction of 474 days for applicant delay is not in dispute.

Patentees do not dispute that the total period of Office delay is the sum of the period of Three Years Delay (474 days) and the period of Examination Delay (501 days) to the extent that these periods of delay are not overlapping.

Patentees contend that 1 day for the failure by the Office to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed, pursuant to § 1.702(a)(2) (June 9, 2005) overlaps with a portion of the Three Year delay period (February 28, 2005 to June 16, 2006).

Thus, according to patentees the total period of overlap is 1 days.

Patentees submit that the total period of Office Delay is 974 days, which is the sum of the period of Three Year Delay (474 days) and the period of Examination Delay (501 days), reduced by the period of overlap (1 day).

As such, patentees assert entitlement to a patent term adjustment of 500 days (474 + 501 reduced by 1 overlap - 474 (applicant delay)).

The Office agrees that as of the filing of the RCE on June 16, 2006, the application was pending 3 years and 474 days after its filing date. The Office agrees that the actions detailed above were not taken within the specified time frames, and thus, the entry of a period of adjustment of 501 days is correct. At issue is whether patentees should accrue 473 days (adjusted for overlap, per patentees' definition of overlap) of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as, 501 days for Office failure to take certain actions within specified time frames (or examination delay).

The Office contends that 474 days overlap. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.*

*154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency

provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3 year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

> Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154](b)(1) are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718[1]

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application.

---

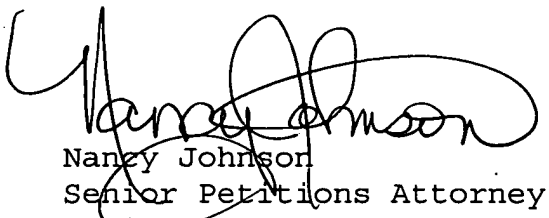
[1] The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period from the filing date of the application, February 27, 2002, to the filing date of the RCE, June 16, 2006. 501 days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within specified time frames during the pendency of the application. All of the 474 days for Office delay in issuing the patent overlap with the 501 days of examination delay. During that time, the issuance of the patent was delayed by 501 days, not 501 + 473 days. The Office took 14 months and 500 days to issue a first Office action and took 1 day over 4 months to respond to a reply under 35 U.S.C. 132. Otherwise, the Office took all actions set forth in 37 C.F.R. § 1.702(a) within the prescribed timeframes. Nonetheless, given the initial 501 days of Office delay and the 474 days of applicant delay and the time allowed within the time frames for processing and examination, as of the filing date of the RCE, the application was pending three years and 474 days. Accordingly, 501 days of patent term adjustment was properly entered since the period of delay of 474 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 501 days attributable to grounds specified in § 1.702(a)(1) and § 1.702(a)(2). Entry of both periods is not warranted. 501 days is determined to be the actual number of days that the issuance of the patent was delayed, considering the 474 days over three years to the filing of the RCE.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

In view thereof, no adjustment to the patent term will be made.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 7

Samuel H. Dworetsky
AT&T Corp.
PO Box 4110
Middletown, NJ 07748-4110

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FEB 17 2004
OFFICE OF PETITIONS

In re Application of :
Frederick M. Burg :
Application No. 10/086,205 : ON PETITION
Filed: October 25, 2001 :
Attorney Docket No. 003493.00186 :

This is a decision on the petition under 37 CFR 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 in reply to the non-final Office action mailed May 2, 2003, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on August 3, 2003.

The statement of unintentional delay was not signed by a person who would have been in a position of knowing that the delay in filing a timely response was unintentional. 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 in fact unintentional, petitioner should make a reasonable inquiry to ascertain that, in fact, the delay was unintentional.

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 Brian F. Hanlon appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If Brian F. Hanlon 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.

This application is being forwarded to Technology Center AU 2643 for further processing.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Banner & Witcoff, Ltd.
1001 G. Street, N.W., 11th Floor
Washington, DC 20001

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HOWSON AND HOWSON
ONE SPRING HOUSE CORPORATION CENTER
BOX 457
321 NORRISTOWN ROAD
SPRING HOUSE, PA 19477

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APR 27 2004

OFFICE OF PETITIONS

In re Application of :
Gideon Goldstein :
Application No. 10/086,208 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. GGP2CUSA

This is a decision on the petition, filed April 19, 2004, which is being treated as a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on March 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 (703) 306-5684.

The file will be forwarded to Technology Center AU 1648 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: ACommissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above.≅ Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVE., NW
WASHINGTON, DC 20036

Mail Date: 05/04/2010

| | | |
|---|---|---|
| **Applicant** | : Gregory R. Mundy | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7618630 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/086,217 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/21/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **210** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831

Paper No.

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JUN 17 2003

OFFICE OF PETITIONS

In re Application of
Li, et al.
Application No. 10/086,222
Filed: February 27, 2002
Atty. Dkt. No.: 15275/9450 (Li 2)
For: HIGH PERFORMANCE SINGLE MODE WAVEGUIDE

: DECISION GRANTING
: PETITION UNDER 37 CFR
: 1.47(a)

This is in response to the petition under 37 CFR 1.47(b), filed April 8, 2003. This petition is being treated under 37 CFR 1.47(a) as petitioner has established the availability of at least one inventor named in the application.

The petition is **GRANTED**.

Petitioner has shown that inventor Yanming Liu has refused to join in the filing of the above-identified application after having been presented with the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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Paper No. 6

Kenneth E. Johnson
8301- 11th Ave S
Bloomington MN 55420

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**JAN 13 2004**

**OFFICE OF PETITIONS**

In re Application of :
KENNETH E. JOHNSON :
Application No. 10/086,224 : ON PETITION
Filed: February 23, 2002 :
Title: PORTABLE BOW PRESS FOR COMPOUND BOWS WITH EITHER TWO PIECE LIMBS OR ONE PIECE LIMBS :

This is a decision on the petition to revive under 37 CFR 1.137(a), filed December 18, 2003.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely file a reply in response to the Notice to File Missing Parts of Nonprovisional Application mailed March 20, 2002, which set a shortened statutory period for reply of two (2) months. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on May 21, 2002. A Notice of Abandonment was mailed on December 4, 2003.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The present petition lacks items (3) and (1).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally

used and observed by prudent and careful men in relation to their most important business."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

In the present petition, petitioner asserts that the delay was caused by nonreceipt of the Notice to File Missing Parts of Nonprovisional Application of March 20, 2002. A review of the written record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity there is a strong presumption that the Notice was properly mailed to the petitioner at the address of record as of March 20, 2002. This presumption may be overcome by a verified showing that the Notice was not in fact received.

With regards to item (3), petitioner has not met the showing required to establish nonreceipt of an Office action. To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the **docket record** where the nonreceived Office action would have been entered had it been received and docketed.[3] A proper docket report consists of a "docket record **where the nonreceived Office action would have been entered had it been received and docketed.**"[4] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing **all** replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[5]

However, as petitioner is a pro-se applicant, the Office understands that petitioner may not keep a formal docket record system for his correspondence. In that case, petitioner must explain his system for keeping track of patent matters - where he keeps the correspondence; where he writes down due dates; how he knows replies are due, etc. In essence, petitioner must explain how he reminds himself of response due dates and show that the due date for the Notice of March 20, 2002, was not entered into

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[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[3] See MPEP 711.03(c)(II).

[4] MPEP 711.03(c)(II) (emphasis added).

[5] Id.

that system. The Office would like to see documentary evidence and records as may exist which would substantiate that petitioner exercised due diligence with respect to his most important business.

With regards to item (1), unfortunately, the declaration form supplied to petitioner did not include spaces for the inventor's residence, mailing address, and country of citizenship, which is required for compliance with 37 CFR 1.63. The Office apologizes for any confusion. The correct declaration form (PTO/SB/01) accompanies the present petition. Petitioner must submit this completed declaration form with any renewed petition.

Alternative Venue:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of **unintentional** delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m), currently $665 for a small entity; and (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. A blank copy of the form for a petition under 37 CFR 1.137(b) is enclosed for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enc: PTO/SB/01 (2 pages)
PTO/SB/64 (2 pages)

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Paper No. 9

KENNETH E. JOHNSON
8301- 11TH AVE S
BLOOMINGTON MN 55420

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**MAR 2 6 2004**

**OFFICE OF PETITIONS**

In re Application of :
Kenneth E. Johnson :
Application No. 10/086,224 :
Filed: 23 February, 2002 :
For: PORTABLE BOW PRESS FOR COMPOUND BOWS WITH EITHER TWO PIECE LIMBS OR ONE PIECE LIMBS :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 15 March, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 21 May, 2002, for failure to timely file a substitute specification as required by the Notice to File Missing Parts of Nonprovisional Application mailed on 30 March, 2002, which set a two (2) month shortened period for reply. Notice of Abandonment was mailed on 4 December, 2003. The petition under 37 CFR 1.137(a) filed on 18 December, 2003, was dismissed on 13 January, 2004.

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[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Receipt of the declaration, substitute specification, and late-filing surcharge filed on 18 December, 2003, is acknowledged. Receipt of the declaration filed with the present petition is also acknowledged.

The application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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KENNETH E. JOHNSON
8301- 11TH AVE S
BLOOMINGTON, MN 55420

COPY MAILED

JAN 27 2006

OFFICE OF PETITIONS

In re Application of :
Kenneth E. Johnson :
Application No. 10/086,224 : ON PETITION
Filed: February 23, 2002 :
Attorney Docket No. None :

This is a decision in response to the petition under 37 CFR 1.137(b), filed December 13, 2005, to revive the above-identified application.

The petition is dismissed because it lacks the required petition fee pursuant to 37 CFR 1.17(m).

Effective December 8, 2004, the small entity fee for a petition to revive an unintentionally abandoned application was increased to $750. Petitioner submitted a partial petition fee payment $700. There is no authorization found in the papers filed December 13, 2005 to charge any fee deficiency. Since any fee paid on or after December 8, 2004, must be paid at the revised amount, petitioner must now submit the petition fee deficiency of $50.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include the $50 petition fee deficiency and a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop PETITION
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300**.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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KENNETH E. JOHNSON
8301 – 11TH AVE S
BLOOMINGTON, MN 55420

COPY MAILED

JUL 05 2006

OFFICE OF PETITIONS

In re Application of
Kenneth E. Johnson
Application No. ~~10/086,227~~ 10/086224
Filed: February 23, 2002
Attorney Docket No. None

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b) to revive the above-identified application, filed March 20, 2006.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before October 13, 2005. A Notice of Abandonment was mailed on May 26, 2006.

The petition as supplemented satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the requisite issue/publication fee; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Publications to be processed into a patent.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (571) 272-4200.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

KENNETH E. JOHNSON
8301 – 11TH AVE S
BLOOMINGTON, MN 55420

COPY MAILED

JUL 05 2006

OFFICE OF PETITIONS

In re Application of
Kenneth E. Johnson
Application No. 10/086,224
Filed: February 23, 2002
Attorney Docket No. None

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b) to revive the above-identified application, filed March 20, 2006.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before October 13, 2005. A Notice of Abandonment was mailed on May 26, 2006.

The petition as supplemented satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the requisite issue/publication fee; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Publications to be processed into a patent.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (571) 272-4200.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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JAN 29 2004

MAILED

JAN 29 2004

OFFICE OF THE DIRECTOR
TC 3600

GREENBERG TRAURIG, P.C.
77 WEST WACKER DRIVE
CHICAGO, IL 60601-1732

Paper No. 11

In re Application of :
Joerg Wurft :
Application No. 10/086,229 :
Filed: February 27, 2002 :
For: WHEEL FOR A MOTOR VEHICLE MADE FROM A MAGNESIUM-CONTAINING ALLOY

**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 October 27, 2003.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on July 28, 2003 and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

cps/1/22/04

KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

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. |
|---|---|---|---|---|
| 10/086,253 | 03/01/2002 | Barbara A. Rincavage | RINCAVAGE-1 | 4031 |

25101 7590 07/15/2010

Philip D. Freedman PC
1449 Drake Lane
Lancaster, PA 17601

| EXAMINER | |
|---|---|
| RINES, ROBERT D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3623 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/15/2010 | 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.

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUL 15 2010

Philip D. Freedman
1449 Drake Lane
Lancaster, PA 17601

In re Application of:
Barbara A. RINCAVAGE et al.
Application No. 10/086,253
Filed: March 01, 2002
For: SYSTEM AND METHOD FOR FILING MEDICAL PRESCRIPTIONS

**DECISION ON PETITION UNDER 37 CFR 1.181**

This is in response to applicants' petition under 37 CFR 1.181 filed May 11, 2010 requesting withdrawal of the finality of the Office action mailed April 26, 2010.

The petition is **DENIED.**

Applicants allege that the final Office action mailed April 26, 2010 is improper because (1) the examiner failed to address certain limitations of applicants' claims, particularly the feature of "brand and dosage discretion" and (2) the examiner further did not respond to applicants' arguments traversing the examiner's rejections of these claim limitations.

MPEP 707.07(f) sets forth that in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. Where the requirements are traversed, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Further, 37 CFR § 1.104 sets forth the nature of examination and specifically states that (b) the examiner's action will be complete as to all matters and that (c)(2) in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

A review of the record reveals that applicant filed a RCE on October 30, 2009 after a decision by the Board of Patent Appeals and Interferences (hereinafter the Board) on September 3, 2009 affirming the examiner's rejection. In response to the RCE, the examiner issued a non-final Office action on December 16, 2009 rejecting claims 21-22, 27-32 and 37-40 over Denny in

view of Borsand et al., and claims 23-26 and 33-36 over Denny, Borsand et al. and Keresman. Applicant filed a response on January 13, 2010 arguing that the new "brand and dosage discretion" claim limitations have not been addressed. The examiner issued a final Office action on April 26, 2010 maintaining the same rejections for all claims and their limitations. 37 CFR § 1.104 sets forth that, in rejecting claims, the examiner must cite the best references at his or her command and that when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. In the final Office action, the examiner cited the particular paragraphs of the prior art relied upon for each claim limitation, specifically detailing on pages 6 and 7 the particular paragraphs relied upon to disclose the "brand and dosage discretion" claim limitations (as referencing on page 2, paragraph 4, of applicants' petition) and providing rationale for such a combination on pages 7 and 8 of the action. These rejections were previously presented on pages 7 and 8 in the non-final office action of December 16, 2009 and maintained, as applicants did not amend the claims in the response filed January 13, 2010. Thus, the examiner has provided a complete office action and has addressed all limitations of applicants' claims, namely the "brand and dosage discretion" claim limitations.

