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166 Kallang Way
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Singapore 349249

**MAIL**

JUL 29 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

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|---|---|
| In re Application of: Jain, et al.<br>Application No. 10/133,941<br>Attorney Docket No. 12205/11<br>Filed: April 26, 2002<br>For: HIGH PERFORMANCE ARCHITECTURE WITH SHARED MEMORY | **DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR §1.181** |

This is a decision on the petition, filed January 13, 2005, requesting the Withdrawal of the Holding of Abandonment of the above-identified application, under 37 CFR §1.181. The instant application was held abandoned for failure to respond to the Office action (Non-Final Rejection) mailed February 25, 2004. A Notice of Abandonment was mailed on November 30, 2004.

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 statement that the Office action was not received and that a search of the file jacket and document records has been performed. Petitioner also provides a copy of the docket record "where the non-received action would have been entered". This is presumed to be ***at the address of record***, as is required. If this is not the case, the Office should be notified. Note, future submissions (of this type of petition) to the Office should include the above noted statement. Finally, Petitioner makes reference to the docket record provided in the petition filed January 13, 2005.

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 and restore the instant application to pending status, before redating and remailing the Non-Final Office action (originally mailed Feb. 25, 2004) to the applicant.

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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Paper No:__

HORIZON IP PTE LTD
166 KALLANG WAY
6TH FLOOR
SINGAPORE 34924-9 SG

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APR 17 2006
OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Jain, et al. | : | DECISION |
| Application No. 10/133,941 | : | |
| Filing Date: 26 April, 2002 | : | |
| Attorney Docket No.: 12205/11 | : | |

This is a revised decision on the petition filed on 15 March, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

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

NOTES:

(1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(It is noted, however, that Petitioner may be unable to present a satisfactory showing to support a petition under 37 C.F.R. §1.181, and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 1 August, 2005, with reply due absent an extension of time on or before 1 November, 2005;
- the application went abandoned after midnight 1 November, 2005;
- the Office mailed the Notice of Abandonment on 16 March, 2006;
- on 9 April, 2006, Petitioner filed the instant petition, with an averment that Petitioner did not receive the paper in question, a search of file did not indicate its presence, and docket records surrounding the due date of the reply did not indicate the paper was received, however, while Petitioner provided the latter general record, Petitioner did not provide the docket record of the instant application.

It further is noted that a Notice of Abandonment was mailed by the Office on 30 November, 2004, and while there as here Petitioner replied to the Notice, this is the second such petition alleging non-receipt by Petitioner in this matter in fifteen (15) months.

For this reason, the Office makes further inquiry and requests additional support for the averment of non-receipt–to include the docket record for the instant matter as referenced above–and to provide some detail as to how mail is received by Petitioner.

## 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

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[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.

the reply now to be accepted on petition.[2]

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[7]

Further, the commentary at MPEP §711.03(c) provides:

* * *

**A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action**

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the

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

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

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

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

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

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

> holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.
>
> * **
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

Thus, as of this writing Petitioner appears not to have satisfied the showing requirements described above in light of the frequency with which Petitioner seems not to receive Office actions in this matter.

## CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**, and as of this writing the 16 March, 2006, Notice of Abandonment is maintained.

A copy of the non-final Office action mailed on 1 August, 2005, is enclosed, and, in an effort to promptly advance prosecution, Petitioner should include a reply thereto with any further petition filed herein.

## ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment may be a petition alleging unintentional delay under 37 C.F.R. §1.137(b).[8]

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:[9]

By mail: Commissioner for Patents[10]
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

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[8] The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

[9] On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf .)

[10] To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

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

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

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

Encl: Copy of the 1 August, 2005, Non-Final Office Action

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/133,941 | 04/26/2002 | Raj Kumar Jain | 12205/11 | 4278 |

7590 08/01/2005

HORIZON IP PTE LTD
166 KALLANG WAY
6TH FLOOR
SINGAPORE, 349249
SINGAPORE

| EXAMINER |
|---|
| TRUONG, BAO Q |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2187 | |

DATE MAILED: 08/01/2005

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/133,941 | 04/26/2002 | Raj Kumar Jain | 12205/11 | 4278 |

7590 02/25/2004

HORIZON IP PTE LTD
166 KALLANG WAY
6TH FLOOR
SINGAPORE,
SINGAPORE

| EXAMINER |
|---|
| TRUONG, BAO Q |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2187 | 5 |

DATE MAILED: 02/25/2004

Restart 8/1/05

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

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/133,941 | JAIN ET AL. |
| | Examiner | Art Unit |
| | Bao Q Truong | 2187 |

*-- 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) 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 the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- 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 26 April 2002.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-20 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) 1-11,13-17 and 20 is/are rejected.

7)☒ Claim(s) 12,18 and 19 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 26 April 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-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

1. The instant application having Application No. 10/133,941 has a total of 20 claims pending in the application; there are 2 independent claims and 18 dependent claims, all of which are ready for examination by the examiner.

### *Oath/Declaration*

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. § 1.63.

### *Priority*

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### *Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 230, 238, and 262. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must comply with 37 CFR 3.73(b).

6. Claims 1, 2, and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 respectively of copending Application No. 10/117,668 in view of Collins (U.S. Patent No. 5,848,428).

Claim 1 and claim 1 of copending application define a method of sharing a memory module between a plurality of processors comprising:

dividing the memory module into n banks, where n = at least 2, enabling the memory module to be accessed by one or more processors simultaneously (claim 1) as dividing the

memory module into n banks, where n at least 2, wherein each bank can be accessed by one or more processors at any one time (claim 1 of copending application);

mapping the memory module to allocate sequential addresses to alternate banks of the memory (claim 1) as mapping the memory bank module to allocate sequential addresses to alternate banks of the memory (claim 1 of copending application);

storing data words in memory, wherein data words in sequential addresses are stored in alternate banks due to the mapping of the memory (claim 1) as storing data bytes in memory, wherein data bytes in sequential addresses are stored in alternate banks due to the mapping of the memory (claim 1 of copending application).

However, claim 1 differs from claim 1 of copending application by a step of providing a first signal path, the first signal path coupling a cache to a processor and the memory module when selected, the cache enabling the processor to fetch a plurality of data words from different banks simultaneously.

Collins (U.S. Patent No. 5,848,428) teaches a system wherein a signal path coupling a secondary cache to a processor and the memory module for prefetching of data and instructions from the memory module to improve performance of the computer system (see figure 2: element 208; and column 6: lines 63-67).

It would have been obvious to one having an ordinary level of skill in the art at the time the invention was made to include in the method taught by claim 1 of copending application a step of providing a first signal path, the first signal path coupling a cache to a processor and the memory module when selected, the cache enabling the processor to fetch a plurality of data words from different banks simultaneously. This would have been obvious because the speed of

a cache is relatively faster compared to that of a system memory, as well known to one having an ordinary level of skill in the art. Furthermore, by providing a cache between the processor and the system memory, data and instructions can be prefetched from the system memory into the cache in advance. Thereby, the processor can fetch a plurality of data words from different memory banks simultaneously and the overall performance of the system will be significantly improved.

Claim 2 defines a step that is clearly disclosed in claim 2 of copending application.

Claims 3-4 defines a step that is clearly disclosed in claim 3 of copending application.

*Claim Rejections - 35 USC § 102*

7. 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 –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 13 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al. (U.S. Patent No. 5,412,788).

Referring to claim 13, Collins discloses a system comprising:

a plurality of processors as plurality of commander nodes (see figure 1);

a memory module comprising n banks, where n = at least 2, wherein a bank can be accessed by one or more processors at any one time as a memory system having two stacks or structures (see figure 4A: elements S1 and S2), each stack having two banks, forming a four-way interleaved memory system (see column 7: lines 23-26); thereby each stack can be accessed by one or more processors at any one time; wherein the applicant's recited "banks" is represented by "stacks" or "structures" of Collins;

a memory map for allocating sequential addresses to alternate banks of the memory module as software interleaving even-numbered-address data words in one structure and odd-numbered-address data words in another structure (see column 6: lines 66-68; column 7: lines 1-3 and lines 23-36);

data words stored in memory, wherein data words in sequential addresses are stored in alternate banks according to the memory map as contiguous memory blocks are alternately stored in different stacks (see column 7: lines 37-41);

plurality of control logic units for enabling a processor to access a plurality of data words from different banks (see figure 5: elements 102A and 104; and column 10: lines 26-42).

As to claim 20, Collins (U.S. Patent No. 5,412,788) further discloses that the control unit comprises a signal path coupling the processor to the memory module as a system bus coupling the processors to the memory system (see figure 1).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al. (U.S. Patent No. 5,412,788) in view of Collins (U.S. Patent No. 5,848,428).

Referring to claim 1, Collins (U.S. Patent No. 5,412,788) teaches a method of sharing a memory module between a plurality of processors (see figure 1), comprising:

dividing the memory module into n banks, where n = at least 2, enabling the memory module to be accessed by one or more processors simultaneously as forming two equal-size stacks or structures (see figure 4A: elements S1 and S2; column 6: lines 61-68; and column 7: lines 1-10); wherein the applicant's recited "banks" is represented by "stacks" or "structures" of Collins;

mapping the memory module to allocate sequential addresses to alternate banks of the memory as interleaving even-numbered-address data words in one structure and odd-numbered-address data words in another structure (see column 7: lines 23-36);

storing data words in memory, wherein data words in sequential addresses are stored in alternate banks due to the mapping of the memory as placing contiguous memory blocks alternately in different stacks (see column 7: lines 37-41).

However, Collins (U.S. Patent No. 5,412,788) does not clearly teach a step of providing a first signal path, the first signal path coupling a cache to a processor and the memory module when selected, the cache enabling the processor to fetch a plurality of data words from different banks simultaneously.

Collins (U.S. Patent No. 5,848,428) teaches a system wherein a signal path coupling a secondary cache to a processor and the memory module for prefetching of data and instructions from the memory module to improve performance of the computer system (see figure 2: element 208; and column 6: lines 63-67).

It would have been obvious to one having an ordinary level of skill in the art at the time the invention was made to include in the method taught by Collins (U.S. Patent No. 5,412,788) a step of providing a first signal path, the first signal path coupling a cache to a processor and the memory module when selected, the cache enabling the processor to fetch a plurality of data words from different banks simultaneously. This would have been obvious because the speed of a cache is relatively faster compared to that of a system memory, as well known to one having an ordinary level of skill in the art. Furthermore, by providing a cache between the processor and the system memory, data and instructions can be prefetched from the system memory into the cache in advance. Thereby, the processor can fetch a plurality of data words from different memory banks simultaneously and the overall performance of the system will be significantly improved.

As to claim 2, Collins (U.S. Patent No. 5,412,788) further teaches a steps of dividing the bank into x blocks, where x = at least 1, wherein a block can be accessed by one of the plurality of processors at any one time as configuring each stacks from two banks, wherein each bank can be accessed by one of the plurality of processors in commander nodes at any one time (see column 10: lines 30-37); wherein the applicant's recited "blocks" is represented by "banks" of Collins.

As to claims 3 and 4, Collins (U.S. Patent No. 5,412,788) further teaches a steps of determining whether contention has occurred, wherein two or more processors are accessing the same address range at any one time, wherein the address range coincides with at least one block as contention occurring when a processor in a commander node has attempted to access an unavailable memory bank of a stacks (see column 11: lines 9-19).

As to claims 5 and 11, Collins (U.S. Patent No. 5,412,788) further teaches a step of synchronizing the processors to access different banks when contention has occurred, comprising inserting wait states for processors with lower priorities when contention occurs as processors which are attempting to access an unavailable memory bank, thereby causing contention, will have to wait until that memory bank is available (see column 4: lines 65-68; and column 5: lines 1-4).

As to claim 6, Collins (U.S. Patent No. 5,412,788) further teaches a step of providing a signal path coupling the processor to the memory module when selected as a system bus coupling the processors to the memory system (see figure 1).

As to claim 7, Collins (U.S. Patent No. 5,412,788) further teaches a step of activating the signal path coupling the processor to the memory module when contention has not occurred as a processor can access an available memory bank via the system bus.

As to claims 8-10, Collins (U.S. Patent No. 5,412,788) further teaches a step of synchronizing the processors to access different banks when contention has occurred, including a step of determining access priorities of the processors when contention has occurred, wherein determining access priorities comprises assigning lower access priorities to processors that have caused the contention as processors which are attempting to access an unavailable memory bank, thereby causing contention, will have to wait until that memory bank is available (see column 4: lines 65-68; and column 5: lines 1-4).

As to claim 14 and 15, Collins (U.S. Patent No. 5,412,788) further discloses that the control unit comprises a signal path coupling the processor to the memory module as a system bus coupling the processors to the memory system (see figure 1).

However, Collins (U.S. Patent No. 5,412,788) does not clearly disclose a signal path coupling a cache to a processor and the memory module.

Collins (U.S. Patent No. 5,848,428) discloses a system wherein a signal path coupling a secondary cache to a processor and the memory module for prefetching of data and instructions from the memory module to improve performance of the computer system (see figure 2: element 208; and column 6: lines 63-67); wherein the signal path comprises a cache register and a multiplexer (see figure 2: element 208; figure 3: element 308; and column 9: lines 22-31).

It would have been obvious to one having an ordinary level of skill in the art at the time the invention was made to include in the system disclosed by Collins (U.S. Patent No. 5,412,788) a signal path coupling a cache to a processor and the memory module. This would have been obvious because the speed of a cache is relatively faster compared to that of a system memory, as well known to one having an ordinary level of skill in the art. Furthermore, by providing a cache between the processor and the system memory, data and instructions can be prefetched from the system memory into the cache in advance. Thereby, the processor can fetch a plurality of data words from different memory banks simultaneously and the overall performance of the system will be significantly improved.

As to claim 16, Collins (U.S. Patent No. 5,412,788) further discloses the bank comprises x blocks, where x = at least 1, wherein a block can be accessed by one of the plurality of processors at any one time as configuring each stacks from two banks, wherein each bank can be accessed by one of the plurality of processors in commander nodes at any one time (see column 10: lines 30-37); wherein the applicant's recited "blocks" is represented by "banks" of Collins.

As to claim 17, Collins (U.S. Patent No. 5,412,788) further discloses a flow control unit for synchronizing the processors to access different blocks at any one time as an arbitration logic controls arbitration between commander nodes so that processors which are attempting to access an unavailable memory bank, thereby causing contention, will have to wait until that memory bank is available (see column 4: lines 65-68; column 5: lines 1-4; and column 15: lines 14-25).

***Allowable Subject Matter***

11. Claims 12 and 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q Truong whose telephone number is (703) 308-7090. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald A Sparks, can be reached on (703) 308-1756. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BAO QUOC TRUONG
BT
Patent Examiner
20 February 2004

Donald Sparks
Supervisory Patent Examiner
Technology Center 2100

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Commissioner for Patents
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JJGJR.: 10-07

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8 KALLANG SECTOR, EAST WING
7TH FLOOR
SINGAPORE 349282 34928-2
SINGAPORE

| | | |
|---|---|---|
| In re Application of | : | |
| Jain, et al. | : | DECISION |
| Application No. 10/133,941 | : | |
| Filing Date: 26 April, 2002 | : | |
| Attorney Docket No.: 12205/11 | : | |

This is a decision on the petition filed on 9 November, 2006, under 37 C.F.R. §1.137(b) seeking to revive an application abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

NOTE: The original petition herein was dismissed on 17 April, 2006, and the Office set a two- (2-) month period for reply, with a due date of 17 June, 2006. Petitioner included with the filing of the instant petition a general authorization of fees, and that authorization is used at this time to make current the reply filed on 9 November, 2005, and the charge of a five- (5-) month extension of time is made to Deposit Account 50-2388.

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

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[1] **NOTE: Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.**

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 1 August, 2005, with reply due absent an extension of time on or before 1 November, 2005;
- the application went abandoned after midnight 1 November, 2005;
- the Office mailed the Notice of Abandonment on 16 March, 2006;
- on 9 April, 2006, Petitioner filed the original petition, with an averment that Petitioner did not receive the paper in question, a search of file did not indicate its presence, and docket records surrounding the due date of the reply did not indicate the paper was received, however, while Petitioner provided the latter general record, Petitioner did not provide the docket record of the instant application–and so the original petition was dismissed on 17 April, 2006;[2]
- the instant petition (with fee), reply in the form of an amendment and statement of unintentional delay seek to overcome these deficiencies.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[3]

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[2] It further was noted at that time that a Notice of Abandonment was mailed by the Office on 30 November, 2004, and while there as here Petitioner replied to the Notice, this is the second such petition alleging non-receipt by Petitioner in this matter in fifteen (15) months. And so the Office made further inquiry and requested additional support for the averment of non-receipt–to include the docket record for the instant matter as referenced above–and to provide some detail as to how mail is received by Petitioner. Petitioner instead elected to file the instant petition.

[3] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

**§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.**
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any

## 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).[4]

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.[5]

Delays in responding properly raise the question whether delays are unavoidable.[6] Where there is

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false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[4] 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.

[5] 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.

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

a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[7] And the Petitioner must be diligent in attending to the matter.[8] 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.[9]))

As to the Allegation
of Unintentional Delay

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

It appears that Petitioner has satisfied the requirements of the regulation.

## CONCLUSION

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

The instant application is released to Technology Center 2100 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[10]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.),

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

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

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

[10] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.

regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of:
FITZMAURICE, GEORGE WILLIAM, et al.
Application Serial No.: 10/183,945
Filed: June 28, 2002
For: **WIDGETS DISPLAYED AND OPERABLE ON A SURFACE OF A VOLUMETRIC DISPLAY ENCLOSURE**

DECISION
ON PETITION

This is a decision on the petition to withdraw the final action as premature, filed February 11, 2008, which is being treated as a petition pursuant to 37 CFR § 1.181.

Petitioner alleges that the examiner erred in holding the Office action mailed February 25, 2005 final and requests withdrawal of finality of the Office action. It has been contended by the petitioner that it is unclear whether claim 28 is being rejected over Microsoft Windows 95 and if so on what grounds.

A review of the file record reveals that a non-final Office action was mailed on March 16, 2007 rejecting: claims 1, 2, 4, 5, 8-10, 12, 14, 15, 17-25, and 28 as being unpatentable over Sullivan (USPN 6,100,862) in view of Cosman (USPN 5,850,225). On page 7 of the office action, it states "In regard to claim 28 the rationale disclosed in the rejection of claim 1 is incorporated herein.". On page 3 of the office action, in reference to the rejection of claim 1, the action identifies the Sullivan reference as referring to Microsoft Windows 95 (col. 6 lines 34-43; Fig. 1) on more than one occasion.

On July 16, 2007, applicant filed an amendment which added the limitation "allowing a user to operate the two-dimensional graphical user interface" to claims 1 and 28.

On October 09, 2007, a final Office action was mailed again rejecting claims 1, 2, 4, 5, 8-10, 12, 14, 15, 17-25, and 28 as being unpatentable over Sullivan in view of Cosman. Again in reference to the rejection of claim 1, on page 2 the action identifies the Sullivan reference as referring to Microsoft Windows 95 on more than occasion. On page 4 first full paragraph of the office action, a further elaboration of Microsoft Windows 95 in a 3D environment using a 2D GUI is made. In reference to claim 28, on page 7 of the office action it again states "In regard to claim 28 the rationale disclosed in the rejection of claim 1 is incorporated herein.". In the paragraph bridging pages 7 and 8 the further elaboration of Microsoft Windows 95 is reiterated.

The issue here is the appropriateness of the final Office action mailed October 09, 2007.

MPEP §706.07(a) [R-1] Final Rejection, When Proper on Second Action, states in part:...

> 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).

In the instant application, the same rejection of claims 1, 2, 4, 5, 8-10, 12, 14, 15, 17-25, and 28 as being unpatentable over Sullivan in view of Cosman was made in both the non-final rejection mailed March 16, 2007 and the final rejection of October 09, 2007. In both rejections, the Sullivan reference was clearly identified as suggesting the use of Microsoft Windows 95 for the rejection of claim 1 and the rejection of claim 28 clearly indicated the incorporation of the rejection of claim 1 for claim 28. The addition of the explanation of Microsoft Windows 95 to the rejection of claim 28 in the final rejection, is clearly a reiteration of what was mentioned in the rejection of claim 1, which was a further elaboration of Microsoft Windows 95 in a 3D environment containing a 2D GUI. Reference to Microsoft Windows 95 is clearly identified in the Sullivan reference (col. 6 lines 34-43) and therefore is not a newly introduced reference. It is clear the rejection of claim 28 in the final rejection remains Sullivan in view of Cosman.

Accordingly, given that the final rejection of claim 28 is the same rejection given in the non-final rejection, the petition to hold the outstanding finality of the Office action as being premature, is **Denied**.

The three month shortened statutory period for response set forth in the Final Office action of October 09, 2007 plus a one month extension given on February 11, 2008 continues to run. The application is being forwarded to the examiner for consideration of the Amendment After Final filed February 11, 2007.

Andrew I. Faile, Director
Technology Center 2600
Communications

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SUITE 1600
CHICAGO, IL 60603-3406

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Ahmad Akashe et al :
Application No. 10/133,955 :
Filed: April 26, 2002 :
Attorney Docket No. 67394 :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Office action mailed March 9, 2004, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on April 10, 2004.

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

The matter is being referred to Technology Center AU 1761 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 6

PAUL DAVIS
HELLER EHRMAN WHITE & McAULIFFE
275 MIDDLEFIELD ROAD
MENLO PARK, CA 94025

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OFFICE OF PETITIONS

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| In re Application of | : |
| Ali Kheirolomoom et al | :DECISION DISMISSING PETITION |
| Application No. 10/133,964 | :FOR SUSPENSION OF RULE |
| Filed: April 24, 2002 | : |
| Attorney Docket No. 39212-0002 | : |

This is a decision on the petition filed on August 28, 2002, which is being treated as a petition requesting that the requirement of 37 CFR 1.213(a)(1) be waived or suspended pursuant to 37 CFR 1.183 in order to file a nonpublication request after the filing of the above-identified application. The petition was accompanied by a nonpublication request and the petition fee.

The petition is dismissed as moot since this application published as Publication Number US0030004746A1 on January 2, 2003.

37 CFR 1.183 provides that, in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner. 35 U.S.C. § 122(b) requires the United States Patent and Trademark Office (USPTO) to publish utility and plant applications filed on or after November 29, 2000, unless applicant makes a nonpublication request upon filing. The requirement that a nonpublication request must be made upon filing of the application is set forth in the statute. *See* 35 U.S.C. § 122(b)(2)(B)(i). Therefore, the USPTO does not have the authority to waive this requirement. Accordingly, the nonpublication request filed with the petition has not been recognized.

If applicant desires to avoid publication of the above-identified application, he may file a continuation application under 37 CFR 1.53(b) claiming benefit to the above-

identified application under 35 U.S.C. 120 with a nonpublication request and, thereafter, abandon the above-identified application by filing a petition under 37 CFR 1.138(c) for express abandonment to avoid publication, including a petition fee ($130.00). This petition should be mailed to Box PGPUB-ABD or faxed to the Pre-Grant Publication Division at (703) 305-8568.

This application is being forwarded to Technology Center AU 3621 for examination in due course.

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

Frances Hicks

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

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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**OFFICE OF PETITIONS**

In re Application of :
Gregory T. Thompson et al :
Application No. 10/133,970 : ON PETITION
Filed: April 26, 2002 :
Attorney Docket No. 9415/9048

This is a decision on the petition, filed November 9, 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 8, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

This matter will be forwarded to Technology Center AU 3661 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

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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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Peter G. Pappas
Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996

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| In re Application of | : | |
| Christian Pierre, et. al. | : | |
| Application No. 10/133,989 | : | ON PETITION |
| Filed: April 26, 2002 | : | |
| Attorney Docket No. 25040-0180 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed on December 2, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed August 23, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned after midnight November 23, 2004.

In response, petitioner submitted with the instant petition $1,370 for the petition to revive fee, $1,370 for the issue fee, $300 for the publication fee, and $30 for ten (10) advance soft copies.

The petition is **GRANTED**.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DANIEL FISHMAN**
**DUFT BORNSEN & FISHMAN, LLP**
**1526 SPRUCE STREET**
**SUITE 320**
**BOULDER, CO 80302**

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Scott Collins et al. | : | |
| Application No. 10/134,022 | : | DECISION ON PETITIONS |
| Filed: April 25, 2002 | : | 37 CFR 1.137(b) |
| Attorney Docket No. 396045 | : | |

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

The petition is **GRANTED**.

This application became abandoned, by operation of law, for failure to timely reply within the three month shortened statutory period set in the non-final Office Action mailed September 21, 2004. No timely filed extensions of time were obtained pursuant to the provisions of 37 CFR §1.136(a). The date of abandonment of this application is December 22, 2004. A notice of abandonment was mailed on May 20, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR §1.137(b) in that (1) the reply (amendment); (2) the petition fee of $750.00 (small entity) and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Non-Final office action mailed September 21, 2004 is accepted as having been unintentionally delayed.

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

A telephonic inquiry was made to the office of attorney Daniel Fishman concerning the address of record. It was confirmed via telephone that the correct address includes suite 302 and not

suite 320. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate correspondence address change 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.

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 $ 510.00 extension of time submitted with the petition on August 17, 2005 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 Angela Ortiz at (571) 272-6051, or in her absence, the undersigned at (571) 272-3217.

This matter is being referred to Technology Center Art Unit 2671 for appropriate action on the concurrently filed response.

Frances Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions

Cc: **DANIEL FISHMAN**
**DUFT BORNSEN & FISHMAN, LLP**
**1526 SPRUCE STREET**
**SUITE 302**
**BOULDER, CO 80302**

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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WITHROW & TERRANOVA PLLC
P O BOX 1287
CARY, NC 27512

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| | | |
|---|---|---|
| In re Application of | : | |
| Ewald Michael | : | |
| Application No. 10/134,023 | : | DECISION ON PETITION |
| Filed: April 26, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 1011-001-007 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 8, 2005.

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

A review of the file record indicates that the power of attorney received July 22, 2002 to Benjamin S. Withrow, Steven N. Terranova, and Taylor M. Davenport of the firm of Withrow and Terranova, PLLC, has been revoked by the assignee of the patent application on February 13, 2006.[1] Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Jenkins, Wilson, Taylor & Hunt, PA
3100 Tower Boulevard
Suite 1200
Durham, NC 27707

[1] It is noted that the power of attorney was not accompanied by a certificate under 37 CFR 3.73(b). However, the July 22, 2002 power of attorney was accompanied by an acceptable certificate under 37 CFR 3.73(b).

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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LAW OFFICE OF DALE B. HALLING,
LLC
655 SOUTHPOINTE COURT, SUITE 100
COLORADO SPRINGS, CO 80906

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SEP 01 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of | : | |
| Christopher Lockton Brandin | : | |
| Application No. 10/134,030 | : | DECISION |
| Filed: April 26, 2002 | : | ON PETITION |
| Attorney Docket Number: | : | |
| NEO-0201 | : | |

This is a decision on the Petition to Revive an Unintentionally Abandoned Application Under 37 CFR 1.137(b), filed January 4, 2006. The delay in treating this petition is regretted.

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed April 20, 2005. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). Applicant filed a reply on September 26, 2005; however, the reply failed to place the application in condition for allowance. Applicant was so notified in an Advisory Action, mailed October 13, 2005. No timely and proper reply having been received, the application became abandoned May 25, 2005. A Notice of Abandonment was mailed July 21, 2005.

With the instant petition, Applicant has filed a Notice of Appeal, and a Pre-Appeal Brief Request for Review. IAW 12 OG 67, the file is being referred to Technology Center 2168 for review of the applicant's remarks and the examiner's rejections.

Telephone inquiries related to this decision may 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

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DEC 19 2002

OFFICE OF PETITIONS

In re Application of
Kisich et al.
Application No. 10/134,039
Filed: April 25, 2002
Attorney Docket No. 2879-69-1

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.10(c), filed November 18, 2002, requesting that the above-identified application be accorded a filing date of April 25, 2002, rather than the presently accorded filing date of April 26, 2002.

Petitioner alleges that the application was deposited in Express Mail service on April 25, 2002. In support of the allegation, the petition is accompanied by a copy of Express Mail label No. EL822583438US. The Express Mail label contains a United States Postal Service (USPS) stamp of April 25, 2002. The same Express Mail label number was placed on the original application papers located in the official file.

In view of the above, the petition is **granted**. No petition fee is necessary.

This application file will be forwarded to the Office of Initial Patent Examination for correction of the filing date to April 25, 2002, and the mailing of a corrected filing receipt.

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
P.O. Box 1450
Alexandria, VA 22313-1450
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**COURTNEY STANIFORD & GREGORY LLP**
**P.O. BOX 9686**
**SAN JOSE CA 95157**

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AUG 17 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Sanjeev DHEER, et al | : | |
| Application No. 10/134,046 | : | ON PETITION |
| Filed: April 26, 2002 | : | |
| Attorney Docket No. CSHE.P009 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 24, 2009, 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 October 15, 2008. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is January 16, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3695 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.

Thurman K. Page
Petitions Examiner
Office of Petitions

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/134,054 | 04/26/2002 | Richard T. Schumacher | 07985-030003 |

JOHN W. FREEMAN, ESQ.
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

OIPE JC160
AUG 1 4 2002
PATENT & TRADEMARK OFFICE

**CONFIRMATION NO. 4027**

**FORMALITIES LETTER**

*OC000000008233663*

Date Mailed: 06/05/2002

# NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

**FILED UNDER 37 CFR 1.53(b)**

***Filing Date Granted***

**Items Required To Avoid Abandonment:**

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

- The oath or declaration is missing.
  *A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of $65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.

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

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

- Substitute drawings in compliance with 37 CFR 1.84 because:
  - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. ( 5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);
  - drawings have a line quality that is too light to be reproduced (weight of all lines and letters must be heavy enough to permit adequate reproduction) or text that is illegible (reference characters, sheet numbers, and view numbers must be plain and legible) see 37 CFR 1.84(l) and (p)(1));

**Items Required To Avoid Processing Delays:**

08/15/2002 SSITHIB1 00000125 10134054

02 FC:205 65.00 OP

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

**SUMMARY OF FEES DUE:**

Total additional fee(s) required for this application is **$65** for a Small Entity

- **$65** Late oath or declaration Surcharge.

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*A copy of this notice MUST be returned with the reply.*

Todd

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

10134054.081402

O I P E JC100
AUG 1 4 2002
PATENT & TRADEMARK OFFICE

0410 08-23-02 MPE

Attorney's Docket No.: 07985-030003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lawrence et al.
Serial No. : 10/134,054
Filed : April 26, 2002
Title : MULTICHAMBER DEVICE FOR PROCESSING OF BIOLOGICAL SAMPLES USING HIGH PRESSURE

Art Unit : 1743
Examiner :

**BOX MISSING PARTS**
Commissioner for Patents
Washington, D.C. 20231

**COPY OF PAPERS ORIGINALLY FILED**

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

In response to the Notice to File Missing Parts of Application under 37 U.S.C. §1.53(b) mailed June 6, 2002 (copy enclosed), applicants claim small entity status (see 37 CFR 1.27) and submit herewith the following:

- ☒ A check in the amount of $65 is attached for payment of the surcharge for late filing of the basic filing fee and/or declaration;
- ☒ A Combined Declaration and Power of Attorney in compliance with 37 CFR §1.63;
- ☒ Petition for Extension of Time with check for $55.00 for the required fee.

It is understood that this perfects the application and no additional papers or filing fees are required. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 8, 2002

Reg. No. 30,175
Celia H. Leber
Reg. No. 33,524

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20487797.doc

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 8, 2002
Date of Deposit

Signature

Julia Doherty
Typed or Printed Name of Person Signing Certificate

OIPE JC180
AUG 1 4 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS
ORIGINALLY FILED

Attorney's Docket No.: 07985-030003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lawrence et al.
Serial No. : 10/134,054
Filed : April 26, 2002
Title : MULTICHAMBER DEVICE FOR PROCESSING OF BIOLOGICAL SAMPLES USING HIGH PRESSURE

Art Unit : 1743
Examiner :

**Attention: Official Draftsman**
Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL OF FORMAL DRAWINGS

Please substitute the enclosed 18 sheets of formal drawings for the corresponding drawings presently in the application.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 8, 2002

Reg. No. 30,175
Celia H. Leber
Reg. No. 33,524

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20488514.doc



CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 8, 2002
Date of Deposit

Signature

Julia Doherty
Typed or Printed Name of Person Signing Certificate

O I P E JC180
AUG 1 4 2002
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Attorney Docket No.: 07985-030003

3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lawrence et al.
Serial No. : 10/134,054
Filed : April 26, 2002
Title : MULTICHAMBER DEVICE FOR PROCESSING OF BIOLOGICAL SAMPLES USING HIGH PRESSURE

Art Unit : 1743
Examiner :

Commissioner for Patents
Washington, D.C. 20231

PETITION FOR ONE-MONTH EXTENSION OF TIME

Pursuant to 37 CFR §1.136, applicants hereby petition that the period for response to the action dated June 5, 2002, be extended for one month to and including September 5, 2002.

Enclosed is a check for $55 for the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 8, 2002

Reg. No. 30,175
Celia H. Leber
Reg. No. 33,524

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20487446.doc

08/15/2002 SSITHIB1 00000125 10134054
01 FC:215 55.00 OP

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I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 8, 2002
Date of Deposit

Signature

Julia Doherty
Typed or Printed Name of Person Signing Certificate

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DAVID A. JAKOPIN**
**PILLSBURY WINTHROP**
**1600 TYSONS BOULEVARD**
**MCLEAN, VA 22102**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Lukas P.P.P. van Ginneken | : | |
| Application No. 10/134,076 | : | NOTICE |
| Filed: April 24, 2002 | : | |
| Attorney Docket No. 054355 0293219 | : | |

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 2825.

Wan Layton
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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**JOHN IMPERANTE**
**2170 LUKE EDWARDS ROAD**
**DACULA GA 30039**

COPY MAILED

MAR 04 2009

OFFICE OF PETITIONS

In re Patent No. 6,756,034 :
Issue Date: June 29, 2004 :
Application.No. 10/134,089 :
Filed: April 29, 2002 :
Attorney Docket No. PCR-010 :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed September 2, 2008 to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on June 30, 2008 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.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. Petitioner should note that a change of correspondence address would not affect the fee address. Therefore, if petitioner desires to receive future correspondence, which **may** be mailed regarding maintenance fees for the above-identified patent, the "fee address" and/or "customer number" forms should be submitted. Further, 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, petitioner has submitted $1,705.00 towards the required $1,640.00 surcharge fee. Accordingly, the overage of $65.00 will be refunded via treasury check in due course.

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

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: John Imperante
60 Fourth Street
Somerville NJ 08876

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. 4

FISH & RICHARDSON P.C.
4350 La Jolla Village Dr., Suite 500
San Diego, CA 92122

MAY 14 2003

| | | |
|---|---|---|
| In re Application of<br>Victor Koretsky<br>Application No. 10/134,090<br>Filed: April 25, 2002<br>For: INTEGRATED CIRCUIT HAVING REDUNDANT, SELF-ORGANIZED ARCHITECTURE FOR IMPROVED YIELD | : | DECISION ON REQUEST TO WITHDRAW FROM RECORD |

This is a decision on the request filed by John C. Phillips to withdraw as attorney/agent of record pursuant to 37 C.F.R. § 1.36 filed on March 25, 2003, via facsimile transmission. Mr. Phillips signed on behalf of all attorneys/agents of record in this application.

The request is **APPROVED** for the withdrawal of all of the attorneys/agents presently of record. The withdrawal is effective as of the date of this letter not when the request for withdrawal was filed.

The application currently has no attorney/agent of record.

As requested, all future communications from the Office will be directed to D.S.P. Group Ltd. at the address provided below unless otherwise notified by applicant.

Edward Westin

Edward Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: D.S.P. GROUP LTD.
5 Shenkar Street
P.O. Box 2019
Herzelia Pituach 46120
Israel
AIR MAIL

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Paper No. 5

Lerner and Greenberg, P.A.
P. O. Box 2480
Hollywood, FL 33022-2480

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of
Andreas Schlögl, et al.
Application No. 10/134,113
Filed: April 29, 2002
Attorney Docket No. MUH-12135

ON PETITION

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 the non-signing inventor has refused to join in the filing of the above-identified application.

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

As provided in 37 CFR 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the declaration and 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.

Telephone inquiries regarding this decision should be directed to Marianne Morgan at (703) 306-3475.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Markus Vossebürger
Im Gefilde 5
D-81739 München,
Germany

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of
Andreas Schlögl; Markus Schmitt; Hans-Joachim Schulze; Markus Vossebürger; and Armin Willmeroth
Application No. 10/134,113
Filed: April 29, 2002
For: SEMICONDUCTOR COMPONENT WITH ENHANCED AVALANCHE RESISTANCE

Dear Markus Vossebürger:

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: Lerner and Greenberg, P. A.
P. O. Box 2480
Hollywood, FL 33022-2480

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Armin Willmeroth
Schwangaustraße 25
D-86163 Augsburg,
Germany

COPY MAILED

APR 1 4 2003

OFFICE OF PETITIONS

In re Application of
Andreas Schlögl; Markus Schmitt; Hans-Joachim Schulze; Markus Vossebürger; and Armin Willmeroth
Application No. 10/134,113
Filed: April 29, 2002
For: SEMICONDUCTOR COMPONENT WITH ENHANCED AVALANCHE RESISTANCE

Dear Armin Willmeroth:

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: Lerner and Greenberg, P. A.
P. O. Box 2480
Hollywood, FL 33022-2480

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Andreas Schlögl
Kleiststraße 19
D-85521 Ottobrunn,
Germany

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of
Andreas Schlögl; Markus Schmitt; Hans-Joachim Schulze; Markus Vossebürger; and Armin Willmeroth
Application No. 10/134,113
Filed: April 29, 2002
For: SEMICONDUCTOR COMPONENT WITH ENHANCED AVALANCHE RESISTANCE

Dear Andreas Schlögl:

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: Lerner and Greenberg, P. A.
P. O. Box 2480
Hollywood, FL 33022-2480

UNITED STATES 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.: 09-05

Paper No:10

INTERNATIONAL BUSINESS
MACHINES CORPORATION
DEPT. 18G
BLDG. 300-482
2070 ROUTE 52
HOPEWELL JUNCTION NY 12533

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Sunaga, et al. | : | DECISION |
| Application No. 10/134,143 | : | |
| Filing Date: 26 April, 2002 | : | |
| Attorney Docket No. JP920010097US1 | : | |

This is a revised decision on the petition filed on 23 October, 2003, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, alternatively 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. §1.181 is **DISMISSED**; and
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES:

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

(It is noted, however, that Petitioner may be unable to present a satisfactory

showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a "Notice to File Corrected Application Papers" (as to a discrepancy between the foreign application listed on the file (Japan 2001 199593) and the certified copy contained in the file (Japan 2001 130481)) prepared for mailing on 11 July, 2003, but either not mailed until or remailed on 23 September, 2003, with a non-extendable 30-day reply period set and therefore with a reply due on or before 23 October, 2003;

- the application went abandoned after midnight 23 October, 2003;

- no Notice of Abandonment is found in the file, although the Office database indicates that one was mailed on 23 September, 2003;

- on 23 October, 2003, Petitioner filed corrected drawings–although the Certificate of Mailing is dated 8 July, 2003, along with the instant request to withdraw the holding of abandonment, alternatively a petition to revive alleging unavoidable delay, under the provisions of 37 C.F.R. §1.137(a).

Copies of the 11 July, 2003, Notice and the 23 September, 2003, coversheet were transmitted to Petitioner via FAX on 16 September, 2003, and also are included with this decision.

## 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

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[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.

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

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[7]

The commentary at MPEP §711.03(c) provides:

> **A. *Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action***
>
> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in

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

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

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

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

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

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

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). (Emphasis supplied.)

Petitioner has not satisfied the requirements described (and highlighted) above.

As to Allegations
of Unavoidable Delay

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

Petitioner has failed to satisfy the "showing" and "reply" requirements as to a petition under 37 C.F.R. §1.137(a).

## CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**; further, the petition under 37 C.F.R. §1.137(a) must be **dismissed**, because Petitioner has failed to satisfy the showing and reply requirement under the regulation. The petition fee (then set at $110.00) is now charged to Deposit Account 09-0458, as authorized.

Further correspondence with respect to this matter should be addressed as follows:[8]

By mail: Commissioner for Patents[9]
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

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[8] 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. (For further information. see: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf .)

[9] To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

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

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

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

Encl.: 11 July, 2003, Notice and 23 September 23, 2003 coversheet

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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JJGJR.: 02-06

Paper No:12

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**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Sunaga, et al. | : | DECISION |
| Application No. 10/134,143 | : | |
| Filing Date: 26 April, 2002 | : | |
| Attorney Docket No. JP920010097US1 | : | |

This is a revised decision on the petition filed on 11 October, 2005, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, alternatively alleging unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below:

- the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; and
- the petition under 37 C.F.R. §1.137(b) is **GRANTED** and the petition fee ($1,500.00) is charged as authorized to Deposit Account 09-0458.

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a "Notice to File Corrected Application Papers" (as to a discrepancy between the foreign application listed on the file (Japan 2001 199593) and the certified copy contained in the file (Japan 2001 130481)) prepared for

mailing on 11 July, 2003, but either not mailed until or remailed on 23 September, 2003, with a non-extendable 30-day reply period set and therefore with a reply due on or before 23 October, 2003;

- the application went abandoned after midnight 23 October, 2003;
- no Notice of Abandonment is found in the file, although the Office database indicates that one was mailed on 23 September, 2003;
- on 23 October, 2003, Petitioner filed corrected drawings–although the Certificate of Mailing is dated 8 July, 2003, along with the instant request to withdraw the holding of abandonment, alternatively a petition to revive alleging unavoidable delay, under the provisions of 37 C.F.R. §1.137(a), and both petitions were dismissed on 19 September, 2005, for failure to satisfy the requirements of the respective rules;
- on renewed petition, Petitioner is unable to provide support for the request to withdraw the holding of abandonment, however, indicates it is likely that the drawings in question simply were not mailed due and so triggered unintentional delay, and Petitioner filed the petition, authorized the fee, made the statement of unintentional delay and with the prior petition filed the drawings as the required reply.

## 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]

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[1] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[7]

Petitioner has not satisfied the Delgar requirements.

As to Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional 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 regulatory requirements as to a petition under 37 C.F.R. §1.137(b).

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

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

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

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

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

## CONCLUSION

Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**.

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

The instant application is forwarded to Technology Center 2800 for further processing in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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| In re Application of | : | |
| Sunaga, et al. | : | |
| Application No. 10/134,143 | : | DECISION |
| Filed: 26 April, 2002 | : | |
| Attorney Docket No. JP920010097US1 | : | |

This is a decision on the petition, filed 11October 2006, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application, and in the alternative to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **DISMISSED** –and the file is returned to Technology Center/AU 2824 for further processing in due course.

As to the Request to Withdraw
the Holding of Abandonment

A proper showing requires at the very minimum: a statement from practitioner stating that the Office action was not received by the practitioner; a statement from the practitioner attesting to the fact that a search of the file jacket and docket records for the application indicates that the Office action was not received with a copy of those docket records; and a **brief** statement of the calendaring process and a copy of the due-date (calendar) docket record(s) where the nonreceived Office action would have been scheduled for reply had it been received must be attached to and referenced in the practitioner's statement.

Alternatively, for a showing of timely and proper reply: a statement from practitioner stating that the reply was timely submitted by the practitioner; and copies of all papers submitted as and/or in support of that reply, with/and a copy of the date-stamped receipt card, Office FAX receipt acknowledgement (not simply Petitioner's FAX transmittal), or EFS receipt acknowledgment from the Office, along with practitioner's attestation as to the correctness/completeness of his/her records.

The showing(s) must include that of the person(s) with first-hand knowledge and an acknowledgment by the Petitioner that he/she has reviewed that information in compliance with his/her duty of candor to the Office.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.).

## BACKGROUND

The record reflects as follows:

This application was held abandoned for Petitioner's (former Counsel's) following Petitioner failed to reply timely and properly to a Notice to File Corrected Application Papers (as to a discrepancy between the foreign application listed on the file (Japan 2001 199593) and the certified copy contained in the file (Japan 2001 130481)) prepared for mailing on 11 July, 2003, but either not mailed until or re-mailed on 23 September, 2003, with a non-extendable 30-day reply period set and therefore with a reply due on or before 23 October, 2003.

The application went abandoned after midnight 23 October, 2003;

No Notice of Abandonment is found in the file, although the Office database indicates that one was mailed on 23 September, 2003.

On 23 October, 2003, Petitioner filed corrected drawings, although the Certificate of Mailing is dated 8 July, 2003, along with the instant request to withdraw the holding of abandonment, alternatively a petition to revive alleging unavoidable delay, under the provisions of 37 C.F.R. §1.137(a), and both petitions were dismissed on 19 September, 2005, for failure to satisfy the requirements of the respective rules;

On renewed petition filed on 11 October, 2005, Petitioner was unable to provide support for the request to withdraw the holding of abandonment, however, indicated it is likely that the drawings

in question simply were not mailed due and so triggered unintentional delay, and Petitioner filed the petition, authorized the fee, made the statement of unintentional delay and (with the prior petition) filed the drawings as the required reply—and so the petition under 37 C.F.R. §1.137(b) alleging unintentional delay was granted on 16 February, 2006.

For reasons wholly unknown, it appears that the earlier petitions of 11 October, 2005, have been re-filed on 11 October, 2006.

In reality, there are no issues to decide—the application is pending status and has been so since 16 February, 2006.

The guidance in the Commentary at MPEP §711.03( c) sets forth the showing requirements for overcoming the presumptions herein.[1]

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[1] The guidance in the Commentary at MPEP §711.03( c) as to non-received Office actions and timely filed replies is as follows:

***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 **>describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

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 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.<

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.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation– since all owe to the Office the continuing duty to disclose.[2]

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

(*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," alternative "A Reply Was Timely Filed"; see also: "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).)

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[3] (See, also, the commentary at MPEP §711.03(c)(I)(A) and (B).)

And the regulation requires that relief be sought within two (2) months of the act complained of.

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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.

[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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

There is no issue undecided.

Allegations as to Abandonment
Due to Unintentional Delay

As indicated earlier, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.).

There is no issue undecided.

CONCLUSION

The petition under 37 C.F.R. §1.181 is **dismissed as moot**; the petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The instant application is released to Technology Center/AU 2824 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision—and it is noted that all inquiries with regard to that change in status should be directed to the Technology Center/AU where that change of status must be effected.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

[4] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIXON PEABODY, LLP
401 9TH STREET NW, SUITE 900
WASHINGTON DC 20004-2128

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JUL 3 1 2008

**OFFICE OF PETITIONS**

In re Application of :
**INUKAI**, Kazutaka :
Application No. 10/134,143 : DECISION GRANTING PETITION
Filed: April 26. 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **JP920010097US1** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 30, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

***Petitioner is advised that the issue fee paid on September 3, 2003 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2824for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Monica A. Graves
Petitions Examiner
Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment of the application.*

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Mailed: 7/15/05

NE

In re application of
Draheim et al.
Serial No. 10/134,150
Filed: April 29, 2002
For: REMOVABLE ANTIREFLECTION FILM

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT filed September 22, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of December 17, 2003, for failure to timely file a proper reply to the Office letter mailed July 21, 2003, be withdrawn since applicants did timely file a response by facsimile transmission on July 31, 2003.

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the evidence presented reveals that applicant's response was properly filed on July 31, 2003. The evidence provided includes a Certification of Facsimile Transmission dated July 31, 2003. Any holding of abandonment for failure to timely file a proper reply to the Office letter mailed July 21, 2003, therefore, is hereby vacated.

In view of the Notice of Rescinded Abandonment previously mailed by the USPTO on December 8, 2004, the application was returned to pending status. The application shall be forwarded to the examiner for an action of the merits for group I claims 1-36. Accordingly, the Petition is **DISMISSED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

KIRKPATRICK & LOCKHART, LLP
75 State Street
Boston, Massachusetts 02109

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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DALINA LAW GROUP, P.C.
7910 IVANHOE AVE. #325
LA JOLLA, CA 92037

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OFFICE OF PETITIONS

In re Application of

Cotman, et al.

Application No. 10/134,157

Filed: April 25, 2002

Attorney Docket No. 86200.911

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed January 25, 2006.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

This application was held abandoned on April 10, 20005, after it was believed that no response was received to the restriction/election requirement mailed March 9, 2005. The notice allowed a period for reply of one (1) month from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on December 29, 2005, indicating that a reply to the notice was not received.

A review of the record reveals that a communication titled, "Request for Extension of Time, Response to Restriction under 35 USC 121" intending to be responsive to the election/restriction requirement was received on May 9, 2005, as evidenced by a review of the application file record. Applicant obtained an extension of time within the first month making the response filed May 9, 2005, timely. Based on the aforementioned, it appears that the application was improperly held abandoned as a response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

Further inquires regarding this decision may be directed to the undersigned at (571) 272-3222.

The application file is being forwarded Technology Center 2600, GAU 2621, for further processing.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

PAUL W. BUSSE
FAEGRE & BENSON, LLP
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55401-3901

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JAN 03 2003

OFFICE OF PETITIONS

In re Application of
HARJIT BHAMBRA
Application No. 10/134,168
Filed: April 26, 2002
Attorney Docket No. A35142-065838.0338

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

This is in response to the petition filed August 5, 2002 (certificate of mail date), under 37 CFR 1.47 (b) in response to the Notice to File Missing Parts mailed June 7, 2002.

The petition under 37 CFR 1.47 (b) 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).

On April 26, 2002 the above identified application was filed naming Harjit Bhambra as the sole inventor but without an Oath or Declaration. Accordingly, a Notice to File Missing Parts was mailed June 7, 2002.

The petition filed August 5, 2002 states that Mr. Bhambra could not be located. The petition asserts that the assignee, Kodak Polychrome Graphics LLC will be irreparably damaged if the petition is not granted and sets forth the last known address of the inventor.

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), and (5) set forth above.

As to item (1), the Rule 47 applicant has failed to show that the inventor cannot be reached. Applicant has simply stated that the declaration and power of attorney were mailed to the last known address and returned by FEDEX as undeliverable. The applicant shows by affidavit of the prior attorney of record that the same materials were sent to the same address a second time. These attempts fail to prove diligence in trying to locate Harjit Bhambra. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached.

The evidence is not sufficient to prove that the non-signing inventor cannot be located.

It should be noted also that the rule requires that a copy of the application papers should be sent to the last known address of the non-signing inventor with a request that he sign the declaration for the patent application. The applicant should be careful to send the complete application package (Specification, claims, drawings etc.). Assuming diligent efforts had been used to located the non-signing inventor, unless Mr. Bhambra was presented with a copy of the application papers (specification, claims and drawings), Mr. Bhambra would not be able to attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given.

As to item (5), the Rule 47 applicant fails to show provide proof that Kodak Polychrome Graphics LLC 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 (company), 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;

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

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

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

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

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

PAUL W. BUSSE
FAEGRE & BENSON, LLP
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS MN 55401-3901

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OFFICE OF PETITIONS

In re Application of
Harjit Bhambra
Application No. 10/134,168
Filed: April 26, 2002
Attorney Docket No. A35142-065838.0338

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

In response to a "Decision Refusing Status Under 37 CFR 1.47(b)" mailed on January 3, 2003, petitioner filed a request for reconsideration on March 3, 2003 and on May 2, 2003, a Declaration signed by the previously nonsigning inventor, Harjit Bhambra.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(b) is moot, the request for reconsideration filed March 3, 2003 will not be considered. 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).

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 Petitions Attorney at (703) 305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

FAEGRE & BENSON LLP

2200 WELLS FARGO CENTER, 90 SOUTH SEVENTH STREET
MINNEAPOLIS, MINNESOTA 55402-3901
TELEPHONE 612-766-7000
FACSIMILE 612-766-1600

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Facsimile No. 612/766-1600

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| | | | |
|---|---|---|---|
| **Applicant:** | HARJIT SINGH BHAMBRA | **Examiner:** | |
| **Serial No.:** | 10/134,168 | **Group Art Unit:** | 21752 |
| **Filed:** | April 26, 2002 | | |
| **For:** | METHOD FOR PREPARAING IMAGED MEMBERS AND IMAGED MEMBERS PREPARED THEREBY | **Docket No.** | 58575-277928 |

**Date:** May 2, 2003 **Time:** _____ __.m. (Minneapolis)

**Number of pages (including this page):** 5 **F&B File No.:** 58575-277928 **Rec.:** 328

**From:** John M. Haurykiewicz **Telephone Number:** 612/766-8216

**To:** **Mail Stop Petitions**

**Commissioner of Patents** **Fax No.: (703)308-6916**

**Message: Attached for filing:**

1. **Transmittal Letter**
2. **Combined Declaration and Power of Attorney**

M2:20541017.01

**If you do not receive all pages, please call the Fax Center at 612/766-1650 or Janice Grooms at 612/766-7814.**

#8

PATENT

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| **Applicant:** | HARJIT SINGH BHAMBRA | **Examiner:** | |
| **Serial No.:** | 10/134,168 | **Group Art Unit:** | 1752 |
| **Filed:** | April 26, 2002 | **Docket No.** | 58575-277928 |
| **For:** | METHOD FOR PREPARING IMAGED MEMBERS AND IMAGED MEMBERS PREPARED THEREBY | | |

Mail Stop Petitions
Commissioner for Patents
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Alexandria, VA 22313-1450

I CERTIFY THAT, ON MAY 2, 2003, THIS PAPER IS BEING SENT VIA FACSIMILE TO THE COMMISSIONER FOR PATENTS, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450; FACSIMILE NO. (703) 308-6916.

Janice Grooms

Janice Grooms

## TRANSMITTAL LETTER

The following paper is being filed in connection with the above-identified patent application:

1. Properly executed Combined Declaration and Power of Attorney.

The present application was filed on April 26, 2002, without a Combined Declaration and Power of Attorney. In response to a Notice to File Missing Parts, Applicant submitted a Petition under 37 CFR 1.47(b) on August 5, 2002. The petition was dismissed and a request for Reconsideration of Petition under 37 CFR 1.47(b) was filed on March 03, 2003, demonstrating, in part, that the sole named inventor, Harjit Singh Bhambra, could not be found or reached after diligent effort.

To our surprise, Mr. Bhambra contacted Ann Kelly, Human Resources and Pensions Administrator at Kodak Polychrome Graphics (KPG) Ltd., located in Leeds, United Kingdom, of his own accord on March 25, 2003, to provide a forwarding address.

A copy of U.S. Patent Application No. 10/134,168 as filed was sent to Mr. Bhambra at the address of 5438 5b Avenue, Delta, British Columbia, Canada V4M 1K5,

together with a Combined Declaration and Power of Attorney. Mr. Bhambra properly executed the Combined Declaration and Power of Attorney.

Therefore, Applicant respectfully requests entry of the Combined Declaration and Power of Attorney and withdraws the Request for Reconsideration of Petition under 37 CFR 1.47(b).

No fee is believed to be necessary. Should any fee be required, the Commissioner is authorized to charge our Deposit Account No. 06-0029 and is requested to notify us of the same.

Respectfully Submitted,

HARJIT SINGH BHAMBRA

By: _____

John M. Hauryklewicz, #29,311
FAEGRE & BENSON LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
612/766-8216

Dated: May 2, 2003

M2:20541011.01

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ROBERT M. HUNTER
P.O. BOX 2709
KAMUELA, HI 96743

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APR 2 2 2004

OFFICE OF PETITIONS

In re Application of :
John S. Lovell et al :
Application No. 10/134,178 :
Filed: April 26, 2002 :
Attorney Docket No. 02-0425-LOV :

ON PETITION

This is a decision on the petition to revive under 37 CFR 1.137(b), filed April 14, 2004, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

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

The above-identified application was held abandoned for failure submit the formal drawings in a timely manner in reply to the Notice of Allowance mailed November 25, 2003, which set a statutory period for reply of three (3) months. Petitioner indicates that the drawings were filed in a timely fashion, with a properly executed certificate of mailing dated December 19, 2003.

Since the formal drawings were submitted timely on December 19, 2003, the $1995 submitted with the petition will be refunded to petitioner's credit card. Therefore, the holding of abandonment will be withdrawn.

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

The application file is being forwarded to the Publishing Division for further processing.

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

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

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

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6719828 | 2004-04-13 | 10134178 | 2002-04-26 | 2060-145 |

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 | /Robert D. Traver/ | Date (YYYY-MM-DD) | 2008-08-04 |
| Name | Robert D. Traver | Registration Number | 47999 |

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. 6719828
Issue Date: April 13,2004
Application No. 10134178
Filed: April 26,2002
Attorney Docket No. 02-0425-LOV

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

This is a decision on the electronic petition, filed August 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 August 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.

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

Mark Farber
C/o
Alexion Pharmaceuticals, Inc.
352 Knotter Drive
Cheshire, CT 06410

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JAN 2 7 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bowdish et al. | : | |
| Application No. 10/134,199 | : | ON PETITION |
| Filed: April 26, 2002 | : | |
| Attorney Docket No. 63 U.S. | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 2, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

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

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

As to item (1), There is no indication that a reply in compliance with 37 CFR 1.821-1.825 as required by the Notice to File Missing Parts mailed May 21, 2002 has been submitted. Accordingly, this application cannot be revived until a complete response to the Notice to File Missing Parts has been submitted.

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

By mail: Mail Stop Petitions
PO Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-6906
Attn: Office of Petitions

By hand: Customer Service Window
2011 South Clark Place
Crystal Plaza 2, Rm. 1B03
Arlington, VA 22202

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

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 10

Mark Farber
Alexion Pharmaceuticals, Inc.
352 Knotter Drive
Cheshire, CT 06410

COPY MAILED
MAR 2 9 2004
OFFICE OF PETITIONS

In re Application of :
Bowdish et al. :
Application No. 10/134,199 : ON PETITION
Filed: April 26, 2002 :
Attorney Docket No. 63 US :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed March 8, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from 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).

As to item (1), There is not indication that a reply in compliance with 37 CFR 1.821-1.825 as set forth in the Notice to File Missing Parts Notice mailed May 21, 2002 has been submitted. The Notice set forth that applicant must provide an initial computer readable form CRF copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d).

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

By mail: Mail Stop Petitions
Box DAC
Washington, D.C. 20231

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

By hand: 2201 South Clark Place
Crystal Plaza 2, Lobby
Rm. 1B03
Arlington, VA 22202

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

Latrice Bond

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

Attachment: Copy of Notice mailed May 21, 2002.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 13

Mark Farber
Alexion Pharmaceuticals, Inc.
352 Knotter Drive
Cheshire, CT 06410

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APR 0 6 2004
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bowdish et al. | : | |
| Application No. 10/134,199 | : | ON PETITION |
| Filed: April 26, 2002 | : | |
| Attorney Docket No. 63 US | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 26, 2004, to revive the above-identified application.

The petition is Granted.

The above-identified application became abandoned for failure to submit a complete reply to the Notice to File Missing Parts Notice mailed May 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 have been obtained. Accordingly, the application became abandoned on July 22, 2002.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

BAKER BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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OCT 0 1 2002

OFFICE OF PETITIONS

In re Application of
Bhambra
Application No. 10/134,204
Filed: April 26, 2002
Attorney Docket No. A35143-065838.0339

ON PETITION

This is a decision on the August 12, 2002 (Monday) petition under 37 CFR 1.47(b).

The petition is **DISMISSED.**

A Notice to File Missing Parts of Nonprovisional Application was mailed on June 10, 2002 ("6/10/02 Notice"), stating that the application as filed did not include an oath or declaration,[1] and setting forth an extendable 2-month period for submitting a proper oath or declaration. In response, the instant petition was filed.

The petition encloses an unsigned Declaration and Power of Attorney, asserts that the sole inventor for the claimed invention, Harjit Bhambra ("Bhambra"), cannot be found after diligent effort, and requests that Kodak Polychrome Graphics LLC ("Kodak") be allowed to file this application on behalf of and as agent for Bhambra.

To be grantable, the petition requires:

(1) proof that Bhambra cannot be reached after diligent effort;
(2) proof of Kodak's proprietary interest in this application;
(3) a proper oath or declaration;
(4) the petition fee;
(5) a statement regarding Bhambra's last known address; and
(6) proof that filing the application as proposed is necessary to preserve the rights of the parties or to prevent irreparable damages.[2]

The petition lacks items (1), (2), and (3) set forth above.

As to item (1), while two letters were sent to Bhambra at his last known address and subsequently returned, there is no indication that Bhambra had moved,[3] and if he did move, that Kodak made any effort to obtain Bhambra's forwarding address. The fact that no other attempts appear to have been made to locate Bhambra (e.g., through e-mail, telephone, or Internet

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[1] See 37 CFR 1.51(b)(2), 1.63.

[2] 37 CFR 1.47(b); MPEP section 409.03(g) (Aug. 2001).

[3] **The petiti n c nclusively states that Bhambra cannot be found, but does not elab rate how that c nclusion was reached.**

searches) leads the Office to conclude that Kodak has not made a reasonably diligent effort to locate Bhambra before concluding that he cannot be found.[4]

Item (2) concerns Kodak's proprietary interest, if at all, in this application to entitle Kodak to prosecute this application. It appears from the petition that Bhambra has not previously assigned his rights in the application to Kodak;[5] nor could he be found to execute the assignment. The petition asserts that Bhambra was formerly employed by Kodak, that the invention at issue was made during Bhambra's employment by Kodak, and that Bhambra is thus obligated to assign all rights to such an invention to Kodak. However, the petition does not enclose a copy of the employment contract, or other documents supporting Kodak's proprietary interest in this application for prosecuting this application, e.g., a legal memorandum signed by an attorney familiar with the law of a particular jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to Kodak.

Regarding item (3), the Declaration and Power of Attorney supplied with the petition is not executed. However, to be the §1.47(b) applicant Kodak must make the oath or declaration as required by 37 CFR 1.63, 1.64.[6] Generally, one of Kodak's officers should sign the oath or declaration. Alternatively, counsel may sign the oath or declaration on behalf of Kodak if authorized to do so by Kodak, and the oath or declaration accompanied by a signed statement by either counsel, or an appropriate officer of Kodak indicating the officer's official title in Kodak, to the effect that counsel is authorized to sign on behalf of Kodak.[7]

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

To prevent abandonment of this application,[8] one of the following must be submitted within **TWO MONTHS** of the mailing date of this decision:[9]

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[4] **For example, the Office was able to find, via www.bt.com, an "H Bhambra" at 22 Moor Allerton Ave., Leeds LS17 6SQ; (0113) 293 6300.**

[5] The PTO records do not show a recordation of any assignment of this application by Bhambra.

[6] Must submit proof for, or statement of, such authority. See MPEP section 409.03(b), 324 (Aug. 2001) ([A]ssignees . . . may, after becoming of record . . . [prosecute] the application . . . An assignee becomes of record . . . by filing a statement in compliance with 37 CFR 3.73(b) that is signed by a party authorized to act on behalf of the assignee).

[7] MPEP section 409.03(b) (Aug. 2001).

[8] See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration . . . pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . to avoid abandonment).

[9] Unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained.

(1) an oath/declaration properly signed by Bhambra;[10] **or**
(2) a renewed petition under 37 CFR 1.47(b) (no fee) that includes:
- -proper statement(s) of facts relied upon to establish that a diligent effort had been made to locate Bhambra and that he could not be found;
- -proper proof that Bhambra made the claimed invention in this application while employed by Kodak, and has agreed in writing to assign such invention to Kodak; or that Kodak otherwise has sufficient proprietary interest in this application to justify its filing of this application on behalf of and as agent for Bhambra;
- -an oath/declaration in compliance with 37 CFR 1.63 and 1.64,[11] **signed** by an officer of Kodak or by a person properly authorized by Kodak to sign on its behalf; and, consequently,
- -a showing that filing of the application by Kodak on behalf of and as agent for Bhambra is necessary to preserve the rights of the parties or to prevent irreparable damages.

The renewed §1.47(b) petition should be addressed as follows:

by mail/by hand: Assistant Commissioner for Patents
USPTO, Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax: (703) 308-6916
Attn: Office of Petitions

Finally, the Office acknowledges receipt with the petition of: the $110 fee for a 1-month extension of time, and the $130 surcharge for not submitting an acceptable oath/declaration upon filing. The $130 petition fee has been charged to Deposit Account No. 02-4377 as authorized.

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

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

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[10] **Submit directly to the Office of Initial Patent Examination along with a copy of this decision.**

[11] **The declaration should be revised as necessary; it currently lists "Moortown, Leeds" as the city of Bhambra's residence.**

UNITED STATES 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

PAUL W. BUSSE
FAEGRE & BENSON, LLP
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55401-3901

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MAY 27 2003

OFFICE OF PETITIONS

In re Application of
Bhambra
Application No. 10/134,204
Filed: April 26, 2002
Attorney Docket No. A35143-065838.0339

ON PETITION

This decision concerns the renewed petition under 37 CFR 1.47(b), filed on March 3, 2003 along with a request for a 3-month extension of time and the requisite extension-of-time fee.

The renewed petition is **DISMISSED as moot.**

The sole inventor for the claimed invention in this application is Harjit Bhambra ("Bhambra"). A prior petition under 37 CFR 1.47(b), filed on August 12, 2002 by Kodak Polychrome Graphics LLC ("Kodak") on behalf of and as agent for Bhambra, was dismissed on October 1, 2002 for failing to properly establish (1) Kodak's proprietary interest in this application to justify its filing of the application as such; and (2) that Bhambra could not be reached/located after diligent effort. Subsequent to the filing of the instant renewed petition, a "Combined Declaration and Power of Attorney in Original Application" executed by Bhambra was submitted by facsimile on May 2, 2003.[1] The instant renewed petition is thus dismissed as moot. No fee is owed.

The application is now complete. The power of attorney and the new correspondence address have been entered and made of record.

The application file is being returned to the Office of Initial Patent Examination for processing of the declaration filed by facsimile on May 2, 2003 (Paper No. 9). Thereafter, the application will be forwarded to the appropriate Technology Center for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

Attachments: Notice Regarding Change of Power of Attorney (revoking prior powers of attorney)

Notice of Acceptance of Power of Attorney (accepting 11/7/02 Power of Attorney)

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[1] This declaration is being treated as a supplement to the 3/3/03 petition, rendering a further extension-of-time unnecessary.

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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SANTANGELO LAW OFFICES, P.C.
125 SOUTH HOWES, THIRD FLOOR
FORT COLLINS CO 80521

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MAR 1 4 2005

**OFFICE OF PETITIONS**

In re Application of
MCSTAY, ROBERT D.
Application No. 10/134,227
Filed: April 25, 2002
For: RELATIONALLY PREDIMENSIONED STONE SURFACING SYSTEM

: Decision
: On
: Access

This is in response to the petition filed July 30, 2004, by Alfred K. Wiedmann, Jr. on behalf of BuffaloStone, Inc., the assignee of record, requesting that the inventor and other assignees be excluded from access to the application.

The petition is **DISMISSED**.

On October 30, 2003, the above referenced pending application was published as application publication no. 20030200713. Upon publication, the Office will furnish any person on request the application-as-filed, the file contents of the application, or a specific document in the file. See 37 CFR 1.14(a)(1)(iii). Since the contents of the application file are no longer confidential, the request to bar the inventor and other assignees from the confidential application contents is dismissed as moot.

The petition also states that BuffaloStone, Inc. is the assignee of the entire interest and requests other unidentified assignees (if any) be barred from access and participating in the prosecution of the application. A request to take over the prosecution of an application requires consent of all partial assignees. See 37 CFR 3.71(b)(2). Without assent of the other assignees no action can be taken and the request must be dismissed.

Telephone inquiries should be directed to Michael L. Lewis at (571) 272-7755.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**KEVIN J. BOLAND, ESQ.**
**W.L. GORE & ASSOCIATES, INC.**
**551 PAPER MILL ROAD**
**P.O. BOX 9206**
**NEWARK, DE 19714-9206**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Dorros et al. | : | |
| Application No. 10/134,237 | : | ON PETITION |
| Filed: April 25, 2002 | : | |
| Attorney Docket No. MP/205 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 28, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed September 17, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on December 18, 2004.

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

The file is now being forwarded to the Publishing Division for processing into a patent.

Telephone inquiries 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
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BAKER & DANIELS
111 E WAYNE STREET, SUITE 800
FORT WAYNE, IN 46802

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MAY 1 1 2005

OFFICE OF PETITIONS

In re Application of
Thomas Kupper et al
Application No. 10/134,291
Filed: April 29, 2002
Attorney Docket No. WE10046

DECISION GRANTING PETITION
UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition, filed May 3, 2005 (and resubmitted on May 5, 2005), under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on April 18, 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 2874 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement, both of which were filed on May 5, 2005.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Francis J. Maguire
Ware, Fressola, Van Der Sluys & Adolphson LLP
755 Main Street
P.O. Box 224
Monroe, CT 06468

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jussi Sipola | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7636301 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/134,311 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/26/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1333** 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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**CHA & REITER, LLC**
**210 ROUTE 4 EAST STE. 103**
**PARAMUS NJ 07652**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Myung Kwon Kim | : | |
| Application No. 10/134,342 | : | ON PETITION |
| Filed: April 26, 2002 | : | |
| Attorney Docket No. 5008-1-002 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed August 30, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee and the publication fee in a timely manner in reply to the Notice of Allowance mailed November 18, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on February 19, 2004.

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

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

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No.

GEORGE R. MCGUIRE
ONE LINCOLN CENTER
SYRACUSE NY 13202-1355

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Nabors et al. | : | |
| Application No. 10/134,350 | : | DECISION ON |
| Filed: April 26, 2002 | : | PETITION |
| Attorney Docket No. 193P028 | : | |

This is a decision on the Petition Under 37 CFR 1.181(a) filed June 26, 2006.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed September 16, 2005. This Notice set a three month shortened statutory period for reply, with extensions of time obtainable under 37 CFR §1.136(a). No reply having been received and no extensions obtained, the above-identified application became abandoned effective December 17, 2005. A courtesy Notice of Abandonment was mailed on June 13, 2006.

In response, applicants filed the instant petition, asserting that the Office action was never received and requesting that the holding of abandonment be withdrawn.

A review of the application file reveals an irregularity in the mailing of the Office action mailed September 16, 2005. Even though the Office action was addressed to the correspondence address of record, the mailing was returned to the Office as undeliverable as addressed. (It is specifically noted that there is no issue of a change of the correspondence address of record).

In addition, the petition includes a statement from the practitioner stating that the Office communication was not received by the practitioner and including a copy of the docket records where the non-received Office communication would have been entered had it been received. The practitioner does not attest to a search of the file jacket indicating that the Office action was not received. Nonetheless, given the irregularity in the mailing, it is concluded that petitioner has made an adequate showing of non-receipt.

In view thereof, the notice of abandonment mailed June 13, 2006 is hereby **VACATED**, and the holding of abandonment is hereby **WITHDRAWN**.

The petition under § 1.181 is **GRANTED**.

No fee is required on petition under § 1.181.

Technology Center AU 3627 has been advised of this decision. The application file is, thereby, forwarded to the Technology Center's technical support staff to withdraw the holding of abandonment and for re-mailing of the non-final Office action mailed September 16, 2005 and for restarting of the period for reply.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MEDTRONIC, INC.
710 MEDTRONIC PARK
MINNEAPOLIS, MN 55432-9924

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JAN 23 2006

OFFICE OF PETITIONS

In re Application of :
John E. Burnes et al :
Application No. 10/134,352 : ON PETITION
Filed: April 26, 2002 :
Attorney Docket No. P-10215 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 21, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed June 17, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on September 18, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition and publication fees; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Publishing Division for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Arthur Garabedian
1111 Glenview Drive
Fullerton, California 92632

SEP 16 2002

| | | |
|---|---|---|
| In re Application of | : | |
| Arthur Garabedian | : | |
| Application No. 10/134,363 | : | DECISION ON PETITION |
| Filed: April 26, 2002 | : | TO MAKE SPECIAL |
| For: Methods and Systems for Concealing | : | |
| Antennas | : | |

This is a decision on the petition under 37 C.F.R. § 1.102, filed June 17, 2002, to make the above-identified application special. No fee is required for this petition.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in M.P.E.P. § 708.02, Item IV: Applicant's Age.

The petition is GRANTED.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Item IV, must include a showing, as by a birth certificate or the applicant's affidavit or declaration, that the applicant is sixty five (65) years of age or more.

The petition includes applicant's affidavit showing that applicant is sixty five (65) years of age or more.

The application is being forwarded to the examiner for expedited prosecution.

If the examiner can make this application special without prejudice to any possible interfering applications, and he/she should make a rigid search for such, he/she is authorized to do so for the next action. Should the application be rejected, the application will not be considered special for the subsequent action unless the applicant promptly makes a bona fide effort to place the application in condition for allowance, even if it is necessary to have an interview with the examiner to accomplish this purpose.

If the examiner finds any interfering application for the same subject matter, he/she should consider such application simultaneously with this application and should state in the official letter of such application that he/she is taking it out of its turn because of possible interference.

Should an appeal be taken in this application or should this application becomes involved in an interference, consideration of the appeal and the interference will be expedited by all Patent and Trademark Office officials concerned, contingent likewise upon diligent prosecution by the applicant.

After allowance, this application will be given priority for printing. See M.P.E.P. § 1309.

The petition is granted to the extent indicated.

Henry Phan

Hien H. Phan, Special Program Examiner
TC 2800 - Semiconductor, Electrical and
Optical Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209

MAILED

JUL 2 8 2003

Technology Center 2100

| | | |
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| In re Application of: Richard I. MELLITZ, et al. | ) | |
| Application No. 10/134,390 | ) | DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY |
| Filed: April 30, 2002 | ) | |
| For: METHOD AND APPARATUS FOR MEASURING DATA TIMING USING UNIT TIME-VOLTAGE SAWTOOTH RAMPS | ) | |

This is a decision on the Request To Withdraw from Representation filed June 19, 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: Schwegman, Lundberg, Woessner & Kluth P.A.
c/o Anne Richards
1600 TCF Tower
121 S. 8th Street
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Harris Zimmerman
Suite 710
1330 Broadway
Oakland, CA 94612-2506

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**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of Jaeger | : | |
| Application No. 10/134,401 | : | Decision on Petition |
| Filing Date: April 29, 2002 | : | |
| Attorney Docket No. 4167/CIP 2 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed October 11, 2006, to revive the above-identified application.

The petition is **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed March 3, 2006, which set a shortened statutory period for reply of three (3) months. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on June 4, 2006. A Notice of Abandonment was mailed on September 11, 2006.

The instant petition requests revival of the application.

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

Technology Center Art Unit 2173 will be informed of the instant decision and the application will be further examined in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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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BRINKS HOFER GILSON & LIONE
ONE INDIANA SQUARE, SUITE 1600
INDIANAPOLIS IN 46204

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SEP 2 9 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Gailey et al. | : |
| Application No. 10/134,405 | : DECISION ON PETITION |
| Filed: April 26, 2002 | : UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. 10022/169 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 7, 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 June 7, 2004, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

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

A 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 Petitions Attorney Christina Tartera Donnell at (703) 306-5589.

This matter is being referred to Technology Center Art Unit 3621 for appropriate action on the amendment filed June 7, 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.

Charles A. Pearson
Director, Office of Petition
Office of the Deputy Commissioner
for Patent Examination Policy

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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ACCENTURE INDY 33391
BRINKS HOFER GILSON & LIONE
ONE INDIANA SQUARE, SUITE 1600
INDIANAPOLIS IN 46204

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OCT 24 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Michael L. Gailey, et al. | : | |
| Application No. 10/134,405 | : | DECISION GRANTING PETITION |
| Filed: April 26, 2008 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 10022/169 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 23, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on June 6, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 3621 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
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 of the application.*

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BRINKS HOFER GILSON & LIONE
ONE INDIANA SQUARE, SUITE 1600
INDIANAPOLIS IN 46204

In re Application of :
Gailey, et al. : LETTER REGARDING PTA
Application No. 10/134,405 :
Filed: April 26, 2002 :
Atty. Dkt. No.: : 10022/169 :

This letter is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT," filed June 6, 2008. The Office thanks applicants for their good faith and candor in bringing this to our attention.

Applicants advise that the adjustment may extend the term of the patent by too many days.

The Determination of Patent Term Adjustment mailed March 7, 2008 indicates that the patent term adjustment (PTA) to date is 581 days. Applicants timely submitted the instant application for patent term adjustment on June 6, 2008.

Prior to a decision on the application for patent term adjustment being rendered, on October 23, 2008, applicants filed a petition to withdraw from issue along with a request for continued examination (RCE). The application was withdrawn from issue on October 24, 2008 and prosecution was reopened.

In view thereof, a decision on the application for patent term adjustment is being **held in abeyance** until after the mailing of any new Notice of Allowance and the filing (or resubmission) of any application for patent term adjustment under 37 CFR 1.705(b). A new determination of patent term adjustment will accompany any new Notice of Allowance and will include any further adjustments or reductions accrued to date. Applicants must submit a timely application for patent term adjustment in response to any new Notice of Allowance. An application for patent term adjustment under 37 CFR 1.705(b) is properly filed after the mailing of the Notice of Allowance on which the application issues and prior to payment of the issue fee (or a request for reapplication of the issue fee) in response to that

Notice. A copy of this decision should accompany any request for reconsideration of this letter.

This application is being, forwarded to the Technology Center 3600 for consideration of the RCE by the examiner.

Telephone inquiries specific to this decision should be directed to the Alesia M. Brown at (571) 272-3205.

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED
JUN 24 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| James A. Roskind | : | |
| Application No. 10/134,437 | : | ON APPLICATION FOR |
| Filed: 04/30/2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. | : | |
| 10587.0067-0000 | : | |

This letter is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION," filed on January 4, 2010, which is treated as an application under 37 CFR 1.705(b). Applicants request review of the initial determination of patent term adjustment. Specifically, applicants dispute the entry of a period of adjustment of 236 days for Office delay.

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED**.

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is six hundred thirty (630) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On October 2, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 USC 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is eight hundred sixty-six (866) days.

On January 4, 2010, applicants timely submitted the instant application for patent term adjustment.[1]

[1] PALM records show that the Issue Fee was received on January 4, 2010.

Applicants request reconsideration of the entry of a period of adjustment of 236 days for Office delay in connection with the filing of the non-final Office action mailed on February 11, 2008, four months and 236 days after the filing of the appeal brief filed on February 20, 2007.

37 CFR 1.702(a)(4) states that the period of adjustment for Office delay includes The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

On February 20, 2007, an appeal brief was filed. That appeal brief, however, was not in compliance with 37 CFR 41.37. In this regard, a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) was mailed on April 19, 2007, stating that the Appeal Brief was defective. On October 9, 2007, an appeal brief in compliance with 37 CFR 41.37 was filed. However, on October 31, 2007, a request for continued examination (RCE) was filed. As an RCE is a request to terminate an appeal, no reply to the brief is needed as the appeal is no longer taken per 35 USC 154(b)(1)(A)(i). On February 11, 2008, less than four months after the filing of the RCE, a non-final Office action was mailed.

Accordingly, the 236 day period of adjustment for Office delay is not warranted and will be removed.

In view thereof, the revised determination of PTA at the time of the mailing of the Notice of Allowance is **six hundred thirty (630)** days (861 (1097 - 236) days of PTO delay, reduced by 231 of Applicant delay).

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

The Office thanks Applicants for their good faith and candor in bringing this matter to the attention of the Office.

The Office of Data Management has been advised of this decision. The application is thereby forwarded to the Office of Data Management for issuance of the patent. The patent term

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

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

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of updated PALM calculation

Day : Wednesday

# PALM INTRANET

Date: 6/23/2010
Time: 13:42:33

| PTA Calculations for Application: 10/134437 | | | |
|---|---|---|---|
| Application Filing Date: | 04/30/2002 | PTO Delay (PTO): | 1097 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 231 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 630 |
| PTO Delay Adjustment: | -236 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 158 | 06/23/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 236 | |
| 137 | 10/02/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 136 | 09/28/2009 | ISSUE REVISION COMPLETED | | | |
| 135 | 09/28/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 134 | 09/28/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 133 | 09/28/2009 | DOCUMENT VERIFICATION | | | |
| 132 | 09/28/2009 | NOTICE OF ALLOWABILITY | | | |
| 131 | 07/28/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 130 | 07/28/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 48 | 123 |
| 127 | 07/28/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 126 | 07/28/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 125 | 07/28/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 124 | 07/18/2009 | DATE FORWARDED TO EXAMINER | | | |
| 123 | 06/10/2009 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 122 | 03/10/2009 | ELECTRONIC REVIEW | | | |
| 121 | 03/10/2009 | EMAIL NOTIFICATION | | | |
| 120 | 03/10/2009 | MAIL NON-FINAL REJECTION | | | |
| 119 | 03/02/2009 | NON-FINAL REJECTION | | | |
| 118 | 12/24/2008 | DATE FORWARDED TO EXAMINER | | | |
| 117 | 12/18/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 116 | 12/24/2008 | DATE FORWARDED TO EXAMINER | | | |

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|---|---|---|---|---|---|
| 115 | 12/18/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 114 | 12/24/2008 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 113 | 12/18/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 112 | 09/19/2008 | ELECTRONIC REVIEW | | | |
| 111 | 09/18/2008 | EMAIL NOTIFICATION | | | |
| 110 | 09/18/2008 | MAIL FINAL REJECTION (PTOL - 326) | 6 | | 101 |
| 109 | 09/15/2008 | FINAL REJECTION | | | |
| 108 | 07/11/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 107 | 03/07/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 106 | 07/11/2008 | REFERENCE CAPTURE ON IDS | | | |
| 105 | 07/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 60 | 101 |
| 104 | 07/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 102 | 07/10/2008 | DATE FORWARDED TO EXAMINER | | | |
| 101 | 05/12/2008 | RESPONSE AFTER NON-FINAL ACTION | | 1 | 97 |
| 100 | 03/07/2008 | REFERENCE CAPTURE ON IDS | | | |
| 99 | 03/07/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 98 | 03/07/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 97 | 02/11/2008 | MAIL NON-FINAL REJECTION | 236 | | 56 |
| 96 | 02/04/2008 | NON-FINAL REJECTION | | | |
| 95 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 94 | 11/29/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 93 | 11/29/2007 | REFERENCE CAPTURE ON IDS | | | |
| 92 | 11/29/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 90 | 11/29/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 89 | 10/31/2007 | REFERENCE CAPTURE ON IDS | | | |
| 88 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 87 | 11/20/2007 | DATE FORWARDED TO EXAMINER | | | |
| 86 | 10/31/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |

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| 85 | 11/20/2007 | DATE FORWARDED TO EXAMINER | | | |
| 84 | 10/31/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 83 | 11/20/2007 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 81 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 80 | 10/31/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 79 | 10/24/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 78 | 10/24/2007 | DATE FORWARDED TO EXAMINER | | | |
| 77 | 10/09/2007 | APPEAL BRIEF FILED | | | |
| 76 | 09/06/2007 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 75 | 08/22/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 74 | 01/23/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 73 | 02/08/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 72 | 07/19/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 71 | 08/02/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 70 | 09/17/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 69 | 09/17/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 68 | 08/02/2007 | REFERENCE CAPTURE ON IDS | | | |
| 67 | 08/02/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 66 | 08/02/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 65 | 07/19/2007 | REFERENCE CAPTURE ON IDS | | | |
| 64 | 07/19/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 63 | 07/19/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 62 | 06/23/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 61 | 06/23/2007 | DATE FORWARDED TO EXAMINER | | | |
| 60.1 | 05/21/2007 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 60 | 05/21/2007 | APPEAL BRIEF FILED | | | |
| 59 | 04/19/2007 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |

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|---|---|---|---|---|---|
| 58 | 04/11/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 57 | 02/22/2007 | DATE FORWARDED TO EXAMINER | | | |
| 56.1 | 02/20/2007 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 56 | 02/20/2007 | APPEAL BRIEF FILED | | | |
| 55 | 02/20/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 54 | 02/08/2007 | REFERENCE CAPTURE ON IDS | | | |
| 53.7 | 02/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 53 | 02/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 52 | 01/23/2007 | REFERENCE CAPTURE ON IDS | | | |
| 51.7 | 01/23/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 51 | 01/23/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 50 | 11/20/2006 | NOTICE OF APPEAL FILED | | 94 | 41 |
| 49 | 11/20/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 48 | 10/03/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 47.7 | 08/22/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 47 | 08/22/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 46 | 08/22/2006 | REFERENCE CAPTURE ON IDS | | | |
| 45 | 08/21/2006 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 44 | 08/17/2006 | ADVISORY ACTION (PTOL-303) | | | |
| 43 | 07/31/2006 | DATE FORWARDED TO EXAMINER | | | |
| 42 | 07/18/2006 | AMENDMENT AFTER FINAL REJECTION | | | |
| 41 | 05/18/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 40 | 05/15/2006 | FINAL REJECTION | | | |
| 39 | 10/20/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 38 | 10/27/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 37 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 36 | 11/29/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 35 | 04/24/2006 | MISCELLANEOUS INCOMING LETTER | | | |

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|---|---|---|---|---|---|
| 34 | 03/23/2006 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 33 | 03/15/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 32 | 03/14/2006 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 03/01/2006 | RESPONSE AFTER NON-FINAL ACTION | | 28 | 21 |
| 30 | 03/01/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 29 | 12/21/2005 | REFERENCE CAPTURE ON IDS | | | |
| 28.7 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 28 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 27 | 11/29/2005 | REFERENCE CAPTURE ON IDS | | | |
| 26.7 | 11/29/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 26 | 11/29/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 25.7 | 10/27/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 25 | 10/27/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 24 | 10/27/2005 | REFERENCE CAPTURE ON IDS | | | |
| 23.7 | 10/20/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 10/20/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 10/20/2005 | REFERENCE CAPTURE ON IDS | | | |
| 21 | 11/01/2005 | MAIL NON-FINAL REJECTION | 855 | | -1 |
| 20 | 10/03/2005 | NON-FINAL REJECTION | | | |
| 19 | 08/29/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 18 | 06/22/2005 | REFERENCE CAPTURE ON IDS | | | |
| 17.7 | 06/22/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 06/22/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 07/06/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 05/17/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 14 | 12/10/2004 | REFERENCE CAPTURE ON IDS | | | |
| 13.7 | 12/10/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

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| 13 | 12/10/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 10/14/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 11.7 | 03/22/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 03/22/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10.7 | 11/14/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 11/14/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9.7 | 07/29/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9 | 07/29/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8.7 | 03/27/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 03/27/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7.7 | 02/06/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 02/06/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 09/27/2002 | RESCIND NONPUBLICATION REQUEST FOR PRE GRANT PUBLICATION | | | |
| 5 | 07/22/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 06/05/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 06/04/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 05/13/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 04/30/2002 | INITIAL EXAM TEAM NN | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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JJGJR.: 07-05

Paper No: __

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

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JUL 0 6 2005
OFFICE OF PETITIONS

In re Application of
Bruecken :
Application No. 10/134,440 : DECISION ON PETITION
Filing Date: 30 April, 2002
Attorney Docket No. 06975-196001/Commerce 06 :

This is a decision on the petition filed on 3 March, 2005, and considered herein under 37 C.F.R. §1.53.

For the reasons set forth below, the instant petition is **DISMISSED**, and, as authorized, the petition fee is charged to Deposit Account 06-1050.

## BACKGROUND

The instant application was deposited on 30 April, 2004, and recited therein a claim for priority to provisional Application No. 60/301,454 (the '454 provisional application), alleged to have been filed on 29 June, 2001.

A review of the file of the '454 provisional application indicates, however, that following deposit of the '454 provisional application, the Office mailed on 27 July, 2001, a Notice of Incomplete Provisional Application–a copy of which Petitioner included with the instant petition and which carries the notation of Petitioner's office that a reply to the Notice was due on or before 27 September, 2001. Notably, further review of that application file indicates that no reply to the Notice was filed in that application.

Petitioner now wishes to have the Office correct the claim for priority to the '454 provisional application in the instant application when the '454 provisional application has no filing date.

As a practitioner registered to practice before the Office, Petitioner is aware that the Rules of Practice (37 C.F.R. Part 1) provide in pertinent part:

> **37 C.F.R. § 1.4 Nature of correspondence and signature requirements.**
>
> * * *
>
> (b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, or other proceeding.
> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. (Emphasis supplied.)
>
> * * *

Thus, the matter of the filing date of the '454 provisional is to be addressed in the '454 provisional, and a priority date claimed in the instant application–if any–may be addressed thereafter.

## CONCLUSION

Therefore, the instant petition is **dismissed**.

This file (Image File Wrapper (IFW)) is released to OIPE for further processing as necessary before being forwarded for 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

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OCT 19 2004

Paper No. 24

In re Application of
Erik Kristensen Worm
Application No. 10/234,460
Filed: April 30, 2002
Attorney Docket No. P07590U00/MP

: DECISION ON PETITION

This is a decision on the petition filed on September 14, 2004, by which petitioner requests withdrawal of the holding that this application stands abandoned for failure to file a timely reply to the Office action dated December 23, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. It is noted that the Office action in question was a non-final action, and not a final action as indicated in the attachments to the petition.

The petition is granted.

Petitioner alleges that this application is not abandoned because petitioner did in fact file a timely reply to the Office letter in question. Petitioner supports this allegation by submitting a copy of the reply, and a copy of a post card receipt for the filing of the reply showing that the reply was in fact received in the Office on March 15, 2004, a date within the period for filing a reply to Office letter in question. Therefore, it is clear that this application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for formal entry of the reply that is attached to the petition. The date to which the reply is entitled is March 15, 2004. Thereafter, the application will be forwarded to the examiner for immediate consideration and appropriate action.

PETITION GRANTED.

Richard A. Bertsch, Director
Technology Center 3700

Stites & Harbison PLLC
1199 North Fairfax Street
Suite 900
Alexandria, VA 22314

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GEORGE DAVID MCCLURE JR.
MURTY PHARMACEUTICALS INC
518 CODELL DRIVE
LEXINGTON, KY 40509

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NOV 23 2004

**OFFICE OF PETITIONS**

In re Application of :
Ram B. Murty, et al. :
Application No. 10/134,520 :
Filed: April 30, 2002 :
Attorney Docket No. MPI-002-USA-P :

ON PETITION

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

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed February 4, 2004.

The petition is found to comply with the requirements of 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center AU 1616 for consideration of the response filed September 3, 2004.

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

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TROPIC NETWORKS INC.
DR. VICTORIA DONNELLY
135 MICHAEL COWPLAND DRIVE
KANATA ON K2M 2E9 CA CANADA

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SEP 15 2003

OFFICE OF PETITIONS

Applicant: Bacque et al.
Appl. No.: 10/134,553
Filing Date: April 30, 2002
Title: METHOD AND SYSTEM OF MEASURING LATENCY AND PACKET LOSS IN A NETWORK
Attorney Docket No.: 78945-42/pw
Pub. No.: US 2003/0115321 A1
Pub. Date: June 19, 2003

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was received on June 30, 2003.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains the wrong correspondence address.

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

The error in the correspondence address is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The error in the correspondence address does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

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

---

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

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions should be addressed as follows:

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

By facsimile: 703-305-8568

The application is being forwarded to Technology Center 2153 to await further examination in due course.

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

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

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NOV 18 2004

ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD CT 06905-5619

| | | |
|---|---|---|
| In re Application of | : | |
| Antonio Montoli | : | |
| Application No: 10/134,584 | : | NOTICE OF |
| Filed: April 29, 2002 | : | WITHDRAWAL FROM ISSUE |
| Title: Mascara Brush With Small | : | UNDER 37 C.F.R 1.313 |
| Diameter Bristle Fibers | : | |

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 C.F.R. 1.313.

The application is being withdrawn to permit reopening of prosecution due to unpatentability of one or more claims. See 37CFR 1.313(b)(3).

PTO records reveal that the issue fee has been paid. If the fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the Examiner for action.

John E. Kittle
Director
Technology Center 3700/2900

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

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DEC 29 2006

OFFICE OF PETITIONS

In re Application of

Joel Marais :

Application No. 10/134,609

: DECISION ON PETITION

Filed: April 30, 2002

:

Attorney Docket No. 113035.00122

This is a decision on the petition under 37 CFR 1.137(b), filed November 3, 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 restriction/election requirement mailed September 24, 2004, which set a shortened statutory period for reply of one (1) month 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 25, 2006.

The above-identified application had been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 CFR 1.1379b) was unintentional. See *Changes to Patent Practice and Procedure*, 62 Fed. Reg, at 53160 and 53178.

The response filed November 3, 2006, is noted.

The application is being forwarded to Technology Center 3600, GAU 3636 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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Alexandria, VA 22313-1450
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**ROBERT N. O'BRIEN**
**2614 QUEENSWOOD DR.**
**VICTORIA, BC V8N 1X5**
**CANADA**

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of<br>O'Brien, Robert Neville<br>Application No. 10/134,635<br>Filed: April 30, 2002<br>Title: METHOD OF DETECTING BIOLOGICAL WEAPON USE BY MONITORING A MONOLAYER | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 27, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 1600 for further examination on the merits.

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

Liana Chase
Petitions Examiner
Office of Petitions

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SHUMAKER & SIEFFERT, P. A.
8425 SEASONS PARKWAY
SUITE 105
ST. PAUL, MN 55125

In re Application of

Biessener, et al.

Application No. 10/134,656

Filed: April 26, 2002

Attorney Docket No. 1009-004US01

: DECISION ON PETITION

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed August 28, 2006, and in duplicate on August 31, 2006.

The petition is **granted**.

This application was held abandoned July 12, 2006, after no reply was received to the Notice of Allowance and Issue Fee Due mailed April 11, 2006. The notice set forth a statutory period of reply of three months from its mailing date. No response was received within the allowable period and the application became abandoned on July 12, 2006. A Notice of Abandonment was mailed August 17,2 006. The instant petition was filed on August 28, 2006. Petitioner maintains that the notice was never received and provides a copy of the relevant docketing calendar as proof of the same.

Section 711.03(c)(II) of the *Manual of Patent Examining Procedure* ("MPEP") provides that in order to establish non-receipt of an Office action so as prove that the imposition of a holding of abandonment is improper, petitioner must: 1) provide a statement to the Office indicating that the Office action was not received by petitioner; 2) include in the statement an attestation to the fact that a review of the file jacket and docket records maintained by petitioner indicates that the Office action was not received; and 3) provide a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

Petitioner has met the burden of proof as established by Section 711.03(c)(II) of the MPEP. The holding of abandonment is, therefore, withdrawn.

The application file is being forwarded to Technology 2100, GAU 2185 for further processing that may include remailing the notice and resetting of the period for reply.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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JOHN S. EGBERT
HARRISON & EGBERT
7TH FLOOR
412 MAIN STREET
HOUSTON, TX 77002

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| | | |
|---|---|---|
| In re Application of | : | |
| Avram LEVI | : | |
| Application No. 10/134,664 | : | DECISION GRANTING PETITION |
| Filed: April 29, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 1285-91 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed October 4, 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 December 17, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 18, 2004.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of a continuation-in-part application (10/958,157, filed October 4, 2004).

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 Betsy L. Deppe at (571) 272-6052 or in her absence, the undersigned at (571) 272-3217.

This abandoned file is being referred to Files Repository.

Francis Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Robert L. Epstein
Epstein Drangel Bazerman & James
60 East 42nd Street, Suite 820
New York, NY 10165

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**MINNEAPOLIS MN 55440-1022**

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| | | |
|---|---|---|
| In re Application of | : | |
| **KIMBALL**, et al. | : | |
| Application No. 10/134,675 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | TO WITHDRAW |
| Attorney Docket No. **06975-231001/PERSONALIZ** | : | 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 2, 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 Scott R. Boalick. Scott R. Boalick has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

SAP / FINNEGAN, HENDERSON LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

| | | |
|---|---|---|
| In re Patent No. 7,599,841 | : | DECISION ON REQUEST |
| Koller et al. | : | FOR |
| Issue Date: October 6, 2009 | : | RECONSIDERATION OF |
| Application No. 10/134,683 | : | PATENT TERM ADJUSTMENT |
| Filed: April 30, 2002 | : | and |
| Atty Docket No. 09282.0036-00 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on December 4, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifty-five (1255) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifty-four (1254) days is **GRANTED to the extent indicated herein.**

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

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on May 1, 2005 and ends on September 14, 2006, the day before the first RCE was filed, which amounts to 502 (not 503) days. See U.S.C. 154(b)(1)(B)(i). As such, considering the 146 days of overlap, the patent term adjustment is increased by 356 days to 1254, not 1255 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand, two hundred and fifty-four (1254) days**.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,599,841 B1

DATED : **October 6, 2009** **DRAFT**

INVENTOR(S) : Koller 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 898 days

Delete the phrase "by 898 days" and insert – by 1254 days--

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SAP / FINNEGAN, HENDERSON LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Walter Koller | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7599841 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/134,683 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/30/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1610** 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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FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS MN 55440-1022

| | |
|---|---|
| In re Application of | : |
| Wang, et al. | : LETTER REGARDING PTA |
| Application No. 10/134,684 | : |
| Filed: April 30, 2002 | : |
| Atty. Dkt. No.: 09531-054001/ | : |
| Z01150 | : |

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed January 3, 2007. The Office thanks applicants for their good faith and candor in bringing this to our attention.

The Determination of Patent Term Adjustment mailed October 18, 2006 indicated that the above-identified application was entitled to a patent term adjustment ("PTA") of 352 days. Applicants indicate that the PTA appears to be longer than appropriate.

The correct Patent Term Adjustment ("PTA") at the time of the allowance is 262 days.

As reflected in the Determination of Patent Term Adjustment mailed October 18, 2006, an adjustment of 470 days in accordance with 37 CFR 1.702(a)(1) and 1.702(a)(1) can be attributed to the Office connection with the restriction requirement mailed October 12, 2004.

As reflected in the Determination of Patent Term Adjustment mailed October 18, 2006, the adjustment is properly reduced 56 days in accordance with 37 CFR 1.704(b) in connection with the response to the restriction requirement submitted March 9, 2005.

As reflected in the Determination of Patent Term Adjustment mailed October 18, 2006, the adjustment is further reduced 62 days in accordance with 37 CFR 1.704(b) in connection with response to the non-final Office action submitted September 7, 2005.

The adjustment is further reduced 90 days in accordance with 37 CFR 1.704(b) in connection with the request for continued examination submitted April 18, 2006. The reduction began January 19, 2006, the day after the date that the final Office action was mailed, and ended April 18, 2006, the date that the RCE was submitted.

Accordingly, at the time of allowance, the application is entitled to an adjustment 262 days.

As applicants are advising us of a potential error in providing too much patent term adjustment in this application, no fee is due in connection with this matter.

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

This application is being forward to the Office of Patent Publication for issuance of the patent.

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

Kery A Fries

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

Enclosure: Copy of Adjustment PAIR Calculation

Day : Monday
Date: 2/26/2007

PALM INTRANET

Time: 15:12:23

| PTA Calculations for Application: 10/134684 | | | |
|---|---|---|---|
| Application Filing Date: | 04/30/2002 | PTO Delay (PTO): | 470 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 118 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 262 |
| PTO Delay Adjustment: | -90 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 51 | 02/26/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 90 | |
| 44 | 10/18/2006 | MAIL NOTICE OF ALLOWANCE | | | |
| 43 | 10/17/2006 | ISSUE REVISION COMPLETED | | | |
| 42 | 10/17/2006 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 41 | 10/10/2006 | NOTICE OF ALLOWABILITY | | | |
| 40 | 08/31/2006 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 08/23/2006 | RESPONSE AFTER EX PARTE QUAYLE ACTION | | | |
| 38 | 06/20/2006 | MAIL EX PARTE QUAYLE ACTION (PTOL - 326) | | | |
| 37 | 06/16/2006 | EX PARTE QUAYLE ACTION | | | |
| 36 | 05/05/2006 | DATE FORWARDED TO EXAMINER | | | |
| 35 | 04/18/2006 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 34 | 05/05/2006 | DATE FORWARDED TO EXAMINER | | | |
| 33 | 04/18/2006 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 32 | 05/05/2006 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 31 | 04/18/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 04/18/2006 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 29 | 04/18/2006 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 28 | 10/18/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 27 | 10/16/2005 | FINAL REJECTION | | | |
| 26 | 09/22/2005 | DATE FORWARDED TO EXAMINER | | | |
| 25 | 09/07/2005 | RESPONSE AFTER NON-FINAL ACTION | | 62 | 23 |
| 24 | 09/07/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |

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|---|---|---|---|---|---|
| 23 | 04/07/2005 | MAIL NON-FINAL REJECTION | | | |
| 22 | 03/31/2005 | NON-FINAL REJECTION | | | |
| 21 | 03/11/2005 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 03/09/2005 | RESPONSE TO ELECTION / RESTRICTION FILED | | 56 | 18 |
| 19 | 03/09/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 18 | 10/12/2004 | MAIL RESTRICTION REQUIREMENT | 470 | | -1 |
| 17 | 10/06/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 16 | 09/08/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 08/26/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 14 | 12/15/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 08/12/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 08/25/2002 | RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS | | | |
| 11 | 08/18/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 08/06/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 9 | 08/02/2002 | APPLICATION IS NOW COMPLETE | | | |
| 7 | 07/17/2002 | PAYMENT OF ADDITIONAL FILING FEE/PREEXAM | | | |
| 6 | 07/17/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 5 | 05/30/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 4 | 05/15/2002 | REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED | | | |
| 3 | 05/14/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 05/11/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 04/30/2002 | INITIAL EXAM TEAM NN | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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| | | |
|---|---|---|
| In re Application of: | : | |
| Cancilla et al. | : | |
| Application No. 10/134690 | : | DECISION DISMISSING |
| Filing or 371(c) Date: 04/30/2002 | : | PETITIONS UNDER |
| Title of Invention: | : | 37 CFR §§ 1.48 and 1.47(a) |
| INTEGRATED DIAGNOSTIC SYSTEM | : | |

This Decision is in response to the Petition Under 37 CFR § 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s), and on the Amendment, Petition and Fee to Correct Inventorship Under 37 C.F.R. 1.48(a), filed June 28, 2007.