Applicant contends that examiner's response is incomplete or inadequate; however, the record shows that the examiner has made a good faith effort to respond to applicant's arguments traversing the prior art rejections of the "brand and dosage discretion" claim limitations in the final Office action dated April 26, 2010. MPEP 707.07(f) sets forth that in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application and that where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it.

On page 4 of the final Office action, the examiner responds to applicants' arguments and clarifies the prosecution history. The examiner's final Office action was in response to communications filed by applicant January 13, 2010, in which no amendments to the claims were made and applicant reiterated his argument from previous communications filed October 30, 2009 that the prior art does not teach the "brand and dosage discretion". The examiner responded to this argument by reasserting the response to argument set forth in the non-final Office action dated December 16, 2009, as well as the decision by the Board dated September 3, 2009. On pages 13-14 of the non-final Office action, the examiner specifically notes and answers applicant's argument regarding the "brand and dosage discretion" claim limitations. Further, the referenced proceedings before the Board addressed substantially similar issues. Examiner's prior art rejections of previously presented claims 1-20 were affirmed, these claims encompassing substantially similar claim concepts, including the claim limitations "entering filled prescription data into said database" and "differences between said filled prescription data and said unfilled prescription data", and rejected using the same prior art references relied upon in the non-final and the final office actions. Thus, the examiner has clearly and sufficiently responded to applicants' arguments traversing the examiner's rejections.

In light of 37 CFR 706.07(a) which states that "under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of

rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)", the finality of the Office action mailed on April 26, 2010 was proper due to the fact that the examiner maintained the same rejections on un-amended claims.

Furthermore, where differences of opinion concern the denial of patent claims because of prior art, and the questions thereby raised relate to the merits, then the appeal process has long been provided by statute. The MPEP clearly states under 37 CFR 1.191(a) that an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection. Thus, the application of the references to support the rejection of the claims by the examiner in this application is a matter appealable to the Board.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Beth Boswell at (571) 272-6737.

Wynn W. Coggins, Director
Patent Technology Center 3600
(571) 272 - 5350

bvb: 07/07/10
LM

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

WEISS & MOY PC
4204 North Brown Avenue
Scottsdale, AZ 85251

MAILED

JUN 2 3 2003

Technology Center 2100

In re Application of:
Scott C. NANCE
Application No. 10/086,263
Filed: March 4, 2002
For: METHOD AND SYSTEM FOR LOCATING CELLULAR PHONE NUMBERS

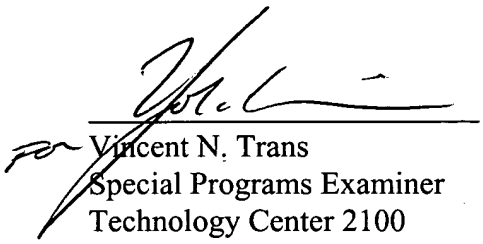
**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed May 20, 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.



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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

WEISS & MOY & HARRIS, P.C.
4204 North Brown Avenue
Scottsdale, AZ 85251

MAILED

JUL 1 7 2003

Technology Center 2100

In re Application of: Scott C. NANCE )
Application No. 10/086,263 )
Filed: March 4, 2002 ) **DECISION ON REQUEST FOR**
For: METHOD AND SYSTEM FOR ) **WITHDRAWAL AS ATTORNEY**
LOCATING CELLULAR PHONE )
NUMBERS )

This is a decision on the Request To Withdraw from Representation filed July 9, 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: Scott C. Nance
10248 Slendor Ridge Avenue
Las Vegas, Nevada 89135

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**SCOTT NANCE**
**1350 N TOWNCENTER #1038**
**LAS VEGAS, NV 89144**

COPY MAILED

OCT 16 2006

OFFICE OF PETITIONS

In re Application of :
Scott C. Nance :
Application No. 10/086,263 : DECISION ON PETITION
Filed: March 4, 2002 :
FOR: METHOD AND SYSTEM FOR :
LOCATING CELLULAR PHONE NUMBERS

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 6, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed May 27, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 30, 2005 (August 28, 2005, the due date, was a Sunday).

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 and fee of $250, (2) the petition fee of $750, and (3) an adequate statement of unintentional delay. Accordingly, the reply to the final Office action of May 27, 2005 is accepted as having been unintentionally delayed.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

This application is being referred to Technology Center AU 2161 for appropriate action by the Examiner in the normal course of business on the Appeal Brief received on March 31, 2006.

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Veronica-Adele R. Cao
Weiss, Moy & Harris, P.C.
4204 N. Brown Avenue
Scottsdale, AZ 85251

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

WAGNER, MARABOUT & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

COPY MAILED

NOV 0 1 2002

OFFICE OF PETITIONS

In re Application of :
Kammer, et al. :
Application No. 10/086,313 : DECISION GRANTING STATUS
Filed: February 28, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No.: PALM-3749.US.P :
For: METHOD FOR INTELLIGENTLY :
SELECTING A BLUETOOTH ACCESS POINT :

This is in response to the petition under 37 CFR 1.47(a), filed October 15, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Jeffrey Loucks has refused to join in the filing of the above-identified application after having been presented with the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

The required petition fee has been charged to Deposit Account No. 23-0085 as authorized in the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

JUL - 5 2005

The Law Offices of James J. Ralabate
5792 Main Street
Williamsville, NY 14221

In re application of
Edward P. Maddox JR., et al.
Application No. 11/086,394
Filed: March 22, 2005
For: MAINTENANCE AND INSPECTION SYSTEM

**DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY**

This is a decision on the request filed on May 19, 2005, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with Items A) and B).

As to Item A), the attorneys listed in the request do not correspond with those named in the Power of Attorney in the declaration, thereby creating confusion as to who is withdrawing. Therefore, some attorneys originally appointed would still be of record if the request were approved. It does not appear that that is the intent of the request. To alleviate this problem, it is suggested that the request be resubmitted and that such request specifically state that the signing attorney is signing on behalf of all attorneys of record in this application.

As to Item B), while a reason may be provided by referencing a specific portion of 37 CFR 10.40, the reason must deal with actions by the client. In this case, there is nothing in the file record that indicates the existence of an assignee or that the assignee is the client. Absent a 3.73(b) statement, the "client" referred to in 37 CFR 10.40 is seen as being those individuals who conferred power upon the attorneys, in this case the inventors.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6611

SNM/pav: 06/30/05

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OFFICE OF PETITIONS

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

In re Application of :
Philippe and Benard :
Application No. 10/086,451 : ON PETITION
Filed: march 4, 2002 :
Attorney Docket No. 05725.1033.00 :

This is in response to the petition under 37 CFR 1.182, filed June 20, 2005, to withdraw a terminal disclaimer filed October 4, 2004.

The petition is granted.

Examiner Konata has determined that the terminal disclaimer filed October 4, 2004, can be withdrawn. The terminal disclaimer is withdrawn, accordingly.

Petitioner is advised that the fee for petition under 37 CFR 1.182 is authorized under 37 CFR 1.17(f). The fee for the instant petition is, therefore, $400.00. Deposit account 06-0916 will be charged an additional $270.00, accordingly.

The application file is being directed to Technology Center 1600, GAU 1616 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

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Mailed: APR 18 2005

dss
Paper Number _____

In re application of :
Kung-Shen Lo : DECISION ON
Serial No.10/086,460 : PETITION
Filed: February 28, 2003 :
For: METHOD OF MAKING STUFFED TOFU AND
THE DEVICE THEREOF :

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT PURSUANT TO 37 C.F.R. § 1.181(a) filed September 17, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of September 08, 2004, be withdrawn since the applicant did timely file a response on July 13, 2004.( A copy of applicant's response, PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) is attached thereto).

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response, PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a), were properly filed on July 13, 2004, in view of the fact that the originally filed papers having a Patent and Trademark Office date stamp July 13, 2004, thereon have been located in the USPTO application file(It is noted that the associated fees have been charged on July 19, 2004). However, such is not a proper response to the FINAL rejection of March 02, 2004; see 37 C.F.R. 1.113(a) for what constitutes a proper reply. The application is still held abandoned.

The Petition is DISMISSED.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Keith Kline
Pro-Techtor International
20775 Norada Court
Saratoga CA 95070-3018

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 8

**JOHN P. WHITE**
**COOPER & DUNHAM LLP**
**1185 AVENUE OF THE AMERICAS**
**NEW YORK, NY 10036**

COPY MAILED

MAR 1 8 2004

OFFICE OF PETITIONS

In re Application of
Schon, Eric A.
Application No. 10/086,489
Filed: February 28, 2002
Attorney Docket No. 44012-AB

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 8, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to Comply with Requirements for Patent Application Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Notice) mailed April 17, 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 June 18, 2002. A Notice of Abandonment was mailed on February 6, 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

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Paper No. 8

BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES CA 90025

COPY MAILED

JUN 16 2003

OFFICE OF PETITIONS

In re Application of :
McMorris, et al. :
Application No. 10/086,490 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 003399.P088 :

This is a decision on the petition to revive under 37 CFR 1.137(f), filed May 15, 2003, which is being treated as a petition under 37 CFR 1.137(b).

The petition is **DISMISSED AS MOOT**.

The above-identified application was filed on February 28, 2002 with a nonpublication request and certification under 35 U.S.C. 122(b)(2)(B)(I). On November 20, 2002, applicant filed a Request to Rescind Previous Nonpublication Request.

With the instant petition, applicant states that the application was foreign filed on December 20, 2002.

As the Request to Rescind Previous Nonpublication Request was filed before the foreign filing, the application will be treated as if the nonpublication request was never made.[1]

As requested, the Request and Certification Under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. A corrected filing receipt indicating a projected publication date of August 28, 2003 accompanies this decision.

The petition fee of $1,300 has been refunded to Deposit Account No. 02-2666.

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[1] See "Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv)", available at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/35usc122b2binterpret.htm.

The application file is being forwarded to Technology Center 2100 for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: corrected filing receipt (2 pages)

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APR 14 2004

Paper No. 10

In re Application of
Louis J. Panaccione
Application No. 10/086,509
Filed: February 28, 2002
Attorney Docket No. PURP01/0010

: DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on March 24, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a timely reply to the Office action dated June 16, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed..

Petitioner alleges that a reply to the Office letter in question was in fact filed by facsimile transmission on September 25, 2003. Petitioner alleges that this reply was both a *bona fide* reply and a timely reply because petitioner had authorized a charge of the $55.00 fee for a one month extension of time against counsel's credit card, but due to "a clerical error in completing the fee transmittal, the one-month extension of time fee was not charged."

Petitioner supports these allegations by furnishing a copy of the amendment as filed by facsimile transmission, a copy of a fee transmittal letter indicating that there was a fee due of $55.00 for the extension of time, and a declaration of counsel. In the declaration, counsel states:

> "Following receipt of the Notice of Abandonment, I was notified that due to a clerical error in completing the fee transmittal, the additional $55.00 fee for the one-month extension of time due for the response was not charged to my credit card. A new fee transmittal and Form PTO-2038 is enclosed herewith."

The record shows that a reply to the Office letter in question was in fact received in the on September 26, 2003, with a 37 CFR 1.8(a) certificate of transmission dated September 25, 2003. The reply consisted of twenty (20) pages. Nineteen (19) of those pages are present in the application file; presumably the twentieth page was the form PTO-2038 that authorized a charge against counsel's credit card for the claim fee surcharge of $54.00. Included in the reply of record in the file is a fee transmittal sheet which shows only that a $54.00 fee for six additional claims was due, and Office financial records show that the $54.00 claim surcharge fee was in fact charged against counsel's credit card.
The record also shows that a letter was mailed on November 17, 2003, more than two months prior to the mailing of the Notice of Abandonment. That letter informed petitioner of the fact that no extension of time had been obtained with respect to the reply filed on September 26, 2003.

In light of the state of the record, the allegations discussed above and the evidence presented in support of those allegations is not clear on a critical point. What was the nature of the clerical error regarding the one month extension of time fee? Is petitioner alleging that the error was on the part of the Office, or was the error a failure to transmit authorization to charge the extension fee? Is it alleged that two separate fee transmittal sheets were transmitted, one dealing solely with the claim surcharge fees and one dealing solely with the extension fee? Were two PTO-2038 forms transmitted, one for each fee? When counsel states that "a new" fee transmittal and Form PTO-2038 are enclosed with the petition, does "new" mean "newly prepared" or does it mean a "new copy" of papers that were in fact originally transmitted with the reply filed on September 26, 2003? When counsel states that he was informed **following receipt of the Notice of Abandonment** that the $55.00 extension fee was not charged, is counsel implying that the November 17, 2003 Office letter was not received? If that letter was received, what action did counsel take with respect thereto?

Petitioner is invited to file a renewed petition, without fee. In the renewed petition, the questions presented above should be addressed. Petitioner should furnish a copy of all PTO-2038 form(s) that were filed with respect to the reply filed on September 26, 2003. The renewed petition should be addressed to the undersigned and must be filed within two months of the date of this decision. See 37 CFR 1.181(f).

The application is being retained in Technology Center 3700 pending receipt of the renewed petition.

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

Timothy J. Shea II, Esq.
200 Linden Street
Wellesley, MA 02482

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET,
SUITE 4000
CHARLOTTE, NC 28280-4000

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OFFICE OF PETITIONS

In re Application of

Louis Panaccione :

Application No. 10/086,509

: DECISION ON PETITION

Filed: February 28, 2002

:

Attorney Docket No. PURP01/0010

This is a decision on the petition under 37 CFR 1.137(b), filed, December 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 16, 2003, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on September 17, 2003. A Notice of Abandonment was mailed January 23, 2004.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply form the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office.