The petitions are **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 [insert the applicable code section]"; 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).

Petition to correct inventorship

Applicant files with the present Amendment, Petition and Fee to Correct Inventorship Under 37 C.F.R. 1.48(a) to add inventor Carl T. Raff. In support of the petition, Applicant includes a statement from each person being added that the error occurred without deceptive intention on his or her part; the consent of the assignee; an oath/declaration executed by the actual inventors, save inventor Ken Wang, with the signature block of inventor Ken Wang executed by Inventor Terry Ogilvie, and a rule 47 petition to accept to oath/declaration on behalf of the other inventors and nonsigning inventor Wang. In support of the rule 47 petition, Applicant files the Declaration of Brenda G. Cnudde, wherein Ms. Cnudde states that the new Declaration and Power of Attorney form was sent to inventor Wang.

Applicable Law, Rules and MPEP

Under 37 CFR 1.48(a), if the correct inventor or inventors are not named in an executed oath or declaration under 37 CFR 1.63 in a nonprovisional application for patent, the application can be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the person named as an inventor in error or the person who through error was not named as an inventor.

37 CFR 1.48(a) requires that the amendment be accompanied by:

> (1) a request to correct the inventorship that sets forth the desired inventorship change;
>
> (2) 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;
>
> (3) 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;
>
> (4) the fee set forth in 37 CFR 1.17 (i); and
>
> (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Applicant lacks item (3).

**Analysis**

As to item (3), a grantable petition under 37 CFR 1.47(a) requires: (A) 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); (B) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (C) the petition fee; and (D) a statement of the last known address of the non-signing inventor. Applicant lacks items (A) and (B) set forth above.

As to item (A), if the whereabouts of the nonsigning inventor are known, Applicant is required to send the application to the inventor for his or her review. If the inventor fails to respond after a reasonable amount of time for a response has lapsed, Applicant may petition this Office based upon a constructive refusal of the nonsigning inventor to join in the application. The MPEP provides

> 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 non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration.

MPEP 409.03(d).

As to item (B), the MPEP 409.03(a), At Least One Joint Inventor Available, provides in relevant part:

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

In this instance, all of the available joint inventors have not made the oath/declaration on behalf of the nonsigning inventor. Here, only inventor Ogilvie has made the oath/declaration on behalf of the nonsigning inventor.

As to item (B), oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank, is required.

**Conclusion**

The petition is dismissed without prejudice. Applicant should file a Request for Reconsideration of Petition and include the necessary statements and/or copies of documents, depending upon whether the whereabouts of the nonsigning inventors are known, or unknown.

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

By mail: Director 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

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| | | |
|---|---|---|
| In re Application of: | : | DECISION GRANTING |
| Cancilla et al. | : | PETITION UNDER |
| Application No. 10/134690 | : | 37 CFR § 1.48 and |
| Filing or 371(c) Date: 04/30/2002 | : | DISMISSING PETITION |
| Title of Invention: | : | 37 CFR 1.47(a) as MOOT |
| INTEGRATED DIAGNOSTIC SYSTEM | : | |

This Decision is in response to the Request for Reconsideration of Petitions Under 37 CFR § 1.47(a) and 37 C.F.R. 1.48(a), filed October 22, 2007, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s) and to correct inventorship.

The petition Under 37 CFR § 1.47(a) is **dismissed as moot**.

The petition Under 37 CFR § 1.48 is **granted**.

Background

Applicant filed a petition to correct inventorship on June 28, 2007, to add inventor Carl T. Raff. In support of the petition, Applicant included a statement from each person being added that the error occurred without deceptive intention on his or her part; the consent of the assignee; an oath/declaration executed by the actual inventors, save inventor Ken Wang, with the signature block of inventor Ken Wang executed by Inventor Terry Ogilvie, and a rule 47 petition to accept to oath/declaration on behalf of the other inventors and nonsigning inventor Wang. In support of the rule 47 petition, Applicant filed the Declaration of Brenda G. Cnudde, wherein Ms. Cnudde stated that the new Declaration and Power of Attorney form was sent to inventor Wang.

The petition was dismissed in a Decision mailed August 21, 2007. The dismissal informed Applicant that 37 CFR 1.48(a) requires that the amendment be accompanied by:

(1) a request to correct the inventorship that sets forth the desired inventorship change;

(2) 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;

(3) 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;

(4) the fee set forth in 37 CFR 1.17 (i); and

(5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The June 28, 2007 petition lacked item (3).

The present request for reconsideration

The present request for reconsideration includes : (1) a request to correct the inventorship that sets forth the desired inventorship change filed June 28, 2007); (2) 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 (filed June 28, 2007); (3) 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 (filed with the present request for reconsideration); (4) the fee set forth in 37 CFR 1.17 (i) (filed June 28, 2007); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment (filed June 28, 2007).

Accordingly, the petitions are granted. A corrected Filing Receipt identifying the inventorship of the application is enclosed herewith.

The application is being referred to Publishing Division 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

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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 |
|---|---|---|---|---|---|---|
| 10/134,690 | 04/30/2002 | 2173 | 1000 | 10473-861 | 3 | 2 |

**CONFIRMATION NO. 3345**

**CORRECTED FILING RECEIPT**

MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

*OC000000026835115*

Date Mailed: 11/20/2007

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Jim J. Cancilla, San Jose, CA;
Bill Duran, Santa Cruz, CA;
Robert Hoevenaar, BT De Weere, NETHERLANDS;
Arnold Kop, AJ Purmerend, NETHERLANDS;
Keith A. Kreft, Cupertino, CA;
Tyrone J. Moritz, Morton Grove, IL;
James M. Normile, Hayward, CA;
Terry R. Ogilvie, San Jose, CA;
Dale A. Trsar, Mt. Prospect, IL;
Dennis G. Williamson JR., Manteca, CA;
Ken Wang, Cupertino, CA;
Robert P. Edwards, San Jose, CA;
Carl T. Raff, Union City, CA;

**Power of Attorney:** The patent practitioners associated with Customer Number 20277

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/289,116 05/08/2001
and claims benefit of 60/291,622 05/18/2001
and claims benefit of 60/354,204 02/06/2002

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 06/07/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/134,690**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

INTEGRATED DIAGNOSTIC SYSTEM

**Preliminary Class**

715

## 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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THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTO, GA 30339-5948

| | |
|---|---|
| In re Application of | : |
| Craig L. Hill et al | : |
| Serial No.: 10/134.774 | : PETITION DECISION |
| Filed: April 29, 2002 | : |
| Attorney Docket No.: 50508-1051 | : |

This is in response to the petition under 37 CFR 1.137(b) which is being treated under 37 CFR 1.181, filed March 15, 2004, requesting withdrawal of abandonment based on non-receipt of an Office action.

A review of the file history shows that the examiner mailed an Office action to applicants on July 17, 2003, setting a three month statutory period for reply. Upon failure to receive a reply the application was held abandoned by Notice of Abandonment mailed to applicants on March 3, 2004. Applicants state that the Office action was never received and provide statements and docket records providing evidence of non-receipt. In view thereof, the Notice of Abandonment is withdrawn and the application restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**The application will be forwarded to the examiner for mailing of a new Office action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.

Bruce M. Kisliuk
Director, Technology Center 1600

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Robert C. Kowert
Conley, Rose & Tayon, P.C.
P.O. Box 398
Austin, TX 78767

MAILED

FEB 15 2006

TECHNOLOGY CENTER 2100

In re Application of: Dinker, et al.
Application No. 10/134,782
Attorney Docket No. 5681-11000
Filed: 4/29/2002
For: SYSTEM AND METHOD FOR DYNAMIC CLUSTER ADJUSTMENT TO NODE FAILURES IN A DISTRIBUTED DATA SYSTEM

DECISION ON PETITION FOR SUPERVISORY REVIEW UNDER *37 CFR §1.181*

This is a decision on the petition under 37 CFR § 1.181, filed December 14, 2005, requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed September 22, 2005.

The petition is **GRANTED**.

## RECENT PROSECUTION HISTORY

(1) On April 21, 2005, a non-final first Office action, treating pending claims 1-23, was mailed.

(2) On July 11, 2005, a response to the non-final Office action, in which amendments to pending claims 1-23, was filed. New claims 24-26 were added.

(3) On September 22, 2005, a final Office action, treating pending claims 1- 26, was mailed.

(4) On November 21, 2005, a reply after final rejection was filed requesting reconsideration of the finality of the September 22, 2005 Office action under MPEP 706.07(d).

(5) On December 8, 2005, an advisory action was mailed maintaining the finality of the previous Office action.

## RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the finality of the September 22, 2005 office action. Specifically, Applicant maintains that the 35 USC 102 rejection, made in the final Office action, is in fact a new ground of rejection not necessitated by the amendment.

## ANALYSIS

A non-final first Office action was issued on April 21, 2005, including a rejection of claims 1-23 under 35 USC 112 (2nd para.) as indefinite. No prior art was applied against claims 9 and 20 in this action, and the Examiner indicated these claims to be allowable, if rewritten to overcome the rejections(s) under 35 USC 112 (2nd para.) and to include all of the limitations of the base claim and any intervening claims. An amendment and response to the first Office action was timely filed and received in the Patent and Trademark Office on July 11, 2005. In the amendment filed July 11, 2005, and with particular attention to newly added independent claims 25 and 26, Applicant indicated these claims to be original claims 9 and 20 rewritten to overcome the 35 USC 112 (2nd para.) rejection and to include the base claim limitations from which they depended (i.e. claims 8 and 19 resp.).

In the final Office action mailed September 22, 2005, the Examiner rejected newly added claims 25-26 under 35 USC 102(e) as being anticipated by Chambers et al. (US 6,480,473). Thus, the final Office action of September 22, 2005 introduces a new reference, Chambers et al. ('473) and a new ground of rejection. Newly added claims 25-26 (identified above) and the language therein, was held by the Examiner to necessitate the new grounds of rejection presented in the final Office action (see "conclusion" on pages 13-14 thereof and Advisory Action mailed December 8, 2005). As per MPEP § 706.07 (d), a request for reconsideration for withdrawal of the finality of the Office action of September 22, 2005 (as premature) occurred in Applicant's remarks with the first after final response (see pages 16-17 thereof) filed on November 21, 2005. The examiner issued an advisory action on December 8, 2005, which denied the request by maintaining the finality of the last Office action.

The relevant sections of the M.P.E.P. are set forth below:

MPEP § 706.07(a) states in part that:
A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, o***f any claim amended to include limitations which should reasonably have been expected to be claimed***. See MPEP § 904 et seq. ***For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element***. Under present practice, second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection ***not necessitated*** by amendment of the application by the applicant, whether or not the prior art is already of record.

MPEP § 706.07(d) states in part that:
If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

MPEP § 706.07(e) states in part that:
When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

In consideration of petitioner's remarks and in reviewing the **original recitation** found in claims 9 and 20 versus newly added independent claims 25 and 26, the recitations appear to be substantially identical to the original claim language of claims 8-9 and 19-20 with the exception of the term "particular" before "node" at various locations throughout the independent claims. The addition of the term "particular" in the amendment of July 11, 2005 to claims 25 and 26 is in direct response to the rejection of claims 9 and 20 under 35 USC 112 (2nd para.) in the non-final Office action of April 21, 2005 on page 3 thereof (i.e. the limitation "the node" in these claims

was rendered to be unclear/indefinite by the examiner), see also second full para., page 24 of the response filed July 11, 2005. The Applicant therefore, was merely supplying the omitted element, identified by the Examiner, for completeness of the claim recitation. As indicated, one would reasonably expect that a rejection under 35 USC 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element or in the case of the instant application, clarifying which "node" was originally claimed. As such, and in accordance with MPEP § 706.07(a), this represents a new ground(s) of rejection not necessitated by amendment.

## CONCLUSION

The final Office action of September 22, 2005 includes a new ground(s) of rejection with respect to at least claims 25-26 under 35 USC 102(e), that was not necessitated by the new limitations and/or amendment presented on July 11, 2005. Thus, it is improper under current Office practice to make the September 22, 2005 Office action final as provided for under MPEP § 706.07(a).

For the above stated reasons, the petition to withdraw the finality of the final Office action of September 22, 2005 is **GRANTED**.

The application file is being forwarded to the Examiner to **WITHDRAW** the finality of the previous Office action and to **CONSIDER** the response filed November 21, 2005, as per MPEP § 706.07(e). An action on the merits should be sent in due course.

Any inquiries related to this decision may be directed to Specials Program Examiner Brian Johnson at (571) 272-3595.

Jack Harvey

Jack Harvey, Director
Technology Center 2100
Computer Architecture, Software, and Information Security

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JJGJr: 08-03

Paper No: 9

WOODARD, EMHARDT,
NAUGHTON, MORIARTY AND MCNETT
BANK ONE CENTER/TOWER
SUITE 3700
111 MONUMENT CIRCLE
INDIANAPOLIS IN 46204-5137

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Perez, et al. | : |
| Application No. 10/134,796 | : DECISION ON PETITION |
| Filed: 31 August, 2001 | : |
| Attorney Docket No.: 20202-31 | : |

This is a decision on the petition filed on 14 July, 2003, to revive the instant nonprovisional application under the provisions of 37 C.F.R. §1.137(f), and considered as a petition under 37 C.F.R. §1.137(b).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of Petitioner identifies as "an International Application" filed on 29 April, 2002. However, while Petitioner rescinded his non-publication request on 6 June, 2002, (within 45 days of the international application filing) Petitioner unintentionally failed to "Notice" the US Patent and Trademark Office within 45 days subsequent to the filing of the international application.

In view of the above, this application became abandoned pursuant to 35 U.S.C. §122(b)(2)(B)(iii) and 37 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. Because the Office data base indicating an actual publication date of 28 November, 2002, no Notice Regarding Rescission of Nonpublication Request indicating a projected accompanies this decision on petition.

The application is being forwarded to Technology Center 2100 for further processing 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

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Paper No. 090204

WU & CHEUNG, LLP
7700 IRVIINE CENTER DRIVE
SUITE 710
IRVINE, CA 92618-3043

SEP - 8 2004

| | | |
|---|---|---|
| In re Application of: | : | |
| SHIAO-SHIEN CHEN | : | |
| Serial No.: 10/134,835 | : | DECISION ON REQUEST TO WITHDRAW |
| Filed: April 29, 2002 | : | FROM RECORD |
| Attorney Docket No.: **JC-8555-C** | : | |

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed August 06, 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 Charles C. H. Wu, on behalf of Maria Erlinda C. Sarno. There is no outstanding Office action at this time.

The request is **APPROVED**.

All other attorneys and agents for Wu & Cheung LLP remain of record at this time.

All future communications from the Office will continue to be directed to Wu & Cheung LLP, at the above address, until otherwise notified by applicant.

Inquiries related to this decision should be directed to Lissi Marquis at (571) 272-1596.

Lissi Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No. 6

Mark Kusner
Mark Kusner Co., LPA
Highland Place – Suite 310
6151 Wilson Mills Road
Highland Heights, OH 44143

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APR 1 4 2003
OFFICE OF PETITIONS

In re Application of :
Israel Peretz, et al. :
Application No. 10/134,836 : ON PETITION
Filed: April 29, 2002 :
Attorney Docket No. NR7364US :

This is in response to the petition under 37 CFR 1.47(b), filed March 26, 2003, which has been treated as a petition under 37 CFR 1.47(a).[1]

The petition is granted.

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

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

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

The application file is being forwarded to Technology Center Art Unit 1742 for further processing.

[1] A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Since an executed oath or declaration by one of the non-signing inventors in compliance with 37CFR 1.63 was received on March 26, 2003, this petition is more appropriately treated under 37 CFR 1.47(a).

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

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Israel Peretz
456 Highpointe Drive
Pittsburgh, PA 15220

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of
Israel Peretz; and Timothy A. Leitzel
Application No. 10/134,836
Filed: April 29, 2002
For: WELL BLOCK FOR METALLURGICAL VESSEL

Dear Israel Peretz:

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: Mark Kusner
Mark Kusner Co., LPA
Highland Place – Suite 310
6151 Wilson Mills Road
Highland Heights, OH 44143

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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JUN 11 2002

Paper No. 4

In re Application of
Bemanali H. Dadbeh
Application No. 10/134,902
Filed: April 29, 2002
Attorney Docket No. 1405-226

: DECISION ON PETITION

This is a decision on the petition filed concurrently with the application by which petitioner requests that this application be accorded special status for advanced examination out of turn. Petitioner has paid the $130.00 petition fee.

The petition is granted.

Petitioner request special status based upon the practice set forth in MPEP 708.02(II), Infringement. A review of the materials set forth in the petition shows that petitioner has complied with the requirements for a petition based upon that grounds.

Accordingly, the examiner will treat this application as special throughout its prosecution. Prior to the first action on the merits, the examiner will conduct a rigorous search for potentially interfering applications. The interference search will be brought up to date prior to each successive action.

The application is being forwarded to the Supervisory Patent Examiner of Patent Examining Art Unit 3711, who will forward the application to the examiner for action consistent with this Decision.

PETITION GRANTED.

Stephen Marcus, Special Program Examiner
Technology Center 3700

Woodard, Emhardt, Naughton, Moriarty and McNett
Bank One Center/Tower
Suite 3700
111 Monument Circle
Indianapolis, IN 46204-5137

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EXXONMOBIL CHEMICAL COMPANY
5200 BAYWAY DRIVE
P.O. BOX 2149
BAYTOWN TX 77522-2149

| | |
|---|---|
| In re Application of | : |
| Pellingra, et al. | : PETITION DECISION |
| Application No. 10/134,903 | : UNDER 37 CFR 1.78(a)(3) |
| Filed: April 29, 2002 | : |
| Dkt. No.: 2002B060 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 4, 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 application filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

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

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

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

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

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

The required fee of $1,370.00 has been charged to Deposit Account No. 05-1712 as authorized in the instant petition.

Any inquiries concerning this decision may be directed to Alesia M. Brown at (571) 272-3205. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1776 for appropriate action on the amendment filed March 4,

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

**ATTACHMENT:** Corrected Filing Receipt

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ——

DATE : 4/25/05

TO SPE OF : ART UNIT 1631

SUBJECT : Request for Certificate of Correction on Patent No.: 6767898 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:**

SPE

1631
Art Unit

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HOUSTON, TX 77208-1389

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| | | |
|---|---|---|
| In re Application of | : | |
| Steven W. Lopez et al | : | DECISION ON PETITION |
| Application No. 10/134,941 | : | TO WITHDRAW |
| Filed: April 30, 2002 | : | FROM RECORD |
| Attorney Docket No. 081543.000008 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 21, 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 Jeffrey S. Whittle on behalf of all attorneys of record who are associated with customer No. 035979.

All attorneys/agents associated with the Customer Number 035979 have been withdrawn.

Applicants are 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.

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

This matter is being referred to Publishing Division.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: MARK PASSLER
AKERMAN SENTERFITT
222 LAKEVIEW AVENUE, SUITE 400
WEST PALM BEACH, FL 33401

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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/134,941 | 04/30/2002 | Steven W. Lopez | 081543.000008 |

**CONFIRMATION NO. 5558**

*OC000000018077739*

Jeffrey S. Whittle
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

Date Mailed: 02/16/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/21/2005.

- 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.

---

Wan Laymon

WAN LAYMON
OP (571) 272-3220

FORMER ATTORNEY/AGENT COPY

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

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OCT 27 2004

**OFFICE OF PETITIONS**

In re Application of :
Boyd L. Coomer :
Application No. 10/134,951 : ON PETITION
Filed: April 29, 2002 :
Attorney Docket No. 42P14107 :

This is a decision on the petition, filed August 19, 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 above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 7, 2003, 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)). No amendment *prima facie* placing the application in condition for allowance or Notice of Appeal (and appeal fee) was timely filed, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 8, 2003.

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

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

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

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

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

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

Attachment: Advisory Action

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LOS ANGELES, CA 90025-1030

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| | | |
|---|---|---|
| In re Application of | : | |
| Boyd L. Coomer | : | |
| Application No. 10/134,951 | : | ON PETITION |
| Filed: April 29, 2002 | : | |
| Attorney Docket No. 42P14107 | : | |

This is a decision on the renewed petition, filed December 29, 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 above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 7, 2003, 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)). No amendment *prima facie* placing the application in condition for allowance or Notice of Appeal (and appeal fee) was timely filed, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 8, 2003.

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

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

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

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

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

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

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1026

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APR 2 8 2005

**OFFICE OF PETITIONS**

In re Application of :
Boyd L. Coomer :
Application No. 10/134,951 :
Filed: April 29, 2002 :
Attorney Docket No. 42P14107 :

ON PETITION

This is a decision on the re renewed petition under 37 CFR 1.137(b), filed April 15, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on April 15, 2005.

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

This matter is being referred to Technology Center AU 2812 for further processing.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : June 29, 2007

TO SPE OF : ART UNIT 1773

SUBJECT : Request for Certificate of Correction for Appl. No. 10/134969 patent no.6893722

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:** _____

SPE

1794

Art Unit

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Alexandria, VA 22313-1450
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MALLOY & MALLOY PA
2800 S.W. THIRD AVENUE
HISTORIC CORAL WAY
MIAMI, FLORIDA 33129

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NOV 16 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Steven Schraga | : | |
| Application No. 10/134,996 | : | DECISION GRANTING PETITION |
| Filed: April 29, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 1.061.01 | : | |

This is a decision on the petition, filed November 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 September 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) 272-3218.

This matter is being referred to forwarded to Technology Center AU 3732 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

David M. Maiorana, Esq.
Jones, Day, Reavis & Pogue
901 Lakeside Avenue
North Point
Cleveland, OH 44114

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DEC 06 2004

OFFICE OF PETITIONS

In re Application of :
Puente Baliarda :
Application No. 10/135,019 : ON PETITION
Filed: April 23, 2002 :
Attorney Docket No.: 100700-00064(HERR 19.680):

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

The petition is **GRANTED**.

The above-identified application is being 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 indicates that an Information Disclosure Statement (IDS) will be subsequently submitted.

***Petitioner is advised that the issue fee paid in the above-identified application on September 10, 2004, 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] Petitioner is also reminded that the IDS should be filed before the mailing of a first Office action on the merits.

The application will be referred to Technology Center AU 2821 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
((571) 272-3204

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

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JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

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MAR 0 5 2007

**OFFICE OF PETITIONS**

In re Patent No. 6,937,191 :
Issue Date: August 30, 2005 :
Application No. 10/135,019 :
Filed: April 23, 2002 :
Attorney Docket No.: 100700-00064(HERR :
19.680) :

NOTICE

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

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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ALEXANDRIA, VA 22313-1450
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TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC
1900 EMBARCADERO ROAD
SUITE 109
PALO ALTO, CA 94303

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OCT 24 2007

**OFFICE OF PETITIONS**

In re Application of
Gautam Bhargava, et al.
Application No. 10/135,031
Filed: April 29, 2002
Attorney Docket No. 100101-001400US

ON PETITION

This is a decision in response to the petition, filed June 29, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed April 28, 2006. A Notice of Abandonment was mailed on May 29, 2007. In response, on June 29, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

The application is being referred to Technology Center AU 2141 for consideration of the amendment filed June 29, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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| | | |
|---|---|---|
| In re Application of | : | |
| Michael Klein et al | : | |
| Application No. 10/135,064 | : | DECISION GRANTING PETITION |
| Filed: April 30, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. KLEN 18.628 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 27, 2006 and resubmitted on September 25, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 26, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 29, 2004 (June 26, 2004, the due date, was a Saturday).

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) a reply, (2) the $750 petition fee, and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of March 26, 2004 is accepted as having been unintentionally delayed.

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

circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

The petition is accompanied by a "Submission of Replacement Declaration," which adds as an inventor Richard J. Manno. However, the executed declaration filed with the application on April 30, 2002 did not include Mr. Manno as a joint inventor. As the declaration filed with the application on April 30, 2002 was executed by inventors Michael Klein and Michael Abrams, any request to now add Richard J. Manno as an inventor must be done by way of a request under 37 CFR 1.48(a). *See also* 37 CFR 1.48(f)(1).

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

This matter is being referred to Technology Center AU 3732 for appropriate action in the normal course of business on the reply received January 27, 2006.

Frances Hicks
Petitions Examiner
Office of Petitions

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MEDTRONIC, INC.
710 MEDTRONIC PARK
MINNEAPOLIS MN 55432-9924

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| | | |
|---|---|---|
| In re Application of | : | |
| Gunderson et al. | : | DECISION ON PETITION TO |
| Application No. 10/135,080 | : | WITHDRAW HOLDING OF |
| Filed: 29 April, 2002 | : | ABANDONMENT |
| Attorney Docket No. P10544.00 | : | |

This is a decision on the petition filed on 21 June, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely reply to the non-final Office action mailed on 14 December, 2005, which set a three (3) month shorted statutory period for reply. Notice of Abandonment was mailed on 5 July, 2006.

Petitioners assert that the non-final Office action mailed on 14 December, 2005, was never received.

In the absence of any irregularity in the mailing of the final Office action, there is a strong presumption that the final Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the final Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and

docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the final Office action may have been lost after receipt rather than a conclusion that the final Office action was lost in the mail.

A review of the record indicates that the Office action was properly mailed to the practitioner of record at the correspondence address of record at the time of mailing. Thus, there was no irregularity in mailing the Office action on the part of the United States Patent and Trademark Office.

In support, the petition includes a statement from the practitioner, Michael C. Soldner, stating that the Office communication was not received by the practicioner, and attesting to the fact that a search of the file jacket indicates that the Office action was not received. A copy of the docket record for the instant application, where the non-received Office action would have been entered had it been received and docketed, is attached.

The petitioner has made a sufficient showing of nonreceipt of the Office action. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED.**

It is noted that applicant has filed an amendment in reply to the Office action mailed on 14 December, 2005, with the present petition. As such the Office action will not be remailed.

The application file is being referred to Technology Center Art Unit 3766 for consideration of the reply filed with the present petition.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Philip M. Weiss, Esq.
WEISS & WEISS
310 Old Country Road
Suite 201
Garden City, NY 11530

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DEC 28 2004

OFFICE OF PETITIONS

In re Application of :
George Conforti, et al. :
Application No. 10/135,126 : ON PETITION
Filed: April 29, 2002 :
Attorney Docket No. P/36-5 DIV :

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

The petition is **DISMISSED**.

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

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

---

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

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

It is noted that applicant alleges non-receipt of the non-final Office action mailed December 4, 2004, although no evidence to support the allegation was filed. Accordingly, a copy of the non-final Office action is enclosed for applicant's convenience.

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 Two, Lobby, Room 1B03
Arlington, VA 22202

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

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

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

Enclosure: Non-final Office action mailed December 4, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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PHILIP M. WEISS, ESQ.
WEISS & WEISS
310 OLD COUNTRY ROAD
SUITE 201
GARDEN CITY, NY 11530

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MAR 2 5 2005

**OFFICE OF PETITIONS**

In re Application of :
George Conforti :
Application No. 10/135,126 : ON PETITION
Filed: April 29, 2002 :
Attorney Docket No. P/35-5 DIV :

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

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed December 4, 2003. A Notice of Abandonment was mailed on June 9, 2004.

The petition is found to comply with the requirements of 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being referred to Technology Center AU 1761 for consideration of the response filed January 20, 2005.

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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TUCKER, ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND OH 44115-1414

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OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of

Tanvir Goraya :

Application No. 10/135,159

: DECISION ON PETITION

Filed: April 20, 2002

:

Attorney Docket No. 76295/22343

This is a decision on the petition under 37 CFR 1.137(b), filed May 24, 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 1, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on September 2, 2005. A Notice of Abandonment was mailed on March 17, 2006.

The amendment filed May 24, 2006, is noted.

The application is being forwarded to Technology Center 2100, GAU 2129 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

# 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. |
|---|---|---|---|---|
| 10/135,163 | 04/30/2002 | Frank Coulier | 11539-00007-US1 | 6021 |

30678 7590 06/30/2009
CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

| EXAMINER |
|---|
| SHAW, YIN CHEN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2439 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/30/2009 | PAPER |

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONNOLLY BOVE LODGE & HUTZ, LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

MAIL

JUN 30 2009

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Frank Coulier
Application No. 10/135,163
Filed: April 30, 2002
Docket: 11539-00007-US1
For: USE AND GENERATION OF A SESSION KEY IN A SECURE SOCKET LAYER CONNECTION

DECISION ON PETITION
UNDER 37 C.F.R. § 1.181

This is a decision on the petition under 37 CFR § 1.181, filed on April 21, 2009 to invoke the Supervisory Authority of the Commissioner to overturn the Examiner' refusal to enter a Declaration under 37 C.F.R. § 1.132.

The petition is Granted.

## Background

On April 30, 2008, A Non-Final Office action was issued by the USPTO, rejecting the claimed limitation in the preamble of claim 1 of "offering an alternative for authenticating the server public key" with Vogelesang et al in a combination of references including Smeets and Powar. Page 3 paragraph a) of the office action identifies Vogelesang as teaching "said method offering an alternative for authenticating the server public key".

On November 25, 2008, A Final Office was issued by the USPTO with the same page 3 citation of Vogelesang reference to meet the claimed limitation in the preamble of "offering an alternative for authenticating the server public key". **Additionally in responding to the arguments on page 37 of the office action, the Powar reference was cited to teach the above quoted claimed language.**

On February 25, 2009, the Petitioner filed a Declaration under 37 C.F.R. § 1.132, where Mr. Frank Coulier, as the inventor of this application, points out how the claim limitations of the preamble differs from the disclosure of the Powar reference (col. 14, lines 45 – 49).

On March 16, 2009, an Advisory Action was issued by the USPTO to show that the Declaration is not in compliance to the timeliness requirement as set forth in MPEP § 716.01. The Examiner pointed out in the Advisory Action that the Declaration could have been still submitted prior to the Final Office Action since the Powar reference was previously applied in the Non-Final Office Action issued on April 30, 2008.

On April 13, 2009, the attorney alleges that an interview occurred and the examiner maintained there position that the Declaration was not timely.

On April 21, 2009 a petition was filed.

## Requirements

**716.01 [R-3] The MPEP stated in part that:**
Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:
(1) prior to a final rejection,
(2) before appeal in an application not having a final rejection, *
**(3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or**
(4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.
For affidavits or declarations under 37 CFR 1.132 filed after appeal, see 37 CFR 41.33(d) and MPEP § 1206 and § 1211.03.<

## Opinion

A review of the facts shows that the Examiner did not use the Powar reference to reject the limitation in the preamble of "offering an alternative for authenticating the server public key" in the Non-Final Office issued on April 30, 2008. However, the Examiner mistakenly argued that the Powar reference meets the limitation in the preamble of "offering an alternative for authenticating the server public key" in the Final Office Action. The Application will be forwarded to the Examiner to further consider of the Declaration under 37 C.F.R. § 1.132.

TB 6-30-09

Accordingly, the petition is **Granted**.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of Contact is Kim Huynh at (571)-272-4147.

Tod R Swann, WQAS 2430
Technology Center 2400
Networking, Multiplex, Cable and Computer Security

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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MAR 06 2007

OFFICE OF PETITIONS

BOWDITCH & DEWEY, LLP
311 MAIN STREET
P.O. BOX 15156
WORCESTER MA 01615-0156

| | | |
|---|---|---|
| In re Application of | : | |
| Patrick J. Houle, et al. | : | |
| Application No. 10/135,191 | : | DECISION ON PETITION |
| Filed: April 29, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 082238.3000-100 | : | 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 26, 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 Jodi-Ann McLane on behalf of all attorneys of record who are associated with customer No. 30407.

All attorneys/agents associated with the Customer Number 30407 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 June 19, 2006 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: PATRICK J. HOULE
235 MAYNARD ROAD
SUDBURY, MA 01776

cc: VALUE BENEFITS INSURANCE AGENCY, INC.
250 COMMERCIAL STREET
WORCESTER, MA 01608

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/135,191 | 04/29/2002 | Patrick J. Houle | 082238.3000-100 |

**CONFIRMATION NO. 5405**

*OC000000022748085*

*OC000000022748085*

30407
BOWDITCH & DEWEY, LLP
311 MAIN STREET
P.O. BOX 15156
WORCESTER, MA 01615-0156

Date Mailed: 03/05/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/26/2006.

- 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.

---

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

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**HAHN LOESER & PARKS, LLP**
**ONE GOJO PLAZA**
**SUITE 300**
**AKRON, OH 44311-1076**

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JUL 07 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Richard C. Raney | : | DECISION ON PETITION |
| Application No. 10/135,201 | : | TO WITHDRAW |
| Filed: April 30, 2002 | : | FROM RECORD |
| Attorney Docket No. 6308-00200 | : | |

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 20, 2009.

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

A review of the file record indicates that on February 16, 2009 the power of attorney to Hahn Loeser & Parks, LLP was revoked by the applicant of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P.O. Box 398
Austin TX 78767-0398

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JJGJR.: 01-05

Paper No: __

JOHN F. SALAZAR
MIDDLETON & REUTLINGER
2500 BROWN & WILLIAMSON TOWER
LOUISVILLE KY 40202

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OFFICE OF PETITIONS

In re Application of
Mula, et al. :
Application No. 10/135,206 :
Filing Date: 30 April, 2002
Attorney Docket No. ZE720/93001 :

This is a decision on the petition filed on 2 November, 2004, alleging unintentional delay under 37 C.F.R. §1.137(b).

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Fees Due mailed on 1 April, 2004, with response due under a non-extendable deadline on or before 1 July, 2004;
- the application went abandoned after midnight 1 July, 2004;
- it does not appear that the Office mailed the Notice of Abandonment before the instant

petition was filed;

- Petitioner filed with the instant petition (and fee) the reply in the form of the Issue and Publication Fees and made the statement of unintentional delay.

## STATUTES, REGULATIONS AND ANALYSIS

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

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

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

---

[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(b) are the petition and fee, a showing of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

Petitioner has satisfied the requirements of the regulation.

## CONCLUSION

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

The instant application is released to Publications Branch to be processed into a patent.

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

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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Douglas M. Eveleigh
Mayer, Brown, Rowe & Maw
P.O. Box 2828
Chicago, IL 60690-2828

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OFFICE OF PETITIONS

In re Application of :
George G. Clarke :
Application No. 10/135,289 : ON PETITION
Filed: April 29, 2002 :
Attorney Docket No. 01851188 :

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

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 1, 2003, 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 after midnight June 1, 2004.

In response, petitioner submitted with the instant petition $665 for the petition to revive fee, a Request for Continued Examination (RCE) under 37 CFR 1.114, along with $385 for the RCE filing fee

The petition is **GRANTED**.

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

The application file is being referred to Technology Center Art Unit 3676, forprocessing the Request for Continued Examination under 37 CFR 1.114, and for further review of the amendment previously submitted on May 28, 2004.

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

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

CC: Douglas M. Eveleigh
Mayer, Brown, Rowe & Maw, LLP
190 S. LaSalle Street
Chicago, IL 60603

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JJGJR.: 02-05

Paper No: 7

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE, 46TH FLOOR
1650 MARKET STREET
PHILADELPHIA PA 19103

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OFFICE OF PETITIONS

In re Application of
Pomrink :
Application No. 10/135,309 :
Filing Date: 30 April, 2002
Attorney Docket No. OVIT-0214 :

This is a decision on the petition filed on 11 March, 2004, and resubmitted via FAX on 3 February, 2005, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter.

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

## BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to a Notice to File Missing Parts mailed on 6 June, 2002, with reply due absent extension of time on or before Monday, 5 August, 2002;
- the application went abandoned after midnight 3 August, 2002;
- the Office mailed a Notice of Abandonment on 26 January, 2004;

- on 11 March, 2004, Petitioner filed the instant petition (with fee authorization), a copy of what purports to be a receipt card date stamped "JUL 2 2002" evidencing receipt of Petitioner's reply to the Notice of Missing Parts, and a copy of Petitioner's reply to that Notice;

- moreover, the file contains Petitioner's reply as filed on 2 July, 2002, and Office records reflect Petitioner's payment by check of the fee due at that time.

## STATUTES, REGULATIONS AND ANALYSIS

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

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

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

---

[1] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

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

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[7]

Petitioner evidences timely reply to the Notice of Missing Parts.

## CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, the Notice of Abandonment of 26 January, 2004, hereby is **vacated**, and the petition fee is waived.

The file is forwarded to Technology Center 1700 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 2727-3214.

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

---

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

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

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| | |
|---|---|
| *In re* Patent No. 6,800,998<br>Issue Date: October 5,2004<br>Appl No.: 10/135,343<br>Filed: April 30, 2002<br>For: DE MAAGT, BENNIE JOSEPHUS | **DECISION GRANTING PETITION**<br>*37 CFR 1.324* |

This is a decision on the petition filed 06/09/2005 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.

Nimeshkumar D. Patel
Supervisory Patent Examiner
Art Unit 2879
Technology Center 2879

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

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 6,800,998
Patented: October 5, 2004

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:

DE MAAGT, BENNIE JOSEPHUS , EINDHOVEN, THE NETHERLANDS

ALESSIO CORAZZA

Nimeshkumar D. Patel
Supervisory Patent Examiner
Art Unit 2879

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**OGILVY RENAULT LLP**
**1981 McGILL COLLEGE AVENUE**
**SUITE 1600**
**MONTREAL QC H3A2Y3 CANADA**

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| | | |
|---|---|---|
| In re Application of | : | |
| Bernard Massie et al | : | |
| Application No. 10/135,362 | : | DECISION GRANTING PETITION |
| Filed: May 1, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 2139-20US-CC:1c1 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 13, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 14, 2005. A Notice of Abandonment was mailed on May 2, 2006.

The rule at 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 of the rule, the statement is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement appearing in the petition.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply, (2) the $1,500 petition fee, and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of July 13, 2005 is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 1622 for appropriate action in the normal course of business on the reply received March 3, 2006.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 3

Wilmer, Cutler & Pickering
2445 M Street, N.W.
Washington DC 20037

**MAILED**

JUN 0 2 2003

**Technology Center 2100**

| | | |
|---|---|---|
| In re Application of: Zhichen XU, et al. | ) | |
| Application No. 10/135,413 | ) | **DECISION ON REQUEST FOR** |
| Filed: May 1, 2002 | ) | **WITHDRAWAL AS ATTORNEY** |
| For: INCREASING PEER PRIVACY BY | ) | |
| FORWARDING A LABEL | ) | |

This is a decision on the Request To Withdraw from Representation filed April 10, 2003.

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

The request 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: HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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Intellectual Property Administration
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Fort Collins, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of Xu et al. :
Application No. 10/135,413 :
Filing Date: May 1, 2002 :
Attorney Docket No. 100200291-1 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.181, filed July 2, 2007, to withdraw the holding of abandonment.

The petition is **dismissed**.

The Office mailed a non-final Office action on October 13, 2006.

The Office action set s three (3) month shortened statutory period for reply.

The Office did not receive a reply to the Office Action. As a result, a Notice of Abandonment was mailed May 2, 2007.

Petitioner contends the October 13, 2006 Office action was never received.

The address of record is:

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

The petition includes the following address:

Ashok Mannava
Mannava & Kang, P.C.
Suite 104
8221 Old Courthouse Road
Vienna, VA 22182

The petition is ambiguous as to whether or not petition is alleging the Office action was never received at the first address and/or is alleging the Office action was never received at the second address.

Petitioner states a search of the file wrapper has been performed. Was a search of the file wrapper at the address of record conducted? The petition is signed by Tiep Nguyen and Ashok Mannava. Did either of these individuals personally search the file at the address of record? The petition cannot be granted without a statement from a person with first hand knowledge of the facts.

Petitioner has supplied a copy of a docket report. Is the docket report a docket report maintained by individuals at the address or record or is it a docket report maintained by individuals at the second address listed on the prior page?

The information of record is currently insufficient to show the Office action was not received at the address of record. The Office notes, if the Office action was lost when being forwarded from the address of record to the second address, a petition to withdraw the holding of abandonment will not be granted.

Any request for information should include the information requested above and any other information necessary to demonstrate the Office action was not received at the address of record

The petition is signed by Tiep Nguyen and Ashok Mannava. A review of the file fails to indicate either individual has ever been given a power of attorney or authorization of agent to prosecute the instant application. Petitioner should take steps to make both individuals representatives of record.

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.

As a courtesy, the Office has attached a copy of the papers mailed October 13, 2006, to the instant decision.

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

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Attached: Copy of papers originally mailed October 13, 2006

cc: Ashok Mannava
Mannava & Kang, P.C.
Suite 104
8221 Old Courthouse Road
Vienna, VA 22182

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/135,413 | 05/01/2002 | Zhichen Xu | 100200291-1 | 8934 |

7590 10/13/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

| EXAMINER |
|---|
| OKORONKWO, CHINWENDU C |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2136 | |

DATE MAILED: 10/13/2006

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

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/135,413 | XU ET AL. | |
| | Examiner | Art Unit | |
| | Chinwendu C. Okoronkwo | 2136 | |

*-- 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 1/5/2006.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-10 and 22-30 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) 1-10 and 22-30 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 5/1/2002 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-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1. Pursuant to USC 131, claims 1-10 and 22-30 are presented for examination.

2. Claims 1-10 and 22-30 are pending.

### *Claim Rejections - 35 USC § 102*

1. 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 a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-5, 22-23 and 25-30 are rejected under 35 U.S.C. 102(e) as being disclosed by Srivastava (U.S. Patent No. 7,047,315 B1).

Regarding claim 1, Srivastava, discloses a method of increasing privacy in a network system, comprising:

- storing a plurality of paths in the network system and a label for each path (col. 5 lines 27-52);
- receiving a request for information from a requester peer (col. 5 lines 27-52);
- identifying a provider peer storing the requested information (col. 5 lines 27-52);

- searching the stored paths for a path through a plurality of peer in the network system from the provider peer to the requester peer (col. 3 lines 25-65);
- identifying a label corresponding to the path from a plurality of the labels for the stored paths, said identified label configured to indicate a pre-determined path through a plurality of peers from the provider peer to the requester peer for said information (col. 3 lines 25-65 and col.4 lines 1-13);
- forwarding said identified label through each of said plurality of peers to form a communication channel through said plurality of peers (col. 3 lines 25-65 and col.4 lines 1-13); and
- transmitting said information through said communication channel (col. 3 lines 25-65 and col.4 lines 1-13).

Regarding claim 2, Srivastava, discloses the method according to claim 1, further comprising:

- responsive to receiving said label at a receiving peer, retrieving a peer subsequent to the receiving peer in accordance to said path (col. 5 lines 27-52);
- transmitting said identified label from said receiving peer to said subsequent peer according to said path (col. 5 lines 27-52); and

- opening a persistent connection from said receiving peer to said subsequent peer as a link of said communication channel (col. 25 lines 10-15 and 53-67).

Regarding claim 3, Srivastava, discloses the method according to claim 2, wherein said subsequent peer further comprises:

- searching a table of said receiving peer with said identified label as a search index (col. 26 lines 15-24).

Regarding claim 4, Srivastava, discloses the method according to claim 1, further comprising:

- generating a plurality of paths, wherein each path is configured to include a combination of said plurality of peers and each path is also configured to have a respective label (col. 25 lines 10-67);
- determining a sub-plurality of paths associated with a peer (col. 25 lines 10-67);
- determining a plurality of subsequent peers for said peer, each subsequent peer following said peer according to a respective path of said sub-plurality of paths (col. 25 lines 10-67);
- associating each subsequent peer with said respective label of each path of said sub-plurality of paths (col. 25 lines 10-67); and

- transmitting an identity of each subsequent peer and said respective label to said peer (col. 25 lines 10-67).

Regarding claim 5, Srivastava, discloses the method according to claim 4, further comprising:

- updating a hash table of said peer with the identity of each subsequent peer and said respective label (col. 27 lines 30-55).

Regarding claim 22, Srivastava, discloses a method of communicating with increased privacy, comprising:

- transmitting from a previous peer a label for a selected path, wherein the selected path is selected from a plurality of stored paths in a table, each stored path having a corresponding stored label stored in an entry for the each stored path in the table (col. 5 lines 27-52);
- receiving said label at a current peer (col. 5 lines 27-52);
- forming a persistent connection link of a communication channel from said current peer to said previous peer (col. 25 lines 10-15 and 53-67);
- retrieving an identity of a next peer following said current peer from a table of said current peer with said label as a search index (col. 5 lines 27-52); and
- transmitting said label to said next peer following said current peer (col. 5 , lines 27-52

Regarding claim 23, Srivastava, discloses the method according to claim 22, further comprising:

- receiving said label at the requestor peer (col. 5 lines 27-52);
- forming a last persistent connection link of said communication channel from said requester peer to a peer previous to said requester peer according to said selected path (col. 25 lines 10-15 and 53-67); and
- notifying a provider peer of a completion of said communication channel between said requestor peer and a provider peer (col. 25 lines 10-15 and 53-67).

Regarding claim 25, Srivastava, discloses a system for increasing privacy, comprising:

- a plurality of peers (col. 3 lines 25-65);
- a directory storing a plurality of paths in the system and a unique label for each path ( col. 4 lines 1-13); and
- a privacy module executing on said directory, wherein said privacy module is configured to identify a provider peer storing requested information; search the stored paths for a path through at least one of the plurality of peers in the system from the provider peer to a requester peer requesting the information: identify a unique label corresponding to the path from the provider peer to the requester peer forward said unique label from the

provider peer to the at least one of the plurality of peers in the system and onward to the requester peer to form a communication channel between the provider peer and the requester peer, and to transmit said information through said communication channel (col. 5 lines 27-52).

Regarding claim 26, Srivastava, discloses the system according to claim 25, further comprising: a peer privacy module configured to be executed on each of the peers, wherein said peer privacy module is configured to retrieve a subsequent peer according to said path in response to receiving said unique label, to transmit said unique label to said subsequent peer according to said path, and to open a persistent connection from said receiving peer to said subsequent peer as a link of said communication channel (col. 5 lines 27-52).

Regarding claim 27, Srivastava, discloses the system according to claim 26, the peer privacy module is further configured to search a table with said unique label as a search index (col. 26 lines 15-24).

Regarding claim 28, Srivastava, discloses the system according to claim 25, wherein said privacy module is configured to generate a plurality of paths, wherein each path is configured to include a combination of said plurality of peers and each path is also configured to have a respective unique label, to determine a sub-plurality of paths associated with a peer, and to determine a

plurality of subsequent peers for said peer, each subsequent peer following said peer according to a respective path of said sub-plurality of paths (col. 25 lines 10-67).

Regarding claim 29, Srivastava, discloses the system according to claim 28, wherein said privacy module is configured to associate each subsequent peer with said respective unique label of each path of said sub-plurality of paths and to transmit an identity of each subsequent peer and said respective unique label to said peer (col. 25 lines 10-67).

Regarding claim 30, Srivastava, discloses the system according to claim 29, wherein said peer privacy module is configured to update a hash table of said peer with each subsequent peer and said respective unique label (col. 25 lines 10-67).

***Claim Rejections - 35 USC § 103***

2. Claims 6-10, 24 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srivastava as applied above, and further in view of Matyas et al.

Regarding claim 6, Srivastava, is silent in disclosing the claimed limitations, however Matyas et al. does disclose the method according to claim 1, further comprising:

- generating an encryption key (col. 26 lines 43-48 of Matyas et al.);
- encrypting said encryption key with a public key of a provider peer (col. 26 lines 60-65 of Matyas et al.); and
- encrypting said encryption key with a public key of a requester peer (col. 26 lines 60-65 of Matyas et al.).

Therefore, it would have been obvious at the time of the invention, for one of ordinary skill in the art to combine the method of providing server affinity and client stickiness of Srivastava with the secure data storage and retrieval with key management and user authentication of Matyas et al.. Matyas et al provides motivation for this combination in the recitation of "an ever increasing awareness among the public as to the privacy of digitally stored data [causing] much attention [to be given to] mechanisms for providing secure files and/or file access [such as the use of encrypted keys]."

Regarding claim 7, Srivastava, discloses the method according to claim 6, further comprising:

- selecting a path from a global path table (col.27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.);

- determining a first peer subsequent to said provider peer according to said path (col. 27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.);
- forming a retrieval message, said retrieval message comprising:
  - one of the plurality of labels associated with said selected ( col. 27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.);
  - said encryption key encrypted with said public key of said provider peer (col. 27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.);
  - said encryption key encrypted with said public key of said requestor peer (col. 27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.);
  - an identity of a first peer following said provider peer according to said selectedpath (col. 27 lines 22-25 of Srivastava and col. 26 lines 60-65 of Matyas et al.).

Therefore, it would have been obvious at the time of the invention, for one of ordinary skill in the art to combine the method of providing server affinity and client stickiness of Srivastava with the secure data storage and retrieval with key management and user authentication of Matyas et al.. Matyas et al provides motivation for this combination in the recitation of "an ever increasing awareness among the public as to the privacy of

digitally stored data [causing] much attention [to be given to] mechanisms for providing secure files and/or file access [such as the use of encrypted keys]."

Regarding claim 8, Srivastava, discloses the method according to claim 7, further comprising: transmitting said corresponding label to said first peer in response to receiving said message (col. 28 lines 53-65 of Srivastava).

Regarding claim 9, Srivastava, discloses the method according to claim 8, further comprising: forming a persistent connection between said first peer and said provider peer as a link of said communication channel in response to receiving said corresponding label (col. 25 lines 10-15 and 53-67 of Srivastava).

Regarding claim 10, Srivastava, discloses the method according to claim 9, further comprising: searching a table of said first peer by using said corresponding label as a search index; retrieving a subsequent peer to said first peer from said hash table; and transmitting said corresponding label to said subsequent peer (col. 26 lines 15-24 of Srivastava).

Regarding claim 24, Kodialam et al., discloses the method according to claim 23, further comprising:

- transmitting information encrypted with an encryption key through said communication channel (col. 3 lines 25-65 and col.4 lines 1-13 of Srivastava and col. 26 lines 43-48 of Matyas et al.) and
- transmitting said encryption key encrypted with a public key of said requestor peer (col. 3 lines 25-65 and col.4 lines 1-13 of Srivastava and col. 26 lines 43-48 of Matyas et al.)