Deposit account 16-0605 will be charged $750.00 for the instant petition fee.

The amendment filed December 22, 2006, is noted.

The communication regarding revocation of power of attorney, filed December 22, 2006, is noted and made of record.

The application is being forwarded to Technology Center 3700, GAU 3728 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure:
"Notice of Acceptance of Power of Attorney"
"Notice Regarding Change of Power of Attorney"

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/086,509 | 02/28/2002 | Louis J. Panaccione | PURP01/0010 |

**CONFIRMATION NO. 2163**

*OC000000022308193*

Timothy J. Shea II, Esq.
Suite H-322
200 Linden Street
Wellesley, MA 02482

Date Mailed: 02/02/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/22/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

KENYA A THORNTON MCLAUGHL
OP (571) 272-3222

NEW ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/086,509 | 02/28/2002 | Louis J. Panaccione | PURP01/0010 |

**CONFIRMATION NO. 2163**

*OC000000022308205*

826
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date Mailed: 02/02/2007

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/22/2006.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

KENYA A THORNTON MCLAUGHL
OP (571) 272-3222

ATTORNEY/APPLICANT COPY

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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/086,509 | 02/28/2002 | Louis J. Panaccione | PURP01/0010 |

**CONFIRMATION NO. 2163**

*OC000000022308193*

Timothy J. Shea II, Esq.
Suite H-322
200 Linden Street
Wellesley, MA 02482

Date Mailed: 02/02/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/22/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

KENYA A THORNTON MCLAUGHL
OP (571) 272-3222

FORMER ATTORNEY/AGENT COPY

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COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 7

BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

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FEB 0 4 2004

Technology Center 2100

| | | |
|---|---|---|
| In re Application of: Robert S. BLOCK, et al. | ) | |
| Application No. 10/086,522 | ) | DECISION ON PETITION TO |
| Filed: March 4, 2002 | ) | MAKE SPECIAL UNDER 37 |
| For: METHOD FOR ADDING | ) | C.F.R. §1.102(c) AND MPEP § |
| METADATA TO DATA | ) | 708.02 (IV): APPLICANT'S AGE |

This is a decision on the petition, filed January 12, 2004, under 37 C.F.R. §1.102(c) and M.P.E.P. §708.02(IV): Applicant's Age, to make the above-identified application special.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section IV must include a showing, as by a birth certificate or the applicant's statement, that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a statement from applicant Robert S. Block, asserting that applicant is more than sixty five (65) years of age. Accordingly, the petition is **GRANTED.**

The application is being forwarded to the examiner for expedited prosecution.

For Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

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OFFICE OF PETITIONS

AT&T CORP
ROOM 2A207
ONE AT&T WAY
BEDMINSTER NJ 07921

In re Application of :
Matthew J. Sherman :
Application No. 10/086,534 : ON PETITION
Filed: March 4, 2002 :
Attorney Docket No. 2685/5866 :

This is a decision on the petition to revive under 37 CFR 1.137(a), filed October 17, 2008.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to file a reply to the non-final Office action mailed September 27, 2007. This Office action set a shortened statutory period for reply of three (3) months. No reply having been received, the application became abandoned on December 28, 2007. The Office mailed a Notice of Abandonment on June 5, 2008.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The instant petition lacks item (2).

The petition fee required for a petition to revive is required for the filing, not merely the grant, of the petition.[1] Accordingly, before the petition can even be considered on the merits, applicant must submit the petition fee in full, currently $540 for a small entity. The Office only received $510. No authorization to charge any additional fees to a deposit account was found. Effective October 2, 2008, the fee for a petition to revive under 37 CFR 1.137(a) was increased to $540. Accordingly, on request for reconsideration, petitioner must submit the $30 due for the petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

[1] See MPEP 711.03(c)(II)(B).

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ROOM 2A207
ONE AT&T WAY
BEDMINSTER NJ 07921

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JAN 21 2009

OFFICE OF PETITIONS

In re Application of :
Matthew J. Sherman :
Application No. 10/086,534 : ON PETITION
Filed: March 4, 2002 :
Attorney Docket No. 2685/5866 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(a), filed December 23, 2008.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to file a reply to the non-final Office action mailed September 27, 2007. This Office action set a shortened statutory period for reply of three (3) months. No reply having been received, the application became abandoned on December 28, 2007. The Office mailed a Notice of Abandonment on June 5, 2008. Applicant filed a petition to revive under 37 CFR 1.137(a) on October 17, 2008. However, the petition was dismissed in a decision mailed on November 10, 2008. The petition was dismissed because the $510 check submitted was not sufficient to cover the $540 petition fee.

On renewed petition, petitioner has pointed out than an authorization was present to charge any deficiencies to his deposit account. As such, the $30 balance has now been charged to Deposit Account No. 50-0732, as authorized. The decision will now turn to a consideration of the petition on the merits.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The instant petition lacks item (1) and (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

With regards to item (3), petitioner states that he did not receive the September 27, 2007 non-final Office action. In support thereof, petitioner has included a statement from Beverly Britt, stating that no such communication was received. However, to establish non receipt of an office action, a practitioner must:

> state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the

---

[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

> equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required. A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the **master 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. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.[3]

Accordingly, on renewed petition, petitioner should submit a copy of a master docket report showing all replies docketed for a due date of December 27, 2007. If no such docket report exists, petitioner should so state for the record, and provide the other evidence as listed above.

With regards to item (1) above, petitioner has not submitted a response to the September 27, 2007 Office action. A copy of that Office action is enclosed for petitioner's convenience.

Alternative Venue and Other Matters:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to **37 CFR 1.137(b)** on the basis of **unintentional** delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); and (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

---

[3] MPEP 711.03(c)(II) (emphasis added).

By mail: Mail Stop Petitions
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P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: September 27, 2007 Office action (5 pages)

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/086,534 | 03/04/2002 | Matthew J. Sherman | 2685/5866 | 9575 |

26652 7590 09/27/2007

AT&T CORP.
ROOM 2A207
ONE AT&T WAY
BEDMINSTER, NJ 07921

| EXAMINER | |
|---|---|
| MEKY, MOUSTAFA M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2157 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/27/2007 | 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.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/086,534 | SHERMAN, MATTHEW J. | |
| | Examiner | Art Unit | |
| | Moustafa M. Meky | 2157 | |

-- *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 *21 June 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) *4-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-9* is/are rejected.

7)☐ Claim(s) _____ 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 *17 June 2002* 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: *Fig 1*.

1. The amendment filed 6/21/2007 has been received and entered by the examiner.

2. Claims 4-9 are presenting for examination.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 4-9 are rejected under 35 U.S.C. 102(e) as being anticipate by Young et al (US Pat. 6,990,116).

5. As to claims 4-9, Young shows in Fig 1, A method for spoofing stations while transmitting data through a medium in an arrangement including a first station sends a Request-to-Send (R-T) message to an Access Point (AP) that includes a duration field, and a second station sends a Clear-to-Send (CTS) message that is responsive to the RTS message that also includes a duration, where the duration field defines a period of time that the medium is to be reserved to allow unimpeded transmission of data that the first station has to transmit, and where each an obeying station in the arrangement that receives either the RTS message or the CTS message, updates a Network Allocation Vector (NAV) with the duration information obtained from the received RTS message, or from the received CTS message when a corresponding RTS message was not received, characterized by:
said NAV being .updated by said receptions from other stations, including said and other AP and other Aps, and said first station employing the NAV to inhibit transmission by said station as long as the NAV indicates that the medium is in use, and permitting resumption of transmission when the .NAV indicates other than that the medium is in use;
said first station setting a duration value for its RTS message to a value other than a time period for a predetermined subsequent message transmission. See col 7, lines 9-25.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Moustafa M. Meky whose telephone number is 571-272-4005. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. 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.

MMM
09/22/2007

MOUSTAFA MEKY
PRIMARY EXAMINER

*Fig. 1*

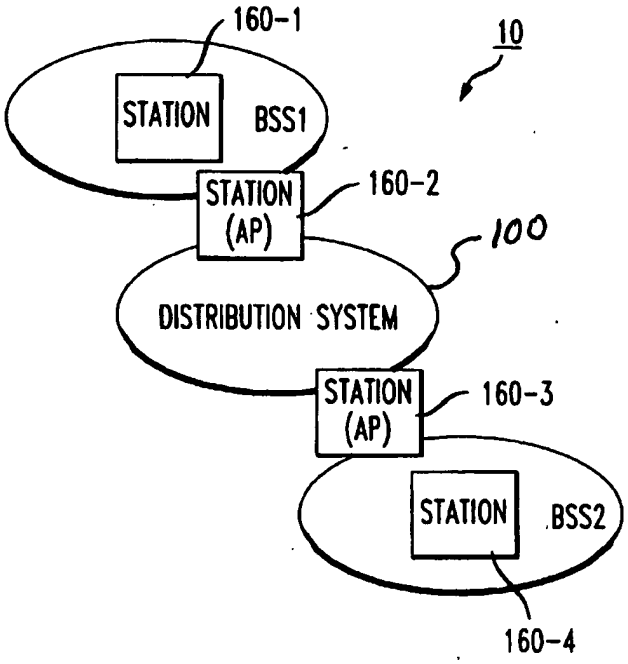
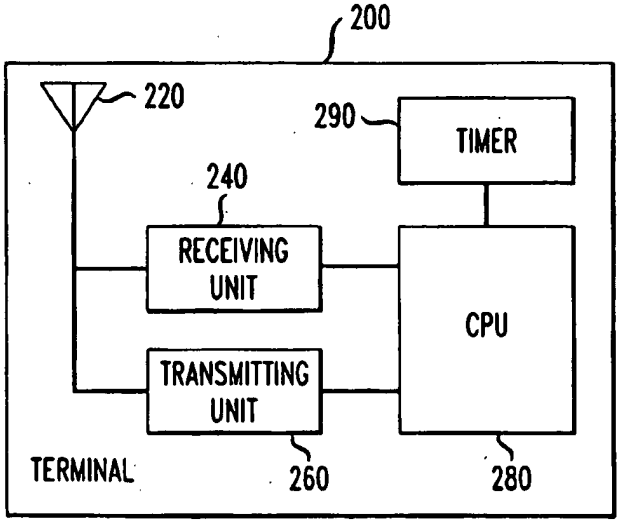

160-1
10
STATION
BSS1
STATION
(AP)
160-2
100
DISTRIBUTION SYSTEM
STATION
(AP)
160-3
STATION
BSS2
160-4

*Fig. 2*


200
220
290
TIMER
240
RECEIVING
UNIT
CPU
TRANSMITTING
UNIT
TERMINAL
260
280

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UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 7

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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NOV 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Myron H. Greenbaum :
Application No. 10/086,586 : DECISION GRANTING PETITION
Filed: March 1, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. ITT 3.0-008 :

This is a decision on the petition, filed October 27, 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 February 28, 2003. 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 February 12, 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 returned to Technology Center Art Unit 2636 for further prosecution.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination/Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 11

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP
50 S. MAIN STREET
AKRON OH 44308

COPY MAILED

JUL 3 1 2003

OFFICE OF PETITIONS

In re Application of
Don r. Stevenson, Thoms C. Jennings, Mark E. Harr, and Michael R. Jakupca

Application No. 10/086,619
Filed: March 1, 2002
Attorney Docket No. 47399.0015
Title: PHOSPHITE ESTER ADDITIVE COMPOSITIONS

DECISION ON RENEWED PETITION

## BACKGROUND

This is a decision on the renewed petition under 37 CFR §1.78(a)(6), filed on June 20, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

On March 1, 2002, the above-identified application was filed with a declaration which incorrectly identified the filing date of priority document 60/314,181 as August 15, 2001 (the correct filing date of 60/314,181 is August 16, 2001).

The original petition, filed on May 5, 2003, was dismissed for failing to include the required statement and either an Application Data Sheet (ADS) or amendment to the specification which identifies the provisional application number that was filed with the original petition.

## RELEVANT LAW AND RULE

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords

similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)

(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim.The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e)

(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term "WTO member country" has the same meaning as the term is defined in section 104(b)(2) of this title; and

(2) the term "UPOV Contracting Party" means a member of the International Convention for the Protection of New Varieties of Plants.

(Amended Oct. 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748; July 28, 1972, Public Law 92-358, sec. 1, 86 Stat. 501; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(1), 108 Stat. 4985.) (Subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec.4503(a)).) (Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564, 588, 589 (S. 1948 secs. 4503(b)(2), 4801 and 4802).) (Subsections (f) and (g) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4802).)

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a)

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

## ANALYSIS

With the renewed peition, petitioner has included an ADS sheet which identifies the provisional application numbers, made an amendment to the specification which does the same, and has submitted the proper statement of unintentional delay.

As such, the petition under 37 CFR 1.78(a)(6) is **GRANTED**.

After this petition is mailed, the application will be forwarded to the Office of Initial Patent Examination for further processing and mailing of a corrected filing receipt.

Telephone inquiries specific to this matter should be directed to Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 01/27/10

**TO SPE OF** : ART UNIT 2857

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10086633 Patent No.: 7222054

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:** _____

_____

_____

_____

_____

_____ _____

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 18 2004

STEPHEN B. MAEBIUS
FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

| | | |
|---|---|---|
| In re Application of | : | |
| Milton David Goldenberg | : | |
| Serial No.: 10/086,637 | : | WITHDRAWAL OF ATTORNEY |
| Filed: March 4, 2002 | : | |
| Attorney Docket No.: 018733-1094 | : | |

This is in response to applicants' attorneys' request, filed February 26, 2004, to withdraw from representation in the above identified application.

37 CFR 10.40 Withdrawal from employment.
(b) Mandatory withdrawal . A practitioner representing a client before the Office shall withdraw from employment if:
(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;
(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
(4) The practitioner is discharged by the client.
(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:
(1) The petitioner's client:
(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
(ii) Personally seeks to pursue an illegal course of conduct;
(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.
(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Applicants' attorney has provided no reason for withdrawal, as required.

The request to withdraw is **DISMISSED**.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at Office facsimile number.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JAN 20 2010

THORPE NORTH & WESTERN, LLP.
P.O. Box 1219
SANDY UT 84091-1219

In re Patent No. 6,876,094
Application No. 10/086,640
Filed: February 28, 2002
Attorney Docket No. **2865-T8719**

NOTICE UNDER 37 CFR. 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On December 08, 2008, the court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED.**

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Inquiries related to this communication should be directed to the Michelle R. Eason at (571) 272-4231.

For Thurman Page
Petitions Examiner
Office of Petitions

cc: **DAVID G. MIRANDA**
**870 WINTER STREET**
**WALTHAM, MA 02451-1449**

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www.uspto.gov

CLIFFORD CHANCE US LLP
31 WEST 52ND STREET
NEW YORK, NY 10019-6131

COPY MAILED
OCT 0 2 2006
OFFICE OF PETITIONS

In re Application of

Elliot Brenhouse :

Application No. 10/086,661

: DECISION ON PETITION

Filed: February 28, 2002

:

Attorney Docket No. 7190-201

This is a decision on the petition under 37 CFR 1.137(b), filed May 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 14, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. A response was filed on March 20, 2006, with a request for an extension of time within the third month. The response was not accompanied by replacement drawings, which were required by the non-final Office action, however. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on March 15, 2006. A Notice of Abandonment was mailed on March 24, 2006

The replacement drawings filed May 22, 2006, is noted.

The application is being forwarded to Technology Center 3600, GAU 3627 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

OIPE
MAR 1 6 2005
PATENT & TRADEMARK OFFICE

3626

PTO/SB/83 (09-04)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

JPW

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

| | |
|---|---|
| Application Number | 10/086,779 |
| Filing Date | 28 February 2002 |
| First Named Inventor | Tammy Luttrell |
| Art Unit | 3626 |
| Examiner Name | Natalie PASS |
| Attorney Docket Number | TAML-100A |

**To: Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

**Updated, and made effective as of date of the prior Request on 03 November 2004 to confirm that the instant Withdrawal as Attorney also includes Patent Attorney Jennifer Bales, Reg. No. 38,070 of the law firm Macheledt Bales et al. --Respectfully,

Please withdraw me as attorney or agent for the above identified patent application, and

☑ all the attorneys/agents of record. ** Declaration had also listed Jennifer Bales, Reg. No. 38,070

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☑ the attorneys/agents associated with Customer Number 28304

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

APPROVED
4/27/05

The reasons for this request are: Under § 10.40 (c) a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because: (1) The petitioner's client: (vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

## CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☑ Change the correspondence address and direct all future correspondence to:

☐ The address associated with Customer Number:

*OR*

| | | | | | |
|---|---|---|---|---|---|
| ☑ Firm or Individual Name | Ms. Tammy Luttrell | | | | |
| Address | P.O. Box 1342 | | | | |
| City | Wellington | State | Colorado | Zip | 80549 |
| Country | US | | | | |
| Telephone | | | Fax | | |

| | | | |
|---|---|---|---|
| Signature | Jennifer Bales | | |
| Name | Jennifer L. Bales | Registration No. | 38,070 |
| Date | 08 March 2005 and made effective on 03 November 2004 | Telephone No. | (303) 664-4734 |

*NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.*

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

NOV 0 8 2004
PATENT & TRADEMARK OFFICE

3626

PTO/SB/83 (09-04)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

| | |
|---|---|
| Application Number | 10/086,779 |
| Filing Date | 28 February 2002 |
| First Named Inventor | Tammy Luttrell |
| Art Unit | 3626 |
| Examiner Name | Natalie PASS |
| Attorney Docket Number | TAML-100A |

**To: Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

Please withdraw me as attorney or agent for the above identified patent application, and

☐ all the attorneys/agents of record.

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☑ the attorneys/agents associated with Customer Number 28304

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are: Under § 10.40 (c) a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because: (1) The petitioner's client: (vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

## CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☑ Change the correspondence address and direct all future correspondence to:

☐ The address associated with Customer Number:

***OR***

| | | | | | |
|---|---|---|---|---|---|
| ☑ Firm or Individual Name | Ms. Tammy Luttrell | | | | |
| Address | P.O. Box 1342 | | | | |
| City | Wellington | State | Colorado | Zip | 80549 |
| Country | US | | | | |
| Telephone | | | | Fax | |
| Signature | | | | | |
| Name | Jean M Macheledt | | | Registration No. | 33,956 |
| Date | 03 November 2004 | | | Telephone No. | (970) 218-6798 |

*NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.*

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

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JAN 0 4 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Outi Hiironniemi | : | |
| Application No. 10/086,780 | : | ON PETITION |
| Filed: February 28, 2002 | : | |
| Attorney Docket No. 059643.00741 | : | |

This is a decision on the petition to revive under 37 CFR 1.137(b), filed August 17, 2007.

The petition under 37 CFR 1.137(b) 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)." No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed November 16, 2006, which set a shortened statutory period for reply of three (3) months. No proper response having been received, the application became abandoned on February 17, 2007. A courtesy Notice of Abandonment was mailed on May 30, 2007.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition lacks item (2), the required reply. The amendment submitted with the petition does not place the application in condition for allowance.

On renewed petition, petitioner must submit a proper reply in response to the final Office action mailed November 16, 2006. The proposed reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law); (2) an amendment that *prima facie* places the application in condition for allowance; (3) the filing of a continuing application under 37 CFR 1.53(b) or if applicable, 1.53(d); or (4) a request for a continuing examination (RCE) under 37 CFR 1.114.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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TYSONS CORNER VA 22182

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MAR 3 1 2008

OFFICE OF PETITIONS

In re Application of :
Outi Hiironniemi :
Application No. 10/086,780 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 059643.00741 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed March 4, 2008.

The petition under 37 CFR 1.137(b) 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)." No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed November 16, 2006, which set a shortened statutory period for reply of three (3) months. No proper response having been received, the application became abandoned on February 17, 2007. A courtesy Notice of Abandonment was mailed on May 30, 2007.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition lacks item (2), the required reply. The amendment submitted with the petition does not *prima facie* place the application in condition for allowance.

On renewed petition, petitioner must submit a proper reply in response to the final Office action mailed November 16, 2006. The proposed reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law); (2) an amendment that *prima facie* places the application in condition for allowance; (3) the filing of a continuing application under 37 CFR 1.53(b) or if applicable, 1.53(d); or (4) a request for a continuing examination (RCE) under 37 CFR 1.114.

Petitioner asserts that the amendment as filed does place the application in condition for allowance. However, the Examiner has informed the undersigned that it does not. Any questions concerning the amendment should be directed to the Examiner.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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JAN 12 2009

**OFFICE OF PETITIONS**

In re Application of :
Outi Hiironniemi :
Application No. 10/086,780 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 059643.00741 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed May 30, 2008.

The petition under 37 CFR 1.137(b) 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)." No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed November 16, 2006, which set a shortened statutory period for reply of three (3) months. No proper response having been received, the application became abandoned on February 17, 2007. A courtesy Notice of Abandonment was mailed on May 30, 2007.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in

filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition lacks item (2), the required reply. The amendment submitted with the petition does not *prima facie* place the application in condition for allowance. Attached is a courtesy copy of an Advisory Action, setting forth the reasons why the amendment does not place the application in condition for allowance.

On renewed petition, petitioner must submit a proper reply in response to the final Office action mailed November 16, 2006. The proposed reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law); (2) an amendment that *prima facie* places the application in condition for allowance; (3) the filing of a continuing application under 37 CFR 1.53(b) or if applicable, 1.53(d); or (4) a request for a continuing examination (RCE) under 37 CFR 1.114.

Any questions concerning the amendment should be directed to the Examiner.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
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Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: courtesy copy of form PTOL-303 (2 pages)

Courtesy Copy

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/086,780 | **Applicant(s)** HIIRONNIEMI, OUTI | |
|---|---|---|---|
| | **Examiner** TOAN D. NGUYEN | **Art Unit** 2416 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 17 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/William Trost/
Supervisory Patent Examiner, Art Unit 2416

Continuation of 11. does NOT place the application in condition for allowance because:
Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
Claim 1 recites the limitation "the threshold and operational is valid" in line 9. There is insufficient antecedent basis for this limitation in the claim. Similar problems exist in claim 11, lines 12-13; and claim 22, line 10.

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OFFICE OF PETITIONS

In re Application of :
Outi Hiironniemi :
Application No. 10/086,780 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No. 059643.00741 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed February 12, 2009.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed November 16, 2006, which set a shortened statutory period for reply of three (3) months. No proper response having been received, the application became abandoned on February 17, 2007. A courtesy Notice of Abandonment was mailed on May 30, 2007. Applicant filed petitions to revive under 37 CFR 1.137(b) on August 17, 2007, March 4, 2008, and May 30, 2008. However, the petitions were dismissed in decisions mailed on January 4, 2008, March 31, 2008, and January 12, 2009.

With the instant petition, applicant has submitted an amendment. The other requirements for a grantable petition were previously met in the earlier filed petitions.

The application is being forwarded to Group Art Unit 2616 for consideration of the Amendment filed with the petition on February 12, 2009.

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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Paper No. 8.

SANDEEP JAGGI
LSI LOGIC CORPORATION M/S D-106
1551 MCCARTHY BOULEVARD
MILPITAS CA 95035

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JUL 2 8 2004

OFFICE OF PETITIONS

In re Application of :
Stuber et al. :
Application No. 10/086,786 : ON PETITION
Filed: February 28, 2002 :
Attorney Docket No.: L13.12-0174/01-262 :

This is a decision on the petition filed under 37 CFR 1.137(a) on February 6, 2004, seeking to revive the above-identified abandoned application.

The petition is **dismissed.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a), or as explained below, 1.137(b)."

The application was deposited with four drawing figures on 3 sheets of drawings. On April 4, 2002, the Office of Initial Patent Examination (OIPE) mailed Notice requiring substitute drawings within an extendible period of 2 months as those of record did not have margins that complied with 37 CFR 1.84(g).

On June 4, applicants filed a reply.

However, on June 17, 2002, OIPE sent a Notice advising applicants that the reply of June 4, 2002, was incomplete, and that the first period for reply continued to run.

As no further reply was received, and no extensions fo time were filed, this application became abandoned midnight on June 4, 2002. A Notice of Abandonment was mailed January 14, 2004.

The instant petition was filed February 6, 2004, accompanied by four sheets of acceptable drawings containing Figures 1-4, a declaration by Manu Kashyap that on June 4, 2002, he mailed two (2) sheets of drawings to the USPTO by way of the Express Mail procedure set forth in 37 CFR 1.10, a copy of the Express Mail label for that mailing, and a copy of an itemized postcard receipt for this application bearing a USPTO date stamp of June 4, 2002, that acknowledges receipt of formal drawings for this application.

Applicants seek withdrawal of the holding of abandonment or alternately, revival under 37 CFR 1.137(a).

*With respect to withdrawal of the holding of abandonment:*

It is noted that abandonment occurs by operation of law for failure to prosecute. See 35 USC 133. Applicants contend that a reply–albeit a flawed reply-- was timely filed on June 4, 2002. As noted in 37 CFR 1.135(b), in order to avoid abandonment applicant must take such prosecution measures that include complete and proper reply as the condition of the application may require.

Applying that rule to the facts of this case, applicant had to file on June 4, 2004, replacement sheets of drawings that had proper margins as required by 37 CFR 1.84(g), in order to avoid abandonment. Applicants admit, with commendable candor, that Mandu Kashyap erred and filed the wrong drawings (but 2 sheets containing 2 Figures whereas 4 Figures regardless of the number of sheets were needed) on June 4, 2002. Thus, since a complete and proper reply to the Notice was not timely filed, there can be no doubt that this application was properly held abandoned.

Applicants further contend that USPTO could have notified applicants of their flawed reply. In fact the USPTO did send out such a communication, but such is immaterial to the fact and date of abandonment. Although the USPTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so. See In re Colombo Inc., 33 USPQ2d 1530, 1532. (Comm'r Pat. 1994). Rather, it is the applicants who are ultimately responsible for filing proper documents. Id. Furthermore, petitioners concededly received the Notice but failed to provide the complete (and timely) reply: The failure to supply the proper reply was the fault of petitioners, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), *cert. den.* 159 USPQ 799:

> The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioners had received the reasonable notice required so as ensure a timely and full response to the Notice. That petitioners failed to timely and adequately respond was unfortunate, but such failure did not operate to save this application from abandonment. See Brenner, supra. Accordingly the holding of abandonment was proper and will not be withdrawn.

*With respect to the petition to revive:*

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, the publication fee, or any portion of each fee, the required reply must be the payment of the issue fee, publication fee or any outstanding balance of each fee; (2) the petition fee 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) in some instances, a terminal disclaimer and fee (not applicable to this application). This petition lacks item (3) noted above.

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).

Assuming that the error herein is a clerical error on the part of Manu Kashyap, then as noted in MPEP 711.03(c) §(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

## ALTERNATE VENUE

In the event that petitioner is not able, or does not wish, to provide the necessary showing of unavoidable delay, petitioner may present a petition and fee under the less stringent "unintentional" delay standard, which does not require such a showing, and also in most cases, the documentation to support the assertions made in the petition.

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. 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 of $665 set forth in § 1.17(l); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and (4) in some instances, a terminal disclaimer and $55 fee (not applicable here).

Petitioner should not construe the mere informative mention of this alternate venue that revival even under this standard is possible. Petitioner is advised, before considering this alternate venue, to reflect on the additional expense and the fact that if any part of the delay in prosecuting, or reviving this case is found to have been intentional, such will preclude revival even under the less stringent "unintentional" standard.