Therefore, it would have been obvious at the time of the invention, for one of ordinary skill in the art to combine the method of providing server affinity and client stickiness of Srivastava with the secure data storage and retrieval with key management and user authentication of Matyas et al.. Matyas et al provides motivation for this combination in the recitation of "an ever increasing awareness among the public as to the privacy of digitally stored data [causing] much attention [to be given to] mechanisms for providing secure files and/or file access [such as the use of encrypted keys]."

Regarding claim 31, Kodialam et al., discloses the system according to claim 25, wherein said privacy module is configured to generate an encryption key, to encrypt said encryption key with a public key of a provider peer, and to encrypt said encryption key with a public key of a requestor peer (Rejected under the same rationale as claim 6).

Regarding claim 32, Kodialam et al., discloses the system according to claim 31, wherein said privacy module is configured to select a path from a global path table, to determine a first peer subsequent to said provider peer according to said path, and to form a retrieval message comprising: a label corresponding to said selected path; said encryption key encrypted with said public key of said provider peer; said encryption key encrypted with said public key of said requestor peer; and an identity of a first peer following said provider peer according to said selected path (Rejected under the same rationale as claim 7).

***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chinwendu C. Okoronkwo whose telephone number is (571) 272 2662. The examiner can normally be reached on MWF 9:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571) 272 4195. 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).

CCO

September 30, 2006

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

10/01/06

| Notice of References Cited | Application/Control No. 10/135,413 | Applicant(s)/Patent Under Reexamination XU ET AL. | |
|---|---|---|---|
| | Examiner Chinwendu C. Okoronkwo | Art Unit 2136 | Page 1 of 1 |

**U.S. PATENT DOCUMENTS**

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|---|---|---|---|---|
| * | A | US-2006/0083370 A1 | 04-2006 | Hwang, Jing-Jang | 380/028 |
| * | B | US-7,047,315 B1 | 05-2006 | Srivastava, Sunil K. | 709/238 |
| | C | US- | | | |
| | D | US- | | | |
| | E | US- | | | |
| | F | US- | | | |
| | G | US- | | | |
| | H | US- | | | |
| | I | US- | | | |
| | J | US- | | | |
| | K | US- | | | |
| | L | US- | | | |
| | M | US- | | | |

**FOREIGN PATENT DOCUMENTS**

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Country | Name | Classification |
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| | N | | | | | |
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| | T | | | | | |

**NON-PATENT DOCUMENTS**

| * | | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
| | U | |
| | V | |
| | W | |
| | X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

UNITED STATES PATENT AND TRADEMARK OFFICE

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of Xu et al. :
Application No. 10/135,413 :
Filing Date: May 1, 2002 :
Attorney Docket No. 100200291-1 :

Decision on Petition

This is a decision on the renewed petition under 37 CFR 1.181, filed January 18, 2008, requesting the Office withdraw the holding of abandonment.

The petition is **granted**.

The Office mailed a non-final Office action on October 13, 2006. The Office action set a three (3) month shortened statutory period for reply. The Office did not receive a reply to the Office Action. As a result, a Notice of Abandonment was mailed May 2, 2007.

The evidence presented by petitioner establishes the October 13, 2006 Office action was never received at the address of record. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

A prior decision on petition mailed October 19, 2007, stated,

> The petition is signed by Tiep Nguyen and Ashok Mannava. A review of the file fails to indicate either individual has ever been given a power of attorney or authorization of agent to prosecute the instant application.

The instant petition cites 37 CFR 1.34 in support of petitioner's assertion Nguyen and Mannava are authorized to represent petitioner. The petition also states Mannava has been a representative of record since as far back as January 6, 2006.

The Office agrees both Nguyen and Mannava are individuals with the ability to act in a representative capacity under the provisions of 37 CFR 1.34. However, the Office notes neither individual is a practitioner of record appointed in compliance with 37 CFR 1.32(b). The authority held by a practitioner solely under 37 CFR 1.34 is less than the authority held by a practitioner appointed in compliance with 37 CFR 1.32(b). For example, neither Nguyen nor Mannava may change the address of record, conduct interviews with the examiner, sign terminal

disclaimers, or take many other actions. Nguyen and Mannava may wish to take steps to become practitioners of record pursuant to 37 CFR 1.32(b).

Technology Center Art Unit 2136 will be informed of the instant decision and the examiner will consider the amendment filed January 18, 2008, in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
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MAIL

JUL 05 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

EDWARD YOO C/O BENNETT JONES
1000 ATCO CENTRE
10035 - 105 STREET
EDMONTON, ALBERTA AB T5J3T-2 CA CANADA

In re Application of
Milley
Application No. 10/135,445
Filed: May 1, 2002
For: **WIRELESS NETWORK COMPUTING**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on April 29, 2005.

A grantable request to withdraw, as attorney/agent of record must:
(1) Indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) Be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) Be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) Indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys/agents with Customer Number (22828) in the request are withdrawn.

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

Ken A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

CC:

META4HAND
Suite 1100 empire Building
10080 Jasper Avenue
Edmonton, Alberta, T5J 1V9, Canada

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JUL 05 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

EDWARD YOO C/O BENNETT JONES
1000 ATCO CENTRE
10035 - 105 STREET
EDMONTON, ALBERTA AB T5J3T-2 CA CANADA

In re Application of
Milley
Application No. 10/135,445
Filed: May 1, 2002
For: **WIRELESS NETWORK COMPUTING**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on April 29, 2005.

A grantable request to withdraw, as attorney/agent of record must:
(1) Indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) Be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) Be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) Indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys/agents with Customer Number (22828) in the request are withdrawn.

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

Ken A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

CC:

META4HAND
Suite 1100 empire Building
10080 Jasper Avenue
Edmonton, Alberta, T5J 1V9, Canada

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

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Gregory Murphy et al | : |
| Application No. 10/135,465 | : DECISION GRANTING PETITION |
| Filed: April 30, 2002 | : UNDER 37 CFR 1.137(f) |
| Attorney Docket No. 28122.104 | : |

This is a decision on the petition, filed August 2, 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 Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be filed within TWO MONTHS from the mail date of this decision. Extensions of time are available pursuant to the provisions of 37 CFR 1.136(a).

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

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

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

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

The petition fails to comply with item (1) above. More specifically, while notification has been given of the foreign filing, the petition fails to state the date of such foreign filing. Accordingly, the date of foreign filing must be supplied before the Office can make a decision on the appropriateness of the instant petition to revive.

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

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

**By hand**: 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 Wan Laymon at (703) 306-5685.

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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**KOWERT & GOETZEL, P.C.**
**P.O. BOX 398**
**AUSTIN, TX 78767-0398**

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OFFICE OF PETITIONS

In re Application of :
Gregory Murphy et al :
Application No. 10/135,465 : DECISION GRANTING PETITION
Filed: April 30, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 5838-00200/EBM :

This is a decision on the renewed petition under 37 CFR 1.182, filed October 4, 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 30, 2004. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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 previously rescinded.

After this decision is mailed, the second petition fee of $685.00 will be credited to petitioner's deposit Account No. 50-1505.

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

This matter is being referred to Technology Center Art Unit 3762 for examination in due course.

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

David M. Ostfeld
CHAMBERLAIN, HRDLICKA, WHITE,
WILLIAMS & MARTIN
1200 Smith Street, Suite 1400
Houston, TX 77002

COPY MAILED

SEP 01 2005

OFFICE OF PETITIONS

In re Application of
DAVE MORVANT, ET AL.
Application No.: 10/135,479
Filed: 30 April 2002
Attorney Docket No.: 000850-06

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 31, 2005 to revive the application identified above.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply to the Office Action mailed 13 August 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 after midnight 13 November 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.

The application file is being referred to Technology Center Art Unit 3672 for review of the amendment filed with the instant application.

Telephone inquiries concerning this decision should be directed to Jeremy Fleming, at 571-272-3284.

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

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

CC:
David M. Ostfeld
ADAMS AND REESE, LLP
4400 One Houston Center
1221 McKinney
Houston, TX 77010

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 10-02

Paper No. 6

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NY 10022-2585

COPY MAILED

NOV 01 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Iguchi et al. | : | |
| Application No. 10/135,487 | : | DECISION GRANTING PETITION |
| Filed: 30 April, 2002 | : | |
| Att'y Docket No. NECW 18.616A | : | |

This is a decision on the petition filed on 3 October, 2002, requesting that the above-identified application, be accorded a filing date of 30 April, 2002.

On 30 April, 2002, the application was filed.

On 30 May, 2002, Initial Patent Examination Division mailed a "Notice of Omitted Items" stating the application had been accorded a filing date, however, Pages 13 & 41 of the specification (description and claims) appeared to have been omitted. In response, on 11 July, 2002, petitioner filed, *inter alia*, Pages 13 & 41 of the specification. Accordingly, the application was accorded a filing date of 11 July, 2002. On 21 August, 2002, a Notice to File Missing Parts of Nonprovisional Application was mailed, stating that the application had been accorded a filing date of 11 July, 2002, and requiring an oath or declaration covering the omitted item(s) and a surcharge for its late filing.

In response, on 3 October, 2002, the present petition was filed. Petitioner now requests that the application be accorded the original filing date of 30 April, 2002. Petitioners further state that Pages 13 & 41 were included in Application No. 09/840,761, of which the present application is a divisional and which is incorporated by reference herein.

The mailing of a "Notice of Omitted Items" 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)).

As petitioner supplied the omitted drawings without establishing prior receipt thereof in the USPTO, the application was properly accorded a filing date of the date the omitted drawings were filed. Nevertheless, as a complete application was present on 30 April, 2002, on petition, the application as filed is entitled to a filing date of 30 April, 2002.

The application will be reprocessed using only the application papers present on filing. The copies of Pages 13 & 41 supplied on 11 July, 2002, will not be used for processing or examination, but will be retained in the application file.

Accordingly, the petition is inappropriate and is subject to dismissal. As the petition was not due to an error on the part of the USPTO, the petition fee will not be refunded.

It is noted that the application transmittal letter identified this application as a division of prior application No. 09/840,761 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), <u>without the need for a petition</u>. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Pages 13 & 41 of the specification are not new matter if they was a part of the disclosure of the prior application. Petitioners should submit Pages 13 & 41 as an amendment to the specification. Amendments to the specification may be entered by the primary examiner without petition so long as the amendment contains no new matter.[1] If Pages 13 & 41 of the specification are filed as an amendment, they will be reviewed by the examiner for new matter.

The application is being returned to Initial Patent Examination Division for reprocessing with a filing date of 30 April, 2002, using only the application papers filed on 30 April, 2002.

Telephone inquires 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

[1] 37 CFR 1.121(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 12-02

Paper No. 8

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NY 10022-2585

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DEC 13 2002

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Iguchi et al. | : CORRECTED DECISION |
| Application No. 10/135,487 | : GRANTING PETITION |
| Filed: 30 April, 2002 | : |
| Att'y Docket No. NECW 18.616A | : |

This is a corrected decision on the petition filed on 3 October, 2002, requesting that the above-identified application, be accorded a filing date of 30 April, 2002.

On 30 April, 2002, the application was filed.

On 30 May, 2002, Initial Patent Examination Division mailed a "Notice of Omitted Items" stating the application had been accorded a filing date, however, Pages 13 & 41 of the specification (description and claims) appeared to have been omitted. In response, on 11 July, 2002, petitioner filed, *inter alia*, Pages 13 & 41 of the specification. Accordingly, the application was accorded a filing date of 11 July, 2002. On 21 August, 2002, a Notice to File Missing Parts of Nonprovisional Application was mailed, stating that the application had been accorded a filing date of 11 July, 2002, and requiring an oath or declaration covering the omitted item(s) and a surcharge for its late filing.

In response, on 3 October, 2002, the present petition was filed. Petitioner now requests that the application be accorded the original filing date of 30 April, 2002. Petitioners further state that Pages 13 & 41 were included in Application No. 09/840,761, of which the present application is a divisional and which is incorporated by reference herein.

The mailing of a "Notice of Omitted Items" 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)).

As petitioner supplied the omitted drawings without establishing prior receipt thereof in the USPTO, the application was properly accorded a filing date of the date the omitted drawings were filed. Nevertheless, as a complete application was present on 30 April, 2002, on petition, the application as filed is entitled to a filing date of 30 April, 2002.

The application will be reprocessed using only the application papers present on filing. The copies of Pages 13 & 41 supplied on 11 July, 2002, will not be used for processing or examination, but will be retained in the application file.

Accordingly, the petition is inappropriate and is subject to dismissal. As the petition was not due to an error on the part of the USPTO, the petition fee will not be refunded.

It is noted that the application transmittal letter identified this application as a division of prior application No. 09/840,761 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), <u>without the need for a petition</u>. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Pages 13 & 41 of the specification are not new matter if they was a part of the disclosure of the prior application. Petitioners should submit Pages 13 & 41 as an amendment to the specification. Amendments to the specification may be entered by the primary examiner without petition so long as the amendment contains no new matter.[1] If Pages 13 & 41 of the specification are filed as an amendment, they will be reviewed by the examiner for new matter.

As the application has been accorded a filing date using only the originally-filed application papers, no supplemental oath or declaration is required. Accordingly, the Notice to File Missing Parts of Nonprovisional Application mailed on 21 August, 2002, is withdrawn.

The application is being returned to Initial Patent Examination Division for reprocessing with a filing date of 30 April, 2002, using only the application papers filed on 30 April, 2002.

Telephone inquires 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

[1] 37 CFR 1.121(b).

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HALLIBURTON ENERGY SERVICES
2600 SOUTH 2ND ST.
P. O. BOX 1431
DUNCAN, OK 73536

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JAN 26 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,730,636 | : | |
| Issue Date: May 4, 2004 | : | |
| Application No. 10/135,492 | : | ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 2000-IP-000429U1D1 | : | |

This is a decision on the petition filed May 10, 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 **DISMISSED**.

In the instant case, petitioner failed to attach the completed Certificate of Correction form as indicated therein. The petition cannot be granted until the proper form(s) has been 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 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

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

Frances Hicks

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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HALLIBURTON ENERGY SERVICES
2600 SOUTH 2ND ST.
P. O. BOX 1431
DUNCAN, OK 73536

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SEP 16 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,730,636 | : | |
| Issue Date: May 4, 2004 | : | |
| Application No. 10/135,492 | : | ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 2000-IP-000429U1D1 | : | |

This is a decision on the paper filed February 7, 2005, which is being treated as a renewed 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 application matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 21 2005

HODGSON RUSS LLP
SUITE 2000
ONE M&T PLAZA
BUFFALO NY 14203-2391

| | |
|---|---|
| In re Application of | : |
| Linda B. Ludwig | : |
| Serial No.: 10/135,545 | : STATUS LETTER |
| Filed: April 30, 2002 | : |
| Attorney Docket No.: 25125.0001 | : |

This is in response to applicants' attorneys' request, filed March 9, 2005, 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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SEP 25 2006

**OFFICE OF PETITIONS**

LINDA B. LUDWIG m.d.
2519 NE 145 Circle
Vancouver, WA 98686

In re Application of
Ludwig
Application No. 10/135,545
Filed: April 30, 2002
Dkt. No.: 25125.0001

DECISION ON PETITION

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

The petition is **DISMISSED**.

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

This application became abandoned February 18, 2005 for failure to timely submit a proper reply to the final Office action mailed November 17, 2004. This decision precedes Notice of Abandonment.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition fails to satisfy requirement (2). Submission of the required petition fee is a prerequisite prior to treatment on the merits of any petition submitted pursuant to 37 CFR 1.137(b). The instant petition was accompanied by a fee in the amount of $250.00. The required small entity fee due under 37 CFR 1.137(b) is currently $750.00.

Any renewed petition must be accompanied by the required fee.

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

By mail: **Mail Stop Petition**

Application No. 10/135,545

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

By facsimile: (571) 273-8300

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LINDA B. LUDWIG m.d.
2519 NE 145 Circle
Vancouver WA 98686

COPY MAILED

JUN 0 9 2008

In re Application of :
Ludwig :
Application No. 10/135,545 : ON PETITION
Filed: April 30, 2002 :
Attorney Docket No. 25125.0001 :

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 20, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned May 11, 2005 for failure to timely file a reply an appeal brief in response to the Notice of Appeal filed March 10, 2005.Notice of Abandonment was mailed November 1, 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 required fee, and the submission required by 37 CFR 1.114; (2) the required petition fee; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU1648 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.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LINDA B. LUDWIG, M.D.
861 MAIN STREET
EAST AURORA, NY 14052

**MAILED**

MAY 03 2010

**OFFICE OF PETITIONS**

In re Application of
Linda B. Ludwig
Application No. 10/135,545
Filed: April 30, 2002
Attorney Docket No.: 25125.0001

ON PETITION

This is a decision in response to the petition, filed February 22, 2010, 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 an Office communication mailed April 8, 2009. A Notice of Abandonment was mailed on October 28, 2009. In response, on February 22, 2010, 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 $810; and (3) an adequate statement of unintentional delay.

The application is being referred to Technology Center AU 1648 for consideration by the Examiner in the normal course of business on the response filed February 22, 2010.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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FEB 05 2007

**OFFICE OF PETITIONS**

SIM & MCBURNEY
330 UNIVERSITY AVENUE
6TH FLOOR
TORONTO ON M5G 1R7 CA CANADA

| | | |
|---|---|---|
| In re Patent No. 6,861,378 | : | |
| Issue Date: March 1, 2005 | : | |
| Application No. 10/135,573 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 6560 | : | |

This is a decision on the petition under 37 CFR 1.182, filed September 11, 2006, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Office of Patent Publication is directed to issue a duplicate Letters Patent.

The $130.00 submitted towards the $400 petition fee for the petition under 37 CFR 1.182 will be refunded.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3215.

Inquiries regarding the issuance of a duplicate Letters Patent may be directed to Krystal Paige in the Office of Patent Publication at (703) 308-9250, Ext. 139.

A copy of this decision is being faxed to the Office of Patent Publication for issuance of a duplicate Letters Patent.

Charlema R. Grant
Petition Attorney
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor, Room C32 (Fax No. (571) 270-9937)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Feb-07

STRATEGIC PATENTS P.C..
C/O PORTFOLIOIP
P.O. BOX 52050
MINNEAPOLIS MN 55402

**COPY MAILED**

FEB 08 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Insler et al. | : | |
| Application No. 10/135579 | : | ON PETITION |
| Filed: 04/30/2002 | : | |
| Attorney Docket No. BINJ-0002-P01 | : | |

This is a decision in reference to the petition to withdraw the holding of abandonment filed on 15 November, 2006. This is also a decision on the petition to revive the application under 37 CFR 1.137(b) filed on 18 December, 2006.[1]

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

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

---

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional 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)).

This application became abandoned on 10 October, 2006, for failure to submit a timely response to the Notice Regarding Drawings mailed on 9 August, 2006, which set a two (2) month shortened period for reply. Notice of Abandonment was mailed on 7 November, 2006.

**Petition to Withdraw the Holding of Abandonment**

While the petition states that the issue fee was timely paid in reference to the Notice of Allowance and Fee(s) Due, it is noted that petitioners never responded to the above-referenced Notice Regarding Drawings. As the Notice mailed on 9 August, 2006, set a two (2) month period for reply and stated that "Failure to take corrective action within the set period will result in abandonment of the application," and no response was received within the two (2) month period set forth therein, the application was properly held abandoned. Furthermore, as petitioners have provided no showing to merit the withdrawal of the holding of abandonment, the petition will be dismissed.

**Petition under 37 CFR 1.137(b)**

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

Receipt of the replacement drawing sheets filed on 18 December, 2006, is acknowledged.

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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DW 08-02

Paper No. 4

DAVID D. MURRAY
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

**COPY MAILED**

**AUG 2 9 2002**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Nehring et al. | : | |
| Application No. 10/135,602 | : | ON PETITION |
| Filed: 30 April, 2002 | : | |
| Attorney Docket No. 7719-089 | : | |

This is a decision on the petition filed on 14 August, 2002, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application be accorded a filing date of 30 April, 2002, with Figure 11 described in the specification.

The petition is **dismissed**.

The application was filed on 30 April, 2002. However, on 11 June, 2002, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 30 April, 2002, and advising applicants that Figure 11 described in the specification appeared to have been omitted.

In response, the present petition was filed on 14 August, 2002 (certificate of mailing date 9 August, 2002).

The mailing of a "Notice of Omitted Items" 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)).

Petitioners assert merely that Figure 11 "should become a part of the application which, in its entirety, should be granted a filing date of April 30, 2002."

The Office file is the official record of the papers originally filed in this application. A review of the official record reveals that no drawing figures were filed with the original application papers. Where the records of the Office (e.g. the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in the absence of convincing evidence (e.g. a postcard receipt under MPEP 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office. It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.[1] This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is 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. However, due to the absence in the record of a postcard receipt itemized with respect to the drawings that bears a USPTO date stamp of 30 April, 2002, showing that a sheet of drawings containing Figure 11 was received in the

[1] The public was afforded a "reminder" of the then extent post card receipt practice at 857 *Off. Gaz. Pat. Off.* 667 (*O.G.*) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the *O.G.* that contains important *O.G.* notices of continuing relevance.

USPTO on 30 April, 2002, the application cannot be accorded a filing date of 30 April, 2002, with Figure 11 as a part of the original disclosure.

It is noted that petitioners assert that Figure 11 does not constitute new matter. Amendments to the specification may be entered by the primary examiner without petition so long as the amendment contains no new matter.[2]

The application will be processed and examined using only the application papers present on the filing date of 30 April, 2002. The copy of Figure 11 supplied with the present petition will not be processed or examined, but will be retained in the application file.

Petitioners should therefore file Figure 11 as a preliminary amendment. If Figure 11 is filed as a preliminary amendment, it will be reviewed by the Examiner for new matter.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of 30 April, 2002, using the application papers filed on that date.

Telephone inquiries concerning this matter may 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

[2] 37 CFR 1.121(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

APR 28 2005

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Cardica, Inc.
900 Saginaw Drive
Redwood City, CA 94063

| | |
|---|---|
| In re Application of<br>Michael Hendricksen et al<br>Serial No. : 10/135,669<br>Filed : April 30, 2002<br>For : Everter and Threadthrough System for Attaching Graft Vessel to an Anastomosis Device | : DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT |

This is a decision on petitioner's request filed October 6, 2004, to review the holding of abandonment mailed September 9, 2004 for failure to pay the issue fee as required in the Notice of Allowance and Fee(s) Due mailed May 4, 2004. The basis for the request is that applicant did not receive the communication mailed May 4, 2004. There is no fee required for this petition.

Petitioner asserts that the communications of May 4, 2004 and September 9, 2004 were mailed to an incorrect address as the Office had failed to promptly act on a request to change the correspondence address associated with Assignee's customer number. Petitioner has submitted a copy of the Notice of Customer Record Change mailed by the Office on July 17, 2003 acknowledging receipt of the request, which notice was mailed to the new address. Unfortunately, the change of correspondence address for the instant application was not made and, hence the actions in question were mailed to an old address. In fact, a review of the file shows that the communications in question were returned undelivered.

In view of the above, it is clear that petitioner did not receive the Notice of Allowance and Fee(s) Due mailed May 4, 2004 and the request to withdraw the holding of abandonment is **granted** and the holding of abandonment is hereby withdrawn. Upon the mailing of this decision, the application will be forwarded to the Legal Instruments Examiner for the mailing of a new Notice of Allowance and Fee(s) Due with a copy of the Notice of Allowability that was mailed May 4, 2004.

Summary: Holding of Abandonment Withdrawn.

Richard A. Bertsch, Director
Technology Center 3700
Phone: (571) 272-3750

ak/04/26/05

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EATON CORPORATION
EATON CENTER
1111 SUPERIOR AVENUE
CLEVELAND, OH 44114

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MAR 0 2 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Pk Haridass Krishnamoorthy, et al. | : | |
| Application No. 10/135,693 | : | ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 01-ASD-344 (GT) | : | |

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 21, 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, the $1480 extension of time submitted on September 23, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account number 05-0275.

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 3753 for further processing.

Retta Williams

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUL 06 2007

OFFICE OF PETITIONS

Lou Lockhart
1610 Ridge Rd.
McEwen, TN 37101

In re Application of
Lou Lockhart
Application No.: 10/135,706
Filed: April 30, 2002
Attorney Docket No:

ON PETITION

This is in response to the petition under 37 CFR 1.137(b) filed November 30, 2006.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition" under 37 CFR 1.137(b)."

This application became abandoned for failure to respond in a timely manner to the Office communication mailed December 28, 2004. The notice set a shortened period for reply of one-month from its mailing date. A response was not received within the allowed period, and the application became abandoned on January 29, 2005. A Notice of Abandonment was mailed on July 26, 2005.

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 pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a non-provisional 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 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(c).

The instant petition does not satisfy the requirements of item (1) above.

The petition was not accompanied by a response to the Office communication mailed December 28, 2004. The renewed petition must be accompanied by a response to the December 28, 2004, communication (copy enclosed). Questions regarding the December 28, 2004, communication should be directed to Examiner Paul Chin.

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

By mail:

Mail Stop Petitions
Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy—Office communication mailed December 28, 2004

[redacted]

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/135,706 | 04/30/2002 | Lou Lockhart | | 7294 |

7590 12/28/2004

Stephen L. Smith
Patent Attorney
2410 Harney Street
Omada, NE 68131-3618

| EXAMINER |
|---|
| CHIN, PAUL T |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3652 | |

DATE MAILED: 12/28/2004

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

***Response to Amendment***

1. The proposed reply filed on September 22, 2004, has not been entered because it is unsigned.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME LIMIT MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. The reply filed on September 22, 2004, is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): applicant fails to explain or argue as to why the amendment would overcome the prior art, Skaggs ((4,251,089) and Gibbons (5,803,518) in view of Sanders (4,531,274) or Manyek (5,129,529). Moreover, applicant does not explain or answer as to how the Drawings Objections, the Claim Objections, and the Claim Rejection under 35 USC 112, questioned by the examiner, have been amended. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (703) 305-1524. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (703) 308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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).

Paul Chin

PAUL T. CHIN
Examiner
Art Unit 3652

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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OCT 25 2002

OFFICE OF PETITIONS

John F. Nethery
SONNENSCHEIN NATH & ROSENTHAL
Wacker Drive Station, Sears Tower
P.O. Box #061080
Chicago IL 60606-1080

In re Application of
Janesick
Application No. 10/135,708
Filed: April 30, 2002
Title: MULTI-MODE IMAGER WITH PINNED PHOTO REGION PHOTORECEPTORS

DECISION GRANTING STATUS UNDER 37 C.F.R. §1.47(b)

This is in response to the July 8, 2002 petition under 37 C.F.R. §1.47(b).

Applicant filed the above-identified application on April 30, 2002. However, the properly executed declaration required by 37 C.F.R. §1.53 was missing. Accordingly, on May 24, 2002, the Office of Initial Patent Examination (hereinafter "OIPE") mailed a notice to file missing parts (hereinafter "the notice") to the address of record. The notice set a two month deadline for responding, running from the mail date of the notice.

Petitioner timely filed his response to the notice on July 8, 2002.

The above-identified application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(b). This application is hereby accorded Rule 1.47(b) status. As provided in Rule 1.47(b), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

This application will be forwarded to the OIPE for further processing under rule 1.47(b).

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-5593

Scott M. Ledford
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Mr. James Janesick
19311 Surfwave Drive
Huntington Beach, CA 92648

COPY MAILED

OCT 25 2002

OFFICE OF PETITIONS

In re Application of
Janesick
Application No. 10/135,708
Filed: April 30, 2002

Dear Mr. Janesick:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at 703-306-5593. Requests for information regarding your application should be directed to the File Information Unit at 703-308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification division at 703-308-9726 or 1-800-972-6382 (outside the Washington, D.C. area).

Scott M. Ledford
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: John F. Nethery
SONNENSCHEIN NATH & ROSENTHAL
Wacker Drive Station, Sears Tower
P.O. Box #061080
Chicago IL 60606-1080

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JUL 21 2006
OFFICE OF PETITIONS

MICHAEL E. KLICPERA
PO BOX 573
LA JOLLA, CA 92038-0573

In re Application of

Scott, et al. :

Application No. 10/135,709

: DECISION ON PETITION

Filed: April 30, 2002

:

Attorney Docket No. 70808.01

This is a decision on the petition under 37 CFR 1.137(b), filed June 12, 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 October 5, 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 January 6, 2006. A Notice of Abandonment was mailed on May 2, 2006.

The amendment filed June 12, 2006, is noted and made of record.

The application is being forwarded to Technology Center 3700, GAU 3763 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

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 22 2007

OFFICE OF PETITIONS

**Raj S. Dave**
**Morrison & Foerster LLP**
**Suite 5500**
**2000 Pennsylvania Avenue NW**
**Washington, DC 20006-1888**

| | | |
|---|---|---|
| In re Application of | : | |
| Hyun-Nam Cho et al. | : | |
| Application No. 10/135,728 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 300602002700 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 24, 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 Barry E. Bretschneider on behalf of all attorneys of record who are associated with customer No. 25227. All attorneys/agents associated with the Customer Number 25227 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. Accordingly, all correspondence will be mailed to the applicant. A courtesy copy of this decision is being mailed to the address noted on the request for withdrawal as attorney. If this firm desires to receive future correspondence regarding this application, the proper power of attorney documents must be submitted.

A notice of appeal was filed on August 8, 2007. Appropriate action to continue prosecution must be taken within the time period set forth in 37 CFR 41.66(a) to avoid the abandonment of this application.

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

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Hyun-Nam Cho
2-38 Singil-dong
Yeongdeungpo-gu
Seoul, Korea

cc: Raj S. Dave
Darby & Darby P.C.
1500 K Street, N.W.
Suite 250
Washington, DC 20005-1714

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
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/135,728 | 05/01/2002 | Hyun-Nam Cho | 300602002700 |

**CONFIRMATION NO. 7465**

*OC000000025394908*

Raj S. Dave
Morrison & Foerster LLP
Suite 5500
2000 Pennsylvania Avenue N.W.
Washington, DC 20006-1888

Date Mailed: 08/16/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/24/2007.

- 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.

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 3

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OCT 30 2002

OFFICE OF PETITIONS

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of
Lopez Gomez, et al.
Application No. 10/135,737
Filed: April 30, 2002
Attorney Docket No.: U 014002-0
For: DEVICE AND PROCESS FOR MEASURING OVALIZATION, BUCKLING, PLANES AND ROLLING PARAMETERS OF RAILWAY WHEELS

DECISION DISMISSING PETITION UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed April 30, 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 April 30, 2002 without a fully executed oath or declaration and naming Jose Luis Lopez Gomez, Angel Luis Sanchez Revuelta, Carlos Javier Gomez Gomez, Rafael Navarro Belsue, Roberto Valerio Cascajo, and Begona Bariabar Azcarraga as joint inventors. The application filing was accompanied by a petition under 37 CFR 1.47.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor, or in the present case, the non-signing legal representative of the deceased 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 requirements (1) and (4) set forth above.

As to item (1), petitioner has provided no evidence to establish that the non-signing inventor either cannot be reached or located, was ever presented with a copy of the application papers (specification, claims, drawings, and oath or declaration), or, having been presented with the application papers, refused to sign the oath or declaration.

Any renewed petition must be supported by evidence to establish the inventor cannot be reached or located or the inventor refuses to sign an oath or declaration after having been presented with the application papers.

As to item (4), petitioner has failed to provide the last known address of the non-signing inventor. Petitioner is required to provide the last known address of the inventor on renewed petition.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 6

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APR 1 8 2003

OFFICE OF PETITIONS

Ladas & Parry
26 West 61st Street
New York, NY 10023

| | |
|---|---|
| In re Application of<br>Gomez, et al.<br>Application No. 10/135,737<br>Filed: April 30, 2002<br>Attorney Docket No.: U 014002-0<br>For: DEVICE AND PROCESS FOR MEASURING OVALIZATION, BUCKLING, PLANES AND ROLLING PARAMETERS OF RAILWAY WHEELS | DECISION NOTING JOINDER OF LEGAL REPRESENTATIVE OF DECEASED INVENTOR AND PETITION UNDER 37 CFR 1.47(a) MOOT |

This decision is in response to the renewed petition under 37 CFR 1.47(a), filed November 8, 2002.

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

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 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
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JJGJR.: 07-07

Paper No:__

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

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JUL 30 2007

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Lauffer, et al. | : | DECISION |
| Application No. 10/135,747 | : | |
| Filing Date: 30 April, 2002 | : | |
| Attorney Docket No.: 00786/421002 | : | |

This is a decision on the petition filed on 4 December, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, petition was received by the attorneys in the Office of Petitions only at this writing.

**NOTE:**

**Monitoring of the status of applications on Private PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected.**

**Status inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181 because regulatory requirements require the filing of such a petition within two (2) months of the act complained of.**

In light of the previous action of the Office herein, the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

## BACKGROUND

The record reflects that:

- the Office mailed a non-final Office action on 24 March, 2006, with reply due absent an extension of time on or before 24 June, 2006;
- on 25 September, 2006, Petitioner replied over a 22 September, 2006, certificate of mailing with, *inter alia*, an amendment and a request and fee for an extension of time;
- papers appear to have crossed in processing/entry, because on 29 September, 2006, the Office the Office mailed the Notice of Abandonment;
- thereafter, on 17 October, 2006, the Office mailed a Notice withdrawing the holding of abandonment;
- Petitioner appears to have ignored the 17 October, 2006, withdrawal of the holding of abandonment, because on 4 December, 2006, Petitioner filed the instant petition–with the unfortunate result being that the Office could not issue a substantive Office action until the petition was entered into the record and addressed.

Out of an abundance of caution, Petitioners always are reminded that:

- the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and
- those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

**§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.**
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are

## STATUTES, REGULATIONS AND ANALYSIS

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

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

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believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[2] 35 U.S.C. §133 provides:

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

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

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

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

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides:

* * *

> **B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed**
>
> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express

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

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

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

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

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

Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the

> Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.
>
> * * *

Moreover, the regulation places upon Petitioner a diligence requirement to seek relief within two (2) months of the act complained of.

It appears that Petitioner's satisfaction of the regulatory requirements is no longer at issue herein.

## CONCLUSION

The petition as considered under 37 C.F.R. §1.181 hereby is **dismissed as moot**.

The instant application is released to Technology Center 1600 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[9]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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[9] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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

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

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DEC 2 0 2002

OFFICE OF PETITIONS

In re Application of
Gromov
Application No. 10/135,783
Filed: April 30, 2002
Attorney Docket No. FNS-001
For: IN-LINE POWER TAP DEVICE FOR ETHERNET DATA SIGNAL

DECISION DISMISSING PETITION

This is a decision on the petition entitled, "Petition to Correct Filing Receipt Having Error in Priority Data," filed October 22, 2002 (certificate of mailing date October 16, 2002), requesting that the above-identified application's priority data be altered. The petition will be treated under 37 CFR 1.181.

Petitioner argues that the filing date of one of the two provisional applications from which the above-identified application claims priority is incorrect. Petitioner states, "**Provisional application no. 60/287,833 has a filing date of April 30, 2001**, not May 1, 2001..."

This statement is incorrect. Provisional application no. 60/287,833 has a filing date of May 1, 2001. More salient to this analysis, provisional application no. 60/287,833 is a completely unrelated application to the above-identifed application.

A review of the specification of the above-identified application reveals that applicant claimed benefit of the same unrelated provisional application (60/287,833).

Applicant should have claimed benefit of provisional application no. 60/287,883. Provisional application no. 60/287,883 has a filing date of April 30, 2001. Provisional application no. 60/287,883 is the provisional application invented by Mr. Gromov and titled, "IN-LINE POWER TAP FOR ETHERNET DATA SIGNAL"

The petition to alter the above-identified application's priority data is **DISMISSED**.

To remedy this situation, petitioner should (1) file an amendment to the specification that claims priority to the correct provisional application (60/287,883) and (2) file a reconsideration petition under 37 CFR 1.181, requesting a corrected filing receipt for the above-identified application **WITHIN TWO MONTHS** of the mail date of this decision.

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

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231
Attn: E. Shirene Willis

By facsimile: (703) 308-6916
Attn: Office of Petitions/E. Shirene Willis

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202
Attn: E. Shirene Willis

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

Paper No. 9

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

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MAR 1 3 2003

OFFICE OF PETITIONS

In re Application of
Gromov
Application No. 10/135,783
Filed: April 30, 2002
Attorney Docket No. FNS-001
For: IN-LINE POWER TAP DEVICE FOR ETHERNET DATA SIGNAL

DECISION VACATING PRIOR DECISION

This decision **vacates** the petition decision of December 20, 2002 to the extent outlined below.

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.

In the December 20, 2002 decision, it was pointed out that applicant claimed benefit of an unrelated provisional application. Therefore, the petition to alter priority information could not be granted.

To remedy the situation, the undersigned requested that petitioner (1) file an amendment to the specification that claims priority to the correct provisional application (60/287,883) and (2) file a reconsideration petition under 37 CFR 1.181, requesting a corrected filing receipt for the above-identified application within two months of the mail date of the December 20, 2002 decision.

However, this application was filed after November 29, 2000 and is subject to the rule that priority claims for the benefit of a prior filed provisional application must be submitted within the later of 4 months from the actual filing date of the nonprovisional application or 16 months from the filing date of the prior application for which a claim for priority is made. 37 CFR 1.78(a)(5).

Technically, petitioner did not submit a priority claim for the correct provisional application until after the 4 month/16 month deadline expired. The undersigned wanted to excuse the delay based on the fact that applicant's error was typographical in nature and a limited amount of searching of Office records would have yielded the correct provisional application number. Unfortunately, the undersigned was overruled by her superiors.

The Office requires petitioner to submit a petition under 37 CFR 1.78(a)(6). The petition must be accompanied by a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional. In addition, the petition must

be accompanied by the $1,300.00 fee. Petitioner has already filed a preliminary amendment correcting the reference to the related provisional application.

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

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231
Attn: E. Shirene Willis

By facsimile: (703) 308-6916
Attn: Office of Petitions/E. Shirene Willis

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202
Attn: E. Shirene Willis

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
www.uspto.gov

Paper No. 12

WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY UT 84111

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MAY 2 9 2003

OFFICE OF PETITIONS

In re Application of
Gromov
Application No. 10/135,783
Filed: April 30, 2002
Attorney Docket No. FNS-001
For: IN-LINE POWER TAP DEVICE FOR ETHERNET DATA SIGNAL

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed March 27, 2003 (certificate of mailing date March 21, 2003), to accept an unintentionally delayed claim under 35 USC 119(e) for the benefit of a prior filed provisional application.

The petition is **GRANTED**.

The petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior filed provisional application must be accompanied by: (1) The surcharge of $1,300.00 set forth in 37 CFR 1.17(t); and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) 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 April 30, 2002 within twelve months of the filing date of the prior provisional application, application no. 60/287,883, which was filed on April 30, 2001, for which priority is claimed. A reference to the prior provisional application has been included in an application data sheet (ADS) or in the first sentence of the specification following the title. Therefore, since the claim for priority herein is submitted after the period specified in 37 CFR 1.78(a)(5), and since the instant petition satisfies the conditions of 37 CFR 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §119(e), the claim for priority to prior filed provisional Application No. 60/287,833 is accepted.

The Revocation and Substitute Power of Attorney, filed by facsimile on May 7, 2003, has been entered and made of record. All future correspondence regarding this application will be mailed

to the above-identified new correspondence address of record.

This application is being forwarded to Technology Center AU 2838 for processing the amendment filed January 21, 2003 and for consideration by the examiner of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior provisional application, Application No. 60/287,883, filed on April 30, 2001.

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

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

enclosures: Notice of Acceptance of Power of Attorney
Notice Regarding Change of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

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

J. GUSTAV LARSON
LARSON NEWMAN ABEL POLANSKY & WHITE, LLP
5914 WEST COURTYARD DRIVE
SUITE 200
AUSTIN TX 78730

COPY MAILED
JUN 1 2 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| MCGOWAN, MICHAEL J. | : | |
| Application No. 10/135,789 | : | DECISION ON APPLICATION |
| Filed: April 30, 2002 | : | FOR |
| Atty Docket No. 1280.SC11636ZC | : | PATENT TERM ADJUSTMENT |

This is a decision on the "Application for Correction of Patent Term Adjustment under 37 CFR 1.705(b)" filed October 28, 2005 requesting that the Office reconsider the determination of Patent Term Adjustment (PTA) that accompanied the Notice of Allowance. Applicant requests that the initial determination of the patent term adjustment for Applicant Delay in this application be corrected from 571 days to 70 days.

Applicant requests reinstatement of the patent term from the date of the original response on July 21, 2003 until the subsequent copy of the response was submitted to the USPTO on December 6, 2004.

The request for patent term adjustment is **DISMISSED.**

For the reasons stated 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 **zero (0)** days, including **574** days of applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

**Background**

On August 3, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term

adjustment to date was zero (0) days comprising zero days for PTO Delay and 571 days for Applicant Delay.

In response, applicant timely filed the instant request for reconsideration of the patent term adjustment on October 28, 2005 albeit without the required fee set forth in 37 CFR 1.18(e). After a communication from the USPTO on May 26, 2006 regarding the deficient fee, applicant submitted via facsimile the required fee authorization on May 26, 2006.

Applicant requests that the patent term adjustment for applicant delay be corrected from a total of 571 days to 70 days. Applicant contents that the beginning date for Applicant Delay due to an omission under 37 CFR 1.704(c)(7) should be the December 6, 2004 date of the resubmission of the amendment instead of the July 21, 2003 date for the filing of the original response to the non-final action mailed on April 23, 2003. Applicant's support for this correction is that the original response to the non-final action (along with the application file) was lost by the USPTO; therefore the date of the response should start with the re-submitted copy of the original response on December 6, 2004 because the USPTO failed to respond in a timely manner, thereby preventing the applicants from timely correcting the inadvertent omission until the response dated July 21, 2003.

**Relevant statues and regulations**

37 CFR 1.704(c)(7) provides that:

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

**OPINION**

Applicant's arguments and evidence have been considered, and in light of the application history, it has been determined that the initial period of adjustment is correct.

A review of the file record shows a timely response dated July 21, 2003 was filed in response to a non-final action mailed on

April 23, 2003, and a duplicate copy of the response was received on December 6, 2004.

While applicant argues that the December 6, 2004 date of the resubmission of the response should be accepted in lieu of the originally filed response on July 21, 2003 for reinstatement of the patent term, there is no basis under 37 CFR 1.704 for this correction. Specifically, 37 CFR 1.704(c)(7) clearly states that the period of adjustment begins on the day after the date of the reply having an omission was filed. Since the official reply having the omission was timely filed on July 21, 2003, this is the date used for the patent term adjustments. While it is regrettable that the USPTO took so long to respond to the reply dated July 21, 2003, why did applicant wait until December 6, 2004, over 16 months after the filing of the original reply, to inquire about the status of the application.

A review of the file record further reveals that the receipt date of the paper correcting the omission is incorrect in PALM and the PTA calculations. The actual postcard receipt date for the acceptable response is February 14, 2005 (instead of February 11, 2005). Accordingly, the applicant delay has been corrected to 574 days (instead of the previous 571 days.)

**Conclusion**

In view thereof, adjustments to the initial patent term calculations for USPTO delay as requested by applicant is not warranted and the petition is dismissed.

The USPTO delay is correct at zero days and applicant delay has been adjusted to 574 days for a patent term adjustment of zero (0) days.

Any petition under 37 CFR 1.705(b) must be accompanied by the submission of the $200.00 fee set as forth in 37 CFR 1.18(e). A fee $200 has been charged to applicant's deposit account as authorized in the fee transmittal communication dated May 26, 2006.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment shown on the patent (and in the Issue Notification mailed approximately three weeks prior to issuance) will include any additional patent term accrued pursuant to sections 1.702(a)(4) and 1.703(b).

Telephone inquiries specific to this matter should be directed to Amelia Au at 571.272.7414.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

# PALM INTRANET

Day : Friday
Date: 6/9/2006
Time: 17:26:43

| PTA Calculations for Application: 10/135789 | | | |
|---|---|---|---|
| Application Filing Date: | 04/30/2002 | PTO Delay (PTO): | 0 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 571 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 0 |
| PTO Delay Adjustment: | -3 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 34 | 06/07/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 571 | | |
| 33 | 06/07/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 574 | |
| 23 | 08/03/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 22 | 08/02/2005 | ISSUE REVISION COMPLETED | | | |
| 21 | 08/01/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 20 | 08/01/2005 | NOTICE OF ALLOWABILITY | | | |
| 19 | 07/25/2005 | DATE FORWARDED TO EXAMINER | | | |
| 18 | 07/19/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 17 | 05/19/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 16 | 05/16/2005 | FINAL REJECTION | | | |
| 15 | 03/14/2005 | DATE FORWARDED TO EXAMINER | | | |
| 14 | 02/11/2005 | RESPONSE AFTER NON-FINAL ACTION | | 571 | 10 |
| 13 | 02/14/2005 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 12 | 01/25/2005 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 11 | 01/24/2005 | DATE FORWARDED TO EXAMINER | | | |
| 10.1 | 07/21/2003 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 10 | 07/21/2003 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 9 | 01/18/2005 | FILE MARKED FOUND | | | |
| 8 | 09/30/2003 | FILE MARKED LOST | | | |
| 7 | 04/23/2003 | MAIL NON-FINAL REJECTION | | | |
| 6 | 04/21/2003 | NON-FINAL REJECTION | | | |
| 5 | 06/29/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 05/31/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 05/29/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 05/09/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 04/30/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

SPE: E. Kim

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/13/06

TO SPE OF : ART UNIT 3711

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/135,822 Patent No.: 6916251

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

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

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


**Lamonte M. Newsome**
**Certificates of Correction Branch**
**703-308-9390 ext. 112**


**Thank You For Your Assistance**

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

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

**Comments:** The Request for Certificate of Correction is not signed.

SPE — 3711 Art Unit

SPE: E. Kim

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/13/06

TO SPE OF : ART UNIT 3711

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/135,822 Patent No.: 6916251

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

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

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


**Lamonte M. Newsome**
**Certificates of Correction Branch**
**703-308-9390 ext. 112**


**Thank You For Your Assistance**

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

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

**Comments:** The Request for Certificate of Correction is not signed.

[signature] 3711

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

Date Mailed : 02/16/07

Patent No. : 6916251 B2
Patent Issued : 07/12/05
Docket No. : **03409.0068**

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.

Respecting the alleged errors in the documents filed on 09/11/06; please see attachment. **"Therefore, no correction(s) is in order here under United States Codes (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1322."**

In view of the foregoing, your request in this matter is hereby denied.

Lamonte M. Newsome
For Cecelia Newman, Supervisor
Decisions & Certificates
Of Correction Branch
(703) 305-8309 or (703)-308-9390 #112

**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP**
**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

LMN

SPE: E. Kim

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/13/06

TO SPE OF : ART UNIT 3711

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/135,822 Patent No.: 6916251

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

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

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


**Lamonte M. Newsome**
**Certificates of Correction Branch**
**703-308-9390 ext. 112**


**Thank You For Your Assistance**

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

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

**Comments:** The Request for Certificate of Correction is not signed.

[signature]
SPE

3711
Art Unit

SPE: E. Kim

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/20/07

TO SPE OF : ART UNIT 3711

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/135,822 Patent No.: 6916251

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.

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

**Comments:** _____

[signature] 3711

**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

Katten Muchin Zavis Rosenman
575 Madison Avenue
New York, NY 10022-2585

**COPY MAILED**

MAY 24 2005

**OFFICE OF PETITIONS**

In re Application of :
Norihasa Matsumoto, et al. :
Application No. 10/135,823 :
Filed: April 26, 2002 :
Attorney Docket No. FUJI 19.697 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 8, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for a failure to timely reply to the final Office action mailed July 13, 2004. This decision precedes the mailing of a Notice of Abandonment.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

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

The application file is being referred to Technology Center AU 2681, for further processing of the request for continued examination under 37 CFR 1.114 filed March 8, 2005.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

COPY MAILED

APR 2 3 2004

OFFICE OF PETITIONS

Applicant: Rosen et al.
Appl. No.: 10/135,839
Filing Date: May 1, 2002
Title: HUMAN G-PROTEIN CHEMOKINE RECEPTOR (CCR5) HDGNR10
Attorney Docket No.: 1488.115000M/EKS/HCC
Pub. No.: US 2003/0166024 A1
Pub. Date: September 4, 2003

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on November 3, 2003.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains a mistake in dependent claim 34, line 8 (section (e)) wherein "$10^{-11}$ M" is misprinted as "$10^{-1}$ M".

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

The typographical error in dependent claim 34 in the patent application publication wherein "$10^{-11}$ M" is misprinted as "$10^{-1}$ M" is an Office error, but it is a minor typographical error, which is clearly understandable. The mistake is clearly understandable as the term is used in stating a range for the dissociation constant ($K_D$), wherein the range is stated in decreasing order in clauses (a)-(f) going from "$10^{-7}$ M" to "$10^{-12}$ M" with "$10^{-1}$ M" being a typographical error, which is clearly understandable. The mistake is a minor typographical error which is understandable from reading the specification, and claim in which the term is used, as terms are not read in a vacuum. The mistake does not affect the public's ability to appreciate the technical disclosure of the patent

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

application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

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

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

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

By facsimile: 703-872-9306

The application will be examined in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Edwin H Taylor
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles CA 90025

**COPY MAILED**

MAY 1 1 2006

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Lindner, et al. :
Application No. 10/135,849 :
Filed: May 1, 2002 :
Attorney Docket No. 034560-089 :
For: EFFICIENT HIGH PERFORMANCE DATA OPERATION ELEMENT FOR USE IN A RECONFIGURABLE LOGIC ENVIRONMENT

This is a decision on the petition, filed March 16, 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 April 5, 2005 non-final Office action. No response being received and no extensions of time being obtained, this application became abandoned on July 6, 2005. A Notice of Abandonment was mailed on December 12, 2005.

Applicants have submitted an amendment in reply to the April 5, 2005 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the April 5, 2005 non-final Office action, and the petition fee.

Regarding the statement of delay, it 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. In the event that practitioner has no knowledge that the delay was in fact unintentional, practitioner should make a reasonable inquiry to ascertain that, in fact, the delay was unintentional. If practitioner discovers that the delay was intentional, practitioner must so notify the Office. A courtesy copy of this decision is being mailed to practitioner. However, any future correspondence regarding this application will be mailed to the address of record.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center AU 2183 for consideration of the amendment filed on March 16, 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

cc: LANNY L. PARKER
OC2-157 4500 S. DOBSON ROAD
CHANDLER, AZ 85248

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**: _____

**DATE** : 11/19/2009

**TO SPE OF** : ART UNIT 1616

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/135,857 Patent No.: 6,946,149

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

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

Ernest C. White, LPE
Randolph Sq. Ste 9D62A
703-756-1590

**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. |
| **X Denied** | State the reasons for denial below. |

**Comments: Inventor name "Mark V. Cleveland" as signed in supplemental oath is not the same as identified inventor "Mark vB. Cleveland". The supplemental oath fails to indicate the residence and post office address of the named inventors. It is noted that the oath form used is supposed to be accompanied by an Application Data Sheet (ADS) which would require among other items the residence and post office address of the named inventors; however,**

there is no ADS attached. The certificate of correction form uses both “Mark V. Cleveland”

and “Mark vB. Cleveland”.