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

**By FAX:** (703) 872-6906
ATTN: Office of Petitions

Telephone inquiries related to this communication should be directed to Paralegal Irwin Dingle at (703) 306-5684.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy

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Paper No. 11

SANDEEP JAGGI
LSI LOGIC CORPORATION M/S D-106
1551 MCCARTHY BOULEVARD
MILPITAS, CA 95035

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OFFICE OF PETITIONS
ON PETITION

In re Application of :
Russell B. Stuber et al :
Application No. 10/086,786 :
Filed: February 28, 2002 :
Attorney Docket No. L13.12-0174/01-262 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 27, 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 April 4, 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 June 5, 2002.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application is being forwarded to the Initial Patent Examination Unit.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

David D. Brush
Suite 1600 – International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

**DOYLE B. JOHNSON**
**CROSBY, HEAFEY, ROACH & MAY**
**SUITE 2000**
**2 EMBARCADERO CENTER**
**SAN FRANCISCO, CA 94111**

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OFFICE OF PETITIONS

In re Application of
Etsuro Saito
Application No. 10/086,796
Filed: February 27, 2002
Attorney Docket No. 351778.05500

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 24, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to PCT Application No. PCT/JP01/05920, filed July 7, 2001 set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on February 27, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed PCT application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed PCT application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed PCT application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. §§ 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed PCT application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed PCT application, as well as to Japan Application No. P2000-207312, filed July 7, 2000, 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 2851 for consideration by the examiner of applicant's claim under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to the above-noted, prior-filed PCT application.

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
P.O. Box 1450
Alexandria, VA 22313-1450
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GILEAD SCIENCES INC
333 LAKESIDE DR
FOSTER CITY, CA 94404

COPY MAILED

MAY 0 4 2005

OFFICE OF PETITIONS

In re Application of :
Tomas CIHLAR :
Application No. 10/086,816 : DECISION ON PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 240.1PCD :

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 2005, to revive the above-identified application.

The petition is **DISMISSED** as being immaterial to a pending application..

A non-final Office action regarding the above-identified application was mailed August 24, 2004, which set a shortened statutory period for reply of three (3) months. A three-month extension of time under the provisions of 37 CFR 1.136(a) was obtained pursuant to a petition filed March 3, 2005 with a Certificate of Mailing dated February 24, 2005. An amendment was also filed March 3, 2005 with a Certificate of Mailing dated February 24, 2005. Accordingly, the reply to the non-final Office Action mailed August 24, 2004 is considered to be timely filed and the above-identified application is not abandoned. Therefore, the petition under 37 CFR 1.137(b), filed March 3, 2005, is moot and the petition fee is credited to Deposit Account 07-1250.

Telephone inquiries concerning this decision should be directed to Betsy Deppe at (571) 272-6052 or in her absence, the undersigned at (571) 272-3217.

The application is being referred to Technology Center AU 1646 for appropriate action on the reply in due course.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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333 LAKESIDE DR
FOSTER CITY, CA 94404

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MAY 2 6 2005

OFFICE OF PETITIONS

In re Application of :
Tomas CIHLAR :
Application No. 10/086,816 : DECISION ON PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 240.1PCD :

This is a decision on the petition under 37 CFR 1.137(b), filed May 23, 2005, to revive the above-identified application.

The petition is granted.

In reply to the decision of May 4, 2005, which dismissed the petition under 37 CFR 1.137(b) filed March 3, 2005 as immaterial, petitioner requests reconsideration. Petitioner notes that notwithstanding the indication on the certificate of mailing on the transmittal letter accompanying the reply and extension of time received March 3, 2005, that such had been deposited as first class mail on February 24, 2005, that correspondence was not mailed on that date. Accordingly, as petitioner correctly notes, the correspondence was untimely, and as such, the correspondence is amenable to acceptance on petition under 37 CFR 1.137(b).

It follows, however, that the extension of time and fee was likewise untimely, and as such cannot be accepted after expiry of the maximum extendible statutory period. See 37 CFR 1.136(a); In re Application of S, 8 USPQ2d 1630, 1631 (Comm'r Pat. 1988). Accordingly, the $1020 fee proffered for the three month extension of time is being credited to counsel's account.

The application file is being referred to the Technology Center.

Telephone inquiries concerning this decision should be directed to Betsy Deppe at (571) 272-6052 or in her absence, the undersigned at (571) 272-3217.

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

Patrick J. S. Inouye, P.S.
810 Third Avenue
Suite 258
Seattle, WA 98104

**MAILED**

AUG 1 2 2002

**Technology Center 2100**

In re Application of:
Carol L. Colrain, et al.
Application No.: 10/086,842
Filed: February 28, 2002
For: SYSTEM AND METHOD FOR PRE-COMPILING A SOURCE CURSOR INTO A TARGET LIBRARY CACHE

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request For Withdrawal As Attorney Under 37 CFR § 1. 36 and 10.40(c) filed April 18, 2002.

A Power Of Attorney Under 37 CFR § 1. 36 was filed on June 6, 2002. The Power Of Attorney revoked all prior Powers Of Attorney and appointed HICKMAN PALERMO TRUONG & BECKER LLP as the attorneys of record of the instant application. The Power Of Attorney of June 6, 2002 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by HICKMAN PALERMO TRUONG & BECKER 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 Program Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, California 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

Paper No.

HUMAN GENOME SCIENCES INC
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

**COPY MAILED**

SEP 15 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Wei et al. | : | DECISION ON APPLICATION |
| Application No. 10/086,882 | : | FOR |
| Filed: March 4, 2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. PF458D1 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed March 11, 2005. Applicants request that the patent term adjustment at the time of the mailing of the Notice of Allowance be corrected from four hundred fifty-three (453) days to four hundred ninety-five (495) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is FOUR HUNDRED NINETY-FIVE (495) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 14, 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 453 days. The instant application for patent term adjustment was timely filed[1]. Applicants dispute

[1] PALM records indicate that the Issue Fee was also received on March 11, 2005.

the reduction of 42 days of PTA for applicant delay in filing a supplemental response on November 17, 2004. Applicants state that this response was filed at the request of the examiner.

The record supports a conclusion that in connection with the interview of November 17, 2004, the supplemental reply was expressly requested by the examiner, within the meaning of § 1.704(c)(8). Accordingly, no reduction is warranted.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is FOUR HUNDRED NINETY-FIVE (495) days.

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The Office will forward the file to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

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. 9

Burns Doane Swecker & Mathis LLP
Post Office Box 1404
Alexandria, VA 22313-1404

MAY 14 2003

| | | |
|---|---|---|
| In re Application of | : | |
| Kyo-Yeol Lee | : | DECISION ON PETITION |
| Application No. 10/086,892 | : | TO WITHDRAW THE |
| Filing Date: March 4, 2002 | : | HOLDING OF ABANDONMENT |
| Attorney Docket No.: 030681-366 | : | |

This is a decision on the request for withdrawal of holding of abandonment filed on February 6, 2003. It is being treated as a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181. There is no fee for this petition.

The petition is **GRANTED**.

The application was held abandoned for failure to file a proper response to the Office action mailed June 27, 2002. A Notice of Abandonment was mailed on March 24, 2003.

Petitioner asserts that a response was timely filed in the above-identified application on July 23, 2002. To support this assertion, petitioner has submitted a copy of the response and a copy of a return postcard which identifies and acknowledges receipt of the response by the Patent and Trademark Office (PTO) on July 23, 2002.

Although the Serial Number of the application was incorrectly listed as 10/086,092 instead of 10/086,892 on the response, on the postcard and on the transmittal letter, the other information such as the title, filing date, attorney's docket no. and applicant's name is correct. Thus, the incorrect Serial Number is considered a minor error that could have been quickly discovered. See M.P.E.P. § 502.

A review of the application file record reveals that the above-identified response having been acknowledged as being received in the PTO on July 23, 2002, is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the response was timely received but lost after receipt thereof.

The copy of the response submitted with the petition on February 6, 2003 is accepted since the response originally submitted is apparently lost.

For the above stated reason, the petition is granted. The Notice of Abandonment mailed March 24, 2003 is hereby vacated and the holding of abandonment is withdrawn.

The application file is being forwarded to the Technology Center 2800 support staff for entry of the response. The application file will then be forwarded to the examiner for prompt appropriate action.

Edward Westin

Edward P. Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : 6-29-05

**TO SPE OF** : ART UNIT 2861

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6764164

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 Drawings

**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:**

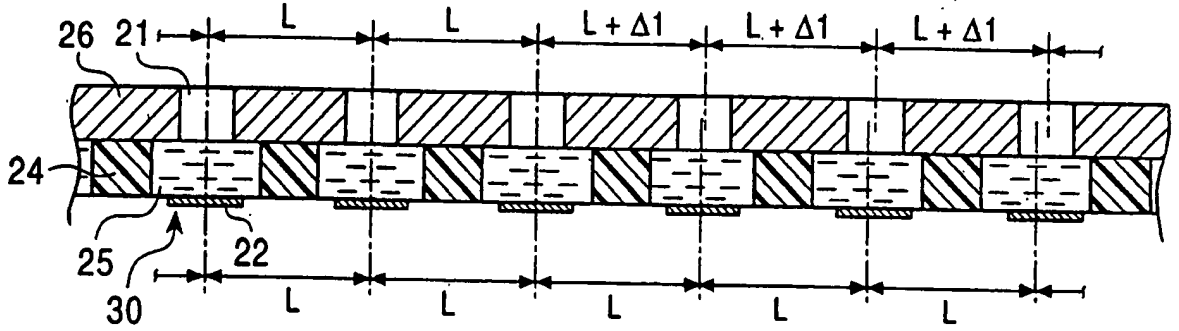
Approved drawing change (fig. 4B)

SPE

2861

Art Unit

FIG. 4A




Approved
8/8/05
TN

FIG. 4B

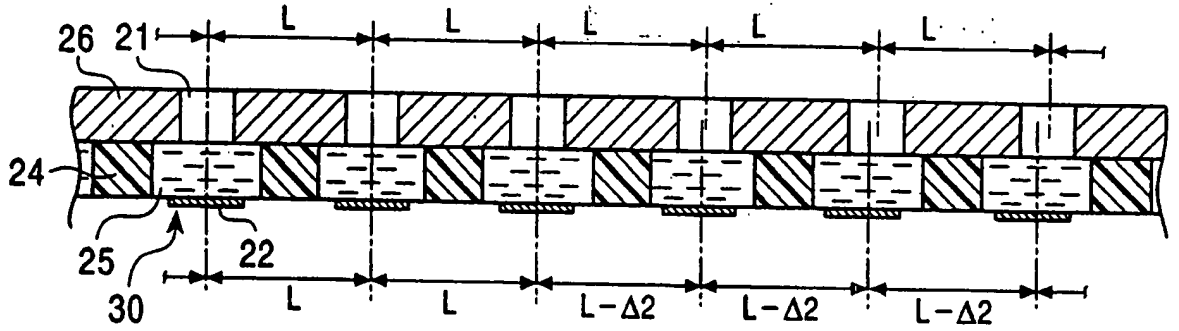
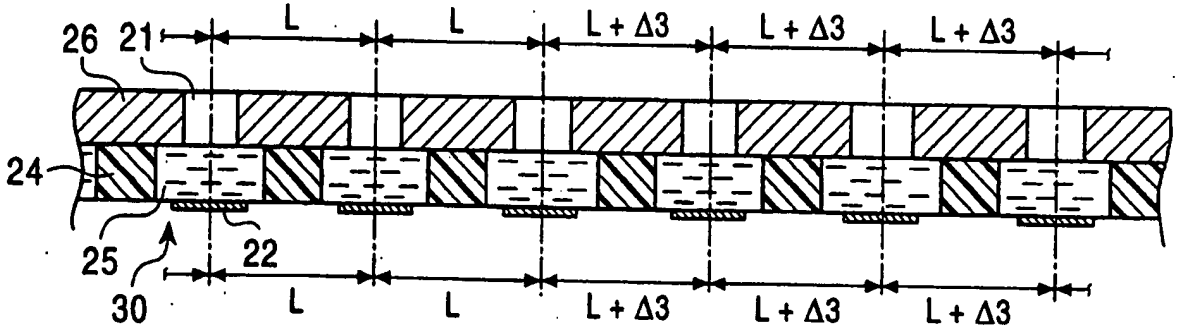



FIG. 4C



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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MAILED

SEP 29 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103-7013

In re application of
John Koresko
Application No. 10/086924
Filed: February 28, 2002
For: SYSTEM AND METHOD FOR CREATING A DEFINED BENEFIT PENSION PLAN FUNDED WITH A VARIABLE LIFE INSURANCE POLICY AND/OR A VARIABLE ANNUITY POLICY

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the petition filed on June 19, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII. The delay in treating this petition is sincerely regretted.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references.

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

**SUMMARY**: Petition to Make Special **GRANTED**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703)308-0866

KJD/ekn 9/17/03

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

JJGJr: 11-05

Paper No: __

WILLIAM P. CHRISTIE
CHRISTIE PARKER & HALE LLP
POST OFFICE BOX 7068
PASADENA CA 91109-7068

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NOV 25 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Phan, et al. | : | |
| Application No. 10/086,941 | : | DECISION ON PETITION |
| Filed: 26 February, 2002 | : | |
| Attorney Docket No.: BTI2 00103502(USP2) USP7X1 | : | |

This is a decision on the petition filed on 31 August, 2005, under 37 C.F.R. §1.183 (seeking a waiver of the provisions of 37 C.F.R. §1.67), but treated more appropriately under 37 C.F.R. §1.47(a)

NOTE: **There is a lack of clarity in the file as to the Power of Attorney and proper Correspondence Address for this matter.**

**Therefore, Petitioner hereby is placed on notice that, if Petitioner desires to receive future correspondence regarding this application at the address corresponding to Petitioner's registration address and to the Customer Number set forth by Petitioner, the appropriate Notice of Change of Address/Revocation-Power of Attorney documentation must be submitted (as separate documents, pursuant to the rules). A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the**

**address of record until such time as appropriate instructions are received to the contrary**.

The petition:

- as considered under 37 C.F.R. §1.47(a) is **GRANTED**; and
- under 37 C.F.R. §1.183 (seeking waiver of 37 C.F.R. §1.67) is **DISMISSED as moot**.