SPE___/Sreeni Padmanabhan/_____ ART UNIT _1627_____

**UNITED STATES DEPARTMENT OF COMMERCE**
**COMMISSIONER FOR PATENTS**
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

| | |
|---|---|
| Date | : 11/24/2009 |
| Patent No. | : 6,946,149 B2 |
| Serial No. | : 10/135,857 |
| Inventor(s) | : Cleveland |
| Issue Date | : September 20, 2005 |
| Title | : **SALT SOLUTION FOR COLON CLEANSING** |
| Doc./File No. | : **113592.137 (BRA-015US)** |

Re: Certificate of Correction

Consideration has been given your request for a certificate of correction, for the above-identified patent under the provisions of Rule 1.322.

Respecting the alleged error in item (75) inventors on the title page, the inventor name "Mark V. Cleveland" as signed in supplemental oath is not the same as identified inventor "Mark vB. Cleveland". The supplemental oath fails to indicate the residence and post office address of the named inventors. It is noted that the oath form used is supposed to be accompanied by an Application Data Sheet (ADS) which would require among other items the residence and post office address of the named inventors; however; there is no ADS attached. The certificate of correction form uses both "Mark V. Cleveland" and "Mark vB. Cleveland". No correction is in order here.

In view of the foregoing, your request for certificate of correction is hereby denied.

Further consideration will be given concerning this matter upon receipt of a request for **Reconsideration** (reconsideration should be accompanied by supporting document(s) such as, amendment, postcard receipt, 1449/892, etc.) and should be filed and directed to Decisions & Certificates of Correction Branch.

**Ernest C. White, *LIE* (703) 756-1590**
Mary F. Diggs, *Supervisor* (703) 756-1580
Decisions & Certificates of Correction Branch

WILMERHALE/BOSTON
60 STATE STREET
BOSTON MA 02109

ecw

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AUG - 1 2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue
Suite 2800
Dallas, TX 75201-2784

| | | |
|---|---|---|
| In re application of<br>Richard Falcone et al.<br>Application No. 10/135,883<br>Filed: April 29, 2002<br>For: OPTIMIZING PROFITABILITY IN BUSINESS TRANSACTIONS | :<br>:<br>:<br>: | **DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)** |

This is in response to the petition filed on July 15, 2005 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(h); (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 fails to adequately meet requirement (B) above. Regarding item (B), the petition fails to include an election without traverse, or a statement that applicant is willing to elect without traverse should a restriction or election be required.

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

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

Applicant should promptly submit a renewed petition to the Commissioner of Patents and Trademarks, 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.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(571) 272-6611

SNM/pav: 07/30/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SEP 17 2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue
Suite 2800
Dallas, TX 75201-2784

| | | |
|---|---|---|
| In re application of<br>Richard Falcone et al.<br>Application No. 10/135,883<br>Filed: April 29, 2002<br>For: OPTIMIZING PROFITABILITY IN BUSINESS TRANSACTIONS | :<br>:<br>:<br>: | **DECISION ON RENEWED PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)** |

This is in response to the renewed petition filed on August 08, 2005 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 original petition filed on July 15, 2005 was dismissed on August 01, 2005 for failing to satisfy requirement (B) above. The renewed petition satisfies the above deficiency.

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

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

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

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

Randolph A. Reese

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

RAR/pav: 09/23/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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KING & SPALDING, LLP
1180 PEACHTREE STREET
ATLANTA, GA 30309-3521

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MAY 08 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Lawrence Tamarkin, et. al. | : | |
| Application No. 10/135,886 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. 01994-0092 | : | |
| (13664.105061) | : | |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 4, 2007, 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 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. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

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

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

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

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

This application is being forwarded 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 to the prior-filed application.

Any inquiries concerning this decision may be directed to Andrea Smith at (571) 272-3226. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

Andrea Smith
Petitions Examiner
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/135,886 | 04/30/2002 | 1635 | 780 | 01994-0092 (13664.105061) | 20 | 3 |

**CONFIRMATION NO. 5662**

**CORRECTED FILING RECEIPT**

20786
KING & SPALDING LLP
1180 PEACHTREE STREET
ATLANTA, GA 30309-3521

*OC000000029824169*

Date Mailed: 05/08/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Lawrence Tamarkin, Rockville, MD;
Giulio F. Paciotti, Baltimore, MD;

**Power of Attorney:** The patent practitioners associated with Customer Number 20786

**Domestic Priority data as claimed by applicant**

This application is a CON of 10/093,578 03/08/2002 PAT 7,229,841
which claims benefit of 60/287,363 04/30/2001
This application 10/135,886
claims benefit of 60/309,705 08/02/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 05/24/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/135,886**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**** SMALL ENTITY ****

**Title**

COLLOIDAL METAL COMPOSITIONS AND METHODS

**Preliminary Class**

436

## 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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APR 17 2008

**OFFICE OF PETITIONS**

**TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC**
**1900 EMBARCADERO ROAD, SUITE 109**
**PALO ALTO, CA 94303**

In re Application of :

**MASTER**, et al. :
Application No. 10/135,905 : DECISION ON PETITION
Filed: April 29, 2002 : TO WITHDRAW
Attorney Docket No. **046301-023000** : 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 21, 2007 and re-submitted October 5, 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 Charles J. Kulas on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

There is an outstanding Office action mailed March 26, 2008 that requires a reply from the applicant.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **PAUL L. MASTER**
**796 DARTSHIRE WAY**
**SUNNYVALE, CA 94087**

cc: **MARC KAUFMAN, ESQ.**
**NIXON PEABODY, LLP**
**401 9TH STREET NW, SUITE 900**
**WASHINGTON, DC 20004-2128**

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JUN 16 2005

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Alexandria, VA 22313-1450
www.uspto.gov

PABST PATENT GROUP L.L.P.
400 Colony Square, Suite 1200
1201 Peachtree Street
Atlanta, GA 30361

In re Application of
Alex Zhu
Serial No. : 10/135,919
Filed : April 29, 2002
Attorney Dkt No. : COOP 100

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.144, filed on September 13, 2004, to review the restriction requirement. The delay in acting on this petition is regretted.

## BACKGROUND

A review of the file history shows that the application was filed under 35 USC 111(a) on April 29, 2002 with claims 1-31.

A requirement for restriction was mailed to applicants on March 25, 2004, requiring the restriction of the claims to one of five inventions under 35 U.S.C. 121. The claims were restricted as follows:

Group I Claims 1-3, 5-9, 19-21, and 23-27, drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed enzymatically or chemically, classified in class 424, subclass 600.

Group II Claims 1-2, 4-9, 19-20, and 22-27, drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed by genetic engineering, classified in class 435, subclass 455.

Group III Claims 10-12, 14-21, and 23-27, drawn to methods of treating comprising transfusing a human with cells produced by a method comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed enzymatically or chemically, classified in class 424, subclasses 93.1 and 600.

Group IV Claims 10-11, 13-20, and 22-27, drawn to methods of treating comprising transfusing a human with cells produced by a method comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed by genetic engineering, classified in classes 424 and 435, subclasses 93. 1 and 455 respectively.

Group V Claims 28-31, drawn to methods of increasing the half-life of a recombinant or non-human protein by removing NeuGc and/or Gal epitopes on the proteins, and recombinant or non-human proteins having lacking or having reduced NeuGc and/or Gal epitopes, classified in classes 530 and 424, subclasses 350 and 600 respectively.

Claims 1 and 19 were indicated as linking inventions I and II and claims 10 and 19 were indicated as linking inventions III and IV.

On April 23, 2004, applicants elected to prosecute Group I, with traverse. The traversal was considered by the Office but not found persuasive and the restriction requirement was made FINAL. A first action on the merits was sent to applicants on July 13, 2004 in which claims 1-3, 5-9, 19-21, and 23-27 were rejected under 35 USC 112 first paragraph, claims 5 and 23 were rejected under 35 USC 112 second paragraph, claims 1, 3, 19 and 21 were rejected under 35 USC 102(b), and claims 1-3, 6-9, 19-21 and 24-27 were rejected under 35 USC 103(a).

The instant petition was filed on September 13, 2004.

On October 13, 2004, applicants responded to the first action on the merits by amending the claims and traversing the previous rejections as they applied to the newly amended claims.

## DISCUSSION

Applicants petition pursuant to 37 C.F.R. 1.144, to review the restriction requirement set forth in the Office action mailed on March 25, 2004. The prosecution history and petition have been carefully considered.

Applicants initially note that applicants agree that the inventions defined by claims 1-27 and by claims 28-31 are different inventions.

Applicants believe that the methods of claims 1-27 are drawn to the same invention: the discovery that removal of N-glyconeuraminic epitopes decreases the immune response to these cells following xenotransplantation, regardless of how the epitopes are removed and thus the search for all of these claims will be for the same elements: removal of the N-glycolneuraminic epitopes.

Applicants traverse the restriction requirement set forth for the following reasons. To be valid, a restriction requirement must establish both that (1) the "inventions" are either independent or distinct, and (2) that examination of more then one of the "inventions" would constitute a burden to the Examiner. The so-called "separate" inventions, all of which are clearly encompassed by the independent claims 1, 10 and 19 are actually a single invention, merely achieved using different methods. The invention, defined by claims 1-27, is the removal of the groups on the surface of non-human cells which elicit an immune response following transplantation into a human.

Applicants argue that the fact that the epitopes may be removed from the surface of the cells either enzymatically/chemically or by genetic engineering, does not mean that the claims encompass separate inventions, nor would concurrent examination constitute a serious burden on the examiner.

Applicants further argue that there is no support for the allegations made by the Examiner in the office action dated March 24, 2004, that since the cells may be chemically/enzymatically treated or genetically engineered, "the structural, chemical and physical properties of the cells are substantially different each from the other (page 4) as the claims are directed to using enzymatic/chemical treatment or genetic engineering to achieve the same result (removal or reduction of immune eliciting-epitopes on the surface of nonhuman cells).

Applicants' complete argument is acknowledged, but found only partly persuasive. Under 35 USC 121, an application may properly be required to be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

Original group I, claims 1-3, 5-9, 19-21, and 23-27, is drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolyneuraminic epitopes on the surface of the cells, wherein the epitopes are removed enzymatically or chemically, classified in class 424, subclass 600 and original Group II, claims 1-2, 4-9, 19-20, and 22-27, is drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolyneuraminic epitopes on the surface of the cells, wherein the epitopes are removed by genetic engineering, classified in class 435, subclass 455. Both of these groups are drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolyneuraminic epitopes on the surface of the cells, however, the result is achieved using different steps. Group I requires that the epitopes are removed enzymatically or chemically, while group II requires that the epitopes are removed by genetic engineering. This difference constitutes a distinction because the difference between the two steps is significant. Each step using different techniques and materials. Further, a search for one group would be a different search from the other group. Thus restriction between the groups I and II is proper, in view of 806.03. As the differences between groups III and IV are analogous to the above differences between groups I and II as discussed above, restriction between groups III and IV is proper, for the same reasons. However, the office does agree that the method of making the animal organ, tissue, or cells, is not distinct from the method of treating using these products. Therefore, group I and III will be rejoined as will II and IV. For purposes of examination, group I was elected, group III will now be examined as well.

Thus: The restriction is as set forth below:

Group I Claims 1-3, 5-9, 10-12, 14-21, and 23-27, drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed enzymatically or chemically, and methods of treating comprising transfusing a human

with cells produced by a method comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed enzymatically or chemically,classified in class 424, subclass 600 and 93.1.

Group II Claims 1-2, 4-11, 13-20, and 22-27, drawn to methods of making a nonhuman animal organ tissue of cells comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed by genetic engineering, and methods of treating comprising transfusing a human with cells produced by a method comprising removing N-glycolylneuraminic epitopes on the surface of the cells, wherein the epitopes are removed by genetic engineering, classified in class 435, subclass 455, and class 424 subclass 93.1.

Group III Claims 28-31, drawn to methods of increasing the half-life of a recombinant or non-human protein by removing NeuGc and/or Gal epitopes on the proteins, and recombinant or non-human proteins having lacking or having reduced NeuGc and/or Gal epitopes, classified in classes 530 and 424, subclasses 350 and 600 respectively.

Claims 1, 7, 10, and 19 are indicated as linking inventions I and II.

## DECISION

For these reasons, the Petition under 37 C.F.R. 1.144 to request review of the restriction requirement is **GRANTED-IN-PART** and the original restriction between groups I and III and groups II and IV is hereby withdrawn.

Any request for consideration of this petition decision must be filed within two (2) months of the mailing date of this decision.

The application will be forwarded to the examiner for appropriate action consistent with this decision and to consider the response filed on 10/13/2004.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

Jasemine C. Chambers

Jasemine Chambers
Director, Technology Center 1600

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David Mitchell Goodrich, Esq.
J. M. Huber Corporation
333 Thornall Street
Edison NJ 08837-2220

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OFFICE OF PETITIONS

In re Application of
Cornelius, et al.
Application No. 10/135,978
Filed: April 30, 2002
Attorney Docket No. 01-210
For: COATED CONDITIONERS FOR USE IN FOODS AND PHARMACEUTICALS

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed on February 15, 2007 to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to properly respond to the final Office action mailed November 16, 2005, which set an extendable three month period for reply. Applicants submitted an amendment after final on certificate of mailing date December 28, 2005. The amendment after final failed to place this application in *prima facie* condition for allowance, as was explained in the May 18, 2006 Advisory action. Accordingly, this application became abandoned on February 17, 2006. A Notice of Abandonment was mailed on November 28, 2006.

Applicants have submitted a RCE and required fee and an amendment as the submission in reply to the November 16, 2005 final Office action, an acceptable statement of the unintentional nature of the delay in responding to the November 16, 2005 final Office action, and the $1,500.00 petition fee.

Regarding the statement of delay: The statement of unintentional delay presented in the petition does not comply with the current rule. 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" be submitted. However, the statement presented will be accepted and construed as meaning 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 this is an incorrect interpretation in view of the rules, petitioners are required to provide a statement to that effect.

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 forwarded to Technology Center AU 1618 for consideration of the RCE and amendment filed on February 15, 2007.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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Jeffrey Brill
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080

**MAILED**

FEB 19 2005

Technology Center 2100

In re Application of:
Paul C. Kocher
Application No. 10/136,012
Filed: April 29, 2002
For: LEAK-RESISTANT CRYPTOGRAPHIC PAYMENT SMARTCARD

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed June 04, 2004.

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

The request is **GRANTED**.

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

for

Vincent N. Trans
Special Program Examiner
Technology Center 2100

cc: Edward J. Radio
Sonnenschein Nath & Rosenthal LLP
685 Market Street, 6th Floor
San Francisco, CA 94105

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Paper No. 16

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JAMES F MCLAUGHLIN
4 VICTORY STREET
SHELTON, CT 06484

| | | |
|---|---|---|
| In re Application of<br>Stefan C. Barry<br>Application No. 10/136,027<br>Filed: April 30, 2002<br>Attorney Docket No. FAT-0001 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision in response to the petition, filed June 27, 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 a non-final Office action mailed July 3, 2003. A Notice of Abandonment was mailed March 22, 2004. In response on June 27, 2005, 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.

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 is being refunded.

The application is being referred to Technology Center AU 3712 for consideration of the amendment filed June 27, 2005.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 12/19/06

2 Serial/Patent # 10/136,027

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| X | Extension of Time | 15 | 06/27/06 | $ 510.00 |
| | Notice of Appeal/Appeal | | | $ |
| | Petition | | | $ |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $ 510.00

8 TO BE REFUNDED BY: Credit Card

| | |
|---|---|
| | Treasury Check |
| | Credit Deposit A/C #: |

9 [ ][ ]--[ ][ ][ ][ ]

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Extension of time filed after the extendable period

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Sherry D. Brinkley TITLE: Petitions Examiner

SIGNATURE: Sherry D. Brinkley PHONE: 2-3204

OFFICE: Petitions

**********

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APPROVED: CKhor DATE: 12/20/06

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(01/90)

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Shumaker & Sieffert, P.A.
1625 Radio Drive
Suite 300
St. Paul MN 55125

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Locke et al. | : | |
| Application No. 10/136,040 | : | DECISION ON PETITION |
| Filed: 04/30/2002 | : | |
| Attorney Docket No. PB9967.00 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 10, 2009, to revive the above-identified application.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed March 13, 2008, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on May 14, 2008. See MPEP 1215.04. A Notice of Abandonment was mailed on November 26, 2008.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply, paid the requisite fees, and made the proper statement of unintentional delay.

Accordingly, the petition is **GRANTED.**

This matter is being referred to Technology Center Art Unit 2838.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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SCOTT A. MCBAIN
LEGAL STAFF – M/C 480-410-202
P.O. BOX 5052
TROY, MI 48007

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Syed A. Hossain et al :
Application No. 10/136,043 :
Filed: April 30, 2002 :
Attorney Docket No. DP-306740

This is a decision on the petition, filed December 15, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on February 27, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

This matter will be forwarded to Technology Center AU 2837 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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ZAGORIN O'BRIEN GRAHAM LLP (004)
7600B NORTH CAPITAL OF TEXAS HIGHWAY
SUITE 350
AUSTIN, TX 78731-1191

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| | | |
|---|---|---|
| In re Application of | : | |
| Zhaoyun Xing | : | DECISION ON PETITION |
| Application No. 10/136,045 | : | |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 004-7810 | : | |

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

This application became abandoned for failure to pay the issue and publication fees as required by the Notice of Allowance and Fee(s) Due mailed on October 12, 2005, which set a three (3) month statutory period for reply. Accordingly, the application became abandoned on January 13, 2006. A Notice of Abandonment was mailed on February 24, 2006.

Petitioner has met the requirements under 37 CFR 1.137(b). Accordingly, the petition is **granted.**

This matter 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 (571) 272-4200.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Paper No. 5

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

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OFFICE OF PETITIONS

In re Application of
Boros, et al.
Application No. 10/136,048
Filed: April 29, 2002
Attorney Docket No. 15685P023D2
For: PERIODIC CALIBRATION ON A COMMUNICATIONS CHANNEL

DECISION GRANTING PETITION

This is a decision on the petition, filed June 24, 2002 (certificate of mailing date June 17, 2002), requesting, in effect, withdrawal of the Notice to File Omitted Item(s) in a Nonprovisional Application (Notice), mailed May 29, 2002.

The application was filed on April 29, 2002. On May 29, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners that page 54 of the specification appeared to have been omitted.

In response to the Notice, petitioners timely filed the present petition. Petitioners request that page 54 be accorded a filing date of April 29, 2002 on the basis that the entire specification, including allegedly missing page 54, was received in the Patent and Trademark Office (PTO) on April 29, 2002. In support, the petition is accompanied by a copy of applicants' itemized postcard receipt showing an Office of Initial Patent Examination generated barcode citing April 29, 2002 as the date of receipt. The postcard lists, *inter alia*, that the filing included 76 pages of specification. A review of the application file reveals that there are 75 pages present, including the cover page. Page 54 is missing.

The return postcard constitutes *prima facie* evidence that the entire specification, including missing page 54, was filed on April 29, 2002. MPEP 503. Accordingly, the request is granted.

The $130.00 petition fee will be credited to petitioners' deposit account, no. 02-2666.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of April 29, 2002, using the copy of page 54 supplied with the petition.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MAIL**

MAR 2 5 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 6

CANTOR COLBURN, LLP
55 Griffin Road South
Bloomfield, CT 06002

In re Application of:
James GROSSMAN
Application No. 10/136,105
Filed: May 1, 2002
For: METHOD, SYSTEM, AND STORAGE MEDIUM FOR FACILITATING WEB SEARCHING AND BRAND RECOGNITION CAPABILITIES OVER A COMPUTER NETWORK

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed February 26, 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: James Grossman
9 Woodland Drive
Westport, CT 06880

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RICHARD K. THOMSON, ESQ.
7691 FAIRLANE DRIVE
FAIRVIEW, PA 16415

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MAR 3 0 2005

OFFICE OF PETITIONS

In re Application of :
Clayton E. Schulze :
Application No. 10/136,114 : DECISION
Filed: February 6, 2001 : ON PETITION
For: WELDMENT PLATE :
SPACER/SUPPORT :

This is a decision on the petition to withdraw abandonment of the application under 37 CFR 1.181, or alternatively, to revive the application under 37 CFR 1.137(b), filed February 5, 2004.

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

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

The above-identified application became abandoned for failure to reply in a timely manner to the nonfinal Office action, mailed June 18, 2003. The Notice set a shortened statutory period for reply of three (3) months from the mail date of the Notice, and also provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned September 19, 2004. A Notice of Abandonment was mailed January 26, 2004.

Applicant's Assertion

Applicant asserts that a timely reply to the Office action, in the form of an Amendment, was timely filed in the Office on September 18, 2003, and included a certificate of mailing under 37 CFR 1.8. Applicant states that the serial number of the parent application was erroneously included on the Amendment instead of the serial number of the above-identified application.

The Manual of Patent Examining Procedure ("MPEP") provides that "[a] minor error in the identification of the application can be corrected by the group provided the correct identification can be quickly discovered. Examples of minor errors are… listing the parent application number. See MPEP 502.

A review of the Amendment filed on September 18, 2003 reveals that the Amendment included the attorney docket number, title of invention, Group Art Unit, Inventor, and Examiner. Accordingly, the petition is granted.

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

A refund of the petition fee has been scheduled.

The application file is being referred to Technology Center Art Unit 3635 for continued processing in due course.

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

Derek L. Woods
Attorney/Advisor
Office of Petitions

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Paper No. 13

Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

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DEC 1 9 2003

**OFFICE OF PETITIONS**

In re Application of :
Espiridion Valdes Rodriguez et al. :
Application No. 10/136,152 :
Filed: May 1, 2002 :
Attorney Docket No. 15832-109001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 11, 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, to the final Office action mailed March 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 after midnight June 15, 2003.

The application file is being forwarded to Technology Center 1761, for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

Latrice Bond

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

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10-5-07

caf

In re application of :
Eric Mazur :
Serial No. 10/136,160 :
Filed: May 1, 2002 :
For: METHOD AND APPARATUS FOR MICROMACHINING :
BULK TRANSPARENT MATERIALS USING :
LOCALIZED HEATING BY NONLINEARLY :
ABSORBED LASER RADIATION, AND DEVICES :
FABRICATED THEREBY :

DECISION ON PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 that the Information Disclosure Citation filed November 3, 2006 be expressly considered in its merits.

On May 5, 2006, Applicant submitted an Information Disclosure Statement. On July 17, 2006 the USPTO issued an office action in which the examiner indicated that the IDS fails to comply with 37 CFR 1.98(a)(1). Applicant submitted a corrected IDS on November 11, 2006. In the final rejection the examiner stated that the IDS filed November 11, 2006 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e) and fails to comply with 37 CFR 1.97, 1.98 and MPEP 609 because the dates of publication (for non-patent documents) are not provided.

It is noted that this petition was submitted on June 14, 2007 which falls more than 2 months after the date of the office action containing the Examiner's consideration of the IDS, making the instant petition untimely under Rule 181. Nonetheless, the instant petition will be considered on its merits.

**DECISION**

Applicant argues that with regard to 37 CFR 1.97(e), that each of the non-patent documents was originally cited in the IDS filed in May 2002 prior to the issuance of an Office Action. The IDS filed in December 2006 simply cited the same references. As such, Applicants are not required to provide a statement as specified in 37 CFR 1.97(e). Moreover, this IDS again provides the publication dates of the non-patent documents.

First it is noted that applicant's reference to the IDS filed in December 2006 is assumed to be directed to the IDS that was filed in November 2006. No IDS was received in December 2006. Further, MPEP 609.05 (a) states:

> If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in MPEP § 609.04(b), including the requirements for fees and/or statement under 37 CFR 1.97(e), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, **but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the requirements based on the time of filing of the IDS** (37 CFR 1.97).

Thus, since the November 2006 IDS was filed after a first office action, but prior to final rejection, a statement under 37 CFR 1.97(e) or fee is required as stated on MPEP 609.01.

Accordingly, the petition is **DENIED**.

Jacqueline M. Stone

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

NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON MA 02210-2604

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : June 27 2008

TO SPE OF : ART UNIT ~~2800~~ 2192

SUBJECT : Request for Certificate of Correction for Appl. No 10/13663 patent no7055140

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:** As per Examiner's Amendment on 1/3/2005.

TUAN DAM
SUPERVISORY PATENT EXAMINER
SPE

2192
Art Unit

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THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH PA 15219

In re Application of
Stefan Pagowski
Application No. 10/136,164
Filed: May 1, 2002
Attorney Docket Number: WAB 02188

ON PETITION

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**.

This application became abandoned for failure to timely reply to the non-Final Office Action mailed April 1, 2004. A shortened statutory period of three months was set for replying to the non-Final Office Action. An amendment was filed with a certificate of mail dated July 1, 2004 however, it was not responsive and as such, a notice was mailed September 20, 2004 to advise petitioner. The "Notice" set a one month or 30 day period for response. Neither a timely response or request for an extension of time was filed. Accordingly, a Notice of Abandonment was mailed May 5, 2005.

Petitioner files the instant petition under 37 CFR 1.137(b). [1]

A five month request for extension of time was filed with the instant petition. However, pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $2,160.00 extension of time fee submitted with the petition on June 13, 2005, was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to counsel's deposit account no. 23-0650.

This application is being forwarded to Technology Center 3644 for appropriate action on the amendment filed June 13, 2005.

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 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(d)).

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**2790 COLUMBUS ROAD**
**GRANVILLE, OH 43023**

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JUN 13 2005

**OFFICE OF PETITIONS**

In re Application of :
Jimmy L. Griggs :
Application No. 10/136,166 : ON PETITION
Filed: May 1, 2002 :
Attorney Docket No. 25171A :

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 **DISMISSED**.

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

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 19, 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 amendments submitted on August 19, 2004 and September 16, 2004, did not *prima facie* place the application in condition for allowance as noted in the Advisory Actions mailed September 2, 2004 and September 28, 2004. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed. Extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on October 20, 2004.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b)

was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (1) above.

As to item (1), petitioner has not submitted an amendment that *prima facie* places the application in condition for allowance. The required reply to the final Office action must be an amendment that *prima facie* places the application in condition for allowance, a Notice of Appeal and the requisite fee, or a request for continued examination (RCE).

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

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Commissioner for Patents
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Alexandria, VA 22313-1450

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

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

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

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

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**260 BEAR HILL ROAD**
**WALTHAM MA 02451-1018**

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| | | |
|---|---|---|
| In re Application of | : | |
| Yosef Stein et al | : | |
| Application No. 10/136,170 | : | ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. AD-300J | : | |

This is a decision on the petition, filed February 6, 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) 272-3208.

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

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHRISTINE E. M. ORICH
INTELLECTUAL PROPERTY GROUP
BOSE, McKINNEY & EVANS, LLP
2700 FIRST INDIANA PLAZA
135 NORTH PENNSYLVANIA STREET
INDIANAPOLIS, INDIANA 46204

**MAILED**

DEC 23 2004

**Technology Center 2100**

| | | |
|---|---|---|
| In re Application of: Witter et al. | ) | |
| Application No. 10/136,238 | ) | DECISION ON PETITION UNDER 37 |
| Attorney Docket No. 9512-0013 | ) | CFR 1.181 TO WITHDRAWAL |
| Filed: May 01, 2002 | ) | HOLDING OF ABANDONMENT |
| For: CUSTOMER RELATIONSHIP | ) | |
| MANAGEMENT SYSTEM | ) | |

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed October 18, 2004.

The petition is **GRANTED.**

## Applicable Prosecution History

November 17, 2003 Restriction Requirement mailed.

August 24, 2004 Notice of Abandonment.

October 18, 2004 Request to withdraw holding of abandonment which includes a copy of the USPTO return postcard, a copy of the January 15, 2004 response to the restriction requirement and the executed certificate of mailing.

A grantable petition must include a copy of the response and proof of timely filing of the response. A properly used Certificate of mail transmission that includes a 37 CFR 1.8 (b) (3) Statement or a USPTO return postcard that properly identifies the contents of the submission is acceptable. No fee is required.

The USPTO return postcard which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. Copies of these papers were filed with the petition and thus serve as a record of the contents of these papers in the file jacket. The petition and the USPTO

return postcard both indicate that the Response to the Restriction Requirement and an executed Certificate of mailing were timely filed on January 15, 2004, and the Abandonment was the result of Office error in not matching the response to the application file.

The petition is **GRANTED**. The Notice of Abandonment is **WITHDRAWN**. The Office regrets any inconvenience caused by this error.

The application file is being forwarded to the Technology Center support staff with instructions to withdraw the holding of abandonment and for processing of the Response to the Restriction Requirement. After processing, the application will then be forwarded to the Examiner for appropriate action.

12/23/04

***Brian L. Johnson***
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
571-272-3595

HMJ: 12/22/04

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30 ROCKEFELLER PLAZA
NEW YORK NY 10112

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**OFFICE OF PETITIONS**

In re Application of
Takashi Hanamoto et al.
Application No. 10/136,337
Filed: May 2, 2002
Attorney Docket No. 00862.022595

ON PETITION

This is a decision in response to the petition filed December 19, 2007, to withdraw the holding of abandonment, which is being treated under 37 CFR 1.181(b), in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

This application became abandoned for failure to pay the issue fee on or before November 7, 2007 as was required by the Notice of Allowance mailed August 7, 2007. This application therefore became abandoned on November 8, 2007. Accordingly, a Notice of Abandonment was mailed December 3, 2007.

The file record discloses that the Notice of Allowance was mailed to the address of record, the same address to which the Notice of Abandonment was mailed and received. However, petitioner contends that the Notice of Allowance was not received. In support, petitioner indicates that a search of the file jacket and docket records revealed that the Notice was not received and submits copies of pages from the docketing system, wherein receipt of the Notice would have been entered, had it been received, to substantiate the claim. The statement and attachments corroborate non-receipt of the Notice of Allowance.

In view of the facts set forth in the petition, it is concluded that the Notice of Allowance was never received. Accordingly, the holding of abandonment is withdrawn. No petition fee is due and none has been charged.

This matter is being referred to Technology Center 2625 for a re-mailing of the Notice of Allowance and Notice of Allowability.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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HARNESS, DICKEY &
PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

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**OFFICE OF PETITIONS**

In re Application of :
Beck et al. : DECISION ON PETITION
Application No. 10/136,358 :
Filed: May 2, 2002 :
Atty Docket No.29250-000587/US:

This is a decision on the PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW HOLDING OF ABANDONMENT filed February 22, 2008.

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

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

Alternatively, petitioner may seek revival under the provisions of 37 CFR 1.137. Such a request should include a cover letter entitled "Petition under 37 C.F.R. § 1.137(a)" or "Petition under 37 C.F.R. § 1.137(b)," as appropriate.

The above-identified application became abandoned for failure to file a proper reply to the final Office action mailed June 6, 2005. The Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). A reply, made timely by an accompanying extension of time for response within the first month, was filed on October 6, 2005. However, the amendment did not place the application in condition for allowance (See Advisory Action mailed January 31, 2008). No further reply filed and no further extension of time obtained, the application became abandoned

effective October 7, 2005. A courtesy Notice of Abandonment was mailed on February 5, 2008.

In response, the instant petition was filed, asserting that a proper response was timely filed to the non-final Office action dated June 6, 2005 on October 6, 2005. In essence, petitioner maintains that the response was sufficient to avoid abandonment of the application as the final Office Action Summary page indicated that the Action was a "non-final office action." Accordingly, the Office action was maintained by the attorneys of record as a non-final Office action and a response to such was filed on October 6, 2005. In support thereof, a copy of the firm's docket records, showing entry of the Office action as a non-final Office action, is provided. In contrast, petitioner submits evidence to show how a final Office action is docketed.

Petitioner's arguments and evidence have been considered but not found persuasive. A review of the Office action confirms that on the Office Action summary page, the box was checked for a "non-final" Office action instead of a "final" Office action. Yet, the text of the action, at page 5, states clearly and boldly that "THIS ACTION IS MADE FINAL." The language in the text of the Office action is controlling. This language advised applicants that the Office action was considered a final Office action. Applicants were advised thereby that prosecution of the application to save it from abandonment must include such complete and proper reply as an application under final rejection requires.

The fact that the Office action was a final Office action and not the fact that it was docketed by the law firm as a non-final office action is controlling. The response filed October 6, 2005 was not sufficient to avoid abandonment of an application under final rejection. Accordingly, the advisory action mailed January 31, 2008 was properly issued.

The evidence of how the response was docketed by the law firm confuses the issue of whether the application was properly abandoned with whether the abandonment should be excused. Pursuant to 35 U.S.C. 133, and 37 CFR 1.135(b), an application is abandoned upon failure to file a proper response to a final Office action regardless of how the application is docketed by the receiving law firm.

In view thereof, the holding of abandonment is considered proper and will not be withdrawn. The petition under § 1.181 is dismissed.

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

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

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

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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JAN 22 2009

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In re Application of :
Beck et al. : DECISION ON PETITION
Application No. 10/136,358 :
Filed: May 2, 2002 :
Atty Docket No.29250-000587/US:

This is a decision on the PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R. §1.137(b) filed November 4, 2008.

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

The above-identified application became abandoned effective October 7, 2005 for failure to file a proper reply to the final Office action mailed June 6, 2005. A courtesy Notice of Abandonment was mailed on February 5, 2008. By decision mailed September 30, 2008, a PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW HOLDING OF ABANDONMENT filed February 22, 2008 was dismissed.

In response, petitioner submitted the instant petition under 37 CFR 1.137(b). On petition, petitioner submitted a Request for Continued Examination (RCE), RCE fee and submission under §1.114; paid the petition fee; and made the required statement of unintentional delay.

Technology Center AU 3736 has been advised of this decision. The application is, thereby, forwarded to the examiner for consideration of the RCE and submission submitted on petition filed November 4, 2008.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 20

**ERIC ROBINSON**
**PMB 955**
**21010 SOUTHBANK STREET**
**POTOMAC FALLS, VA 20165**

COPY MAILED

JUN 1 0 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Shunpei Yamazaki et al | : |
| Application No. 10/136,373 | : DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : UNDER 37 CFR 313(c)(2) |
| Attorney Docket No. 0756-2487 | : |

This is a decision on the petition, filed June 9, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on May 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 (703) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 3713 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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Alexandria, VA 22313-1450
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#25

ERIC ROBINSON
PMB 955
21010 SOUTHBANK STREET
POTOMAC FALLS, VA 20165

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OFFICE OF PETITIONS

In re Application of
Shunpei Yamazaki et al
Application No. 10/136,373
Filed: May 2, 2002
Attorney Docket No. 740756-2487

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid 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.

Upon receipt of the file in the Office of Petitions and association of the instant petition, RCE, IDS and decision on petition with the file, the file will be forwarded to Technology Center AU 3713 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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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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ERIC ROBINSON
PMB 955
21010 SOUTHBANK STREET
POTOMAC FALLS, VA 20165

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NOV 0 5 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Shunpei Yamazaki et al<br>Application No. 10/136,373<br>Filed: May 2, 2002<br>Attorney Docket No. 740756-2487 | DECISION GRANTING PETITION<br>UNDER 37 CFR 1.313(c)(2) |

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid 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.

Upon receipt of the file in the Office of Petitions and association of the instant petition, RCE, IDS and decision on petition with the file, the file will be forwarded to Technology Center AU 3713 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks

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

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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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ALEXANDRIA, VA 22313-1450
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Paper No. 20

**ERIC ROBINSON**
**PMB 955**
**21010 SOUTHBANK ST.**
**POTOMAC FALLS A 20165**

**COPY MAILED**

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of
Koichiro Tanaka
Application No. 10/136,374
Filed: May 2, 2002
Attorney Docket No. 740756-2496

This is a decision on the petition, filed November 18, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on October 17, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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 2812 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Edwin H.Taylor
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard Seventh Floor
Los Angeles, CA 90025

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SEP 15 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Wong et al. | : | |
| Application No. 10/136,390 | : | |
| Filed: May 2, 2002 | : | ON PETITION |
| Attorney Docket No.: | : | |
| 219.41237X00 | : | |

This is a decision on the Petition to Revive the Application based upon unintentional abandonment, filed July 8, 2005 (Certificate of Mailing dated July 6, 2005).

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed August 11, 2004. The Notice set a non-extendable three (3) month period for reply. Accordingly, the application became abandoned on November 12, 2004. A Notice of Abandonment was mailed April 6, 2005.

With the instant petition Applicant has submitted the issue fee.

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

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

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 17

PATENT & TRADEMARK SERVICE, INC.
6111 SADDLE HORN DRIVE
FAIRFAX VA 22030

COPY MAILED

OCT 1 2 2005

OFFICE OF PETITIONS

In re Application of
Pitchko & Bartle
Application No. 10/136,395
Filed: May 2, 2002
Attorney Docket No. JHM1573
For: CINCHPAC SELF-LOADING ROTARY SHAFT SEAL

DECISION ON PETITION

This is a decision on the petition to revive under 37 CFR 1.137(b), filed on April 15, 2005, The petition will be treated under 37 CFR 1.181 as a petition to withdraw the holding of abandonment, rather than a petition under 37 CFR 1.137(b).

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **GRANTED**.

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

The Office contended that this application became abandoned on April 1, 2004 for failure to submit a timely reply to the December 31, 2003 non-final Office action, which set a three month extendable period for reply. No reply was received. A Notice of Abandonment was mailed on July 13, 2004.

A review of the application file reveals that a revocation/power of attorney/change of address was submitted on October 7, 2003. This document appears to have been signed by only one inventor, Mr. Pitchko. A power of attorney must be signed by all joint inventors to be effective. MPEP 402.10. The Office should **not** have processed the revocation/power of attorney signed only by Mr. Pitchko. As a result, the December 31, 2003 Office action was mailed to an address other than the rightful correspondence of record and the application was abandoned when the erroneously empowered attorney failed to timely respond to the Office action.

Accordingly, the holding of abandonment is withdrawn, the petition under 37 CFR 1.181 is granted and the petition under 37 CFR 1.137(b) is dismissed as moot.. The original power of attorney to Attorneys McGlynn and Zack has been reinstated. The correspondence address of record is that listed above.

If Mr. Pitchko would like to appoint his own attorney, then a petition under 37 CFR 1.182 and a $400.00 petition fee is required. Mr. Pitchko must provide good and sufficient reasons as to why such a request should be granted. The granting of the petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, the representative of each party must sign all subsequent replies. Correspondence will be mailed to only one attorney, though. Unless the parties agree otherwise, the correspondence address will be that of the first empowered attorney. MPEP 402.10

A courtesy copy of this decision will be mailed to Norman E. Lehrer, the attorney that Mr. Pitchko desired as his attorney.

As this petition was treated under 37 CFR 1.181, which is a feeless petition, the $750.00 petition fee submitted with the instant petition will be refunded to petitioner's credit card.

Petitioner has submitted an amendment to the December 31, 2003 non-final Office action. Therefore, it is unnecessary to re-mail the December 31, 2003 non-final Office action.

After the mailing of this decision, the application file will be returned to Technology Center 3600's technical support staff in order to process the amendment filed with the instant petition. Then the application file will be forwarded to the examiner of record for further examination.

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

cc: NORMAN E. LEHRER
1205 NORTH KINGS HIGHWAY
CHERRY HILL, NJ 08034

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : March 22, 2007

**TO SPE OF** : ART UNIT 3677

**SUBJECT** : Request for Certificate of Correction on Patent No.: **7178806 B1 – 10/136395**

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

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance**

Elisha Evans
**Certificates of Correction Branch**
***Tel. No. 703-308-9390 EXT 110***

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

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

**Comments:**

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SPE — 3677 Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 07082004

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington DC 20005-3096

JUL 13 2004

*In re* Application of
SHIRAHAMA et al.
Application No.: 10/136,398
Filed: May 2, 2002
Attorney Docket No. **57454-498**

**WITHDRAWAL FROM ISSUE**
*37 CFR 1.313*

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn from issue because the application was allowed without taking into consideration the amendment filed with the RCE on May 11, 2004.

The US 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 Kammie Cuneo, Supervisory Patent Examiner, at (571) 272-1957.

The application is being returned to the examiner for consideration of the preliminary amendment and for taking appropriate action.

Sharon Gibson, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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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. 07082004

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington DC 20005-3096

JUL 13 2004

*In re* Application of
SHIRAHAMA et al.
Application No.: 10/136,398
Filed: May 2, 2002
Attorney Docket No. **57454-498**

**WITHDRAWAL FROM ISSUE**
*37 CFR 1.313*

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn from issue because the application was allowed without taking into consideration the amendment filed with the RCE on May 11, 2004.

The US 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 Kammie Cuneo, Supervisory Patent Examiner, at (571) 272-1957.

The application is being returned to the examiner for consideration of the preliminary amendment and for taking appropriate action.

Sharon Gibson, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 02/14/06

**TO SPE OF** : ART UNIT **2635**

**SUBJECT** : Request for Certificate of Correction on Patent No.: 10/136403 6982651

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

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance**

**Angela Green**
**Certificates of Correction Branch**
***Tel. No. 703-305-9380 ext. 123***

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

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

**Comments:**

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SPE — 2635 Art Unit

UNITED STATES
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TRADEMARK OFFICE

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

MAY 20 2003

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

#9

| | |
|---|---|
| In re Application of | : |
| Thomas Piccariello et al | : |
| Serial No.: 01/136,433 | : PETITION DECISION |
| Filed: May 2, 2002 | : |
| Attorney Docket No.: 54719.000054 | : |

This is a response to the petition under 37 CFR 1.59(b), filed April 11, 2003, to expunge information from the above identified application.

Petitioner requests that an Information Disclosure Statement (IDS), filed March 23, 2003, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been paid.

A review of the file shows that the IDS is present in the file. The IDS consists of citations of US patents and published applications and non-patent literature publications available to the public as well as a number of items relating to presentations, etc. Applicants request return of the entire IDS. However, it would not be appropriate to return information contained in an IDS which is available to the public and may have a bearing on the patentability determination to be made by the examiner. It is noted that information which is considered confidential may be submitted for examiner consideration in accordance with 37 CFR 1.59:

1.59 Expungement of information or copy of papers in application file.
(a) (1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.
(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h)

and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

M.P.E.P. 724.02 sets forth additional guidelines for such submissions:

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials. Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.
Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)
A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED
ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND
TRADEMARK OFFICE EMPLOYEE.
In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:
ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(h)) to expunge the information, if found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, may also accompany the envelope or container.

724.05 Petition To Expunge Information or Copy of Papers in Application File

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION
A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;
(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
(C) the information has not otherwise been made public;
(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and
(F) the petition fee as set forth in 37 CFR 1.17(h) is included.
A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

As was noted above, the IDS contains both public and apparently confidential information which was inadvertently submitted. Only the information which is confidential may be returnable. However applicants have not specifically identified such items other than to supply a complete copy of the Form 1449 which accompanied the IDS listing all of the items submitted. Such does not appear to fully meet items (B) and (E) above.

The petition is **DISMISSED** subject to resubmission in proper form with identification of materials to be returned. Any renewed petition doe snot require a petition fee, if promptly submitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7230

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 13 2005

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

| | |
|---|---|
| In re Application of | : |
| Thomas Piccariello et al | : |
| Serial No.: 10/136,433 | : PETITION DECISION |
| Filed: May 2, 2002 | : |
| Attorney Docket No.: 54719.000054 | : |

This is a response to the renewed petition under 37 CFR 1.59(b), filed June 9, 2003, to expunge information from the above identified application. This application has not been allowed or had an *ex parte Quayle* action mailed, however the petitions will be addressed on the merits. The delay in acting on this petition is regretted.

Petitioner requests that some of the documents submitted March 26, 2003, as an Information Disclosure Statement be expunged from the record. Petitioner states that the material was unintentionally submitted and either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) was previously paid.

The documents appear to be directed to presentations to investment groups and other proprietary letters. Thus the documents do not relate to the merits of patentability of the application and may be expunged. Since this application has been converted to an Image File Wrapper (IFW) application the documents are not physically returnable, but access to the documents has been closed to the public (they will remain accessible to the examiner) with an annotation that they are expunged.

The renewed petition is **GRANTED**.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, N.C. 27627

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JUN 2 0 2002

OFFICE OF PETITIONS

In re Application of
Saptharishi Sriram
Application No. 10/136,456
Filed: October 24, 2001
Attorney Docket No. 5308-195

: DECISION GRANTING PETITION

This is a decision on the petition filed May 23, 2002, requesting that an application of Saptharishi Sriram entitled "DELTA DOPED SILICON CARBIDE METAL-SEMICONDUCTOR FIELD EFFECT TRANSISTORS AND METHODS OF FABRICATING DELTA DOPED SILICON CARBIDE METAL-SEMICONDUCTOR FIELD EFFECT TRANSISTORS HAVING A GATE DISPOSED IN A DOUBLE RECESS STRUCTURE" (attorney docket No. 5308-195) be accorded a filing date of October 24, 2001.

A petition under 37 CFR 1.10(e) was first filed on March 26, 2002, but it appears the copy of the application papers submitted with the petition did not contain drawings. Accordingly, the petition under 37 CFR 1.10(e) was resubmitted on May 23, 2002.

Petitioner alleges that the original application papers were deposited in Express Mail service on October 24, 2001, in accordance with the procedures set forth in 37 CFR 1.10 and that the application is entitled to the date of deposit in Express Mail service as the filing date. In support, petitioner has supplied a copy of the original application papers showing the Express Mail label No.EL920743024US thereon. A copy of the official United States Postal Service (USPS) Track and Confirm page for Express Mail label No. EL920743024US indicates that the Express Mail package was deposited with the USPS on October 24, 2001. The petition included a statement that the copies of the correspondence supplied with the petition are true copies of the originally mailed correspondence.

The petition to accord the application a filing date of October 24, 2001 is granted. No petition fee is required and none has been charged.

Since the original application papers cannot be located in the Office, the duplicate papers received May 23, 2002, will be used to process the application. The application has been assigned application No. 10/136,456.

Applicant should notify this office if the original papers are subsequently discovered in the Office so that the present duplicate file can be merged with the original papers and any duplicate filing fee refunded.

The application is being forwarded to Initial Patent Examination Division for further processing with a filing date of October 24, 2001, using the copy of the application papers, including the five (5) sheets of drawings, supplied on May 23, 2002.

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

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 37428
Raleigh, N.C. 27627

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JAN 23 2003

OFFICE OF PETITIONS

In re Application of
Saptharishi Sriram
Application No. 10/136,456
Filed: October 24, 2001
Attorney Docket No. 5308-195

: LETTER MERGING FILES

~~In re Application of~~
~~Saptharishi Sriram~~
~~Application No. 10/165,672~~
~~Filed: October 24, 2001~~
~~Attorney Docket No. 5308-195~~

This is a response to the "Request For Refund of Filing Fee And Merger of Duplicate Application Papers" filed by facsimile on October 3, 2002, and the "Request For Assignment of the First Assigned Serial Number" filed by facsimile on November 13, 2002, requesting that application No. 10/165,672 be merged into application No. 10/136,456 and that any duplicate filing fee be refunded. Applicant also requests that a new filing receipt be issued.

On June 20, 2002, a Decision was mailed according duplicate application papers filed on May 23, 2002 with the petition a filing date of October 24, 2001. Since the original application papers could not be located, the duplicate papers were assigned application No. 10/136,456. The original application papers filed on October 24, 2001, have now been identified. The original application papers were assigned application No. 10/165,672 and accorded a filing date of October 24, 2001.

The copy of the original application papers supplied with the petition has already been used to process application No. 10/136,456 with a filing date of October 24, 2001. In addition, applicant states that the application No. 10/136,456 has been used with respect to foreign filings and a certified copy of application No. 10/136,456 was obtained and submitted to the Taiwanese Patent Office. Therefore, the papers present in the file of application No. 10/165,672 will be merged into

the file of application No. 10/136,456 and the filing fee paid in application No. 10/165,672 will be refunded.

After mailing of this decision, the fees paid in application No. 10/165,672, including the $740.00 basic filing fee, the $756.00 excess claim fees, and the $40.00 assignment recordation fee will be credited to counsel's deposit account No. 50-0220.

Thereafter, the applications will be forwarded to Initial Patent Examination Division for merging the file of application No. 10/165,672 into the file of application No. 10/136,456. Initial Patent Examination Division will also mail a new filing receipt for application No. 10/136,456 as requested by applicant. Application No. 10/165,672 will no longer be an active application number. All future correspondence concerning this application should be directed to application No. 10/136,456.

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

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : **NOVEMBER 9, 2005**

**TO SPE OF** : ART UNIT **2811**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **10136456** Patent No.: **6906350B2**

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

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

DO NOT SENT TO ATTORNEY

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

*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:** The references cited on the Certificate of Correction do not appear in any PTO Form 892, or in any information disclosure (1449) either mailed by the examiner, or filed by applicant, respectively.

LYNNE GURLEY
SUPERVISORY PATENT EXAMINER
AU 2811, TC 2800
Lynne A. Gurley
SPE

2811
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/136456

DATE : ~~11/9/05~~ 1/17/06

Paper No.: —

TO SPE OF : ART UNIT 2811

SUBJECT : Request for Certificate of Correction on Patent No.: 6906350 B2

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

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Virginia Tolbert

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9390 ext. 113***

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

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

**Comments:**

The references cited on the Certificate of Correction do not appear in any PTO Form 892, or in any information disclosure (1449) either mailed by the examiner, or filed by applicant, respectively.

LYNNE GURLEY
SUPERVISORY PATENT EXAMINER
AU 2811, TC 2800

Lynne A. Gurley — SPE

2811 — Art Unit

cofc

OIPE IAP88 OCT 28 2005 PATENT & TRADEMARK OFFICE

Attorney Docket No. 5308-195 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Sriram
Application Serial No.: 10/136,456
Filed: October 24, 2001
For: *Delta Doped Silicon Carbide Metal-Semiconductor Field Effect Transistors Having a Gate Disposed in a Double Recess Structure*

U.S. Patent No.: 6,906,350
Issued: June 14, 2005

Date: October 26, 2005

Commissioner for Patents
Attn: Certificate of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

Please do not enter. Denied. J.H. 8/30/07

**REQUEST FOR ENTRY OF CERTIFICATE OF CORRECTION UNDER 35 U.S.C §254 AND 37 C.F.R. §1.322**

Sir:

The Assignee of record for the above-referenced patent hereby requests, pursuant to 35 U.S.C §254 and 37 C.F.R. §1.322, that a Certificate of Correction be issued. This request is made in order to correct the mistakes incurred through the fault of the U.S. Patent and Trademark Office. No fee is believed due. However, the Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0220.