## BACKGROUND AND ANALYSIS

The record reflects that:

- during prosecution the Examiner observed a defect in the instant application, in that it was filed on 26 February, 2002, absent, *inter alia*, a fully and properly executed oath/declaration (co-inventor KaYuen Yeung had altered the address without initialing and dating the change), and on 25 March, 2005, the Examiner mailed a non-final Office action requiring correction of the defect, and setting therein, *inter alia*, a three- (3-) month period for reply absent extension of time;
- on 31 August, 2005, Petitioner Jerry L. Hefner (Reg. No. 53,009) filed (with a request and fee for extension of time) an oath/declaration signed by co-inventor Bridgette Chau Phan, Jorna Ante Virtanen, Amethyst Hoang Lam (on behalf of themselves and), but without the signature of now non-signing inventor KaYuen Yeung, and with a statement by Petitioner as to the process of sending the entire application (description, claims, abstract and drawings) for review, with the oath/declaration for signature, supported said statement with a copy of the transmittal letters, and set forth the averred last known and valid current address of the non-signing inventor;
- Petitioner seeks a waiver under 37 C.F.R. §1.183 of the requirements of 37 C.F.R. §1.67;
- however, as is clear from the record, a waiver is not necessary here because Petitioner has tracked the requirements of the underlying provisions of 37 C.F.R. §1.47(a), in that when

> . . . 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 . . .

- and this may be done if Petitioner sends to the non-singing inventor the entire application

(description, claims, abstract and drawings) and submits "[t]he oath or declaration in such an application * * * accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor." (See: 37 C.F.R. §1.47(a), and MPEP §409.03(b) and §409.03(d).)

Petitioner has made such a showing herein.

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and Petitioner has shown 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(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

As provided under 37 C.F.R. §1.47(a), the 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 also will be published in the Official Gazette.

This file is released to the Technology Center for further examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

cc:
JERRY L. HEFNER
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**GLADYS H. MONROY**
**MORRISON & FOERSTER**
**755 PAGE MILL ROAD**
**PALO ALTO, CA 94304**

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FEB 0 6 2006

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Kesavan Esuvaranathan et al | :DECISION ON PETITION |
| Application No. 10/086,973 | :UNDER 37 CFR 1.78(a)(3) |
| Filed: March 1, 2002 | : |
| Attorney Docket No. 488002000200 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 4, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed PCT Application No. PCT/SG/00130, filed September 1, 2000, set forth in the amendment submitted concurrently with the instant petition. This is also a decision on the petititon under 37 CFR 1.182 for expedited consideration of the petition under 37 CFR 1.78(a)(3).

The petition considered under 37 CFR 1.78(a)(3) is **DISMISSED**.

The petition considered under 37 CFR 1.182 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.

The instant petition does not comply with item (1) above.

The amendment filed November 4, 2005 claims priority to PCT Application No. PCT/SG/00130. However, the year of filing is missing from the PCT application No. Further, the examiner has indicated that the proposed amendment would not be entered because "[t]he proposed amendment to claim priority would render composition claims 57, 59-61, and 63-65 allowable, and necessitate rejoinder of withdrawn method claims 1, 3-16, 18-31, 33, 34, 36-41, 43, 46-56, and 62. Examination of these claims, in particular claim 41, would require further search and consideration, particularly with regard to enablement and written description issues." Therefore, since the amendment does not *prima facie* place the application in condition for allowance for the reasons indicated by the examiner, petitioner must now submit a Notice of Appeal, a request for continued examination (RCE) under the provisions of 37 CFR 1.114, or file a continuing application pursuant to the provisions of 37 CFR 1.53(b).

Any request for reconsideration of this decision must be accompanied by a cover letter entitled "Renewed Petition under 37 CFR 1.78(a)(3)" and must include the appropriate reply to continue prosecution of the instant application.

37 CFR 1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii)and the date the claim was filed was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.78(a)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.78(a)(3).

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) 272-3220

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

Frances Hicks
Lead Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Gladys H. Monroy
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto CA 94304

COPY MAILED
AUG 1 0 2006
OFFICE OF PETITIONS

In re Application of
KESAVAN ESUVARANATHAN, et al.
Application No. 10/086,973
Filed: March 1, 2002
Attorney Docket No. 488002000200

DECISION ON PETITIONS
UNDER 37 CFR 1.78(a)(3)
AND 37 CFR 1.55(c)

This is a decision on the **renewed** petition under 37 CFR 1.78(a)(3), filed March 7, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed PCT application PCT/SG00/00130 as 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) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) 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 granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) and 37 CFR 1.55(c) 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 365(c) and 37 CFR 1.78(a)(1) and (a)(2) and 35 § U.S.C. 119(a)-(d) and 37 CFR 1.55(a)(1) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-***

***filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Amelia Au at (571) 272-7414. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being to referred to Technology Center Art Unit 1635 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c), and for entry of the Request for Continued Examination (RCE) under § 1.114 filed concurrently on March 7, 2006

Frances Hicks
Lead Petitions Examiner
Office of Petitions

**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

WK

Mailed: 6/15/05

| | | |
|---|---|---|
| In re application of | : | |
| Henrick Hansen, et al. | : | |
| Serial No. 10/087,014 | : | DECISION ON |
| Filed: March 1, 2002 | : | PETITION |
| For: COATING A MEDICAL IMPLANT USING A PAN COATER | : | |

This is a decision on the PETITION UNDER 37 CFR 1.182 filed August 31, 2004 requesting entry of a claim erroneously withdrawn by the July 14, 2004 final Office action. The petition has been accepted as a request under 37 CFR 1.181 and will be decided by the Director of Technology 1700.

The first Office action, mailed on November 24, 2003 included an election between group I, encompassing claims 1-19 and 25-28 and group II, claims 20-24. Applicant on February 19, 2004 elected group I without traverse and added claim 29. Claim 29 is a method claim dependent from claim 1.

In the final Office Action of May 3, 2004, the examiner did not include claim 29. The examiner in a supplemental final action on July 14, 2004 included claim 29 and made a new restriction requirement based on claim 29 and since applicant received an action on the merits for the originally presented invention, claim 29 was withdrawn from consideration as being directed to a non-elected invention.

The examiner's basis for the restriction of claim 29 was that claim 29 was directed to an invention that is independent or distinct from the invention originally claimed namely that the immersion species is distinct from the spraying species previously examined.

Applicants originally elected claims were drawn to a spraying a therapeutic agent into a rotating drum to coat the medical devices and tumbling devices into a vat of therapeutic agent. The examiner asserts that spraying and immersion are distinct species of the claimed invention

Applicant asserts that claim 29 is within the scope of the species defined and elected by the applicant and that the subject matter of claim 29 falls within the same class and sub-class of search identified by the first Office action. A review of facts shows that applicant's request has merit.

**DECISION**

Claim 29 depends from a member of group I and is within the scope of the species defined in the first Office action and elected by the applicant, which is a method of coating.

This Petition is **GRANTED**.

Since applicant's filing of the petition on August 31, 2004, a request for continued examination was filed and a final rejection mailed on April 18, 2005.

The application will be forwarded to the Examiner for the examination of claim 29. The finality of the previous office action will be withdrawn and new action issued incorporating claim 29.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Fred T. Grasso
Kenyon & Kenyon
1500 K Street, N.W., Suite 700
Washington, DC 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 6

PENNIE & EDMONDS LLP
1667 K STREET NW
SUITE 1000
WASHINGTON DC 20006

MAILED

FEB 04 2003

Technology Center 2600

In re Application of :
Isaac Shpantzer et al :
Application No. 10/087,022 : DECISION ON REQUEST TO
Filed: February 28, 2002 : WITHDRAW AS ATTORNEY
For: **SYSTEM AND METHOD FOR ORTHOGONAL FREQUENCY DIVISION MULTIPLEXED OPTICAL COMMUNICATION** :

This is a decision on the request to withdraw as attorney/agent of record filed on January 14, 2003.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application are removed from record.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc: Isaac Shpantzer, Ph. D.
Chief Technical Officer
CeLight, Inc.
12200 Tech Road, Suite 300
Silver Spring, MD 20904

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JJGJr.:09-02

Paper 5

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SEP 16 2002

OFFICE OF PETITIONS

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE WA 99201

In re Application of
Smith, et al
Application No. 10/087,027
Filed: 28 February, 2002
Attorney Docket No. MS1-86-861USC1

: DECISION ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47,[1] filed on 11 June, 2002

Petitioner has shown that, while inventors all seventy-five (75) other inventors have signed the oath/declaration, the non-signing inventor **David Bau (Mr. Bau)** has refused to join in the filing of the above-identified application after having been presented with the application papers.

Specifically, the declaration/statement/submission of facts of/by Lewis Lee (Reg. No. 34,656) establishes that the non-signing inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond positively to the request that he sign the declaration or in fact sign said declaration.

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and petitioner has shown 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(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

As provided under 37 C.F.R. §1.47(a), the 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 also will be published in the Official Gazette.

---

[1] The regulations at 37 C.F.R. §1.47 provide:

**§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(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, 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, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

This file is being forwarded to OIPE for processing as necessary to reflect the instant decision, and then will be forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 4

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

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MAY 1 4 2003

OFFICE OF PETITIONS

In re Application of :
Miles Wu et al :
Application No. 10/087,045 : DECISION GRANTING PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.137(f)
Attorney Docket No. 529252000100 :

This is a decision on the petition, filed by facsimile transmission on May 5, 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 February 25, 2003. 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). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A corrected Filing Receipt which sets forth the projected publication date of August 28, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2665 for examination in due course.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

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) |
|---|---|---|---|---|
| 6,792,533 | 2004-09-14 | 10/087,048 | 2002-03-01 | 97-1019DIVCON |

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 | /Lesley Coulson Boveri/ | Date (YYYY-MM-DD) | 2010-02-26 |
| Name | Lesley Coulson Boveri | Registration Number | 46642 |

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. 6792533
Issue Date: September 14,2004
Application No. 10087048
Filed: March 1,2002
Attorney Docket No. 155607-0360 (P062DC)

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 26,2010 ,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 26,2010 . 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 6

DOYLE B. JOHNSON
CROSBY, HEAFEY, ROACH & MAY
SUITE 2000
2 EMBARCADERO CENTER
SAN FRANCISCO, CA 94111

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OFFICE OF PETITIONS

In re Application of
Etsuro Saito et al
Application No. 10/087,060
Filed: February 27, 2002
Attorney Docket No. 351778.05600

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 24, 2003, and supplemented by facsimile transmission on October 29, 2003 to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of PCT Application No. PCT/JP01/05921, filed July 6, 2001 set forth in the amendment filed October 29, 2003.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant pending application was filed on February 27, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed PCT application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed PCT application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed PCT application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. §§ 120 and 365(c). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed PCT application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed PCT application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 2878 for consideration by the examiner of applicant's claim under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to the above-noted, prior-filed PCT Application No. PCT/JP01/05921, filed July 6, 2001.

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
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 4

Peter J. Yim
Morrison and Foerster, LLP
425 Market Street
San Francisco, CA 94105-2482

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MAY 1 9 2003

OFFICE OF PETITIONS

In re Application of :
Nickhil Jakatdar, et al. :
Application No. 10/087,069 : DECISION GRANTING PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.137(f)
Attorney Docket No. 509982003200 :

This is a decision on the petition filed May 2, 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 non-provisional application is the subject of an application filed in a foreign country on February 25, 2003. However, the U. S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the reply which is met by notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

The instant petition has been found in compliance with the 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 USC 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of August 28, 2003 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to Marianne Morgan at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 2811 for examination in due course.

Frances Hicks

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

Hercules Incorporated
Legal Department
Hercules Plaza
1313 N. Market Street
Wilmington DE 19894

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SEP 1 2 2002

OFFICE OF PETITIONS

In re Application of
Walton and Warchol
Application No. 10/087,074
Filed: March 1, 2002
For: RESINS ACTING AS WET STRENGTH AGENTS AND CREPING AIDS AND PROCESSES FOR PREPARING AND USING THE SAME

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed July 19, 2002. Applicant obtained a two-month extension of time to reply. Therefore, the petition is filed timely.

The petition is **dismissed**.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing 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 March 1, 2002, without an executed oath or declaration. Accordingly, on April 5, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on July 19, 2002, applicant filed the present petition, a request for a two-month extension of time, a declaration and power of attorney, a Statement of Facts of Gary A. Samuels, and the requisite fees. In the Statement of Facts, Mr. Samuels states that declaration and assignment papers were prepared and mailed to Cynthia D. Walton, the non-signing inventor, on four separate occasions; however, she has not responded to date.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) as set forth above.

As to item (1), applicant appears to demonstrate that the non-signing inventor was presented with the declaration and assignment papers only. Unless Ms. Walton was presented with a copy of the complete application papers, including the specification, claims and drawings, she could not attest that she has reviewed and understands the application papers, and therefore, could not sign the declaration which she was given. See 37 CFR 1.63. Accordingly, applicant failed to show or provide sufficient proof that the inventor has refused to sign the declaration. See MPEP 409.03(d). Applicant should show that a copy of the complete application papers, including the specification, claims and drawings, was presented to the inventor, but that she did not respond to the request that she sign the oath/declaration in order to show that the inventor has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events.

Further correspondence with respect to this matter should be addressed as follows and to the **Attention of Senior Petitions Attorney Christina Tartera Donnell:**

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 308-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 8

Hercules Incorporated
Legal Department, Hercules Plaza
1313 N. Market Street
Wilmington DE 19894

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DEC 0 6 2002

OFFICE OF PETITIONS

In re Application of :
Walton and Warchol :
Application No. 10/087,074 : DECISION GRANTING
Filed: March 1, 2002 : PETITION UNDER
For: RESINS ACTING AS WET : 37 CFR 1.47(a)
STRENGTH AGENTS AND CREPING :
AIDS AND PROCESSES FOR :
PREPARING AND USING THE SAME :

This is in response to the renewed petition under 37 CFR 1.47(a), filed November 18, 2002 (certificate of mailing November 12, 2002.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the statement of facts of Gary A. Samuels establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that she sign the declaration.

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 present petition. Notice of the filing of this application will also be published in the Official Gazette.