The mistakes appearing in the patent are set forth with corrections on the Certificate of Correction enclosed herewith, with an additional copy thereof and a return post card.

Respectfully submitted,

Elizabeth A. Stanek
Registration No. 48,568

Certificate NOV 02 2005 of Correction

Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401
Customer No. 20792

**Certificate of Mailing under 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Attn: Certificate of Correction Branch, P.O. Box 1450, Alexandria, VA 22313-1450 on October 26, 2005.

Monica L. Croom

NOV - 8 2005

PTO/SB/44 (04-04)
Approved for use through 04/30/2007. OMB 0651-0033
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)

Denied. Please do not enter. J.H. 8/30/07

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

PATENT NO. : 6,906,350

DATED : June 14, 2005



INVENTOR(S) : Sriram

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

On the Title Page:
Section 56 should include the following references:

U.S. PATENT DOCUMENTS

| | | | |
|---|---|---|---|
| 5,972,801 | 10/1999 | Lipkin et al. | 438/770 |
| 5,925,895 | 07/1999 | Sriram et al. | 257/77 |
| 5,396,085 | 03/1995 | Baliga | 257/77 |
| 4,947,218 | 08/1990 | Edmond et al. | 357/13 |
| 4,897,710 | 01/1990 | Suzuki et al. | 357/71 |
| 4,762,806 | 08/1988 | Suzuki et al. | 437/100 |
| 4,757,028 | 07/1988 | Kondoh et al. | 437/40 |
| 4,732,871 | 03/1988 | Buchmann et al. | 437/41 |

FOREIGN PATENT DOCUMENTS

| | | | |
|---|---|---|---|
| JP | 2-10772 | 01/1990 | Abstract |
| JP | 1-308876 | 12/1989 | Abstract |
| JP | 1-106477 | 04/1989 | Abstract |
| JP | 1-106476 | 04/1989 | Abstract |
| JP | 63-47983 | 02/1988 | Abstract |
| JP | 60-154674 | 08/1985 | Abstract |
| JP | 60-142568 | 07/1985 | Abstract |
| JP | 54-155482 | 10/1979 | Abstract |
| JP | 47-5124 | 03/1972 | Abstract |

OTHER PUBLICATIONS

Allen et al., U.S. Serial No. 09/587,717, filed May 10, 2000
Konstantinov et al., *Investigation of Lo-Hi-Lo and Delta-Doped Silicon Carbide Structures*, Mat. Res. Soc. Symp. Proc., Vol. 640, 2001, pp. H2.4.1-H2.4.6
Noblanc et al., *Power Density Comparison Between Microwave Power MESFET's Processed on Conductive and Semi-Insulating Wafer*, Materials Science Forum, Vols. 338-342, 2000, pp. 1247-1250
Hilton et al., *Surface Induced Instabilities in 4H-SiC Microwave MESFETs*, Materials Science Forum, Vols. 338-342, 2000, pp. 1251-1254
Nilsson et al., *Characterization of SiC MESFETs on Conducting Substrates*, Materials Science Forum, Vols. 338-342, 2000, pp. 1255-1258
Rorsman et al., *Fabrication, Characterization and Modeling of SiC MESFETs*, Materials Science Forum, Vols. 338-342, 2000, pp. 12-59-1262
Jonsson et al., *Physical Simulations on the Operations of 4H-SiC Microwave Power Transistors*, Materials Science Forum, Vols. 338-342, 2000, pp. 1263-1266
Heftman, *Wireless Semi Technology Heads Into New Territory*, Microwaves & RF, February 2000, pp. 31-38
Browne, Editorial: *The Power and the Glory*, Microwaves & RF, July 1999, p. 17
Browne, *Top Products of 1999*, Microwaves &RF, December 1999, pp. 223-233
Browne, *SiC MESFET Delivers 10-W Power at 2 GHZ*, Microwaves & RF, October 1999, pp. 138-139
*SiC MESFET Drives PCS Base Stations*, Wireless Systems Design, October 1999, pp. 24
*A 10 W 2 GHz Silicon Carbide MESFET*, Microwave Journal, September 1999, pp. 232, 240, 242
Allen, *Silicon Carbide MESFET's with 2W/mm and 50% P.A.E. at 1.8 GHz*, 1996
Palmour et al., *Ultrafast Silicon-Carbide Rectifiers*, Powertechnics Magazine, August 1989, pp. 18-21

NOV - 2 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,906,350

DATED : June 14, 2005

INVENTOR(S) : Sriram



Denied. Please do not enter. J.B. 8/30/07

Palmour et al., *Characterization of Device Parameter sin High-Temperature Metal-Oxide-Semiconductor Field Effect Transistors in β-SiC Thin Films*, J. Appl. Phys, Vol. 64, No. 4, August 15, 1988, pp. 2168-2177
Soares, ed., *GaAs MESFET Circuit Design*, Artech House, 1988, pp. 7-9, 17-18
Palmour et al., *High-Temperature Depletion-Mode Metal-Oxide-Semiconducter Field Effect Transistors in Beta-SiC Thin Films*, Appl. Phys. Lett., Vol. 51, No. 24, December 14, 1987, pp. 2028-2030
Kelner et al., *β-SiC MESFET's and Buried-Gate JFET's*, IEEE Electron Device Letters, Vol. EDL-8, No. 9, September 1987, pp. 428-430
Kong et al., *temperature Dependence of the Current-Voltage Characteristics of Metal-Semiconductor Field-Effect Transistors in n-Type β-SiC Grown Via Chemical Vapor Deposition*, Appl. Phys Lett., Vol. 51, No. 6, August 10, 1987, pp. 442-444
Sze, *Physics of Semiconductor Devices, Second Edition*, John Wiley & Sons, 1981, pp. 341-347
*First Silicon Carbide Microwave Power Products Are Introduced*, Applied Microwave & Wireless, pp. 104

MAILING ADDRESS OF SENDER:
Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

PATENT NO. 6,906,350
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 are required 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.

NOV - 2 2005

NOV - 2 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

September 11, 2007

Elizabeth A. Stanek
MYERS, BIGEL, SIBLEY & SAJOVEC, P.A.
P.O. Box 37428
Raleigh, NC 27627

Patent No: 6,906,350 B2
Application No: 10/136456
Applicant: Saptharishi Sriram
Issued: June 14, 2005
Title: **DELTA DOPED SILICON CARBIDE METAL-SEMICONDUCTOR FIELD EFFECT TRANSISTORS HAVING A GATE DISPOSED IN A DOUBLE RECESS STRUCTURE**

Request for Certificate 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 Rule 1.322.

Respecting the alleged errors in the References Cited, the patent is printed in accordance with the record, since there is no record of a 1449 or 892 with references considered by the Examiner.

In view of the foregoing, your request in this matter is **dismissed**. However, further consideration will be given to your request upon receipt of a copy of the post card receipt and 1449 or 892 with the requested references which were considered by the Examiner.

Virginia Tolbert
For Cecelia Newman, Supervisor
Decisions and Certificate of Correction
(703) 308-8309 or (703) 308-9390 ext. 113

vt

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:**

**DATE** : 11/12/09

**TO SPE OF** : ART UNIT 1638 (App # 10/136,465)

**SUBJECT** : Request for Certificate of Correction on Patent No.: PP 14,737

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**

Magdalene Talley
**Certificates of Correction Branch**

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

Note your decision on the appropriated box.

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

**Comments:**

Anne Marie Grunberg
ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER

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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PATTERSON & SHERIDAN, LLP/CISC
3040 POST OAK BLVD.
SUITE 1500
HOUSTON, TX 77056-6582

Mail Date: 06/02/2010

| | | |
|---|---|---|
| **Applicant** | : Arturo Fagundo | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7624437 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/136,480 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/01/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1056** 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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JONDLE & ASSOCIATES PC
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

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APR 0 5 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| William H. Eby et al | : |
| Application No. 10/136,481 | : DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. N1421-051 | : |

This is a decision on the petition, filed March 29, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on 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) 272-3218.

This matter is being referred to Technology Center AU 1638 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Jondle & Associates, P.C.
9085 East Mineral Circle
Suite 200
Centennial, CO 80112

**COPY MAILED**

JAN 27 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| William H. Eby, et al. | : | |
| Application No. 10/136,482 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. N1421-052 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 22, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being referred to Technology Center 1600 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

PATTON BOGGS
PO BOX 270930
LOUISVILLE CO 80027

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OCT 0 3 2002

OFFICE OF PETITIONS

In re Application of
Sneh
Application No. 10/136,490
Filed: May 1, 2002
Attorney Docket No. 20008.104US
For: INTEGRATED CAPACITOR WITH ENHANCED CAPACITANCE DENSITY AND METHOD OF FABRICATING SAME

DECISION ON PETITION

This is a decision on the petition, filed August 23, 2002 (certificate of mailing date August 16, 2002), requesting that Figure 6 be accorded a filing date of May 1, 2002.

The application was filed on May 1, 2002. On July 15, 2002, the Office of Initial Patent Examination mailed a " Notice of Omitted Items in a Nonprovisional Application" informing petitioner that Figure 6, as described in the specification, appeared to have been omitted.

In response to the Notice, petitioner timely filed the present petition. Petitioner requests a May 1, 2002 filing date for Figure 6 on the basis that the allegedly omitted figure was received in the Patent and Trademark Office (PTO) on May 1, 2002. In support, the petition is accompanied by a declaration of an attorney of record who reviewed the application and attests to the fact that figure 6 was present.

The declaration by Attorney Carl A. Forest submitted with the petition states that he each checked the assembled application papers in the Express Mail envelope to determine that the application included all intended sheets of drawings.

The Office file is the official record of what was filed on May 1, 2002. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. In this regard, declarations by individuals involved in the preparation and mailing of the original application reciting their personal recollection or belief of what was contained in the application that they reviewed and/or mailed are no more persuasive of what was actually mailed than the contents of the official record. Such declarations, as in this case, are usually made months after the actual events recited. In this case, the declaration supplied the instant petition was made more three (3) months after the application was actually mailed.

It is for this reason that the Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, which was long ago established and is well publicized, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See section 503, Manual Of Patent Examining Procedure (MPEP 503).

To reiterate, a properly itemized return postcard constitutes *prima facie* evidence that the items were filed on the date stamped thereon.

Unfortunately, the undersigned cannot locate the itemized, date-stamped postcard receipt for this application in the file, despite the fact that is was allegedly included with the petition. Petitioner is urged to submit another copy of the itemized, date-stamped postcard receipt with his petition for reconsideration of this decision.

The petition is dismissed.

The application will be retained in the Office of Petitions until petitioner submits another copy of the itemized, date-stamped postcard receipt. At this point, page 6 submitted with the instant petition will **not** be considered part of the original filing.

Any inquiries pertaining to this matter may be directed to the undersigned (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

20008.104

OIPE JC26 OCT 24 2002 PATENT & TRADEMARK OFFICE

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

RECEIVED OCT 09 2002 Patton Boggs LLP

Paper No. 5

Date Docketed: 10/9/02
Docketed by:
See: ECV
Atty: CAF

PATTON BOGGS
PO BOX 270930
LOUISVILLE CO 80027

COPY MAILED
OCT 03 2002
OFFICE OF PETITIONS

In re Application of
Sneh
Application No. 10/136,490
Filed: May 1, 2002
Attorney Docket No. 20008.104US
For: INTEGRATED CAPACITOR WITH ENHANCED CAPACITANCE DENSITY AND METHOD OF FABRICATING SAME

DECISION ON PETITION

This is a decision on the petition, filed August 23, 2002 (certificate of mailing date August 16, 2002), requesting that Figure 6 be accorded a filing date of May 1, 2002.

The application was filed on May 1, 2002. On July 15, 2002, the Office of Initial Patent Examination mailed a " Notice of Omitted Items in a Nonprovisional Application" informing petitioner that Figure 6, as described in the specification, appeared to have been omitted.

In response to the Notice, petitioner timely filed the present petition. Petitioner requests a May 1, 2002 filing date for Figure 6 on the basis that the allegedly omitted figure was received in the Patent and Trademark Office (PTO) on May 1, 2002. In support, the petition is accompanied by a declaration of an attorney of record who reviewed the application and attests to the fact that figure 6 was present.

The declaration by Attorney Carl A. Forest submitted with the petition states that he each checked the assembled application papers in the Express Mail envelope to determine that the application included all intended sheets of drawings.

The Office file is the official record of what was filed on May 1, 2002. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. In this regard, declarations by individuals involved in the preparation and mailing of the original application reciting their personal recollection or belief of what was contained in the application that they reviewed and/or mailed are no more persuasive of what was actually mailed than the contents of the official record. Such declarations, as in this case, are usually made months after the actual events recited. In this case, the declaration supplied the instant petition was made more three (3) months after the application was actually mailed.

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It is for this reason that the Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, which was long ago established and is well publicized, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See section 503, Manual Of Patent Examining Procedure (MPEP 503).

To reiterate, a properly itemized return postcard constitutes *prima facie* evidence that the items were filed on the date stamped thereon.

Unfortunately, the undersigned cannot locate the itemized, date-stamped postcard receipt for this application in the file, despite the fact that is was allegedly included with the petition. Petitioner is urged to submit another copy of the itemized, date-stamped postcard receipt with his petition for reconsideration of this decision.

The petition is dismissed.

The application will be retained in the Office of Petitions until petitioner submits another copy of the itemized, date-stamped postcard receipt. At this point, page 6 submitted with the instant petition will **not** be considered part of the original filing.

Any inquiries pertaining to this matter may be directed to the undersigned (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

OIPE JC26
OCT 2 4 2002
PATENT & TRADEMARK OFFICE

EM 5/14/02

Receipt acknowledged by USPTO on the date stamped below:

In Re: Patent application of: Sneh
Serial No.: Not Yet Assigned
Date filed: Herewith
Title: Integrated Capacitor with Enhanced Capacitance Density and method of Fabricating same

New Application Transmittal 1 page(s)
Specification 57 page(s); Abstract 1 page(s)
Claims 13 page(s); Number of Claims: 112
Drawings (52 sheets) Number of FIGS: 52 ☒ formal ☐ informal
Combined Declaration and POA 2 page(s)
☐ IDS ____ page(s) ☐ ____ cited US ref.
☐ ____ cited foreign ref.
☐ ____ cited other ref.
Recordation Form Cover Sheet 2 page(s) Assignment 1 page(s)
Payment: ☐ Check No ____ / ☒ Deposit Acct / amount of $ 1868.00
Other: Fee Transmittal - 1 page
Certificate of mailing - 1 page

Atty CAF / EVS / KJH Express Mail Label No. EV 121488547 US
Atty Docket No. 20008.104 US Date Mailed: 05/01/2002

J1046 U.S. PTO
10/136490
05/01/02

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

PTO/SB/05 (11-00)

Approved [illegible] through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

OIPE JC26 OCT 2 4 2002 PATENT & TRADEMARK OFFICE

# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 C.F.R. 1.53(b))

| | |
|---|---|
| Attorney Docket No. | 20008.104US |
| First Inventor | Ofer Sneh |
| Title | INTEGRATED CAPACITOR WITH ENHANCED CAPACITANCE DENSITY AND METHOD OF FABRICATING SAME |
| Express Mail Label No. | EV121488547US |

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

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 71 ]
   (preferred arrangement set forth below)
   - Descriptive title of the Invention
   - Cross References 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 52 ]
5. Oath or Declaration [Total Pages 2 ]
   a. ☒ Newly executed (original or copy)
   b. ☐ Copy from a prior application (37 CFR 1.63 (d))
   (for a continuation/divisional with Box 18 completed)
   i. ☐ DELETION OF INVENTOR(S)
   Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76
7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
   a. ☐ Computer Readable Form (CRF)
   b. Specification Sequence Listing on:
      i. ☐ CD-ROM or CD-R (2 copies); or
      ii. ☐ paper
   c. ☐ Statements verifying identity of above copies

### ACCOMPANYING APPLICATIONS PARTS

9. ☒ Assignment Papers (cover sheet & document(s))
10. ☐ 37 C.F.R.§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. ☐ Request and Certification 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 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.**

### 17. CORRESPONDENCE ADDRESS

☒ *Customer Number or Bar Code Label* (Insert Customer No. or Attach bar code label here) or ☐ *Correspondence address below*

| | | | | | |
|---|---|---|---|---|---|
| Name | | | | | |
| Address | | | | | |
| City | | State | | Zip Code | |
| Country | | Telephone | | Fax | |

| | | | |
|---|---|---|---|
| Name (Print/Type) | Carl A. Forest | Registration No. (Attorney/Agent) | 28,494 |
| Signature | | Date | 05-01-2002 |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

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PTO/SB/17 (10-01)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, persons are required to respond to a collection of information unless it displays a valid OMB control number.

OIPE JC26 OCT 2 4 2002 PATENT & TRADEMARK OFFICE

# FEE TRANSMITTAL for FY 2002

*Patent fees are subject to annual revision.*

☒ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** ($) 130

| *Complete if Known* | |
|---|---|
| Application Number | 10/136,490 |
| Filing Date | 01 May 2002 |
| First Named Inventor | Ofer Sneh |
| Examiner Name | Unknown |
| Group / Art Unit | 2811 |
| Attorney Docket No. | 20008.104US |

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 50-1848

Deposit Account Name: Patton Boggs LLP

**The Commissioner is authorized to:** *(check all that apply)*
☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ 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 |
|---|---|---|---|---|---|
| 101 | 740 | 201 | 370 | Utility filing fee | |
| 106 | 330 | 206 | 165 | Design filing fee | |
| 107 | 510 | 207 | 255 | Plant filing fee | |
| 108 | 740 | 208 | 370 | Reissue filing fee | |
| 114 | 160 | 214 | 80 | Provisional filling fee | |

**SUBTOTAL (1)** ($) 0

2. EXTRA CLAIM FEES

| | | | Extra Claims | | Fee from below | | Fee Paid |
|---|---|---|---|---|---|---|---|
| Total Claims | | - ** = | 0 | X | | = | 0 |
| Independent Claims | | - ** = | 0 | X | | = | 0 |
| Multiple Dependent | | | | X | | = | 0 |

| Large Entity Fee Code | Large Entity Fee ($) | Small Entity Fee Code | Small Entity Fee ($) | Fee Description |
|---|---|---|---|---|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 84 | 202 | 42 | Independent claims in excess of 3 |
| 104 | 280 | 204 | 140 | Multiple dependent claim, if not paid |
| 109 | 84 | 209 | 42 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

**SUBTOTAL (2)** ($) 0

**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 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 | 130 |
| 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)** ($) 130

**SUBMITTED BY** — Complete *(if applicable)*

| | | | | | |
|---|---|---|---|---|---|
| *Name (Print/Type)* | Carl A. Forest | *Registration No. Attorney/Agent)* | 28,494 | *Telephone* | 303-379-1114 |
| *Signature* | | | | *Date* | October 18, 2002 |

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

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/136,490 | 05/01/2002 | Ofer Sneh | 20008.104US |

24283
PATTON BOGGS
PO BOX 270930
LOUISVILLE, CO 80027

OIPE JC26
OCT 2 4 2002
PATENT & TRADEMARK OFFICE

CONFIRMATION NO. 8223
FORMALITIES LETTER
*OC000000008451209*

Date Mailed: 07/15/2002

# NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION

## FILED UNDER 37 CFR 1.53(b)

A filing date has been accorded to the above-identified nonprovisional application papers; however, the following item(s) appear to have been omitted from the application:

- Figure(s) **Fig. 6** described in the specification.

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and $130.00 petition fee *(37 CFR 1.17(h))*) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the $130.00 petition fee *(37 CFR 1.17(h))* requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b)**. In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (*i.e.*, the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabelled drawing figures, is required. Any drawing changes should be accompanied by a copy of the drawing figures showing the proposed changes in red ink. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

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***A copy of this notice MUST be returned with the reply.***

Haimanot Tegbaru

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

OIPE JC26
OCT 24 2002
PATENT & TRADEMARK OFFICE

#7 B

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 10/136,490

Filed: May 1, 2002

For: Integrated Capacitor With Enhanced Capacitance Density And Method Of Fabricating Same

Applicants (Inventors): Ofer Sneh

Group Art Unit: 2811

Examiner: Unknown

Docket No: 20008.104US

**Certificate of Mailing Under 37 CFR 1.8**

I hereby certify that this correspondence, along with all papers referred to as being enclosed or attached, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Office Of Petitions, Assistant Commissioner for Patents, Washington, DC 20231.

October 18, 2002
Date

Elaine C. VonSpreckelsen
Elaine C. VonSpreckelsen

OFFICE OF PETITIONS
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON DC 20231

~~Match & Return~~

Sir:

This is responsive to the Decision On Petition mailed October 3, 2002 and a Response To Notice Of Omitted Item(s) In A Nonprovisional Application With Petition Under Rule 1.53(e)(2) mailed July 15, 2002. A Declaration Of Carl A. Forest is enclosed.

## RESPONSE TO DECISION ON PETITION

Applicant hereby requests a reconsideration of the petition filed August 23, 2002 under Rule 1.53(e)(2) to enter the disputed FIG. 6 and grant a filing date of May 1, 2002 for the entire application including FIG. 6 and the Petition mailed October 3, 2002.

On October 9, 2002, applicant's attorneys received a Decision On Petition (hereinafter "the Decision"), a copy of which is enclosed. The Decision states that a copy of the itemized, date-stamped postcard receipt had been omitted from the original petition. Our records indicate that the Senior Petitions Attorney (E. Shirene Willis) was indeed correct in that the return postcard was not enclosed with the original petition, and the undersigned attorney apologizes for this error.

10/25/2002 ROSMAN1 00000019 501848 10136490
01 FC:1460 130.00 CH
Adjustment date: 06/12/2003 CKHLOK
08/23/2002 SDENBOB1 00000102 501848 10136490
01 FC:122 130.00 CR
RECEIVED
MAY 16 2003
OFFICE OF PETITIONS

Applicant hereby submits a copy of the return postcard stamped by the USPTO with the application number and the date of filing.

On July 23, 2002 applicant's attorneys received a Notice Of Omitted Item(s) In A Nonprovisional Application (hereinafter "the Notice"), a copy of which is enclosed. The Notice states that FIG. 6 described in the application had been omitted from the application.

Applicant contends that the alleged omitted item was in fact deposited in the United States Patent And Trademark Office (USPTO) with the nonprovisional application papers.

Applicant submits the following evidence of such deposit: 1) as mentioned above, a copy of the return postcard stamped by the USPTO with the application number and the date of filing; 2) a copy of the Utility Patent Application Transmittal sheet filed with the application; and 3) a Declaration of Carl A. Forest (hereinafter "the Declaration").

The postcard indicates that 52 sheets of drawings were enclosed with the application. It is the duty of the USPTO person who receives the mail and stamps the postcard to check that all materials noted on the postcard have been received. It is presumed that this person did their duty, and that, in fact, 52 sheets of drawing, including the alleged missing FIG. 6, were enclosed.

The Utility Patent Application Transmittal sheet that was signed by Carl A. Forest indicated that he was the attorney responsible for the correct, complete, and accurate filing of the application.

The Declaration Of Carl A. Forest originally submitted August 23, 2002 shows that Patton Boggs, and Mr. Forest in particular, has an elaborate procedure in place to ensure that every application filed is complete, and that this procedure was actually performed for the application. Since this procedure was instituted, except for the present Notice, the USPTO has never even alleged that an application filed by Mr. Forest was incomplete.

The fact that our records agree with Attorney Willis in that they show that the postcard was not enclosed with the first petition, further underlines the accuracy of our records and supports the reasoning that FIG. 6 was enclosed with the original application.

Based on the above facts, and the submittal of the postcard, it is submitted that it is

highly unlikely that the alleged omitted item was actually omitted, and entry of FIG. 6 with a filing date of May 1, 2002 is respectfully requested. In any case, applicant requests that the original filing date of May 1, 2002 be retained.

A $130.00 petition fee (37 CFR 1.17(h)) is enclosed. It is understood that the petition fee will be refunded if it is determined that the item in question, FIG. 6, was received by the US Patent Office. If any additional fee is required, the Commissioner is authorized to charge Deposit Account No. 50-1848.

Respectfully submitted,
**PATTON BOGGS LLP**

By: _____

Carl A. Forest, Reg. No. 28,494
Telephone: 303-379-1114
Facsimile: 303-379-1155
**Customer No.: 24283**

**UNITED STATES PATENT & TRADEMARK OFFICE**
**Washington, D.C. 20231**

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 6/10/03

2 Serial/Patent # 10/136,490

| | 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 | 3 + 7 | 8/23/02 + 10/24/02 | $ 130x2=260 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $ 260

8 TO BE REFUNDED BY:

| | |
|---|---|
| | Treasury Check |
| X | Credit Deposit A/C #: |

9 50-- 1848

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Postcard proves allegedly omitted drug was present on initial filing. Petitioner paid (2) pet fees. Refund both

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Eshrene Willis TITLE: Pet Atty

SIGNATURE: Eshrene Willis PHONE: 308-6712

OFFICE: Office of Petitions

**********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: [illegible] DATE: 6/12/03

*Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:*

**Office of Finance**
**Refund Branch**
**Crystal Park One, Room 802B**

FORM PTO 1577
(01/90)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

PATTON BOGGS
PO BOX 270930
LOUISVILLE CO 80027

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JUN 1 2 2003

OFFICE OF PETITIONS

In re Application of
Sneh
Application No. 10/136,490
Filed: May 1, 2002
Attorney Docket No. 20008.104US
For: INTEGRATED CAPACITOR WITH ENHANCED CAPACITANCE DENSITY AND METHOD OF FABRICATING SAME

DECISION ON PETITION

This is a decision on the reconsideration petition, filed October 24, 2002 (certificate of mailing date October 18, 2002), requesting that Figure 6 be accorded a filing date of May 1, 2002. The reconsideration petition was only recently forwarded to the Office of Petitions. The undersigned apologizes for the delay in addressing the petition and regrets any inconvenience occasioned by the delay.

The application was filed on May 1, 2002. On July 15, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Items in a Nonprovisional Application" informing petitioner that Figure 6, as described in the specification, appeared to have been omitted. Applicant's petition under 37 CFR 1.53(e), filed August 23, 2002 (certificate of mailing date August 16, 2002), was dismissed on October 3, 2002 for failure to submit persuasive evidence that Figure 6 was filed on May 1, 2002.

Petitioner requests that Figure 6 be accorded a filing date of May 1, 2002 on the basis that 52 sheets of drawing figures, including Figure 6, were received in the Patent and Trademark Office (PTO) on May 1, 2002. In support, the instant reconsideration petition is accompanied by a copy of applicant's itemized postcard receipt showing an Office of Initial Patent Examination generated barcode citing May 1, 2002 as the date of receipt. The postcard lists, *inter alia*, that the filing included 52 sheets of drawings.

The return postcard constitutes *prima facie* evidence that 52 sheets of drawing figures were filed on May 1, 2002. MPEP 503. A review of the application file reveals that there are 51 sheets of drawing figures present. The missing sheet of drawings corresponds to that which would have contained a Figure 6.

Accordingly, the petition under 37 CFR 1.53(e) is **GRANTED**.

A review of financial records indicates that petitioner has paid two $130.00 petition fees. Pursuant to petitioner's authorization, both will be refunded to deposit account no. 50-1848.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of **May 1, 2002**, using the copy of Figure 6 submitted with the instant petition. Office records will be corrected to show that 52 sheets of drawings were present on filing.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

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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Paper No. None

PAULA D. MORRIS & ASSOCIATES, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON TX 77042

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APR 13 2004

OFFICE OF PETITIONS

In re Application of
Billy G. Chesser et al.
Application No. 10/136,522
Filed: May 1, 2002
Attorney Docket No. 154-10722-CIP
Title: DRILLING FLUID SYSTEMS WITH IMPROVED FLUID LOSS PROPERTIES

DECISION ON PETITION

This is a decision on the petition filed on March 26, 2004, under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed June 6, 2002, which set a shortened statutory period for reply of two (2) months. The notice set forth that an executed oath or declaration and the surcharge associated with the late submission of the same were required. No response was received, but for a one-month extension of time under the provisions of 37 C.F.R. §1.136(a). Accordingly, the above-identified application became abandoned on September 7, 2002.

With the instant petition, Petitioner has submitted two postcard receipts, which establish that on August 6, 2002, a one-month extension of time was received[1], and that on August 22, 2002, a declaration was received in response to the notice.

As such, the evidence is convincing that the Petitioner timely responded to the notice, and the declaration was subsequently misplaced by the Office.

As such, the petition is **GRANTED**. The holding of abandonment of the above-identified application is hereby **WITHDRAWN**.

Unfortunately, Petitioner has not included a copy of the declaration with her petition. As such, after the mailing of this decision, the application will be forwarded to the Office of Initial Patent Examination for re-mailing of the notice of June 6, 2002, and for re-starting of the time period for response.

1 A copy of this request for a one-month extension of time has been located in the electronic file.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0011.

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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NOV 18 2008

**AT & T CORP.**
**ROOM 2A207**
**ONE AT&T WAY**
**BEDMINSTER NJ 07921**

| | | |
|---|---|---|
| In re Application of | : | |
| Chen et al | : | |
| Application No. 10/136,540 | : | ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 2001-0442 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 27, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the nonfinal rejection mailed November 14, 2007.

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

**While a statement of entire delay was provided, the statement is signed for application number 11/585,639, docket no. 2006-0048. Note page two(2) of petition.**

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

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

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

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

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

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**AT&T CORP.**
**ROOM 2A207**
**ONE AT&T WAY**
**BEDMINSTER NJ 07921**

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FEB 24 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yih-Farn Robin Chen et al | : | |
| Application No. 10/136,540 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 2001-0442 | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed January 21, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed November 14, 2007, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2619 for appropriate action by the Examiner in the normal course of business on the amendment received August 27, 2008.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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TRASK BRITT
P. O. BOX 2550
SALT LAKE CITY, UT 84110

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MAY 17 2007

OFFICE OF PETITIONS

In re Application of :
Charles H. Dennison et al :
Application No. 10/136,544 : DECISION GRANTING PETITION
Filed: May 1, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 5081.2US (91-0463.7) :

This is a decision on the petition, filed May 16, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on April 24, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This matter is being referred to Technology Center AU 2812 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.*

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**GENENTECH, INC.**
**1 NDA WAY**
**SOUTH SAN FRANCISCO, CA 94080**

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JUN 22 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Patricia A. Valdez et al | : | |
| Application No. 10/136,574 | : | ON PETITION |
| Filed: April 29, 2002 | : | |
| Attorney Docket No. P2896-1 | : | |

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 September 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 December 11, 2004.

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

This matter is being referred to Technology Center AU 1646.

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

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Ginger R. DREGER
HELLER EHRMAN LLP
275 Middlefield Road
Menlo Park, California 94025

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AUG 17 2007

**OFFICE OF PETITIONS**

In re Application of:
VALDEZ, Patricia, A., et al.
Application No.: 10/136,574
Filing Date: April 29, 2002
Attorney's Docket No.: P2896-1
For: COMPOSITIONS AND METHODS FOR THE TREATMENT OF IMMUNE RELATED DISEASE

DECISION ON PETITION
(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 August 03, 2007.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper reply in a timely manner to the non-final Office action mailed April 13, 2006, which set a shortened statutory period for reply of three (3) months. A response was not filed and no extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned at midnight on July 13, 2006.

The present petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the reply in the form of a response to the Office action mailed April 13, 2006; (2) the petition fee; and (3) the required statement of unintentional delay. Accordingly, the reply to the Office action of April 13, 2006 is accepted as having been unintentionally delayed.

It is noted that the person signing the statement of unintentional delay was appointed as an attorney of record after the abandonment of the present application. It is therefore 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, petition must notify the Office.

The application file is being referred to Technology Center AU 1647

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

Richard M. Ross
Attorney Advisor

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ALCATEL LUCENT
INTELLECTUAL PROPERTY & STANDARDS
3400 W. PLANO PARKWAY, MS LEGL2
PLANO TX 75075

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JUL 27 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Stefan Keller-Tuberg | : | DECISION ON PETITION |
| Application Number: 10/136581 | : | |
| Filing Date: 04/30/2002 | : | |
| Attorney Docket Number: ALCATEL | : | |
| 135915 | : | |

This is a decision on the petition, filed on 4 June, 2007, under 37 CFR 1.137(f) which is treated as a petition to revive the above-identified nonprovisional application under the unintentional provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

Petitioner states that the present nonprovisional application is the subject of a foreign or international application filed on 28 March, 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 present 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)(i) has been rescinded.

A Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing, which sets forth the projected publication date of 1 November, 2007, is enclosed herewith.

The application is being referred to the Office of Patent Publications for further processing.

Any inquiries concerning this decision may be directed to the undersigned at 571.272.3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|---|
| 10/136,581 | 04/30/2002 | Stefan Keller-Tuberg | ALCATEL 135915 |

**CONFIRMATION NO. 8125**

24587
ALCATEL LUCENT
INTELLECTUAL PROPERTY & STANDARDS
3400 W. PLANO PARKWAY, MS LEGL2
PLANO, TX 75075

Date Mailed: 07/27/2007

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 11/01/2007.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|---|
| 10/136,581 | 04/30/2002 | Stefan Keller-Tuberg | ALCATEL 135915 |

**CONFIRMATION NO. 8125**

24587
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INTELLECTUAL PROPERTY & STANDARDS
3400 W. PLANO PARKWAY, MS LEGL2
PLANO, TX 75075

Date Mailed: 07/27/2007

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 11/01/2007.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

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NOV 3 2005

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Alexandria, VA 22313-1450

#9

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

In re Application of
Grayson Stowell et al
Serial No.: 10/136,582
Filed : May 1, 2002
Attorney Docket No.: 5573-142CT2

WITHDRAWAL OF ABANDONMENT

This is in response to the petition under 37 CFR 1.181, filed May 17, 2004, requesting withdrawal of abandonment of the above-identified application based on timely filing of a response. The delay in acting on this petition is regretted.

A review of the file history shows that the examiner mailed an Office action to applicants on August 29, 2003, setting a three month shortened statutory period for reply. The application was held abandoned by Notice of Abandonment mailed May 5, 2004, due to non receipt of a response to the Office action. Applicants assert that they replied to the Office action on November 19, 2003, and provide an Office date stamped return postcard dated November 21, 2003, and a copy of the response and a terminal disclaimer. In view thereof, the Notice of Abandonment was mailed in error and is withdrawn and the application is restored to pending status with the mailing of this decision.

The petition is **GRANTED.**

**The application will be forwarded to the examiner for further action.**

Should there be any questions regarding this decision, please contact William R. Dixon, Jr. by mail 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 571-273-8300.

George C. Elliott
Director, Technology Center 1600

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

Paper No. 8

MCDONNELL BOEHNEN HULBERT &
BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

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APR 2 8 2003

OFFICE OF PETITIONS

In re Application of :
Rubbert et al. :
Application No. 10/136,607 :
Filed: May 1, 2002 :
Attorney Docket No. 01-100-A :

DECISION ON PETITION

This is a decision on the Petition under 37 CFR 1.182, filed September 20, 2002, to change the order of the names of the inventors. The delay in treating this petition is regretted.

The Petition is **granted**.

The order of the names of the inventors will be changed as follows:

1. Rudger Ruppert
2. Hans Imgrung
3. Peer Sporbert
4. Stephan Maetzal
5. Thomas Weise

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

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

ORAMETRIX, INC.
2350 CAMPBELL CREEK BLVD, SUITE 400
RICHARDSON TX 75082

In re Application of Rubbert et al. :
Application No. 10/136,607 :
Filing Date: May 1, 2002 :
Attorney Docket No. 01-100-A :

Decision on Petition

This is a decision on the petition under 37 CFR 1.181, filed February 1, 2006, to withdraw the holding of abandonment.

The petition is **granted.**

A request to change the address of record to the address associated with customer number 38600 was properly filed.

Due to a typographical error, the address of record was changed to the address associated with customer number 03860.

As a result of the incorrect address, petitioner failed to receive the Office action mailed March 23, 2005, or the Notice of Abandonment mailed January 24, 2006.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Technology Center Art Unit 2623 will be informed of the instant decision so that the examiner may mail a new copy of the Office action setting a new time period for reply.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**WILLIAM W. JONES**
**6 JUNIPER LANE**
**MADISON, CT 06443**

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FEB 1 2 2004

OFFICE OF PETITIONS

In re Application of
Leamy, John T.
Application No. 10/136,631
Filed: May 2, 2002
Attorney Docket No. H-1355

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 2, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed June 6, 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 August 7, 2002. A Notice of Abandonment was mailed on January 26, 2004.

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

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

Paul McGill
808 Kendall
Nashville, TN 37209

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MAY 14 2004
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Paul McGill | : | |
| Application No. 10/136,634 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. N/A | : | |

This is a decision on the petition under 37 CFR 1.137(a), filed April 30, 2004, to revive the above-identified application.

The petition is **DISMISSED.**

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

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;[1] (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

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

A nonfinal Office action was mailed to applicant on May 8, 2003, setting a three-month shortened statutory period within which to submit a reply. Applicant submitted an amendment and an extension of time request on September 16, 2003. Thereafter, a Notice of Non-Compliant Amendment (hereinafter "Notice") was mailed to applicant on September 29, 2003. The Notice set forth a one (1) month time period to submit a reply. Since no reply was received and no further extensions of time were obtained in response to the Notice, the application became abandoned on October 30, 2003.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Petitioner alleges that the Notice was never received. However, petitioner has not provided any evidence to support such an allegation. MPEP 711.03(c) in pertinent part states:

> "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."

In other words, in order to establish that the Notice was not received, petitioner must provide evidence to that effect. 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 applicant at the address of record.

Petitioner is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $665 petition fee. A blank unintentional petition form is attached herewith for petitioner's use.

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).

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this filed usually acts as a liability in affording the maximum protection for the invention disclosed. It is suggested that applicant secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. Nevertheless, the Office cannot aid in selecting an attorney or agent.

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

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

**Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the Customer Window located at:**

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

Marianne E. Morgan

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

Attachment: Blank Unintentional Petition Form under 37 CFR 1.137(b)

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Paper No. 10

Paul McGill
808 Kendall
Nashville, TN 37209

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AUG 0 6 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Paul McGill | : | |
| Application No. 10/136,634 | : | DECISION DISMISSING |
| Filed: May 2, 2002 | : | PETITION |
| Attorney Docket No. N/A | : | |

This is a decision on the petition filed September 16, 2003, requesting that the above-identified application be accorded a filing date of April 26, 2002, rather than the presently accorded date of May 2, 2002.

The petition is **DISMISSED**.

Petitioner requests the earlier filing date on the basis that the application was purportedly deposited in First Class Mail on April 26, 2002, pursuant to the requirements of 37 CFR 1.8.

The procedure set forth in 37 CFR 1.8 cannot be used to file a patent application and have that application receive a filing date as of the date of deposit as first class mail. 37 CFR 1.8(a)(2) in pertinent part states:

> "...no benefit will be given to a Certificate of Mailing or Transmission on the following:
>
> ...(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining a filing date..."

In view thereof, this application cannot be accorded the filing date requested and the current filing date of May 2, 2002, will be preserved.

The application file will be retained in the Office of Petitions to await a reply to the decision on petition under 37 CFR 1.137 mailed April 30, 2004.

Telephone inquiries concerning this matter may be directed to Marianne Jenkins at (703) 306-3475.

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paul McGill
808 Kendall
Nashville, TN 37209

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Paul McGill | : | |
| Application No. 10/136,634 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. N/A | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed May 16, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply to a non-final Office action.

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.

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

The application file is being referred to Technology Center 2800.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions

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Paper No. 11

**THOMAS C. PONTANI**
**COHEN PONTANI LIEBERMAN & PAVANE**
**551 FIFTH AVENUE, SUITE 1210**
**NEW YORK, NY 10176**

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JUN 1 5 2004
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| | | |
|---|---|---|
| In re Application of | : | |
| Ronald B. Morford | : | |
| Application No. 10/136,672 | : | ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 4452-637 : | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed June 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 June 10, 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 September 11, 2003.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 3681.

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 10-02

Paper No. 5

ERIK B. CHERDAK, ESQ.
C/O STEPTOE & JOHNSON, LLP
1330 CONNECTICUT AVE., N.W.
WASHINGTON DC 20036

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OCT 16 2002

OFFICE OF PETITIONS

In re Application of :
Joseph A. Grundfest :
Application No. 10/136,689 : ON PETITION
Filed: 1 May, 2002 :
Atty's Docket No. 064.0002 :

This is a decision on the petition filed under 37 CFR 1.53(e) on 22 July, 2002, filed in response to the Notice of Omitted Item(s) in a Nonprovisional Application mailed on 21 May, 2002.

The petition is **dismissed**.

The application was filed on 1 May, 2002. However, on 21 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 1 May, 2002, and advising applicant that Figures 9E described in the specification appeared to have been omitted.

The mailing of a "Notice of Omitted Items" 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, petitioners neither assert that the missing figures

were deposited on 1 May, 2002, nor request the 22 July, 2002 (the date the missing page was supplied) filing date. Rather, petitioners have simply supplied a copy of the missing Figure.

Accordingly, the petition is inappropriate and is subject to dismissal. As the petition was not due to an error on the part of the USPTO, the petition fee will not be refunded.

Petitioners should either provide evidence that Figure 9E was filed on 1 May, 2002 (*i.e.*, with an itemized postcard receipt in accordance with MPEP 503) or state on renewed petition that petitioners desire to accept the application, including Figure 9E, with a filing date of 22 July, 2002. Alternatively, petitioners may submit Figure 9E as a preliminary amendment. If Figure 9E is submitted as a preliminary amendment, it will be reviewed by the examiner for new matter.[1]

The application will be processed and examined using only the application papers filed on 1 May, 2002. The one (1) sheet of drawings containing Figure 9E filed on 22 July, 2002, will not be used for processing, but will be retained in the application file.

In view of the above, the "Notice" was properly mailed and will not be withdrawn. The present petition was not necessitated by any error on the part of the Office and the $130.00 petition was required upon filing of the petition. Thus, the $130.00 petition fee will not be refunded.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of 1 May, 2002, using the application papers filed on that date.

Telephone inquiries concerning this matter may 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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[1] 37 CFR 1.121(b).

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Paper No. 5

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SEP 12 2002

OFFICE OF PETITIONS

Erik B. Cherdak
c/o Steptoe & Johnson, LLP
1330 Connecticut Ave., N.W.
Washington DC 20036

In re Application of
Grundfest
Application No. 10/136,690
Filed: May 1, 2002
Attorney Docket No.: 064.0004
FOR: SYSTEM AND METHOD FOR FACILITATING MANAGEMENT OF A MATTER ONLINE WITHIN AN ACCESS CONTROLLED ENVIRONMENT

: DECISION ON PETITION
&
: NOTICE TO FILE MISSING PARTS

This is a decision on the petition under 37 CFR 1.182, filed August 9, 2002, requesting that the above-identified application be accorded a filing date as of the date of submission of omitted Figures 11A -D.

The petition under 37 CFR 1.182 is **GRANTED**.

The application was filed on May 1, 2002. On June 10, 2002, the Office of Initial Patent Examination mailed a Notice of Omitted Items in a Nonprovisional Application (Notice) informing petitioner that Figures 11A-D appeared to have been omitted and a signed oath was required.

In response to the Notice, a petition under 37 CFR 1.182, including 4 sheets of drawings containing Figures 11A-D, a declaration, and petition fee were filed on August 9, 2002. Petitioner requests that the above-identified application be accorded a filing date as of the date of deposit of the items noted as omitted in the Notice mailed June 10, 2002.

Regarding the declaration, submitted August 9, 2002, there no way to ascertain whether or not the inventor reviewed the later filed drawing figures because the declaration only references application serial No. 10/136,690, filed May 1, 2002. Petitioner must submit another signed declaration that references the omitted items within 2 MONTHS of the mail date of this decision. A $130.00 surcharge must accompany this late filed declaration.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 9, 2002, using the 4 sheets of drawings containing Figures 11A-D, filed on August 9, 2002.

A courtesy copy of this decision is being mailed to the address noted on the petition.

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

cc: ERIK B. CHERDAK
11300 ROCKVILLE PIKE, SUITE 906
ROCKVILLE, MD 20852

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : **AUGUST 15, 2007**

**TO SPE OF** : ART UNIT **2178**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **10/136,698** Patent No.: **7237192**

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

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

**DO NOT SENT TO ATTORNEY**

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

_____

_____

_____

_____

**SPE** — 2178 **Art Unit**

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JUN 19 2009

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Lawrence A. Aaronson, P.C.
12850 Higway 9
Suite 600-PMB 338
Alogaretta GA 30004

In re Patent No. 7,424,715 :
Issued: September 9, 2008 :
Application No. 10/136,705 : PATENT TERM ADJUSTMENT
Filed: April 30, 2002 :
Dkt. No.: 20284-013001 :

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT," filed November 10, 2008. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment (PTA) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,424,715 on September 9, 2008. The patent issued with a PTA 241 days. The request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d). Patentees request that the adjustment be increased from 241 days to 529 days.

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' calculation of adjustment asserts that the following adjustments do not overlap: a three year delay by the Office, pursuant to 37 CFR 1.703(b), of 288 days and the period of adjustment due to examination delay, pursuant to 37 CFR 1.702(a)(1), of 620 days. The 288-day period is calculated based on the application having been filed under 35 U.S.C. 111(a) on April 30, 2002, and the patent having been issued on September 9, 2008. Patentees assert that in addition to this 288-day period, they are entitled to a period of adjustment due to examination delay pursuant to 37 CFR 1.702(a)(1) of 620 days.

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 patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay. Patentees do not dispute the period of reduction of 379 days for applicant delay.

Patentees do not dispute that the total period of Office delay is the sum of the period of three years delay and the period of examination delay, to the extent that these periods of delay are not overlapping. However, in effect, patentees contend that no portion of the three year delay period overlaps with the period of examination delay. Accordingly, patentees submit that the total period of adjustment for Office delay is 908 days (deemed by applicants to be the sum of the period of three year delay (288 days) and the period of examination delay (620 days), reduced by zero days of overlap). As such, patentees assert entitlement to a patent term adjustment of 529 days (288 days *plus* 620 days *less* zero days of overlap *less* 379 days of applicant delay).

The Office agrees that as of the time that the first request for continued examination was filed on February 13, 2006, the application was pending three years and 289 days after its filing date. The three years delay commences the day after the date that is three years after the date that an application is filed, and ends the date that the patent issues, notwithstanding any periods of time excluded pursuant to U.S.C. 154(b)(1)(B)(i)-(iii). The Office agrees that certain action was not taken within a specified time frame, and, thus, the entry of a period of adjustment of 620 days is correct. At issue is whether patentees should accrue an additional 289 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 620 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 289 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, 35 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].

[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.

As such, the period for over three-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.

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 during which the application was pending before the Office, April 30, 2002, to the date the patent issued on September 9, 2008. Prior to the issuance of the patent, 620 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. All of the 289 days for Office delay in issuing the patent overlap with the 620 days of Office delay. During that time, the issuance of the patent was delayed by 620 days. The Office did not delay 620 days and then delay an additional 289 days. Accordingly, as the 289 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 620 days attributable to grounds specified in § 1.702(a)(1), entry of both periods is not warranted.

In view thereof, no adjustment to the patent term will be made.

The Office acknowledges submission of the required application fee of $200.00. See, 37 CFR 1.18(e). No additional fees are required.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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| | | |
|---|---|---|
| In re Application of | : | |
| Borst et al. | : | |
| Application No. 10/136,713 | : | ON PETITION |
| Filed: 30 April, 2002 | : | |
| Atty Dckt No. P-3875.12 | : | |

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 4 May, 2005, to revive the above-identified application.

The petition is **GRANTED**.

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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)).

This application became abandoned on 20 February, 2005, for failure to file a proper reply to the final Office action mailed on 19 October, 2004, which set a three (3) month shortened statutory period for reply. On 13 December, 2004, petitioners submitted an amendment after final rejection. The amendment was determined by the examiner not to place the application in *prima facie* condition for allowance, and an Advisory Action was mailed on 12 January, 2005, providing a one (1) month extension of the period for reply. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petitioners have filed a Request for Continued Examination (RCE) and have indicated that the previously filed amendment is the submission required under 37 CFR 1.114.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $1,020.00 extension of time fee submitted on 4 May, 2005 (certificate of mailing date 2 May, 2005), was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will been credited to counsel's deposit account, No. 13-2546.

The application is being referred to Technology Center Art Unit 3736 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**PERKINS COIE LLP**
**P.O. BOX 2168**
**MENLO PARK CA 94026**

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MAR 0 3 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Hadfield et al. | : | |
| Application No. 10/136,733 | : | ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 60072-8002.US01 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 27, 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 Election; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 2100 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Chase
Petitions Examiner
Office of Petitions

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Ballard Spahr Andrews & Ingersoll, LLP
SUITE 1000
999 PEACHTREE STREET
ATLANTA GA 30309-3915

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| | | |
|---|---|---|
| In re Application of | : | |
| Shou LIN | : | |
| Application No. 10/136,734 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 13027.0001U2 | : | |

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

The petition is **GRANTED**.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of April 21, 2008. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is July 22, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $810; 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.

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 Karin Reichle at (571) 272-6051.

This application is being referred to Technology Center AU 1632 for appropriate action by the Examiner in the normal course of business on the reply received.

David Bucci
Petitions Examiner
Office of Petitions

Cc: Robert A. Hodges
ARNALL GOLDEN GREGORY LLP
171 17TH STREET NW
SUITE 2100
ATLANTA, GA 30363

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Paper No. 7

**HEWLETT-PACKARD COMPANY**
**INTELLECTUAL PROPERTY ADMINISTRATION**
**P.O. BOX 272400**
**FORT COLLINS, CO 80527-2400**

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MAY 25 2004

OFFICE OF PETITIONS

In re Application of :
Darin D. Lindig et al :
Application No. 10/136,766 : ON PETITION
Filed: April 30, 2002 :
Attorney Docket No. 10018121-1 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 11, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 12, 2003, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 13, 2003.

Pursuant to petitioner's authorization, Deposit Account No. 08-2025 was charged $1,330.00 for the petition to revive an unintentionally abandoned application.

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

The application file is being forwarded to Technoloyg Center AU 2856.

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

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caj

Mailed: 5-30-06

In re application of :
Jeffrey Rock : DECISION ON
Serial No. 10/136,781 : PETITION
Filed: April 30, 2002 :
For: COMPACT FUEL CELL STACK STRUCTURE

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed February 2, 2006.

On November 2, 2005, a final office action was mailed to Applicants, rejecting all of the pending claims under 35 USC 102 or 35 USC 103 and 35 USC 112 1st paragraph. Applicants responded to this office action with an amendment after final which was filed on February 2, 2006. The examiner refused entry of the amendment in an advisory action mailed February 15, 2006.