The $130.00 petition fee is unnecessary and will be credited to Deposit Account No. 08-1800.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

#5

OIPE JC37
JUN 13 2002
PATENT & TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D. C. 20231.
Date: June 7, 2002

Scott D. Sanford, Reg. No. 51,170

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant: | Bonora, et al. | | |
| Serial No: | 10/087,092 | Art Unit: | Unknown |
| Filed: | March 1, 2002 | Examiner: | Unknown |
| Conf. No.: | 1981 | | |
| Title: | SEMICONDUCTOR MATERIAL WAFER HANDLING SYSTEM | | |

PETITION TO EXPUNGE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. § 1.59(b), Applicant hereby requests that Application Numbers 10/087,400 and 10/087,638 cited in the Information Disclosure Statement filed concurrently herewith, be expunged and preserved in confidence. Application Numbers 10/087,400 and 10/087,638 have a filing receipt date of March 1, 2002 and have not been published in the United States or any foreign country. Under 37 C.F.R. § 1.14(a), patent applications that have not been published under 35 U.S.C. 122(b) are preserved in confidence pursuant to 35 U.S.C. 122(a). Therefore, applicant requests that Application Numbers 10/087,400 and 10/087,638 be expunged and preserved in confidence.

06/20/2002 MAHMED1 00000068 10087092
01 FC:122 130.00 OP

Respectfully submitted,

O'MELVENY & MYERS LLP

Date: June 7, 2002

By: _____
Scott D. Sanford
Reg. No.: 51,170

Attorney Docket No.: 34741-774

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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MAIL Paper No.4

JUL 1 1 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Columbia IP Law Group, PC
10260 SW Greenburg Road
Suite 820
Portland, OR 97223

In re Application of :
Engstrom et al. :
Application No. 10/087,098 : DECISION ON PETITION
Filed: March 1, 2002 : TO MAKE SPECIAL
Attorney Docket No. 41051.P004 :
For: PERSONALIZING ELECTRONIC DEVICES AND SMART COVERING :

This is a decision on the petition to make special filed on May 23, 2002.

A petition for accelerated examination 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.

Reinhard J. Eisenzopf
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4711

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

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OCT 2 2 2003

OFFICE OF PETITIONS

In re Application of :
Raul A. Cernea :
Application No. 10/087,108 : DECISION GRANTING PETITION
Filed: February 28, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. SDK1P008/250 :

This is a decision on the petition, filed September 22, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on January 27, 2003. 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.

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 2818 for further prosecution.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Conferee: Frances M. Hicks
Lead 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
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KING & SPALDING LLP
191 PEACHTREE STREET, N.E.
ATLANTA GA 30303-1763

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OFFICE OF PETITIONS

In re Application of
Jin & Confalone
Application No. 10/087,112
Filed: March 1, 2002
Attorney Docket No. PHAR2001 08841.105031
For: METHOD FOR THE SYNTHESIS OF 2'3'-DIDEOXY-2'3'-DIDEHYDRONUCLEOSIDES

ON PETITION

This is a decision on the petition filed October 26, 2004, entitled, "PETITION UNDER 37 CFR 1.47(A)." The petition will be treated as a petition under CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which requires all of the joint inventors to execute a supplemental declaration.[1]

The petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 is **DISMISSED**.

The petition under 37 CFR 1.47(a) 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. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

While this waiver petition is not a petition under 37 CFR 1.47, it is evaluated the same way a Rule 47 petition is. Therefore, a grantable petition requires

(1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,

(2) a proper oath or Declaration executed by the available joint inventor(s),

[1] Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2).

With respect to item (1), Applicant has failed to establish that the non-signing inventor, Fuquiang Jin, cannot be located. The petition contains a declaration by Agent Susanne Hollinger who states that when she called Dr. Jin's last known telephone number, a woman identifying herself as his wife stated that Dr. Jin was in China and that he would not return before December 2004 at the earliest and gave no definite date of return. She also stated that it would not be possible to contact him before his return to the United States.

A showing of **diligence** is critical in obtaining Rule 47 status when an inventor cannot be located or reached. The evidence presented shows that Dr. Jin's unavailability to execute the supplemental declaration is a function of his being out of the country. As stated in MPEP 409.03(d), " 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(a)." This rationale holds true in a petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67, as well.

Therefore, petitioner's best option to obtain waiver of 37 CFR 1.63 and 1.67 is to show that Dr. Jin is refusing to cooperate. Petitioner must attempt to contact Dr. Jin at his last known address in New Hope, PA in December 2004. The Office requires that petitioner mail a supplemental declaration and a complete copy of the application to Dr. Jin's last known address. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

Dr. Jin must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. When petitioner can provide evidence that Dr. Jin received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration within a reasonable amount of time, petitioner will have established Dr. Jin's refusal to join in the filing of the application.

Any written refusal to sign the declaration should be included as documentary evidence in any reconsideration petition. If there is an oral refusal, the facts surrounding the refusal should be included in a declaration by a party with first hand knowledge of the refusal. If it is concluded by the 37 CFR 1.47 applicant 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.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.67 still has not been presented. There are two pages of declaration and neither contains information for Dr. Jin. The signing inventor must execute another declaration that contains the signer's own information and lists Dr. Jin's name, citizenship, residence, and post office address. An oath or declaration in compliance with 37 CFR 1.63 and 1.67 signed by Mr. Confalone on behalf of the non-signing inventor is REQUIRED. See MPEP 409.03(a).

Pursuant to petitioner's authorization, the $130.00 petition fee due will be charged to deposit account no. 11-0980.

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
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

**By FAX:** (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
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KING & SPALDING LLP
191 PEACHTREE STREET, N.E.
ATLANTA GA 30303-1763

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APR 11 2005

OFFICE OF PETITIONS

In re Application of
Jin & Confalone
Application No. 10/087,112
Filed: March 1, 2002
Attorney Docket No. PHAR2001 08841.105031
For: METHOD FOR THE SYNTHESIS OF 2'3'-DIDEOXY-2'3'-DIDEHYDRONUCLEOSIDES

: ON PETITION

This is a decision on the reconsideration petition, filed January 25, 2005 (certificate of mailing date January 19, 2005), under CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which requires all of the joint inventors to execute a supplemental declaration.

The petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 is **DISMISSED AS MOOT**.

Papers filed on January 24, 2005 (certificate of mailing date January 19, 2005) in reply to a November 19, 2004 decision dismissing the petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 included a declaration signed by the previously nonsigning inventor, Fuqiang Jin, in compliance with 37 CFR 1.63 and 1.67.

In view of the joinder of the previously non-signing inventor, the petition is dismissed as moot.

After the mailing of this decision, the application file will be forwarded to Publications Division for processing into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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JUL 25 2006
OFFICE OF PETITIONS

In re Patent No. 6,927,291 :
JIN et al. : DECISION ON REQUEST
Application No. 10/087,112 : FOR RECONSIDERATION OF
Filed: March 1, 2002 : PATENT TERM ADJUSTMENT
Atty Docket No. 09797.0005-0000 :

This letter is in response to the "NOTICE OF ERROR IN DETERMINATION OF PATENT TERM ADJUSTMENT," filed October 11, 2005. Pursuant to patentee's duty of good faith and candor to the Office, patentee requests confirmation of the issuance of a patent term adjustment of 109 days.

The request for review of the determination of patent term adjustment (PTA) is **dismissed**.

On October 11, 2005, patentee submitted the instant comment. On August 9, 2005, the above-identified application matured into U.S. Patent No. 6,927,291, with a revised patent term adjustment of 109 days. Patentee refers to 37 C.F.R. 1.704(c)(10) in the request for review of the patent term adjustment, stating the correct patent term adjustment period should be twenty-two (22) days.

A review of the application history supports a conclusion that the number of days adjusted for Office delay and the number of days reduced for Patentee's delay was correct. Patentee refers to 37 C.F.R. 1.704(c)(10) but otherwise does not state a basis for their disagreement with the according of 109 days of PTA. 37 C.F.R. 1.704(c)(10) states that the period of adjustment of the term of a patent will be reduced by the lesser of the number of days beginning on the date the amendment under § 1.312 was filed and ending on the mailing date of the notice in response to the amendment under § 1.312 or four months. Since four months is less than the number of days beginning on the date the

amendment under § 1.312 was filed and ending on the mailing date of the notice in response to the amendment under § 1.312, the period of adjustment was reduced by four months. A copy of the PAIR calculations for this application is enclosed. Patentee continues to be under a duty to advise the Office of any error in according too much PTA.

In view thereof, the revised Patent Term Adjustment remains one hundred nine (109) days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to Files Repository.

Telephone inquiries specific to this matter should be directed to Denise Pothier, Petitions Examiner, at (571) 272-4787.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

enc: PAIR screen for U.S. Application No. 10/087,112

| PTA Calculations for Application: 10/087112 | | | |
|---|---|---|---|
| Application Filing Date: | 03/01/2002 | PTO Delay (PTO): | 237 |
| Issue Date of Patent: | 08/09/2005 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 128 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 109 |
| PTO Delay Adjustment: | 0 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 68.5 | 07/20/2005 | PTA 36 MONTHS | | | |
| 68 | 08/09/2005 | PATENT ISSUE DATE USED IN PTA CALCULATION | 162 | | 62 |
| 67 | 07/11/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 66 | 07/11/2005 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 65 | 06/08/2005 | RECEIPT INTO PUBS | | | |
| 64 | 06/08/2005 | DISPATCH TO FDC | | | |
| 63 | 06/08/2005 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 62 | 10/29/2004 | ISSUE FEE PAYMENT VERIFIED | | 1 | 35 |
| 61 | 06/06/2005 | RECEIPT INTO PUBS | | | |
| 60 | 06/03/2005 | MAIL RESPONSE TO 312 AMENDMENT (PTO-271) | | | |
| 59 | 04/20/2005 | RECEIPT INTO PUBS | | | |
| 58 | 04/11/2005 | PETITION DECISION - DISMISSED | | | |
| 55 | 03/04/2005 | RESPONSE TO AMENDMENT UNDER RULE 312 | | | |
| 47 | 01/24/2005 | PETITION ENTERED | | | |
| 46 | 10/29/2004 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 120 | 60 |
| 45 | 01/24/2005 | WORKFLOW INCOMING PETITION IFW | | | |
| 44 | 01/28/2005 | RECEIPT INTO PUBS | | | |
| 43 | 10/29/2004 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 0 | 60 |
| 42 | 12/17/2004 | RECEIPT INTO PUBS | | | |
| 41 | 11/19/2004 | PETITION DECISION - DISMISSED | | | |
| 40 | 10/26/2004 | PETITION ENTERED | | | |
| 39 | 11/19/2004 | PETITION DECISION - DISMISSED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 38 | 10/26/2004 | PETITION ENTERED | | | |
| 37 | 10/29/2004 | ISSUE FEE PAYMENT RECEIVED | | | |
| 36 | 08/09/2004 | WORKFLOW - FILE SENT TO CONTRACTOR | | | |
| 35 | 07/28/2004 | MAIL NOTICE OF ALLOWANCE | | | |
| 34 | 07/26/2004 | ISSUE REVISION COMPLETED | | | |
| 33 | 07/26/2004 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 32 | 07/26/2004 | NOTICE OF ALLOWABILITY | | | |
| 31 | 01/13/2003 | REFERENCE CAPTURE ON IDS | | | |
| 30 | 07/21/2004 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 07/06/2004 | AMENDMENT AFTER FINAL REJECTION | | | |
| 28 | 07/06/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 27 | 05/05/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 26 | 05/03/2004 | FINAL REJECTION | | | |
| 25 | 06/11/2002 | MISCELLANEOUS INCOMING LETTER | | | |
| 24 | 03/19/2004 | DATE FORWARDED TO EXAMINER | | | |
| 23 | 02/27/2004 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 20 |
| 22 | 02/27/2004 | REFERENCE CAPTURE ON IDS | | | |
| 21 | 02/27/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 11/25/2003 | MAIL NON-FINAL REJECTION | | | |
| 19 | 11/24/2003 | NON-FINAL REJECTION | | | |
| 18 | 10/25/2003 | DATE FORWARDED TO EXAMINER | | | |
| 17 | 10/20/2003 | RESPONSE TO ELECTION / RESTRICTION FILED | | 5 | 15 |
| 16 | 10/20/2003 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 15 | 07/15/2003 | MAIL RESTRICTION REQUIREMENT | 75 | | -1 |
| 14 | 07/14/2003 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 13 | 01/13/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 09/19/2002 | RECORD PETITION DECISION OF GRANTED RELATED TO ATTORNEY | | | |
| 11 | 09/04/2002 | PETITION ENTERED | | | |
| 10 | 08/12/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 07/11/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 8 | 07/09/2002 | APPLICATION IS NOW COMPLETE | | | |
| 7 | 06/11/2002 | ADDITIONAL APPLICATION FILING FEES | | | |
| 6 | 06/11/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC | | | |

| | | | | | |
|---|---|---|---|---|---|
| | | 115, OATH OF THE APPLIC | | | |
| 5 | 04/09/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 2 | 03/21/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 03/01/2002 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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KING & SPALDING LLP
191 PEACHTREE STREET, N.E.
ATLANTA GA 30303-1763

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MAR 0 7 2005

**OFFICE OF PETITIONS**

In re Application of :
Jin & Confalone :
Application No. 10/087,112 : ON PETITION
Filed: March 1, 2002 :
Attorney Docket No. PHAR2001 08841.105031
For: METHOD FOR THE SYNTHESIS OF 2'3'-DIDEOXY-2'3'-DIDEHYDRONUCLEOSIDES

Papers filed on January 24, 2005 (certificate of mailing date January 19, 2005) in response to the November 19, 2004 decision dismissing a petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 included a supplemental declaration signed by the previously unavailable inventor, Fuqiang Jin, in compliance with 37 CFR 1.63 and 1.67.

In view of the above, the petition under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.67 is **DISMISSED AS MOOT**. Petitioners have submitted an acceptable supplemental declaration.

After the mailing of this decision, this application will be forwarded to Publications Division for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 7/22/06

DATE : 06-17-06

TO SPE OF : ART UNIT 2836

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/087125** Patent No.: **6807036**

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**.

A Green

**Angela Green**
**Certificates of Correction Branch**
**703.308.9380 ext.** 123

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** Drawings submitted on 3/4/02 showed the changes in the request. Formal Drawings of 4/17/02 incorporated typographical error. Therefore the instant change request does not constitute new and is approved.
Ronald W. Leja 7/22/06

BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
SPE

2836
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 9

Larry Coats
COATS & BENNETT, PLLC
P.O. Box 5
Raleigh, NC 27602

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MAY 2 8 2004

OFFICE OF PETITIONS

In re Application of :
James FORE et al. :
Application No. 10/087,131 : DECISION GRANTING PETITION
Filed: March 1, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 4287-014 :

This is a decision on the petition, filed March 5, 2004, under 37 CFR 1.137(f), which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application.

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on February 28, 2003. 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© for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(b) to revive for failure to timely notify the Office of the filing of an application in a foreign country must be accompanied by:

(1) the required reply, which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the 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© is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(I) has been rescinded. The instant application was published on May 6, 2004.

Any inquiries concerning this decision may be directed to Samuel A. Acquah at (703) 605-5229 or, in his absence, to the undersigned at (703) 308-3865.

This application is being forwarded to Technology Center Art Unit 2125 for examination in due course.

BethAnne Daoan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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TECHNOLOGY LAW DEPARTMENT
WORLDCOM INC
9854/003 10TH FLOOR
1133 19TH STREET NW
WASHINGTON DC 20036

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OFFICE OF PETITIONS

In re Application of :
Clint J. Bishard : DECISION GRANTING PETITION
Application No. 10/087,132 : AND WITHDRAWING THE
Filed: March 1, 2002 : HOLDING OF ABANDONMENT
Attorney Docket No. 84262.5 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed June 26, 2007.

The petition under 37 CFR 1.181 is **GRANTED**.

The holding of abandonment is **WITHDRAWN**.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed August 29, 2006. This Office action set a shortened statutory period of three (3) months for reply. No reply having been received, the application became abandoned on November 30, 2006. A Notice of Abandonment was mailed on April 26, 2007.

Petitioner states that he did not receive the August 29, 2006 Office action. To establish non-receipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where

the non-received Office action would have been entered had it been received and docketed.[1] A proper docket report consists of a "docket record where the non-received Office action would have been entered had it been received and docketed."[2]

Here, petitioner has met the requirements to establish non-receipt. In particular, petitioner has submitted a satisfactory docket record showing all PTO actions received during the period from August 29, 2006 to September 29, 2006. An entry for the instant application is absent, supporting the conclusion that the Office action was not received.

Accordingly, the holding of abandonment is withdrawn.

Given the basis for granting this petition, no petition fee was required, and none has been charged.

The application is being forwarded to Group Art Unit 2616 for re-mailing of the August 29, 2006 Office action to the above address of record, setting a new period for reply.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

---

[1] See MPEP 711.03(c)(II).

[2] Id.

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TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

MAR 28 2003

#10

CISLO & THOMAS LLP
233 WILSHIRE BOULEVARD
SUITE 900
SANTA MONICA, CA 90401

In re Application of :
Vincent Ardizzone : PETITION DECISION
Serial No.: 10/087,135 :
Filed: February 28, 2002 :
For: Bi-Axial Rotating Magnetic Therapeutic Device:

This is in response to the petition applicant filed on December 23, 2002 to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, VIII, thus the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700 Washington, DC 20231, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director
Technology Center 3700/2900

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**SCHMEISER OLSEN & WATTS**
**18 E UNIVERSITY DRIVE**
**SUITE # 101**
**MESA AZ 85201**

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MAR 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Haskew, James W. :
Patent No. 6,776,606 : ON PETITION
Application No. 10/087,139 :
Filed: March 1, 2002 :
Issued: August 17, 2004
Attorney Docket No. HASK-0535

This is a decision in response to the papers filed on February 16, 2005, which are being treated as a request under 37 CFR 3.81 to accept the correction of the assignee data and as a petition under 37 CFR 1.182 to reprint the front page of the Letters Patent.

The request under 37 CFR 3.81 is **GRANTED**.

The petition under 37 CFR 1.182 to reprint the front page of the Letters Patent is **GRANTED**.

37 CFR 3.81(b) currently states:

> Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter.

The fee of $130.00 for the request under 37 CFR 3.81 has been charged to petitioner's deposit account. In addition, $100 will be charged for the Certificate of Correction.

Petitioner is advised that it is the practice of the U.S. Patent and Trademark Office (USPTO) to issue a certificate of correction to correct an error on the part of an application in those cases where minor errors are present.

In view of the above, and since the desired correction of the title and deletion of the assignee's name can be effected by way of a certificate of correction, it is unnecessary to reprint the front page of the Letters Patent.

However the USPTO will reprint the front page of the Letters Patent if the following conditions are met:

1. Submission of a petition under 37 CFR 1.182
2. Payment of a $200 petition fee
3. Payment of a $100 fee to place a certificate of correction in the USPTO archives

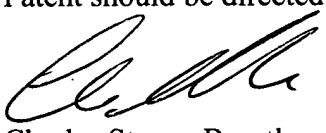
Since petitioner has met all conditions noted above, the front page of the Letters Patent will be reprinted to fix the title and delete the assignee's name.

Petitioner may wish to note that the patent's front page is reprinted for petitioner's records only, and the Office's records of the patent will not be changed, except to add the certificate of correction. On the USPTO Internet web site, e.g., the original patent's front page will remain as originally printed and will not be replaced by the new front page. Petitioner should retain the original copy of the patent since the original copy is the copy, which would need to be surrendered if petitioner files a reissue application.

As stated above, petitioner's deposit account will be charged $130 for the request under 37 CFR 3.81(b), $100 for the Certificate of Correction, and $200 for the reprinting of the front page of the Letters Patent.

This matter is being referred to the Certificate of Correction Branch for appropriate processing of a certificate of correction to be placed in the archives of the USPTO. The Certificate of Correction should change the title of the invention from "Method For Oxidizing Mixtures" to "Catalyst Composition And Method For Oxidizing Mixtures." In addition, the Certificate of Correction should delete the name of the assignee since an assignee does not exist. Afterwards, the matter will be referred to the Publishing Division for reprinting of the front page of the original Letters Patent.

Telephone inquiries concerning this decision should be directed to Paralegal Liana Chase at (571) 272-3206. Telephone inquiries regarding the reprinting of the front page of the Letters Patent should be directed to the Publishing Division at (703) 308-7385.



Charles Steven Brantley
Petitions Attorney
Office of Petitions

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WASHINGTON, D.C. 20231
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Paper No. 6

SYNGENTA BIOTECHNOLOGY INC
PATENT DEPARTMENT
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

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AUG 0 2 2002

OFFICE OF PETITIONS

In re Application of :
Erica J. Pascal et al : DECISION GRANTING
Application No. 10/087,167 : PETITION
Filed: October 24, 2001 :
Attorney Docket No. 50018A :

This is a decision on the petition under 37 CFR 1.10(c) filed May 7, 2002, requesting that the above-identified application be accorded a filing date of October 24, 2001 rather than the presently accorded filing date of March 1, 2002.

Applicants allege that the application was deposited in "Express Mail" service with the U.S. Postal Service, on October 24, 2001. In support, applicants provided, inter alia, a copy of the Express Mail label, receipt no. ET327549134US, showing a Date-In of October 24, 2001. The same Express Mail receipt number appears on the copy of the original transmittal letter submitted with the present petition. Applicants request that the application be accorded a filing date of October 24, 2001.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on October 24, 2001.

The petition is granted. The $130.00 petition fee is being credited to counsel's deposit account.

The application is being returned to Initial Patent Examination Division for correction of the filing date to October 24, 2001.

Telephone inquires specific to this matter should be directed to Wan Laymon at (703) 306-5685.

Brian Hearn
Special Projects Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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OFFICE OF PETITIONS

AGENSYS C/O MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of :
Challita-Eid et al. :
Application No. 10/087,190 : ON APPLICATION FOR
Filed: February 28, 2002 : PATENT TERM ADJUSTMENT
Atty Docket No. 511582003420 :
Title: NUCLEIC ACID AND :
CORRESPONDING PROTEIN :
ENTITLED 121P1F1 USEFUL IN :
TREATMENT AND DETECTION OF :
CANCER :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705," filed May 6, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is one hundred and fifty-eight (158) days, not one hundred and fourteen (114) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction partly on the basis that the Office will take in excess of three years to issue this patent.

In addition, applicants assert that a two-day reduction for applicant delay was made in error.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, 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 can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (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]

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that Applicants otherwise request review of the patent term adjustment, the request is **DISMISSED**.

On February 11, 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 114 days. The instant application for patent term adjustment was timely filed[2] on or before payment of the issue fee.

Applicant disputes a reduction of two days, on the basis that the amendment that placed the application in allowance was allegedly expressly requested by the Examiner.[3]

Applicant's argument has been considered, and it is not deemed to be persuasive

A final Office action was mailed on October 24, 2008, and an after-final amendment was received on December 23, 2008. The amendment failed to place the application in condition for allowance, and consequently, an advisory action was mailed on January 16, 2009. An amendment in compliance with 37 C.F.R. § 1.113(c) was not filed until January 26, 2009, which is three months and 2 days after the mailing of the final Office action. This resulted in a reduction of two days.

The period of applicant delay in taking action in response to a final Office action is calculated based on the date a reply is filed in compliance with 37 CFR 1.113(c). MPEP 2731 sets forth, *in pertinent part*:

> 37 CFR 1.703(a)(3) also pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(ii) and specifies that the period is the number of days, if any, beginning on the day after the date that is four

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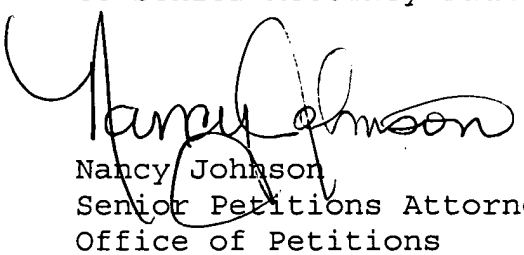
[2] PALM records indicate that the issue fee was paid on May 6, 2009.
[3] Petition, page 3.

> months after the date a reply in compliance with 37 CFR 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. A reply under 37 CFR 1.113 is a reply to a final Office action, and a reply in compliance with 37 CFR 1.113 is a reply that cancels all of the rejected claims and removes all outstanding objections and requirements or otherwise places the application in condition for allowance. Any amendment after final that does not cancel all of the rejected claims and remove all outstanding objections and requirements or otherwise place the application in condition for allowance is not a reply in compliance with 37 CFR 1.113(c).

As such, the four-month period for the Office to provide a response does not commence until an acceptable reply to the final Office action is received. Therefore, the after-final amendment of December 23, 2008 that did not place the application in condition for allowance was not a proper reply. It follows that Applicant's delay continued to run pursuant to Rule 1.704(b) until a proper reply was received (January 26, 2009), when the Office's four-month period for response commenced.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Paper No. 7

FOLEY & LARDNER
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Richard E. Jaeger | : | |
| Application No. 10/087,191 | : | DECISION GRANTING PETITION |
| Filed: February 28, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. | : | |
| QUANT1390(028248-3201) | : | |

This is a decision on the petition, filed by facsimile tranmission on April 22, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on February 28, 2003. 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 December 11, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 2811 for examination in due course.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

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OFFICE OF PETITIONS

**Morrison & Foerster LLP**
**755 Page Mill Road**
**Palo Alto, CA 94304-1018**

In re Application of
David W. Morris et al.
Application No. 10/087,192
Filed: March 1, 2002
Attorney Docket No. 529452000122

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 24, 2005.

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 April 18, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Terri Williams at 571-272-2991.

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Sagres Discovery Inc.**
**Intellectual Property-R440**
**P.O. Box 8097**
**Emeryville, CA 94662-8097**

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COMMISSIONER FOR PATENTS
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Paper No. 9

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**FEB 11 2004**

**OFFICE OF PETITIONS**

Roger Proksch
206 San Clemente
Santa Barbara, CA 93109

In re Application of :
Roger Proksch :
Application No. 10/087,196 :
Filed: February 28, 2002 :
Attorney Docket No. :

DECISION GRANTING PETITION

This is a decision on the petition filed January 29, 2004, under 37 CFR 1.10 requesting that the above-cited application be accorded a filing date of February 28, 2002, rather than the presently accorded filing date of March 1, 2002.

Petitioner alleges that the application was deposited with the Express Mail Service on February 28, 2002. In support of the allegation, the petition is accompanied by a copy of the Express Mail postcard with a tracking number ET103595955US showing a "date-in" of February 28, 2002. The tracking number cited is the same number found on the application transmittal sheet that accompanied the original application papers. The evidence is convincing that the application papers were deposited on February 28, 2002.

In view of the above, the petition is granted. The new filing date for the above-cited application is February 28, 2002.

The request that the correspondence address for the above-cited application be changed is noted, however; the request was not made the inventor, assignee, or an attorney of record. Petitioner must either file a power of attorney for Mr. Lebens or have the inventor, or assignee, authorize the change of address. In the interim, a courtesy copy of this decision is being mailed to the address as cited on the petition, but all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

The Office of Initial Patent Examination will further process the application with a filing date of February 28, 2002, and issue a corrected filing receipt.

Any inquiries related to this decision should be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc:

Thomas Lebens
Sinsheimer, Schiebelhut & Baggett
1010 Peach Street
PO Box 31
San Luis Obispo, CA 93406

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

| SERIAL NUMBER | REQUEST DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/087,198 | 4/1/02 | Daryl Real et al | 5407/2J138 |

Title:
**METHOD OF ENHANCING REPRODUCTIVE PERFORMANCE IN SOWS**

| Art Unit | Paper Number |
|---|---|
| | |

Correspondence Address:
Bert Lewen
Darby & Darby
805 Third Avenue
New York NY 10022-7513

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 528,588

Grant Date: 01-Apr-02

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**[Title 35, United States Code (1952) Sections 184, 185, 186]**