On April 3, 2006, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment of February 2, 2006.

Petitioner's position is that the amendment after final did not raise any new issues as alleged by the examiner in the advisory action and that the amendment further reduces the issues for appeal.

## DECISION

Section 714.13 of the MPEP states:

**ENTRY NOT A MATTER OF RIGHT**

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection. An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions. See also MPEP § 1206 and § 1211.

**ACTION BY EXAMINER**
See also MPEP § 706.07(f).
In the event that a proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for nonentry should be concisely expressed. For example:
(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
(B) The claims, if amended as proposed, would raise the issue of new matter.
(C) The claims as amended present new issues requiring further consideration or search.
(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. Ex parte Wirt, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Section 714.20 of the MPEP states :

**List of Amendments Entered in Part**
To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. At times, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for reply. Thus:
(A) An "amendment" presenting an unacceptable substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry in toto. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been entered. See 37 CFR 1.125 and MPEP § 608.01(q) for information regarding the submission of a substitute specification. Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A proper substitute specification will normally be accepted by the Office even if it has not been required by the examiner. However, entry of a substitute specification filed after the notice of allowance has been mailed (37 CFR 1.312) is not a matter of right.
(B) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See MPEP § 714.16(e).
(C) In an application in which prosecution on the merits is closed, i.e., after the issuance of an Ex Parte Quayle action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the

amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution.
(D) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted.

In the final rejection mailed November 2, 2005, all of the claims were rejected under 35 USC 112 1st paragraph for failing to comply with the written description requirement. Specifically, the examiner's position was that the specification provided no support for the limitation "non-discrete adjustability of an overlap" recited in claim 10 and that the specification failed to enable the specific arrangement required by claim 32. In the after final amendment, Applicants attempted to amend independent claims 10 and 32. The examiner stated in the advisory action that such an amendment would raise a new issue that would require a further search and/or consideration.

Petitioner argues that the proposed amendment to the claim 10 merely makes explicit that which was implicit in claim 10 as previously presented. It is urged by petitioner that the amendment to claim 10 puts the application in better condition for appeal.

These arguments are not persuasive. Petitioner has not addressed the after final amendment in its entirety. While the proposed amendment to claim 10 may only clarify that the overlap between the physical components could not occur over an infinite distance, the proposed amendment to claim 32 adds an additional requirement and raises new issues which would require further consideration and/or search, as noted by the examiner. After final amendments may not be entered in part; therefore, petitioner's request for the entry of claim 10 alone is improper.

Accordingly, the petition for entry of the after final amendment is **DENIED.**

Jacqueline M. Stone

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

HARNESS, DICKEY 7 PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MICHIGAN 48303

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Dong-Jing Fu et al :
Application No. 10/136,829 :
Filed: April 30, 2002 :
Attorney Docket No. 25491-2402D :

This is a decision on the petition, filed October 31, 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 18, 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 1637 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).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : August 21, 2006

TO SPE OF : ART UNIT 1637

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/136829 Patent No.: 6,991,903

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

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

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

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

SPE

1637

Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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FEB 2 8 2006

Technology Center 2100

In re Application of: William Johnson
Application No. 10/136,853
Filed: April 30, 2002
For: HOPSCOTCH TICKETING

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed January 17, 2006.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal is the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 10.40(a) further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

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

for

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: SIMON P. SIMPSON, VICE PRESIDENT
QUANTUM DIGITAL SOLUTIONS, INC.
12100 WILSHIRE BLVD.
LOS ANGELES, CA 90025

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SAN FRANCISCO, CA 94111-4187

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Joseph C. Ramaekers | : | |
| Application No. 10/136,854 | : | ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. A-70303-1/RFT/SPL | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed February 14, 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 June 28, 2004, which set a shortened statutory period for reply of three (3) months. Two months extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 29, 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 $295 extension of time submitted with the petition on February 14, 2005 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 February 14, 2005.

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

This is being forwarded to Technology Center AU 1651 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/136,868 | 04/30/2002 | Clifford R. Eisler | 4774/2 |

CONFIRMATION NO.
8920

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP
900 THIRD AVENUE
NEW YORK NY 10022

## Decision Dismissing Petition under 37 CFR 1.138(c)

*The declaration of express abandonment will not be recognized*

This is in response to the petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the above-identified application, for which a faxed copy of the original petition was received on December 22, 2003.
The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition under 37 CFR 1.138(c) was not received in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process.

2. ■ The Application was published on October 30, 2003, in compliance with 35 U.S.C. 122(b), the publication number is US20030204462A1, and it is available on the USPTO web site at http://www.uspto.gov/patft/index.html.

The application **has been published** as scheduled.

Telephone inquiries should be directed to the Office of Patent Publication, the Pre-Grant Publication Division, at 703-605-4282.

Barbara J. Debnam
Office of Patent Publication
Pre-Grant Publication Division

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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In re Patent No. 7028264
Issue Date: April 11,2006
Application No. 10136873
Filed: April 30,2002
Attorney Docket No. 17651-034001

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

This is a decision on the electronic petition, filed April 30,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 30,2010 .
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.

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) |
|---|---|---|---|---|
| 7028264 | 2006-04-11 | 10136873 | 2002-04-30 | SCT-00-002001 |

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Richard G. A. Bone/ | Date (YYYY-MM-DD) | 2010-04-30 |
| Name | Richard G. A. Bone | Registration Number | 56637 |

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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**SQUIRE, SANDERS & DEMPSEY, LLP**
**14TH FLOOR**
**8000 TOWERS CRESCENT**
**TYSONS CORNER, VA 22182**

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SEP 13 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Yogesh Prem Swami | : | |
| Application No. 10/136,882 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. 059643.00743 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 6, 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 January 22, 2007, as required by the Notice of Allowance and Fee(s) Due, mailed October 20, 2006, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on January 23, 2007.

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 $ 1400.00 and the publication fee of $300, (2) the petition fee of $1500.00, 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 Kimberly Inabinet 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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MAY 26 2006
OFFICE OF PETITIONS

BABAK KUSHA
TOWNSEND AND TOWNSEND AND CREW
2175 N CALIFORNIA BLVD STE 625
WALNUT CREEK, CA 94596

| | | |
|---|---|---|
| In re Application of | : | |
| David Mitlin, et al. | : | |
| Application No. 10/136,885 | : | DECISION ON REQUEST |
| Filed: April 30, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 014939-004600US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed March 15, 2006.

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

A review of the file record indicates that the power of attorney to Babak Kusha and all the attorneys/agents associated with Customer No. 20350 has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 CFR § 1.36(b) is moot.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

It is noted that an Office action was mailed on December 23, 2005 that requires a reply from the applicant.

Telephone inquires concerning this decision should be directed to Sherry D. Brinkley at 571-272- 3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Conferee:

cc: LAWRENCE BERKELEY NATIONAL LABORATORY
ONE CYCLOTRON ROAD, MAIL STOP 90B
UNIVERSITY OF CALIFORNIA
BERKELEY CA 94720

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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3COM CORPORATION
350 CAMPUS DRIVE
MARLBOROUGH, MA 01752-3064

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Victoria Lynn Irwin | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7590855 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/136,896 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/30/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1290** 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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Bernard I. Kleinke
Duckor Spradling & Metzger
401 West A Street
Suite 2400
San Diego, CA 92101

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OCT 08 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 10

In re application of
Richard Agee
Application No. 10/136902
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the petition filed on April 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 April 30, 2002 fails to adequately meet requirement (C) above. A specific listing of the field of search, including classes and subclasses used in the pre-examination search is required. Further, as applicant has stated that an electronic database search was done, a listing of the search terms and search fields are also required to show the field of search.

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 and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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

KJD/ekn 10/1/03

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Bernard I. Kleinke
Duckor Spradling & Metzger
401 West A Street
Suite 2400
San Diego, CA 92101

MAILED

NOV 24 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

Paper No. 12

In re application of
Richard Agee
Application No. 10/136,902
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on October 24, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

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

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

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

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

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/cps 11/18/03

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.04

PEACOCK MYERS AND ADAMS P C
P. O. BOX 26927
ALBUQUERQUE, NM 87125-6927

JUN 5 2003

In re Application of:
Donald A. Swenson
Application No. 10/136,905
Filed: May 02, 2002
Attorney Docket No.: 31282-1001

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102, filed May 02, 2002, to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.) § 708.02, Section IV: Applicant's Age.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section IV, must include evidence showing that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a Statement of age from the applicant as a showing that applicant is now sixty five (65) years of age or more.

Accordingly, the petition is GRANTED.

The application is being forwarded to the examiner for expedited prosecution.

If the examiner can make this application special without prejudice to any possible interfering applications, and s/he should make a rigid search for such, s/he is authorized to do so for the next action. Should the application be rejected, the application will not be considered special for the subsequent action unless the applicant promptly makes a bona fide effort to place the application in condition for allowance, even if it is necessary to have an interview with the examiner to accomplish this purpose.

If the examiner finds any interfering application for the same subject matter, s/he should consider such application simultaneously with this application and should state in the official letter of such application that s/he is taking it out of its turn because of possible interference.

Should an appeal be taken in this application or should this application become involved in an interference, consideration of the appeal and the interference will be expedited by all Patent and Trademark Office officials concerned, contingent likewise upon diligent prosecution by the applicant.

After allowance, this application will be given priority for printing. See M.P.E.P. § 1309.

The petition is granted to the extent indicated.

Inquiries regarding this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.

Lissi Mojica Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No. 5

RUTAN & TUCKER, LLP
P.O. BOX 1950
COSTA MESA, CA 92628-1950

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NOV 01 2002

OFFICE OF PETITIONS

In re Application of
Wang, et al.
Application No. 10/136,932
Filed: April 30, 2002
Atty. Dkt. No. 100330.0019US2
For: NOVEL NUCLEOSIDES HAVING
BICYCLIC SUGAR MOIETY

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed September 3, 2002.

The petition is hereby **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. 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 April 30, 2002 without an executed oath or declaration and naming Guangyi Wang, Zhi Hong, and Haoyun An as joint inventors. Accordingly, on June 4, 2002, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed, requiring an executed oath or declaration and 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 instant petition lacks item (2) set forth above. The declaration is deemed unacceptable as it fails to comply with the provisions of 37 CFR 1.63 and 37 CFR 1.64 in that declaration fails to set forth the full mailing address of the non-signing inventor. Any renewed petition must be accompanied by an oath or declaration in full compliance with 37 CFR 1.63 and CFR 1.64.

Further correspondence with regard to the petition under 37 CFR 1.47(a) 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

Application No. 10/136,932

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RUTAN & TUCKER, LLP
P.O. BOX 1950
COSTA MESA, CA 92628-1950

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JAN 07 2003

OFFICE OF PETITIONS

In re Application of
Wang, et al.
Application No. 10/136,932
Filed: April 30, 2002
Atty. Dkt. No. 100330.0019US2
For: NOVEL NUCLEOSIDES HAVING BICYCLIC SUGAR MOIETY

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR 1.47(a), filed December 23, 2002.

The petition is hereby **GRANTED**.

Petitioner has shown that inventor Guangyi Wang 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.

No fee is required for a petition renewed under 37 CFR 1.47. Petitioner may request a refund of the petition fee submitted December 23, 2002 by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

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

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GUANGYI WANG
5066 MILLAY COURT
CARLSBAD, CA 92008

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JAN 07 2003

OFFICE OF PETITIONS

In re Application of
Wang, et al.
Application No. 10/136,932
Filed: April 30, 2002
Atty. Dkt. No. 100330.0019US2
For: NOVEL NUCLEOSIDES HAVING
BICYCLIC SUGAR MOIETY

LETTER

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
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TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

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JUL 0 5 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Edward J. Scartezina<br>Application No. 10/136,948<br>Filed: April 30, 2002<br>Attorney Docket No. 5307US | DECISION GRANTING PETITION<br>UNDER 37 CFR 1.137(b) |

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**.

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 Office action of September 24, 2004, is accepted as having been unintentionally delayed.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, an extension of time is not now necessary.

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

This matter is being referred to Technology Center AU 1723.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CANCELLED

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Application of :
Edward J.Scartezina :
Application No. 10/136,948 : DECISION GRANTING PETITION
Filed: April 30, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 5307US :

This is a decision on the petition under 37 CFR 1.137(b), filed November 27, 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 May 23, 2006, 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 1723.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

Application No.

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. 3

CHARLES N.J. RUGGIERO
OHLANDT GREELEY RUGGIERO & PERLE
ONE LANDMARK SQUARE, 10TH FLOOR
STAMFORD, CT 06901-2682

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SEP 04 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Michael Stuart Brusca | : | DECISION GRANTING |
| Application No. 10/136,961 | : | PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 440.0022USU | : | |

This is a decision on the paper styled " REQUEST FOR CORRECTED FILING DATE" filed August 19, 2002, request that the above-identified application be accorded a filing date of May 1, 2002, rather the presently accorded filing date of May 2, 2002. The petition is properly treated as a petition under 37 CFR 1.10(d).

Applicant alleges that the application was deposited in "Express Mail" service with the U.S. Postal Service, on May 1, 2002. In support, applicant provided a copy of the Express Mail label, receipt No. EV017942635US, showing a Date-In of May 2, 2002. The petition is also accompanied by a copy of applicant's "Express Mail Corporate Account Mailing Statement" showing that postage for Express Mail label no. EV017942635US was charged on May 1, 2002. The same Express Mail receipt number was referred to in the copy of the original application transmittal letter found in the present application.

In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on May 1, 2002.

The petition is granted.

The application is being returned to Initial Patent Examination Division for correction of the filing date to May 1, 2002.

Telephone inquiries 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 Commissioner
for Patent Examination Policy

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INTELLECTUAL PROPERTY & STANDARDS
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SAN JOSE CA 95131

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OFFICE OF PETITIONS

In re Application of :
Bulthuis et al. :
Application No. 10/136,978 : ON PETITION
Filed: April 30, 2002 :
Attorney Docket Number: US 020097

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

This above-identified application became abandoned for failure to timely file a reply to the non-final Office Action of October 29, 2004. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on January 30, 2005. A Notice of Abandonment was mailed on August 9, 2006.

This Petition is hereby **Granted**.

Pursuant to petitioner's request, deposit account no.14-1270 will be charged the $1500 petition fee.

The office hereby acknowledges the receipt of the Amendment submitted with the instant petition.

This application is being forwarded to Technology Center 2600 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

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
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CORPORATE PATENT COUNSEL
U. S. PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN NY 10591

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OFFICE OF PETITIONS

Applicant: Van Der Schaft et al.
Appl. No.: 10/136,989
Filing Date: May 1, 2002
Title: ELECTROLUMINESCENT DEVICE
Attorney Docket No.: NL-01.0268
Pub. No.: US 2002/0164415 A1
Pub. Date: November 7, 2002

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on April 2, 2003 for the above-identified application.

The request is DISMISSED.

The instant request is that the application be republished because published application includes the specification of another application, which was filed in an information disclosure statement with the application.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." The request for corrected publication received on April 2, 2003, was not timely filed under 37 CFR 1.221(b).

Due to the nature of the errors in this publication, the Office will *sua sponte* publish a corrected patent application publication. The corrected patent application publication will be published in due course, unless the application is allowed and the patent issues before the application is republished.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Under Secretary of Comm rce for Intellectual Property and
Director f th United States Patent and Trad mark Office
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WHITE & CASE LLP
PATENT DEPARTMENT

APR 25 2002

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Michael W. Glynn
Novartis Corporation
564 Morris Avenue
Summit, New Jersey 07901

| | | |
|---|---|---|
| In re Application of | : | |
| Michael G. KOZIEL et al. | : | DECISION |
| Application No. 08/438,666 | : | ON PETITIONS |
| Filed: May 10, 1995 | : | 37 CFR §1.48(a), |
| Attorney Docket No. S-19433/P1/C | : | 1.47(a) & 1.183 |

This is a decision on the petitions filed March 11, 2002, under 37 CFR §1.48(a), 1.47(a), and 1.183, to correct the inventorship in the instant application, to accept a substitute declaration signed by less than all the inventors of record, and to waive the requirements of 37 CFR 1.64, respectively.

The petition under 37 CFR 1.48(a) is GRANTED.

The petition under 37 CFR 1.47(a)[1] is being treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.64 and is GRANTED.

The petition under 37 CFR 1.183 is deemed unnecessary in view of the submission of the above-mentioned petition under 37 CFR 1.47(a) and therefore is DISMISSED AS MOOT.

In view of the papers filed March 11, 2001, 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 addition of Nadine Carozzi. A filing receipt reflecting the inventorship as corrected will be mailed under separate cover. PTO PALM data has also been corrected to reflect the same.

With respect to the petition filed under 37 CFR 1.47(a), which has been treated as a petition under 37 CFR 1.183, the remedy for acceptance of the supplemental declaration lies via a waiver under 37 CFR 1.183 of 37 CFR 1.64, and does not lie under 37 CFR 1.47. In this instance, the showings of inability to locate all of the originally signing inventors are accepted with respect to Andreas Tanner and Francis Cammack.

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[1]Rule 47 only applies where, in the first instance, the signature of an originally named, or to be added, inventor cannot be obtained. As Andreas Tanner and Francis Cammack executed the original declaration and thus made the application, 37 CFR 1.47 no longer applies to the issue. See 37 CFR 1.47; MPEP 201.03. Rather, the remedy lies under 37 CFR 1.183 when a required supplemental declaration is not executed in whole or in part by a previously signing inventor(s). See MPEP 603.

Petitioner is advised that no fee has been charged for the submission of the petition pursuant to 37 CFR 1.183 inasmuch as there remains no issue for which relief is sought to which this petition is applicable.

With respect to the Change of Correspondence Address Form (PTO/SB/122) submitted with the Issue Fee Transmittal (PTOL-85), Applicant is advised that the requested change has not been made in the instant application. MPEP 601.03 states, in pertinent part "the correspondence address may be changed by (A) a registered attorney or agent of record appointed in compliance with 37 CFR 1.34(b)". Inasmuch as the instant request for Change of Correspondence Address has been signed by an attorney who is NOT of record in the instant application, it has not been processed.

Paper No. 34, filed January 4, 2000, seeks to add John Scheibeler and Dimitrios Drivas as Associate Attorneys in the instant application. However, the paper requesting the appointment of associate attorneys was in itself signed by Mr. Larry W. Stults, who is not of record in the instant application. MPEP 402.02 notes "The principal attorney or agent may appoint an associate attorney or agent as provided in 37 CFR 1.34. The associate attorney may not appoint another attorney." Thus an attempt to appoint associate attorneys by Mr. Stults, who himself is not of record in the instant application, is deemed to be improper. A courtesy copy of the instant communication is being provided to Mr. Scheibeler.

This application is being forwarded to Publication Branch.

Inquiries regarding this communication may be directed to B. Dayoan at (703) 308-3865 or, in her absence, to the undersigned at (703) 305-1820.

Brian Hearn

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: John P. Scheibeler
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036.

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of Gondek et al. :
Application No. 10/137,001 : Decision on Petition
Filing Date: May 1, 2002 :
Attorney Docket No. 100111292-1 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 9, 2004, to revive the above-identified application. The Office apologizes for the delay in the issuance of the instant decision.

The petition is **DISMISSED**.

Facts:

The Office mailed a Notice to File Missing Parts of Application on June 6, 2002. The Notice indicated:

(1) an executed oath or declaration had not been filed, and
(2) the abstract was not on a separate sheet of paper.

An executed declaration was filed June 21, 2002. However, a new abstract was not filed.

A Notice to File Corrected Application Papers was mailed July 18, 2002. The Notice indicated the abstract was a not a separate sheet of paper. The Notice set a period for reply of two (2) months from the mail date of the Notice.

Petitioner failed to file a reply to the July 18, 2002 Notice and the application became abandoned on September 19, 2002.

A Notice of Abandonment was mailed January 21, 2004.

The instant petition was filed March 9, 2004.

Discussion:

A grantable petition under 37 CFR 1.137(b) must be accompanied by the required reply. In this case, the required reply is an amendment to the specification resulting in the abstract appearing

on a separate sheet of paper. Unfortunately, the petition is not accompanied by the required reply. Therefore, the Office is unable to grant the petition at this time.

A request for reconsideration should be filed along with an amendment to the specification resulting in the abstract appearing on a separate sheet of paper.

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)."

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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In re Application of Gondek et al. :
Application No. 10/137,001 :
Filing Date: May 1, 2002 :
Attorney Docket No. 100111292-1 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(b), filed September 27, 2006, to revive the above-identified application.

The petition is **granted**.

A Notice to File Corrected Application Papers was mailed July 18, 2002. The Notice indicated the abstract was not on a separate sheet of paper. The Notice set a period for reply of two (2) months from the mail date of the Notice.

Petitioner failed to file a reply to the July 18, 2002 Notice and the application became abandoned on September 19, 2002.

A Notice of Abandonment was mailed January 21, 2004.

The instant petition requests revival of the application.

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

The Office of Initial Patent Examination will be informed of the instant decision and will take steps to prepare the application for examination in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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SCHULZ AND ASSOCIATES. P.C.
5400 LBJ FREEWAY, SUITE 1200
DALLAS, TX 75240

In re Application of
Mark R. Moore
Application No. 10/137,025
Filed: April 30, 2002
Attorney Docket No. 59428.0113

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed January 31, 2006.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before September 10, 2004. A Notice of Abandonment was mailed on October 27, 2004.

The petition 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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Paper No. 5

BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK NY 10022

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OFFICE OF PETITIONS

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|---|---|
| In re Application of<br>Rao, et al.<br>Application No. 10/137,033<br>Filed: May 1, 2002<br>Attorney Docket No. 87112553-4<br>Title: INSTANTANEOUS POLLING UTILIZING A MESSAGE SERVICE MOBILE PHONE NETWORK | DECISION REFUSING STATUS UNDER 37 CFR 1.47(a) |

This is in response to the paper titled "Response to Notice of Missing Parts and Petition for Acceptance of Inventor Declaration Due to Unavailability of an Inventor Under 37 CFR 1.47", filed August 28, 2002, which is being treated as a petition under 37 CFR 1.47(a).

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

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

The above-identified application was filed on May 1, 2002. On July 2, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring 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. Accompanying the petition was a declaration executed by inventor Henry Rao, with the signature block for inventor Eric Lin left blank.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or

declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Rule 47 applicant has not met requirements (1) and (4) above.

As to requirement (1), the petition has been carefully considered. However, applicant is not shown to have demonstrated diligent effort in finding the non-signing inventor. With respect to showing diligent effort, "an affidavit or declaration of facts should be submitted that **fully describes the exact facts** which are relied on to establish that a diligent effort was made."[1] Here, applicant has provided no information other than that the non-signing inventor could not "be found or reached after diligent effort." In addition, applicant has provided no documentary evidence, such as a certified mail return receipt or copies of an internet search, to support such a finding[2].

As to requirement (4), applicant has not provided a statement of the last known address of the non-signing inventor.

The petition fee of $130 and the $65 surcharge for late filing of the declaration have been charged to Deposit Account No. 02-0393, as authorized.

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

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

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

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

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

Nancy Johnson

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

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[1] MPEP 409.03(d) (emphasis added).

[2] Such documentary evidence should be made part of the affidavit or declaration. See id.

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Paper No. 7

BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK NY 10022

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OFFICE OF PETITIONS

In re Application of
Rao, et al.
Application No. 10/137,033
Filed: May 1, 2002
Attorney Docket No. 87112553-4
Title: INSTANTANEOUS POLLING UTILIZING A MESSAGE SERVICE MOBILE PHONE NETWORK

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is in response to the Request for Reconsideration of Petition Under 37 CFR 1.47(a), filed December 27, 2002.

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

The above-identified application was filed on May 1, 2002. On July 2, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration (and a surcharge for its late filing). This Notice set a two-month period for reply.

In reply, applicant filed a petition under 37 CFR 1.47(a) on August 28, 2002. Accompanying the petition was a declaration executed by inventor Henry Rao, with the signature block for inventor Eric Lin left blank.

However, the August 28, 2002 petition was dismissed in a decision mailed on November 18, 2002. Petitioner did not provide sufficient evidence to conclude that a diligent effort had been made to find the non-signing inventor. In addition, petitioner did not provide a statement of the last know address of inventor Lin.

On renewed petition, petitioner has enclosed a copy of a cover letter dated November 29, 2002, transmitting the declaration and application papers to Lin. In addition, petitioner has included a statement of the last known address of inventor Lin.

The declaration filed August 28, 2002 and the petitions filed August 28 and December 27, 2002 have been reviewed and found to be in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to non-signing inventor Lin 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 Petitions Attorney Cliff Congo at (703) 305-0272.

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

Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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ERIC LIN
NO 10 ALLEY 30 LANE 77 MINGSHING ROAD
NAN CHIU TAINAN
TAIWAN ROC

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OFFICE OF PETITIONS

In re Application of
Herman Rao and Eric Lin
Application No. 10/137,033
Filed: May 1, 2002
Title: INSTANTANEOUS POLLING UTILIZING A MESSAGE SERVICE MOBILE PHONE NETWORK

LETTER

Dear Mr. Lin:

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

Ya-Chiao Chang
Baker & McKenzie
805 Third Avenue 29th Floor
New York, New York 10022

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**BAKER & McKENZIE LLP**
**1114 AVENUE OF THE AMERICAS**
**NEW YORK, NY 10036**

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Herman Rao and Eric Lin | : | |
| Application No. 10/137,033 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 2617 | : | 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 December 16, 2005.

The request is **APPROVED** to the extent noted below.

A review of the file record indicates that Eunhee Park, the person signing the request to withdraw: (1) does not have power of attorney in this patent application and is therefore without authority to request withdrawal of all the attorneys of record;[1] and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of this decision, Mr. Park has 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). However, as the record indicates that the signing applicant, Herman Rao, appointed Ya-Chiao Chang (RN 43,407) and Anna Y. Tsang (RN 48,003) of the firm of Baker and McKenzie, as attorneys to prosecute this application, and as no appropriate request been made to withdraw these attorneys of record, future correspondence will continue to be mailed to the above-noted address of record, until otherwise appropriately instructed by applicant.

A courtesy copy of this communication is being mailed to the below-listed, non-intervening assignees of the entire interest under 37 CFR 3.71 and to the address noted on the request to withdraw as attorney or agent, which is the address for one of the assignee(s). Additionally, a courtesy copy of this communication is being mailed to the address noted on a communication received in this application from Mr. Winston Hsu. If Mr. Hsu desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be

[1] The only evidence that Mr. Park may have been employed or engaged in proceedings in this application can be found in a copy of an Assignment received on August 28, 2002, which grants Mr. Park, among others, "the power to insert on this assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document." However, this is not considered to be a grant of a power of attorney to prosecute this application by the assignee(s).

submitted. If the power of attorney is by the assignee(s), compliance with 37 CFR 3.73(b) must be satisfied.

While a Notice of Abandonment has not been mailed in this application, it appears that this application is now abandoned by operation of law for failure to timely reply to the final Office action mailed July 19, 2005, which set a three month shortened statutory period for reply.

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

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Far Eastone Telecommunications Co., Ltd.
28F, 207, Sec. 2, Tun Hwa S. Rd.
Taipei, Taiwan 106

AT&T Corp.
32 Avenue of the Americas
New York, NY 10013-2412

Winston Hsu
P. O. Box 506
Merrifield, VA 22116

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Foley and Lardner LLP
Suite 500
3000 K Street N
Washington D.C. 20007

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|---|---|---|
| In re Application of | : | |
| Ranjan Perera et al. | : | |
| Application No. 10/137,036 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 11000.1036c4 | : | FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 11, 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 Richard C. Peet on behalf of all attorneys of record who are associated with Customer No. 22428.

All attorneys/agents associated with the Customer No. 22428 have been withdrawn.

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

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

There is no outstanding Office action at this time.

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

David Bucci
Petitions Examiner
Office of Petitions

cc: **Ranjan Perera**
12117 Granada Oakwood
Apt. 1018
Overland Park, KS 66209

cc: **Cooley Godward LLP**
The Bowen Building
875 15th Street, N.W.
Washington D.C. 20005-2221

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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AUG 19 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Bernard L. Kleinke
Ddckor, Spradling & Metzger
401 West A Street
Suite 2400
San Diego, CA 92101

Paper No. 8

In re application of
Richard Agee et al.
Application No. 10/137,045
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD-CASH AND CASH-SUBSTITUTE TRANSACTIONS

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the petition filed on April 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 delay in acting on this petition is regretted.

The petition is **DISMISSED**.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

The petition filed April 30, 2002 fails to adequately meet requirement (C) above. The petition states that a pre-examination search was made listing the field of search by class and subclass, publication etc. However, the subclasses for the classes listed (235,364,395 and 705) have not been listed nor is there a record of search strategy or key words searched been offered for the electronic database search that was done.

Also, the petition filed April 30, 2002 fails to adequately meet requirement (E) above since the detailed discussion does not include discussion of how the claimed subject matter is patentable over the references. Applicant merely describes the prior art in detail but does not present comprehensive discussion of the how the features of the claims of the present invention patentably define over the found references.

For the above stated reasons, the petition is dismissed.

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

**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.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

snm/ekn: 8-15-03

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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Bernard L. Kleinke
Duckor, Spradling & Metzger
401 West A Street
Suite 2400
San Diego, CA 92101

**MAILED**

DEC 11 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 11

In re application of
Richard Agee et al.
Application No. 10/137,045
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD-CASH AND CASH-SUBSTITUTE TRANSACTIONS

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on September 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 petition is **DENIED**.

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 renewed petition filed September 19, 2003 still fails to adequately meet requirement (E) above since the detailed discussion does not include discussion of how the claimed subject matter is patentable over the references. Applicant merely describes the prior art in detail but does not present comprehensive discussion of <u>how the features of the claims of the present invention</u> patentably define over the found references.

The application will be returned to the central files storage area to await examination on the merits in its normal turn.

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

RAR/cps: 12/10/03

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ALEXANDRIA, VA 22313-1450
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Duckor Spradling Metzger
401 West A Street, Suite 2400
San Diego, CA 92101

**MAILED**

MAR 1 2 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re application of
Richard Agee et al.
Application No. 10/137,045
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD-CASH AND CASH-SUBSTITUTE TRANSACTIONS

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on December 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 petition is **DISMISSED**.

MPEP § 708.02 VIII states:

> In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner. Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

Applicant submitted a Petition to Make Special - Accelerated Examination on April 30, 2002 and a Decision dismissing that request for failure to meet the requirements of Section VIII was mailed August 19, 2003. Applicant submitted a renewed request on September 19, 2003 and a Decision denying that request was mailed on December 11,

2003 based in part on the same reasons noted in the initial request; namely, failure to provide 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 applicant has already been granted one opportunity to perfect the request, the second renewed request filed December 19, 2003 will not be considered as per the relevant section of MPEP § 708.02 VIII cited above.

The application will be returned to the central files storage area to await examination on the merits in its normal turn.

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

KJD/mjz: 3/11/04

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

DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : John Gavin MacDonald | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7578997 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/25/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/137,052 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/30/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1957** 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

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Garo J. Derderian | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7589029 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/137,058 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/02/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **462** 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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**FULWIDER PATTON LEE & UTECHT, LLP**
**200 OCEANGATE, SUITE 1550**
**LONG BEACH, CA 90802**

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DEC 28 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Diem Xuan Vuong | : | |
| Application No. 10/137,072 | : | NOTICE |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. LBCIT.59421 | : | |

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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 1723 and for consideration of the concurrently filed Amendment.

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

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

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| | | |
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| In re Application of | : | |
| Klaus Winter, et al. | : | |
| Application No. 10/137,091 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | |
| Attorney Docket No. 10191/2423 | : | |

This is a decision on the petition, filed October 31, 2006, 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 became abandoned as a result of petitioner's failure to file a complete and proper appeal brief within the time period provided in 37 CFR 41.37(a)(1). As a complete and proper appeal brief was not filed within one (1) month of the Notification of Non-Compliance with 37 CFR 41.37(c)(1), mailed February 9, 2006, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. *See* 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on March 10, 2006. *See* MPEP 1215.04. A Notice of Abandonment was mailed on October 5, 2006.

Petitioner asserts that the Office action dated February 9, 2006 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement.

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

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The application is being referred to Technology Center AU 3663 for consideration of the replacement Appeal Brief filed October 31, 2006.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. Inquiries relating to the prosecution of the application should be referred to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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WASHINGTON, D.C. 20231
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Paper No. 7

SKJERVEN MORRILL MACPHERSON LLP
SUITE 300
610 NEWPORT CENTER DRIVE
NEWPORT BEACH CA 92660

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**FEB 21 2003**

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Chen et al. | : |
| Application No. 10/137,096 | : DECISION NOTING JOINDER OF |
| Filed: 1 May, 2002 | : INVENTOR AND PETITION UNDER |
| Attorney Docket No. M-12600-1P US | : 37 CFR 1.47(a) MOOT |

Papers filed on 31 January, 2003, subsequent to the filing of a Petition Under 37 CFR 1.47(a), on 13 January, 2003, included a Declaration signed by the previously non-signing inventor, Giuseppe Colangelo, 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 will be forwarded to Office of Initial Patent Examination for further processing.

Since joinder occurred prior to consideration of the petition under 37 CFR 1.47(a), the petition fee of $130.00 is unnecessary. The petition fee will be refunded to counsel's deposit account, No. 19-2386.

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

D Wood

Douglas I. Wood
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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DIW Feb-07

BEYER WEAVER LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

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FEB 27 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Chen et al. | : | |
| Application No. 10/137,096 | : | ON PETITION |
| Filed: 1 May, 2002 | : | |
| Attorney Docket No. | : | |
| NOVLP194X1/NVLS-2691 | : | |

This is a decision in reference to the "PETITION OF NON-RECEIPT BASED ON FAILURE TO RECEIVE OFFICE ACTION UNDER 37 CFR 1.181 (See MPEP 711.03(c)), filed on 10 March, 2004, which is treated as a petition filed under 37 CFR 1.181 requesting withdrawal of the holding of abandonment. This is also a decision on the petition filed on 14 November, 2006, under 37 CFR 1.137(b).[1]

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

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

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

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

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

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

This application became abandoned on 12 October, 2003, for failure to submit a timely response to the non-final Office action mailed on 11 July, 2003, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 26 October, 2004.

**Petition to withdraw the holding of abandonment.**

Petitioners assert that the Office action mailed on 11 July, 2003, was never received. In support, petitioners have provided a statement from registered patent attorney Tom Chen of the law firm of MacPherson Kwok Chen and Heid, LLP, stating that a search of the file jacket and docket records indicate that the Office action was never received. A copy of the docket record where the Office action would have been entered is also provided.

The showing of record is insufficient to withdraw the holding of abandonment.

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 applicant at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[2] This showing 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.

It is noted that the Office action mailed on 11 July, 2003, was mailed to Skjerven Morrill Macpherson LLP, Suite 300, 610 Newport Center Drive, Newport Beach, CA 92660 (hereinafter "the Skjerven

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[2] See Withdrawing the Holding of Abandonment When Office Actions Are Not Received, Notice 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

Morrill address"), which was the address associated with Customer No. 27869, which was provided as the correspondence address in the oath or declaration in compliance with 37 CFR 1.63 filed on 13 January, 2003. However, on 1 March, 2004, petitioners filed a change of correspondence address changing the correspondence address to MacPherson Kwok Chen & Heid, LLP, 1762 Technology Drive, Suite 226, San Jose, CA 95110 (hereinafter "the MacPherson Kwok address"). It is further noted that the petition filed on 10 March, 2004, contains the MacPherson Kwok address.

As such, the showing of record is that the docket report pertains to Office correspondence received and docketed at the MacPherson Kwok address rather than at the Skjerven Morrill address. However, no evidence has been provided as to whether the correspondence was ever received at the Skjerven Morrill address. Therefore, petitioners must clarify whether they were still receiving mail at the address of record on or after 11 July, 2003. In summary, the showing of record suggests that the docketing and receipt of Office correspondence was no longer occurring at the Skerjven Morrill address at the time the Office action mailed on 11 July, 2003, was sent.

It appears, therefore, that the Office action may have been properly mailed to petitioners' address of record but not received due to petitioners' changing counsel, or was lost after receipt due to counsel's relocation. Any renewed petition to withdraw the holding of abandonment must include a showing that petitioners were, in fact, receiving mail at the correspondence address of record at the time the Office action mailed on 11 July, 2003, was mailed, **and for a reasonable time thereafter**.

As the showing is insufficient to withdraw the holding of abandonment, the petition is dismissed.

**Petition Under 37 CFR 1.137(b).**

Receipt of the amendment filed on 14 November, 2006, is acknowledged.

The petition is **granted**.

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.[3] 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 application is being referred to Technology Center Art Unit 2818 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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[3] See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1208 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

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Alexandria, VA 22313-1450
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Paper No. 9

**MEDTRONIC, INC.**
**710 MEDTRONIC PARKWAY NE**
**MS-LC340**
**MINNEAPOLIS, MN 55432-5604**

COPY MAILED

SEP 13 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Cornelius Borst et al | : |
| Application No. 10/137,159 | : DECISION ON PETITION |
| Filed: April 30, 2002 | : UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. P-3875.13 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 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 April 30, 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).

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 the undersigned at (703) 305-8680. Effective September 27, 2004, the new phone number will be 571-272-3218.

This application is being forwarded to Technology Center Art Unit 3736 for appropriate action on the amendment filed August 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.

Frances Hicks

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

**ATTACHMENT**: Corrected Filing Receipt

**DO NOT SCAN!** **Please forward case and paper to address shown below.**

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.:** _____

**DATE** : 3/26/07

**TO SPE OF** : ART UNIT 1762

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/137164 Patent No.: 7160577

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

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

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

**HENRY RANDALL**
**Certificates of Correction Branch**
**703-308-9390 ext.** _____

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

SPE

1762
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

UR
Paper NO. 5

Mailed SEP - 9 2002

| | | |
|---|---|---|
| In re Application of | : | |
| Keith G. Copeland et al. | : | |
| Serial Number: 10/137,169 | : | DECISION ON |
| Filed: May 02, 2002 | : | PETITION UNDER |
| For: AUTOMATED BIOLOGICAL REACTION APPARATUS | : | M.P.E.P. 708.02, II |

This is a decision on the Petition to Make Special because of Actual Infringement (37 C.F.R. 1.102 and MPEP 708.02) filed May 02, 2002, along with the requisite fee (paid), in the above-noted application. The petition with accompanying statement, meet the requirements of Section 708.02 (II) of the MPEP.

If the examiner finds any interfering application for the same subject matter, the examiner should consider such application simultaneously with this case and should state in the official letter of such application that the examiner is taking it out of its turn because of a possible interference.

Should an appeal be taken in this case or should this case become involved in an interference, consideration of the appeal and the interference will be expedited by Patent and Trademark Office Officials concerned, contingent likewise upon diligent prosecution by applicant.

After allowance, this case will be given priority for printing. See MPEP 1309.

The petition is GRANTED.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

**McDonnell Boehnen Hulbert & Berghoff**
**300 South Wacker Drive, Suite 3200**
**Chicago, IL 60606**

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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MEDTRONIC, INC.
710 MEDTRONIC PARK
MINNEAPOLIS, MN 55432-9924

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SEP 0 5 2006
OFFICE OF PETITIONS

In re Application of

Condie, et al.

Application No. 10/137,171

Filed: April 20, 2002

Attorney Docket No. P-10317.100

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), July 31, 2006, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to timely file corrected drawings as required by the Notice of Allowability mailed February 8, 2006. The notice allowed a statutory period for reply of three-months from its mailing date. No response was received within the allowable period. Accordingly, this application became abandoned on May 9, 2006. A Notice of Abandonment was mailed on June 21, 2006 A drawing was received on April 7, 2006.

Corrected drawings were received on July 31, 2006.

The application is being forwarded to the Office of Patent Publications 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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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUN 15 2004

Paper No. 6

In re Application of
Terry Lovett
Application No. 10/137,182
Filed: April 26, 2002
Attorney Docket No. LOVETT.004A

DECISION ON PETITION

The papers filed by facsimile transmission on May 12, 2004 are construed as a petition under 37 CFR 1.181 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the final Office action dated October 6, 2003. No fee is required for the petition.

The petition is granted.

Petitioner alleges that the application is not abandoned because a reply to the Office letter in question was actually filed on December 29, 2003. Petitioner has supported this allegation by furnishing a copy of the reply and a copy of a filing receipt for the reply which shows the reply was in fact received in the Office on December 29, 2003, a date within the period for filing a reply to the final Office action. Based upon this evidence, it is clear that this application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for processing the reply filed on October 9, 2003 and for processing the revocation and power of attorney filed on May 14, 2004. Thereafter, the application will be forwarded to the examiner for appropriate action.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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Paper No. 8

RADER FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS MI 48304-0610

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APR 0 8 2003

OFFICE OF PETITIONS

In re Application of
Burris, et al.
Application No. 10/137,184
Filed: May 1, 2002
Attorney Docket No. 60680-1616

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the "Petition Pursuant to 37 CFR 1.47 Involving the Refusal of a Co-inventor to Execute the Power of Attorney", filed November 18, 2002, which is being treated as a petition under 37 CFR 1.47(a) to have one joint inventor make an application for patent on behalf of himself and another joint inventor who refuses to join in the application or can not be found.

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

The above-identified application was filed on May 1, 2002. On June 11, 2002, petitioner was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring 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 under 37 CFR 1.47(a) and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a three month extension of time and included a Certificate of Mailing dated November 12, 2002.[1] Accompanying the petition was a declaration executed by joint inventor Todd Burris, but lacking a signature from joint inventor Christina Rouse.

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

On petition, attorney Michael B. Stewart has supplied, *inter alia*, a copy of a cover letter to the last known address of Rouse, dated September 11, 2002, transmitting the application papers. According to Stewart, as of the date of the petition, no executed declaration from Rouse has been received.

---

[1] November 11, 2002 fell on a federal holiday. See 37 CFR 1.7(a).

The petition filed November 18, 2002, has been reviewed and determined to be in compliance with 37 CFR 1.47(a). The declaration filed with the petition has been determined to be in compliance with 37 CFR 1.63. Accordingly, the above-identified 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 forwarded to the Office of Initial Patent Examination for pre-examination processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

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Washington, D.C. 20231
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CHRISTINA ROUSE
1103 CASTLETON RD
CLEVELAND HEIGHTS OH 44121

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APR 0 8 2003

OFFICE OF PETITIONS

In re Application of :
Todd Burris and Christina Rouse :
Application No. 10/137,184 :
Filed: May 1, 2002 :
Title: SALES TRACKING AND FORECASTING :
APPLICATION TOOL

LETTER

Dear Ms. Rouse:

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

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

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

Cliff Congo

Cliff Congo
Petitions Attorney
Office of Petitions

Michael B. Stewart
Rader, Fishman & Grauer PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304
(248)594-0633

UNITED STATES PATENT AND TRADEMARK OFFICE

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20 NORTH WACKER DRIVE
CHICAGO IL 60606

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MAR 0 2 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Thomas J. Wool | : | DECISION ON PETITION |
| Application No. 10/137,185 | : | UNDER 37 CFR 1.137(f) |
| Filed: 30 April, 2002 | : | |
| Atty Docket No. TJW-01 | : | |

This is a decision on the petition under 37 CFR 1.137(f),[1] filed on 29 October, 2004, to revive the above-identified application.

The petition is **dismissed** as inappropriate for the reasons stated below.

The record discloses that, on 30 April, 2002, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention disclosed in the attached **application has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing."

On 29 October, 2004, petitioners filed a request under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded and the application revived because this application became abandoned for failure to notify the Office of the filing of a corresponding international or foreign application. The present petition was also filed on 29

[1] 37 CFR 1.137(f) provides for revival of a nonprovisional application which became abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

October, 2004. In this regard, petitioner states that an international or foreign application corresponding to the instant application was filed on 26 March, 1993, a date prior to the date that the instant application was filed.

The instant nonprovisional application did not become abandoned as a result of the filing of a corresponding application filed in another country, or under a multilateral international agreement, **subsequent** to the filing of the present application. In this regard, 35 U.S.C. § 122(b)(2)(B)(iii) states:

> An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional [emphasis supplied].

The facts of this case are that the subject application was filed on 30 April, 2002, and the corresponding foreign application was filed on 26 March, 1993. The statute does not provide for the situation where a certification under 35 U.S.C. § 122(b)(2)(B)(i) was made, despite the fact that an application was filed on a prior date in another country or under the multilateral international agreement. In view of petitioner's statement that the corresponding foreign application was filed on 26 March, 1993, a date prior to the date of filing of the subject application, the filing of the corresponding foreign application cannot be considered to have been filed **subsequent** to the filing of the subject application in the United States. The statute at 35 U.S.C. § 122(b)(2)(B)(iii) only provides for revival in the situation where a certification was made under 35 U.S.C. § 122(b)(2)(B)(i) at the time of filing the application and an application was **subsequently** filed in a foreign country without notifying the Office within 45 days of the filing thereof.

Since the corresponding foreign or international application was

either filed on the same date or filed prior to the filing date (this would be true if the corresponding foreign or international application has a filing date of 26 March, 1993) as the subject application, this application did not become abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii). Therefore, a petition to revive pursuant to the provisions of 37 CFR 1.137(f) is inappropriate and, consequently, must be dismissed.

As requested, the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A review of Office PALM records reveals that the present application was published on 17 February, 2005.

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.[2] Accordingly, the required $685.00 petition fee has been received.

The application is being forwarded to Technology Center Art Unit 3762 for further processing.

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

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

[2] *See* 35 U.S.C. § 41(c)(7).

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APR 0 5 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Thomas J. Wool | : | DECISION ON PETITION |
| Application No. 10/137,185 | : | UNDER 37 CFR 1.137(f) |
| Filed: 30 April, 2002 | : | |
| Atty Docket No. TJW-01 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(f),[1] filed on 11 March, 2004, to revive the above-identified application.

The petition is **granted**.

The petition under 37 CFR 1.137(f) filed on 29 October, 2004, was dismissed on 2 March, 2005, as inappropriate because petitioner stated that the present nonprovisional application was the subject of a foreign or international application filed on 26 March, 1993. In the renewed petition, petitioner states that the 26 March, 1993, date provided in the initial petition was incorrect due to inadvertent error, and that the correct date that the foreign or international application was filed was 26 March, 2003.

Petitioner states, in the renewed petition, that the present nonprovisional application is the subject of a foreign or international application filed on 26 March, 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.

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[1] 37 CFR 1.137(f) provides for revival of a nonprovisional application which became abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

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 present 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)(i) has been rescinded.

The petition fee was previously paid, and no further petition fee is due.

The application is being referred to Technology Center Art Unit 3762 for further processing.

Any inquiries concerning this decision may be directed to the undersigned at 571.272.3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**Intellectual Property Law Department**
**Square D Company**
**1415 South Roselle Road**
**Palatine IL 60067-7399**

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| | | |
|---|---|---|
| In re Application of | : | |
| Ronald Gross | : | |
| Application No. 10/137,192 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | |
| Attorney Docket No. SAA-88 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before November 27, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed August 25, 2006. Accordingly, the date of abandonment of this application is November 28, 2006. The Notice of Abandonment was mailed December 26, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,440, (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay.

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

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

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

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

Chris Bottorff
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20090616

**DATE** : June 14, 2009

**TO SPE OF** : ART UNIT 2625

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7149009

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:**

/MARK K ZIMMERMAN/
Supervisory Patent Examiner.Art Unit 2625

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

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JAN 24 2005

OFFICE OF PETITIONS

In re Application of :
Tatsuya Iwasaki, et al. :
Application No. 10/137,350 :
Filed: May 3, 2002 :
Attorney Docket No. 03500.016404 :

ON PETITION

This is a decision on the petition, filed January 21, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on October 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2818 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

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ALEXANDRIA, VA 22313-1450
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**MacPHERSON KWOK CHEN & HEID LLP**
**2033 GATEWAY PLACE**
**SUITE 400**
**SAN JOSE, CA 95110**

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JUL 11 2007

OFFICE OF PETITIONS

In re Application of :
Hyun-Su Lee et al :
Application No. 10/137,360 : DECISION ON PETITION
Filed: May 3, 2002 :
Attorney Docket No. :
6192.0271.AA

This is a decision on the petition under 37 CFR 1.137(b), filed October 26, 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 February 7, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on May 8, 2006. A Notice of Abandonment was mailed on October 2, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply in the form of a request for continued examination, $790 filing fee, and submission as required by 37 CFR 1.114, (2) the petition fee of $1,500, and (3) an adequate statement of unintentional delay. Accordingly, the failure to timely reply to the final Office action of February 7, 2006 is accepted as being unintentionally delayed.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement 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.

This application is being referred to Technology Center AU 2629 for processing the request for continued examination and for appropriate action in the normal course of business on the submission under 37 CFR 1.114.

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

Frances Hicks
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : January 9, 2006

**TO SPE OF** : ART UNIT 3653

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,945,528

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

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Magdalene Talley

**Thank You For Your Assistance**

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

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

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

**Comments:**

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**SPE** — 3653 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31

MAR 14 2003

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

~~JUL 30 2002~~

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

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

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

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

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

The Decision is set forth in five parts:

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

Part I. Background

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

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

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

Part II. Petition Under 37 CFR 1.182 - Special Treatment

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

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

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

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Part IV. Summary

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

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

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

Part V. Further Correspondence

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

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

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TC Assignment Appendix
Bulk Filing List With TC Assignment

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| 205889US-8737737-99 | 09733688 | 2824 |
| 205914US-8737-8737-99 | 09795784 | 2824 |

| Docket Number | Application # | Art Unit |
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| 210259US-8737-873799 | 09897128 | 2824 |
| 210784US-8737-8737-99 | 09905098 | 2824 |
| 211577US-8737-9737-99 | 09909905 | 2824 |
| 21301 OUS-8737-8737-99 | 09930308 | 2824 |
| | 10125410 | 2825 |
| 205912US-8737$737 99 | 09624690 | 2825 |
| 205893US-8737-873799 | 09625100 | 2825 |
| 210788US-8737-8737-99 | 09901110 | 2825 |
| 211317US-8737-8737-99 | 09906730 | 2825 |
| 211688US-8737-8737-99 | 09908891 | 2825 |
| 211579US-8737-8737-99 | 09909940 | 2825 |
| 211917US-8737-8737-99 | 09911460 | 2825 |
| 205973US-8737-8737-99 | 09584601 | 2826 |
| 205938US-8737-8737-99 | 09624296 | 2826 |
| 205934US-8737-8737.89 | 09624754 | 2826 |
| 205884US-8737-8737-99-CIP | 09758723 | 2826 |
| 205968US-8737-8737-99 | 09824273 | 2826 |
| 206669US-8737-873799 | 09838273 | 2826 |
| 209491 US-8737-8737-99-CIP | 09840213 | 2826 |
| 209284U S,B737-8737-99 | 09842734 | 2826 |
| 209281 US-8737-8737-99 | 09853744 | 2826 |
| 209336US-8737-8737-99 | 09870834 | 2826 |
| 209505US-8737-8737-99 | 09874984 | 2826 |
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| Docket Number | Application # | Art Unit |
|---|---|---|
| 205915US-8737-9737-99 | 09624803 | 2834 |
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| 205972US-8737-873799 | 09624698 | 2872 |
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| 205951 US-8737-8737-99 | 09607744 | 2874 |
| 205947US-8737-8737-99 | 09608807 | 2874 |
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| 212590US-8737-8737-99 | 09927393 | 2881 |
| 209342US-87378737-99 | 09870833 | 2882 |
| | 9905115 | 3662 |
| | 9911420 | 3663 |
| | 09607722 | 3736 |

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MAR 1 4 2003
PATENT & TRADEMARK OFFICE

By FAX: (703) 872-9005

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

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

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

Attachment: TC Assignment Appendix

6,758,384

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12-1-05

TO SPE OF : ART UNIT 1725

SUBJECT : Request for Certificate of Correction on Patent No.: 6758384

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

Please complete this form and return with file, within 7 days to:

**Certificates of Correction Branch - ~~PK 3-922~~** South Tower 9A22

Palm location **7580** - Tel. No. 305-8309

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

Check Drawings

**Thank You For Your Assistance**

E Young

**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:**

_____

_____

_____

_____

_____

_____ **SPE**

1725 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

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OFFICE OF PETITIONS

In re Application of :
Thomas Wong, Panagiotis Tsirigotis, :
Sanjay Radia, Rajeev Chawla and :
Omid Ahmadian :
Application No. 10/137,443 :
Filed: May 3, 2002 :
Title: APPARATUS AND METHODS FOR :
CACHING OBJECTS USING MAIN MEMORY :
AND PERSISTENT MEMORY :

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

This is in response to the "Petition to File Application with a Nonsigning Inventor under 37 C.F.R. §1.47(a)," filed October 18, 2002.

The petition is **GRANTED**.

The above-identified application was filed on May 3, 2002, without an executed oath or declaration. Thomas Wong, Panagiotis Tsirigotis, Sanjay Radia, Rajeev Chawla and Omid Ahmadian were identified as joint inventors. Accordingly, on June 11, 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 from the mailing date of the notice, with extensions of time obtainable under §1.136(a).

In response, rule 47 applicants filed four declarations executed in combination by joint inventors Wong, Radia, Chawla and Ahmadian on behalf of themselves and on behalf of nonsigning inventor Tsirigotis, with the instant petition (and fee); paid the surcharge for late filing under 1.16(e); and authorized the three-month extension of time necessary to make timely the response. Rule 47 applicants maintain that status under §1.47(a) is proper because inventor Tsirigotis has refused to join in the application.

In support thereof, applicants submitted a declaration of patent attorney Kenie Ho explaining the circumstances of the presentation of the application papers to inventor Tsirigotis and his refusal to sign the application papers. Further, documentary evidence, including copies of the cover letter transmitting the application papers to inventor Tsirigotis by Federal Express to his last known address; and inventor Tsirigotis' letter in response stating that it is unable to sign the declaration because he cannot afford to spend the time necessary to properly review the 41-page patent application, and his expectation that he is reasonably compensation for taking the time to review the application were submitted.

Having considered the evidence, it is concluded that applicants have shown that inventor Tsirigotis has refused to join in the application. The declarations filed October 18, 2002, and the petition have been reviewed and found in compliance with 37 C.F.R. §§1.63 and 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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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ONE PLASTICS AVENUE
PITTSFIELD MA 01201-3697

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of
Richard W. Cruse et al. :
Application No. 10/137,463 :
Filed: April 30, 2002 :
Attorney Docket Number: 0062-OS :

This is a decision on the petition under 37 CFR 1.137(b), filed March 17, 2005, to revive the above identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the non-Final Office Action mailed September 16, 2003. A shortened statutory period of three months was set for replying to the non-Final Office Action. No extensions of time having been requested, this application became abandoned December 17, 2003. Accordingly, a Notice of Abandonment was mailed June 10, 2004.

Petitioner files the instant petition under 37 CFR 1.137(b). [1]

Additionally, there is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

This application is being forwarded to Technology Center 1712 for appropriate action on the amendment filed March 17, 2005.

---

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In 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)).

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

cc:
ADRIAN T. CALDERONE
DILWORTH & BARRESE LLP
333 EARLE OVINGTON BLVD.
UNIONDALE, NY 11553

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

Foley & Lardner
402 West Broadway, 23rd Floor
San Diego, CA 92101

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MAR 05 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 5

In re application of
Richard Agee et al.
Application No. 10/137,493
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD FOR DEBIT-TYPE TRANSACTIONS

**DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the petition filed on April 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 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 in accordance with 37 CFR 1.111 (b) and (c).

The petition filed April 30, 2002 fails to adequately meet requirement (C) above. The petition lists the class in which the pre-examination search was conducted. However, a specific listing of the field of search, by class **and** subclass, is required.

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

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

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

Applicant should promptly submit a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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

SNM/tpl: 3/4/03

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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JUN 03 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2800

Bernard L. Kleinke
Duckor Spradling & Metzger
401 West A Street
Suite 2400
San Diego, CA 92101

Paper No. 9

In re application of
Agee et al.
Application No. 10/137,493
Filed: April 30, 2002
For: RAPID TAX COLLECTION SYSTEM AND METHOD FOR DEBIT-TYPE TRANSACTIONS

: **DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on May 2, 2003, remedying the defect of the petition dated April 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; 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.

Petitioner has remedy the defect pertaining to item (C) by Applicant's Declaration stating that a search was made with certain search terms in all classes and subclasses.

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

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

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

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

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121
(703) 605-0586 (fax)

RAR/dxn: 5/28/2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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1600 TCF TOWER
121 SOUTH EIGHT STREET
MINNEAPOLIS, MN 55402

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**OFFICE OF PETITIONS**

In re Application of
Kie Y. Ahn, et al.
Application No. 10/137,499
Filed: May 2, 2002
Attorney Docket No.: 1303.050US1

ON PETITION

This is a decision on the petition, filed October 5, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on May 23, 2005, in the above-identified application, cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being referred to Technology Center AU 2812 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).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 12, 2006

TO SPE OF : ART UNIT 2812

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/137499 Patent No.: 7,045,430

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

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

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

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

SPE

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Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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401 West A Street
Suite 2400
San Deigo, CA 92101

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

| | | |
|---|---|---|
| In re application of<br>Richard Agee et al.<br>Application No. 10/137,513<br>Filed: April 30, 2002<br>For: SYSTEM FOR AND METHOD OF RAPID COLLECTION OF INCOME TAXES | :<br>:<br>:<br>:<br>: | **DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)** |

This is in response to the petition filed on April 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).

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/vdb: 5/11/04

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710 MEDTRONIC PARKWAY NE
MS-LC340
MINNEAPOLIS, MN 55432-5604

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APR 22 2005

OFFICE OF PETITIONS

In re Application of :
Laporte et al. :
Application No. 10/137,516 :
Filed: April 30, 2002 :
Title of Invention: :
IMPLANTABLE MEDICAL DEVICE AND :
PATCH SYSTEM AND METHOD OF USE :

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 5, 2004, to revive the above-identified application based upon unintentional delay. The petition is properly treated as a petition to withdraw the abandonment of the application 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 to File Missing Parts of Nonprovisional Application ("Notice"), mailed July 1, 2002. The Notice required an executed oath or declaration, and substitute drawings in compliance with 37 CFR 1.84. The Notice set a two (2) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant files the instant petition wherein Applicant avers substitute drawings were filed prior to the mail date of the Notice, and that an executed oath or declaration and two (2) month extension-of-time were filed and received in the Office as evidenced by Applicant's return-receipt postcards. In support, Applicant provides a copy of a return receipt postcard acknowledging receipt of "27 sheets of Formal Drawings" by this Office on July 8, 2002, and a return receipt postcard acknowledging receipt of , *inter alia*, a "Response to Notice of Incomplete Reply", by this Office on November 7, 2002.

Further to this, a review of Office records reveal receipt in the Office of an executed oath/declaration and a request and payment for a two (2) month extension-of-time, on October 2, 2002. As such, Applicant timely filed a proper reply to the July 1, 2002 Notice.

Accordingly, the holding of abandonment is improper and is hereby withdrawn.

The RCE fee, 395.00, has been charged to deposit account 19-3878, as authorized in the instant petition.

A refund of the petition fee, $1370.00, has been credited to deposit account 13-2546.

The application file is being referred to the Office of Initial Patent Examination for continued processing.

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

Derek L. Woods
Attorney
Office of Petitions

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Carstens Yee & Cahoon, LLP
P O Box 802334
Dallas, TX 75380

MAILED

AUG 05 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re Application of:
Edward J. Fox
Serial No. 10/137,524
Filed: May 2, 2002
For: METHOD FOR EVALUATING RETAIL LOCATIONS

**DECISION ON PETITION TO MAKE SPECIAL (ENERGY)**

This is a decision on the petition filed May 27, 2004 under 37 CFR 1.102 (c) to make the above-identified application special under the accelerated examination procedure set forth in MPEP 708.02, Section VI: Energy.

A grantable petition to make an application special under 37 C.F.R. 1.102 (c), MPEP 708.02, Section VI for an invention which materially contributes to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources must be accompanied by statements under 37 CFR 1.102 by applicant or his attorney explaining how the invention materially contributes to category (A) or (B) set forth above.

The petition states that the present invention contributes to the more efficient utilization and conservation of energy by facilitating a more efficient use of shopper's travel time by evaluating prospective commercial retail sites. However, applicant has not provided any facts in support of this statement. The petition should include an explanation describing the features and/or uses of the claimed invention which result in the conservation of energy. Additionally, the petition itself should provide all the facts necessary to render a decision. For example, it is unclear what is meant by "efficient placement" or "effectively evaluating". Additionally, making efficient use of shopper's travel time could actually use more energy as it would allow more time for other energy consuming activities. Therefore, these statements are inadequate to establish for the record the discovery or development of energy resources, or more efficient utilization and conservation of energy resources.

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

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Applicant should promptly submit a renewed petition to the

Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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

KJD/vdb 8/3/04

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8/1/06

TO SPE OF : ART UNIT 1733

SUBJECT : Request for Certificate of Correction for Appl. No.: 7033458 Patent No.: 10/137531

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**.


**HENRY RANDALL**
Certificates of Correction Branch
703-308-9390 ext.


**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

Comments: _____

SPE

1733
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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JAMES W. MCKEE, ESQ.
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP
SEVENTH FLOOR
1100 SUPERIOR AVENUE
CLEVELAND, OH 44114-2579

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FEB 03 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Hockenberry, et al. :
Application No. 10/137,542 :
Filed: May 2, 2002 :
Attorney Docket No. ESCA 2 00121 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 30, 2004, 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 4, 2003. A three month extension of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), the date of abandonment of this application is June 5, 2004. A Notice of Abandonment was mailed on July 9, 2004.

Petitioner submitted a Request For Continued Examination (RCE) on September 30, 2004, with the instant petition. However, the prosecution in the application must be closed before a RCE may be submitted. As the Office action of December 4, 2003 was not final, the submission of a RCE is not an appropriate response at this time since prosecution in the application is not closed. As such, the RCE, filed September 30, 2004 is considered improper. However, a reply to the non-final Office action was submitted with the improper RCE, the reply, an amendment, will be entered and considered under 37 CFR 1.111.

The file is being forwarded to Technology Center 3600, for review of the amendment filed September 30, 2004, *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
United States Patent and Trademark Office

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## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/30/09

TO SPE OF : ART UNIT 2617

SUBJECT : Request for Certificate of Correction for Appl. No.: 10137545 Patent No.: 7310334

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.

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

**Comments:** _____

12/23/09



DEPARTMENT OF COMMERCE Patent and Trademark Office

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SPE RESPONSE FOR CERTIFICATE OF CORRECTION

| SPE | Art Unit |
|---|---|
| | 2617 |

CHARLES N. APPIAH
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 7

Ryan, Mason & Lewis, LLP
Suite 205
1300 Post Road
Fairfield CT 06430

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JAN 2 0 2004

**OFFICE OF PETITIONS**

In re Application of:
Chen, et al.
Application No. 10/137,550
Filed: April 30, 2002
Attorney Docket No. YOR919980117US2
For: SYSTEM FOR SELECTING, ACCESSING, AND VIEWING PORTIONS OF AN INFORMATION STREAM(S) USING A TELEVISION COMPANION DEVICE

ON PETITION

This is a decision on the petition filed November 17, 2003 (certificate of mailing date November 13, 2003), entitled, "PETITION UNDER 37 CFR 1.181 TO TREAT PATENT APPLICATION SERIAL NO. 10/137,550 AS AN RCE."

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

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

Petitioner filed the instant application in response to the December 31, 2001 final Office action in parent application no. 09/063,295. Unfortunately, petitioner did not purchase a one month extension of time in the parent application. Thus, there is no copendency between the two applications. Petitioner requests that the instant application be converted to a RCE and the Office charge a retroactive one month extension of time to make the new RCE timely filed.

Petitioner chose to file a continuation application on April 30, 2002. There were no ambiguous directions or references to a RCE. Petitioner received what petitioner requested -- a new continuation application. Converting the instant application to a RCE would be, in essence, withdrawing the application because a RCE is not a new application. Once an application is filed it will generally not be withdrawn absent extraordinary circumstances.

Petitioner is attempting to correct a prosecution error in the parent case though extraordinary means in the child case.

However, petitioner has a suitable remedy on hand for his predicament, that does not require an extraordinary remedy. It is brought to petitioner's attention that justice does not require an

extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Petitioner himself recognizes the remedy in the present petition. Petitioner must revive the parent application solely for co-pendency with the instant application.

A copy of the present petition will be entered into application no. 09/063,295 and will be treated shortly.

After the mailing of this decision and the mailing of a decision in application no. 09/063,295, the instant application file will be returned to Technology Center 2600 for consideration of the amendment filed November 17, 2003 (certificate of mailing date November 13, 2003).

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

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

**By hand:** Crystal Plaza 1 Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202

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

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
P.O. Box 1450
Alexandria, VA 22313-1450
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TRASK BRITT
P O BOX 2550
SALT LAKE CITY, UT 84110

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Robert T. Rasmussen | : |
| Application No. 10/137,553 | : DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : UNDER 37 CFR 1.313(c)(2) |
| Atty Dkt No. 3850.1US (98-1106.1) | : |

This is a decision on the petition, filed December 21, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

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

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

This matter is being referred to Technology Center AU 2821 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

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JUN 30 2005
OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Robert T. Rasmussen | : |
| Application No. 10/137,553 | : DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : UNDER 37 CFR 1.313(c)(2) |
| Atty Dkt No. 3850.1US (98-1106.1) | : |

This is a decision on the petition, filed June 23, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on April 25, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This matter is being referred to Technology Center AU 2821 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

GEORGE J. NETTER, ESQ.
260 S. LOS ROBLES #216
PASADENA CA 91101

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APR 2 9 2004

OFFICE OF PETITIONS

In re Application of
Vafi Sassan
Application No. 10/137,576
Filed: May 2, 2002
Title of Invention: SWIMWEAR AND METHOD OF MANUFACTURE

DECISION ON PETITION

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

This above-identified application became abandoned for failure to timely file a reply to a non-final Office Action mailed August 21, 2003. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 22, 2003. A Notice of Abandonment was mailed on April 19, 2004.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

This application is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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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**SNELL & WILMER LLP (OC)**
**600 ANTON BOULEVARD**
**SUITE 1400**
**COSTA MESA CA 92626**

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MAY 11 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| JOSEPH NEEV | : | |
| Application No. 10/137,577 | : | DECISION ON PETITION |
| Filed: May 02, 2002 | : | |
| Attorney Docket No. YBE1-BQ59A | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 30, 2006, 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 June 24, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed March 24, 2004, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on June 25, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a payment of the issue fee of $700 and the publication fee of $300; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Accordingly, the reply to the Notice of Allowance of March 24, 2004 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 to the undersigned.

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

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

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OFFICE OF PETITIONS

In re Application of :
Alan Dane Smith, et al. :
Application No. 10/137,580 : ON PETITION
Filed: May 2, 2002 :
Attorney Docket No. 73896 :

This is a decision on the petition under 37 CFR 1.313(c)(3), filed March 11, 2004, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioners request that the application be withdrawn from issue for express abandonment. See 37 CFR 1.313(c)(3). The above-identified application is expressly abandoned in favor of a continuing application under 37 CFR 1.53(b) filed March 4, 2004.

Telephone inquiries should be directed to the undersigned at (703) 305-9220.

The file will be forwarded to Files Repository as an abandoned application.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SONNENSCHEIN NATH & ROSENTHAL
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

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JUN 23 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| David W. Moskowitz | : | |
| Application No. 10/137,592 | : | DECISION ON PETITION |
| Filed: May 2, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 60019190-1005 | : | 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 14, 2006.

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

A review of the file record indicates that the power of attorney to Tara A. Nesley, Ph. D. and all the attorneys/agents of record associated with customer No. 26263 have been revoked by the assignee of the patent application on June 19, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

This application is being referred to Technology Center AU 1634 to await a reply to the final Office action mailed March 29, 2006.

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

Amelia Au
Petitions Examiner
Office of Petitions

cc: BLACKWELL SANDERS PEPER MARTIN
720 OLIVE STREET, SUITE 2400
ST. LOUIS, MO 63101

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United States Patent and Trademark Office
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OFFICE OF PETITIONS

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

In re Application of
Borg
Application No. 10/137.599
Filed: May 1, 20020
Attorney Docket No. 07844-457001

: DECISION GRANTING LETTER

This decision is in response to Applicant's 'LETTER REGARDING PATENT TERM ADJUSTMENT (PTA) PURSUANT TO COMMENT 43 OF THE FINAL RULE (09/18/00) AT ALLOWANCE" filed on July 24, 2006 requesting that the USPTO review the PTA determination at the time of the mailing of the notice of allowance.

Applicant's letter concerning PTA is **GRANTED.** The Office will adjust the PTA calculation at the time of the mailing of the notice of allowance to reflect a determination of **739 days** of PTA. A copy of the adjusted PTA calculation is provided with this determination.

Applicant asserts that the USPTO may have granted too much PTA at the time of the notice of allowance. Applicant requests review of the PTA determination but did not provide any assert any specific reason for the discrepancy.

A review of the record reflects that applicant is correct. The Office failed to reduce the PTA for the submission of the RCE on February 27, 2006, a four-day delay pursuant to 37 CFR 1.704(b). The Office mailed the notice of allowance on November 23, 2005 and the Office received the request for the RCE along the IDS submission on February 27, 2006. The USPTO notes that the USPTO delayed by a period of 745 days pursuant to 37 CFR 1.702(a)(1). In addition, applicant delayed by a period of two days pursuant to 37 CFR 1.702(b) for the response filed on October 17, 2005. Accordingly, the correct determination of PTA at the time of the mailing of the notice of allowance is 739 (745-2-4=739 days).

The USPTO acknowledges that any delays pursuant to 37 CFR 1.702(a)(4) and 1.702(b) will be added at the time of the issuance of the patent and will be reflected in the PTA determination provided to applicant in the issue notification letter.

After the mailing of this decision, the Office will forward this application to the Office of Publications for a prompt issuance of the patent.

If applicant believes that the Office erred in calculating the PTA for reasons other than provided in this decision, applicant may provide further clarification as to the inaccuracy of such calculation.

Because applicants were providing good faith and candor notice as to the amount of PTA, no fee is being assessed.

Any questions concerning this decision should be directed to Kery Fries, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy, at 571-272-7757.

Kery A. Fries

Kery A. Fries
Senior Legal Advisor,
Office of Patent Legal Administration
Office of Deputy Commissioner
For Patent Examination Policy

cc: Adjusted PAIR calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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HALLIBURTON ENERGY SERVICES
P O BOX 819052
DALLAS, TX 75381-9052

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MAR 1 0 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| David J. Steele et al | : |
| Application No. 10/137,611 | : DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 2001-IP-006073 | : |

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

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

This matter is being referred to Technology Center AU 3672 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

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

George M. Cooper
Jones Tullar & Cooper
Eads Station
PO Box 2266
Arlington, VA 22202

COPY MAILED
MAR 03 2004
OFFICE OF PETITIONS

In re Application of
William E. Freeman
Application No. 10/137,622
Filed: May 1, 2002
Attorney Docket No. 15-0267

ON PETITION

This is a decision on the petition under 37 CFR 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 in reply to the Notice to File Corrected Application Papers mailed May 20, 2002, which set a period for reply of (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on August 21, 2002.

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

Telephone inquiries should 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

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

Receipt

**PATENT APPLICATION**

ATTORNEY DOCKET NO. 10020209-1

**IN THE**
**UNITED STATES PATENT AND TRADEMARK OFFICE**

I P E JC103
JUL 0 9 2002
PATENT & TRADEMARK OFFICE

**Inventor(s):** John F. Corson et al.

**Serial No.:** 10/137,658

**Examiner:** Unassigned

**Filing Date:** 04/30/2002

**Group Art Unit:** 1645

**Title:** READING DRY CHEMICAL ARRAYS

COPY OF PAPERS
ORIGINALLY FILED

**COMMISSIONER FOR PATENTS**
**Washington, D.C. 20231**

TRANSMITTAL LETTER FOR SUBMITTAL OF MISSING PARTS

**Sir:**

This is in response to a Notice to File Missing Parts of Application under 37 CFR 1.53(f) mailed on **06/10/2002**. Enclosed is a copy of said Notice and the following documents and fees to complete the filing requirements of the above-identified application.

(X) Executed Declaration and Power of Attorney. The above-identified application is the same application which the inventor executed by signing the enclosed declaration.

(X) Statutory basic filing fee (X) Utility $740.00 ( ) Design $330.00

(X) Additional claim fees of $ **$600.00**

(X) Missing Parts Surcharge $130.00

( ) A Petition for Extension of Time for reply to Notice of Missing Parts is attached.
- ( ) one month $110.00
- ( ) two months $400.00
- ( ) three months $920.00
- ( ) four months $1440.00

Please charge to Deposit Account **50-1078** the sum of **$1470.00**. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account **50-1078** pursuant to 37 CFR 1.25.

**(X)** A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

**John F. Corson et al.**

By

**Gordon M. Stewart**

Attorney/Agent for Applicant(s)
Reg. No. **30,528**

Date: **June 28, 2002**

Telephone No.: **(650) 485-2386**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: **June 28, 2002**

Typed Name: **Elizabeth Miller**

Signature: Elizabeth Miller

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/137,658 | 04/30/2002 | John F. Corson | 10020209-1 |

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

OIPE JC103
JUL 09 2002
PATENT & TRADEMARK OFFICE

**CONFIRMATION NO. 9433**

**FORMALITIES LETTER**

*OC000000008258565*

Date Mailed: 06/10/2002

# NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

**FILED UNDER 37 CFR 1.53(b)**

***Filing Date Granted***

COPY OF PAPERS
ORIGINALLY FILED

**Items Required To Avoid Abandonment:**

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

- The statutory basic filing fee is missing.
  *Applicant must submit $ **740** to complete the basic filing fee for a non-small entity. If appropriate, applicant may make a written assertion of entitlement to small entity status and pay the small entity filing fee (37 CFR 1.27).*
- The oath or declaration is missing.
  *A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.

**Items Required To Avoid Processing Delays:**

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

- Additional claim fees of **$600** as a non-small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

**SUMMARY OF FEES DUE:**

Total additional fee(s) required for this application is **$1470** for a Large Entity

07/16/2002 BABRAHA1 00000022 501078 10137658

01 FC:101 740.00 CH
02 FC:105 130.00 CH
03 FC:103 432.00 CH
04 FC:102 168.00 CH

- **$740** Statutory basic filing fee.
- **$130** Late oath or declaration Surcharge.
- Total additional claim fee(s) for this application is **$600**
  - **$432** for **24** total claims over 20.
  - **$168** for **2** independent claims over 3.

---

***A copy of this notice MUST be returned with the reply.***

E. Harly

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**CERAMATEC, INC.**
**2425 SOUTH 900 WEST**
**SALT LAKE CITY UT 84119**

**COPY MAILED**

APR 17 2008

**OFFICE OF PETITIONS**

In re Application of
Ashok V. Joshi et al
Application No. 10/137,661
Filed: May 1, 2002
Attorney Docket No. MIC-021054

DECISION DISMISSING PETITION
UNDER 37 CFR 1.313(a)

This is a decision on the petition under 37 CFR 1.313(a), filed April 15, 2008, requesting withdrawal of the above-identified application from issue.

The petition is **dismissed** as moot for the reasons stated below.

A review of the file record discloses that a Notice of Allowance and Fee(s) Due was mailed on February 5, 2008, with the issue fee being due on or before May 5, 2008. The issue fee in this case has not been paid.

The filing of a petition under 37 CFR 1.313(a) is unnecessary, since the mere filing of an RCE and submission will effectively withdraw an application from issue prior to payment of the issue fee. In view thereof, the petition to withdraw from issue is dismissed as involving a moot issue. *Note* MPEP §§ 706.07(h)(IX) and 1308.

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.

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

The matter is being referred to Technology Center AU 3763 for appropriate processing of the RCE filed April 15, 2008, and for consideration of the concurrently filed IDS.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Diane Reed
Reed & Eberle, LLP
800 Menlo Avenue, Suite 210
Menlo Park, CA 94025

**COPY MAILED**

**AUG 21 2003**

**OFFICE OF PETITIONS**

ON PETITION

In re Application of
Cleary et al.
Application No. 10/137,664
Filed: May 1, 2002
Attorney Docket No. 2335-0008
For: Hydrogel Compositions

This is a decision in response to the paper filed June 13, 2003, which is being treated as a petition under 37 CFR 1.181 to vacate the revocation of the power of attorney mailed February 10, 2003.

The petition is **granted** to the extent indicated below.

The application was filed without an oath or declaration. Therefore, the address listed on the transmittal papers became the correspondence address of record.

A declaration has been filed, but the declaration does not request a change of address or give any practitioners a power of attorney.

A power of attorney seeking to empower Diane Reed and others has been filed, but the power of attorney is only signed by two of the inventors. Since the power of attorney is not signed by all the inventors, the power of attorney cannot be entered and therefore cannot be revoked.

A power of attorney seeking to empower David E. Newhouse and requesting that a copy of all correspondence be sent to David E. Newhouse has been filed. However, the paper is only signed by one of the three inventors and therefore cannot be entered.

MPEP 402.10 states,

> To give or revoke power of attorney without signatures of all applicants or owners, must file petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. The petition should be directed to the Office of Petitions.
>
> The acceptance of such papers by petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent replies submitted to the Office. See In re Goldstein, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). Upon accepting papers appointing and/or revoking a power of attorney that are signed by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent replies. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent replies and the paper number(s) where the split powers of attorney appear. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at

least one applicant or owner prosecuting the application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree.

Petitioner should file a petition under 37 CFR 1.182 signed by an attorney for each inventor (for example by Diane Reed and David Newhouse) along with the fee of $130. The Office will not engage in dual correspondence so the parties should decide the address to which future correspondence should be mailed. If the parties cannot agree on a correspondence address, then all future correspondence will be mailed only to the address listed at the top of the instant decision.

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

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

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

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

The file will be retained in the Office of Petitions to await the filing of a petition under 37 CFR 1.182.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

cc: David E. Newhouse, Esq.
Newhouse & Associates
477 Ninth Avenue 112
San Mateo, CA 94402-1858

UNITED STATES 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

Diane Reed
Reed & Eberle, LLP
800 Menlo Avenue, Suite 210
Menlo Park, CA 94025

COPY MAILED
NOV 03 2003
OFFICE OF PETITIONS

In re Application of :
Cleary et al. :
Application No. 10/137,664 :
Filed: May 1, 2002 :
Attorney Docket No. 2335-0008 :
For: Hydrogel Compositions

ON PETITION

This is a decision in response to petition under 37 CFR 1.182 filed October 20, 2003, which is being treated as a petition under 37 CFR 1.182 to allow prosecution by two sets of attorneys.

The petition is **granted**.

MPEP 402.10 states,

> To give or revoke power of attorney without signatures of all applicants or owners, must file petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. The petition should be directed to the Office of Petitions.
>
> The acceptance of such papers by petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent replies submitted to the Office. See In re Goldstein, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). Upon accepting papers appointing and/or revoking a power of attorney that are signed by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent replies. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent replies and the paper number(s) where the split powers of attorney appear. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at least one applicant or owner prosecuting the application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree.

The power of attorney to Diane Reed and other members of her firm has been entered. The power of attorney to David E. Newhouse has been entered. All future papers must include the signature of David Newhouse and Diane Reed (or a member of her firm).

All future correspondence will be sent to the address above.

The Office notes that a petition under 37 CFR 1.48 was filed by Diane Reed prior to the filing of the instant petition. The Office will enter the paper even though the paper is signed by only Diane Reed. However, all future papers must be signed by both attorneys.

The file will now be forwarded to Technology Center 1600 for consideration of the petition under 37 CFR 1.48.

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

Mailed: MAR 18 2004

WAK
Paper Number 15

In re application of
Hideaki Hirabayashi, et al.
Serial No. 10/137,679
Filed: May 3, 2002
For: COPPER-BASED METAL POLISHING SOLUTION AND METHOD FOR MANUFACTURING SEMICONDUCTOR DEVICE

DECISION ON PETITION

This is a decision from the applicants' PETITION filed on September 12, 2003. This PETITION is being treated as a PETITION UNDER 37 CFR 1.181(a)(3) requesting that the Office invoke its supervisory authority in this application and acknowledge consideration of the cited JPOA dated April 3, 2001 that was filed on PTO-Form 1449 on May 3, 2002. Applicants further request that the Examiner consider the JPOA that was submitted on September 24, 2002 but was not listed on PTO-form-1449. The Examiner did consider all the references that were cited on the form. Applicants also request entry of the SADS that was filed September 12, 2003. The application was allowed on June 17, 2003 .

**DECISION**

The Examiner will consider the cited JPOA that was filed on PTO-form-1449 on May 3, 2002. The SADS filed September 12, 2003 will be entered. The Examiner will not consider the JPOA that was submitted on September 24, 2002 but not listed on PTO-form-1449 (see 37 C.F.R. 1.98(a)(1) and(b)(4)(5).

1.98 Content of information disclosure statement.
(a) Any information disclosure statement filed under § 1.97 shall include:
(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(b)
(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

10/137,679

The PETITION is **granted-in-part and denied-in-part.**

The application will be forwarded to the Examiner for consideration of the JPOA date April 3, 2001 and for entry of the SADS filed September 12, 2003.

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

Oblon, Spivak, McClelland Maier & Neustadt PC
1940 Duke Street
Alexandria, Virginia 22314

OIPE JC180
APR 0 5 2004
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220446US0SDA

RECEIVED: 3-22-04
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 3-22-04
Type of Resp(s): _____
Due Date(s): _____

Mailed: MAR 1 8 2004

WAK
Paper Number __

In re application of
Hideaki Hirabayashi, et al.
Serial No. 10/137,679
Filed: May 3, 2002
For: COPPER-BASED METAL POLISHING SOLUTION AND METHOD FOR MANUFACTURING SEMICONDUCTOR DEVICE

DECISION ON PETITION

RECEIVED
JUL 0 6 2004
TC 1700

This is a decision from the applicants' PETITION filed on September 12, 2003. This PETITION is being treated as a PETITION UNDER 37 CFR 1.181(a)(3) requesting that the Office invoke its supervisory authority in this application and acknowledge consideration of the cited JPOA dated April 3, 2001 that was filed on PTO-Form 1449 on May 3, 2002. Applicants further request that the Examiner consider the JPOA that was submitted on September 24, 2002 but was not listed on PTO-form-1449. The Examiner did consider all the references that were cited on the form. Applicants also request entry of the SADS that was filed September 12, 2003. The application was allowed on June 17, 2003 .

**DECISION**

The Examiner will consider the cited JPOA that was filed on PTO-form-1449 on May 3, 2002. The SADS filed September 12, 2003 will be entered. The Examiner will not consider the JPOA that was submitted on September 24, 2002 but not listed on PTO-form-1449 (see 37 C.F.R. 1.98(a)(1) and(b)(4)(5).

1.98 Content of information disclosure statement.
(a) Any information disclosure statement filed under § 1.97 shall include:
(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(b)
(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

COPY

10/137,679

The PETITION is **granted-in-part and denied-in-part.**

The application will be forwarded to the Examiner for consideration of the JPOA date April 3, 2001 and for entry of the SADS filed September 12, 2003.

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

Oblon, Spivak, McClelland Maier & Neustadt PC
1940 Duke Street
Alexandria, Virginia 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 2 3 2004

| | | |
|---|---|---|
| In re Application of<br>Hideaki HIRABAYASHI, et al.<br>Serial No. 10/137,679<br>Filed: May 3, 2002<br>For: COPPER-BASED METAL POLISHING SOLUTION AND METHOD FOR MANUFACTURING SEMICONDUCTOR DEVICE | :<br>:<br>:<br>:<br>:<br>:<br>:<br>: | NOTICE OF WITHDRAWAL<br>FROM ISSUE<br>UNDER 37 CFR 1.313(b) |

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

The above-identified application is hereby withdrawn from issue.

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

Telephone inquiries should be directed to at Nadine Norton (571) 272-1465.

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

Oblon Spivak McClelland
Maier & Neustadt, PC
1940 Duke Street
Alexandria, VA 22314

cc: Allowed Files—Pk3-915

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

THOMAS L. ADAMS, ESQ
120 EAGLE ROCK AVENUE
P O BOX 340
EAST HANOVER NJ 07936

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MAR 2 4 2003

OFFICE OF PETITIONS

In re Application of
Aziz Hassan et al
Application No. 10/137,689
Filed: May 3, 2002
Attorney Docket No. BSN5

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.137(f)

This is a decision on the petition, filed March 11, 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 January 2, 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). However, while the statement of unintentional delay does not comply with the rule, the statement presented will be

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construed as meaning that "the entire delay in filing the required reply [Notice to Rescind Previous Nonpublication Request Under 35 U.S.C. § 122(b)(2)(B)(ii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice of Acceptance of Publication Request which sets forth the projected publication date of July 10, 2003 accompanies this decision on petition.

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

This application is being forwarded to Technology Center Art Unit 1762 for examination in due course.

Frances Hicks

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

ATTACHMENT: Notice of Acceptance of Publication Request

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper N .: _____

DATE : May 12, 2006

TO SPE OF : ART UNIT 1755 (S.P.E. Jerry Lorengo)

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/137689 Patent No.: 6,811,824

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 see the spec.**

STACY POWELL

**Certificates of Correction Branch**

**703-308-9390 ext.** 120

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

SUPERVISORY PATENT EXAMINER

**SPE**

1755

**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
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AGILENT TECHNOLOGIES, INC.
LEGAL DEPARTMENT, DL429
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 7599
LOVELAND CO 80537-0599

**COPY MAILED**

DEC 19 2003

**OFFICE OF PETITIONS**

In re Application of
Marvin Glenn Wong
Application No. 10/137,691
Filed: May 2, 2002
Attorney Docket No.10010448-1

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 4, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 28, 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 relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being referred to Technology Center AU 2834 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

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ALEXANDRIA, VA 22313-14
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**AGILENT TECHNOLOGIES, INC.**
**LEGAL DEPARTMENT, DL429**
**INTELLECTUAL PROPERTY ADMINISTRATION**
**P.O. BOX 7599**
**LOVELAND, CO 80537-0599**

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DEC 2 2 2003

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Arthur Fong et al | : | |
| Application No. 10/137,692 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. 10011329-1 | : | |

This is a decision on the petition, filed December 4, 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 July 28, 2003 in the above-identifi d 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.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 145
ALEXANDRIA, VA 22313-145
www.uspto.g

Paper No. _____

Date : December 22, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Arthur Fong et al
Application No. : 10/137,692
Filed : May 2, 2002

The above-identified application has been assigned Patent No. 6,674,218 and an issue date of January 6, 2004.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of January 6, 2004:

> "All reference to Patent No. 6,674,218 to Arthur Fong et al of Colorado Springs, CO, for SOLID SLUG LONGITUDINAL PIEZOELECTRIC LATCHING RELAY appearing in the Official Gazette of January 6, 2004 should be deleted since no patent was granted."

Wan Laymon
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, Crystal Park 3-910

UNITED STATES
PATENT AND
TRADEMARK OFFICE

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

DEC 18 2002

#7

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON MA 02110

| | |
|---|---|
| In re Application of | : |
| Ching Song et al | : |
| Serial No.: 10/137,695 | : PETITION TO MAKE SPECIAL |
| Filed: May 2, 2002 | : |
| Attorney Docket No.: 10634-004001 | : |

This is in response to applicants' petition filed September 26, 2002, 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. 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) 305-3599.

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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Paper No. None

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
4 EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111

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**OFFICE OF PETITIONS**

In re Application of
Gary Blackburn et al.
Application No. 10/137,710
Filed: April 30, 2002
Attorney Docket Number: A-70476-3
(463037-00239)/
Title: NUCLEIC ACID REACTIONS USING LABELS WITH DIFFERENT REDOX POTENTIALS

DECISION ON PETITION UNDER 37 C.F.R. §1.78(A)(3)

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed on August 16, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed application number 09/626,096, filed on July 26, 2000, 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 application 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 above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the 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 questions concerning this matter may be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

This application is being forwarded to Technology Center Art Unit 1600 for appropriate action on the amendment submitted concurrently with this petition, including consideration by the examiner of the claim under 35 U.S.C. § §120 and 37 CFR 1.78(a)(2) for the benefit of the prior-filed application.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

Encl. Corrected filing receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAPER NO. 14

HAYNES AND BOONE, LLP
1000 LOUISIANA
SUITE 4300
HOUSTON TX 77002

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AUG 27 2003

OFFICE OF PETITIONS

In re Application of
Vasyl V. Molebny, et al.
Application No. 10/137,720
Filed: May 1, 2002
Attorney Docket No. 29750.18

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed by facsimile transmission on August 25, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 14, 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 relating to this decision should be directed to the undersigned at (703) 305-9220.

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 3737 for further processing of the request for continued examination under 37 CFR 1.114.

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

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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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JAN 19 2007

Technology Center 2100

Hans R. Troesch
FISH & RICHARDSON, P.C.
P.O. BOX 1022
Minneapolis, MN 55440-1022

In re Application of:
Brian McKellar et al.
Application No. 10/137,727
Filed: April 30, 2002
For: DELTA-HANDLING IN SERVER-PAGES

**DECISION ON PETITION**

This is a decision on the petition, filed on 27 October 2006, requesting withdrawal of the Notification of Non-Complaint Appeal Brief mailed 13 October 2006.

A review of the application indicates that (1) the Appeal Brief filed on 05 October 2006 failed to include the status of claims 7, 9-10, 13 and 15-16 as required under 37 CFR 41.37(c)(1)(iii); thus, the Notification of Non-complaint Appeal Brief mailed 13 October 2006 was not a mistake and (2) the Appeal Brief filed on 27 October 2006 did include the status of claims 7, 9-10, 13 and 15-16 as been canceled; the Appeal Brief filed on 27 October 2006 is now complied with all provisions of 37 CFR 41.37 and is ready for examiner's consideration.

For the above stated reasons, the petition is **DISMISSED AS MOOT**.

The application has been forwarded to examiner of record to consider the Appeal Brief filed on 27 October 2006 and issue an appropriate Office Action.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

Vincent N. Trans, WQAS
Technology Center 2100
Computer Architecture, Software, and
Information Security

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Paper No. 6

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& CREW LLP
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JUL 2 4 2003

OFFICE OF PETITIONS

In re Application of
Liddy
Application No. 10/137,740
Filed: April 30, 2002
Attorney Docket No. 017704-001012US

ON PETITION

This decision concerns the June 27, 2003 petition under 37 CFR 1.47(b) and the concurrently filed petition under 37 CFR 1.137(b).

The petition under 37 CFR 1.47(b) is **DISMISSED.**
The petition under 37 CFR 1.137(b) is **DISMISSED.**

## Background

The application was filed with an unexecuted declaration. On June 4, 2002, a Notice to File Missing Parts of Nonprovisional Application was mailed, setting forth an extendable 2-month period for submitting, *inter alia*, a proper oath or declaration.[1]

No reply was filed on or before January 6, 2003 (Monday), and no extension of time under 37 CFR 1.136(a) was obtained. The application became abandoned on August 5, 2002.

## Petition under 37 CFR 1.47(b)

The application names a sole inventor, Elizabeth D. Liddy ("Liddy"). According to the petition, Liddy's former employer Textwise Company, LLC ("Textwise") acquired certain interest in the instant claimed invention from Liddy under an employment agreement executed in 1996. Apparently, Textwise assigned its entire rights in the invention claimed in application No. 09/942,027, the parent of the instant application, to Technology Innovations, LLC ("Technology Innovations") on June 10, 2002.

The petition under 37 CFR 1.47(b) encloses a declaration signed by an officer of Technology Innovations ("June 27, 2003 Declaration"), asserting that Liddy refuses to sign the declaration, and requesting that Technology Innovations be allowed to file this application on behalf of, and as agent for, Liddy.

---

[1] Also missing were the application basic filing fee and extra claims fees.

Under 37 CFR 1.47(b), in the instant case, Technology Innovations may do so provided it can be **shown** that:

(1) Liddy made the instant claimed invention, which is also the subject matter of the June 10, 2002 assignment, while employed by Textwise;[2] or,

(2) Liddy has assigned, or has agreed in writing to assign, the claimed invention to Textwise;[3] or,

(3) Textwise otherwise had sufficient proprietary interest in the instant claimed invention when executing the June 10, 2002 assignment.[4]

The instant petition encloses a document that appears to describe the instant claimed invention. This document is not signed and does not aid in proving that Liddy made (conceived; reduced to practice) the instant claimed invention while employed by Textwise. Consequently, the petition fails to establish a chain of title from Liddy to Technology Innovations to enable the latter to file this application on behalf of, and as agent for, Liddy. The §1.47(b) petition is thus dismissed. The June 27, 2003 Declaration is not accepted.

**Petition under 37 CFR 1.137(b)**

Under 37 CFR 1.137(b), a grantable petition to revive an abandoned application must be accompanied by: (1) **the required reply**,[5] 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 its due date until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer and the accompanying fee, as required by 37 CFR 1.137(d), for a utility application filed before June 8, 1995.[6]

---

[2] This may be proved, e.g., through a **statement of a person having firsthand knowledge of the fact that the claimed invention was made by Liddy while employed by Textwise**, e.g., someone who worked with Liddy on the project. Evidently, the statement must include facts such as when Liddy was employed by Textwise. See MPEP section 409.03(f) (Rev. 1, Feb. 2003).

[3] E.g., an agreement specifically identifying the instant claimed invention as the subject matter transferred to Textwise from Liddy. An agreement that is of a general nature and does not refer to the claimed invention through either a description of the invention, the title of the invention, or the application serial number will not suffice.

[4] See also MPEP sections 409.03(b), (f) (Rev. 1, Feb. 2003).

[5] Generally, the required reply is the reply sufficient to have avoided abandonment had it been timely filed. In the instant case, the required reply includes a properly executed oath/declaration or at least one accepted under a granted §1.47 petition, the application basic filing fee, and extra claims fees. See MPEP section 711.03(c)(III)(A) (Rev.1, Feb. 2003).

[6] Not applicable to this application.

Here, the cause of abandonment was non-filing of the missing items, including a proper oath/declaration, on or before the set deadline. The petition authorizes the Office to charge the $650 petition fee (small entity), the application basic filing fee, and the extra claims fees to Deposit Account No. 20-1430. Given that the June 27, 2003 Declaration is not accepted as discussed above, the petition to revive is dismissed for failing to meet the threshold requirement of 37 CFR 1.137(b).

## Options

A renewed §1.137(b) petition (no fee) must be filed within **TWO MONTHS** of the mailing date of this decision,[7] and be accompanied by:

(A) -an oath/declaration, properly signed by Liddy; **or**,

-a renewed §1.47(b) petition (no fee) that includes appropriate statement(s) of facts and accompanying evidence as indicated above;

(B) a statement that the entire delay in filing a proper oath or declaration from its due date until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The renewed petition(s) should be addressed as follows:

by mail/by hand: Commissioner for Patents, USPTO
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax: (703) 308-6916
Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

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[7] Extensions of time under 37 CFR 1.136(a) are permitted. However, intentionally delaying the filing of that petition may result in its denial.

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& CREW LLP
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SAN FRANCISCO, CA 94111

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OFFICE OF PETITIONS

In re Application of
Liddy
Application No. 10/137,740
Filed: April 30, 2002
Attorney Docket No. 017704-001012US

: DECISION ACCORDING
: STATUS UNDER
: 37 CFR 1.47(b)

This decision concerns the October 1, 2003 renewed petition under 37 CFR 1.47(b) and the concurrently filed renewed petition under 37 CFR 1.137(b).

The petition under 37 CFR 1.47(b) is **GRANTED.**
The petition under 37 CFR 1.137(b) is **GRANTED.**

**Renewed petition under 37 CFR 1.47(b)**

The previous petition under 37 CFR 1.47(b), filed on June 27, 2003, was dismissed on July 24, 2003 for lacking sufficient showing that the §1.47(b) applicant, Technology Innovations, owns the entire interest in the instant claimed invention to enable it to file this application on behalf of, and as agent for, the sole inventor, Elizabeth D. Liddy.

The exhibits accompanying the instant renewed petition indicate that:

-Elizabeth D. Liddy made the claimed invention while employed by Textwise Company, LLC ("Textwise");

-In a 1996 employment agreement with Textwise, Elizabeth D. Liddy agreed to assign, to Textwise, all her rights in the inventions made by her during her employment at Textwise;

-The entire interest in this invention was transferred, in June of 2002, from Textwise to Technology Innovations, and does not appear to have been further assigned.

In addition, on October 11, 2002, Technology Innovations' outside counsel mailed Elizabeth D. Liddy, *inter alia*, a copy of this application. Apparently, as of September 24, 2003, when the instant renewed petition was being prepared for filing, counsel did not receive any reply from Elizabeth D. Liddy. The Office concludes that Elizabeth D. Liddy refuses to sign the application declaration, and that Technology Innovations is the proper party for filing this application on

behalf of, and as agent for, Elizabeth D. Liddy. The declaration signed by an officer of Technology Innovations and submitted with the June 27, 2003 petition is hereby accepted. The §1.47(b) petition is thus granted.

The application is now complete.

As provided in 37 CFR 1.47(c), the Office will forward notice of the filing of this application to Elizabeth D. Liddy at her last known address indicated in the June 27, 2003 petition:

104 Victoria Place
Syracuse, NY 13210

Notice of the filing of this application will also be published in the *Official Gazette*.

**Renewed petition under 37 CFR 1.137(b)**

On July 24, 2003, the concurrently filed §1.137(b) petition was also dismissed for lacking a proper oath or declaration in response to the June 4, 2002 Notice to File Missing Parts.

Given that the June 27, 2003 declaration has been accepted upon grant of the renewed §1.47(b) petition, the renewed §1.137(b) petition is also granted.

The application file is being forwarded to Technology Center 2100 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

017704-001012US
H -N, SF

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& CREW LLP
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OFFICE OF PETITIONS

In re Application of
Liddy
Application No. 10/137,740
Filed: April 30, 2002
Attorney Docket No. 017704-001012US

: DECISION ACCORDING
: STATUS UNDER
: 37 CFR 1.47(b)

This decision concerns the October 1, 2003 renewed petition under 37 CFR 1.47(b) and the concurrently filed renewed petition under 37 CFR 1.137(b).

The petition under 37 CFR 1.47(b) is **GRANTED.**
The petition under 37 CFR 1.137(b) is **GRANTED.**

**Renewed petition under 37 CFR 1.47(b)**

The previous petition under 37 CFR 1.47(b), filed on June 27, 2003, was dismissed on July 24, 2003 for lacking sufficient showing that the §1.47(b) applicant, Technology Innovations, owns the entire interest in the instant claimed invention to enable it to file this application on behalf of, and as agent for, the sole inventor, Elizabeth D. Liddy.

The exhibits accompanying the instant renewed petition indicate that:

-Elizabeth D. Liddy made the claimed invention while employed by Textwise Company, LLC ("Textwise");

-In a 1996 employment agreement with Textwise, Elizabeth D. Liddy agreed to assign, to Textwise, all her rights in the inventions made by her during her employment at Textwise;

-The entire interest in this invention was transferred, in June of 2002, from Textwise to Technology Innovations, and does not appear to have been further assigned.

In addition, on October 11, 2002, Technology Innovations' outside counsel mailed Elizabeth D. Liddy, *inter alia*, a copy of this application. Apparently, as of September 24, 2003, when the instant renewed petition was being prepared for filing, counsel did not receive any reply from Elizabeth D. Liddy. The Office concludes that Elizabeth D. Liddy refuses to sign the application declaration, and that Technology Innovations is the proper party for filing this application on

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behalf of, and as agent for, Elizabeth D. Liddy. The declaration signed by an officer of Technology Innovations and submitted with the June 27, 2003 petition is hereby accepted. The §1.47(b) petition is thus granted.

The application is now complete.

As provided in 37 CFR 1.47(c), the Office will forward notice of the filing of this application to Elizabeth D. Liddy at her last known address indicated in the June 27, 2003 petition:

104 Victoria Place
Syracuse, NY 13210

Notice of the filing of this application will also be published in the *Official Gazette*.

**Renewed petition under 37 CFR 1.137(b)**

On July 24, 2003, the concurrently filed §1.137(b) petition was also dismissed for lacking a proper oath or declaration in response to the June 4, 2002 Notice to File Missing Parts.

Given that the June 27, 2003 declaration has been accepted upon grant of the renewed §1.47(b) petition, the renewed §1.137(b) petition is also granted.

The application file is being forwarded to Technology Center 2100 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
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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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION - WEST BLDG.
WINTON HILL BUSINESS CENTER - BOX 412
6250 CENTER HILL AVENUE
CINCINNATI OH 45224

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bruce Barger et al | : | |
| Application No. 10/137,748 | : | DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 8919 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed August 2, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of 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 of March 26, 2007, is accepted as having been unintentionally delayed.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

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

Karen Creasy
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

**TRASK BRITT**
**P.O. BOX 2550**
**SALT LAKE CITY UT 84110**

In re Application of
Warren M. Farnworth et al
Application No. 10/137,766
Filed: May 2, 2002
Attorney Docket No. 3400.6US(97-709.6)

ON PETITION

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 October 14, 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 2827 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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AUG 31 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Michael Best & Friedrich, LLP
100 E Wisconsin Avenue
Milwaukee, WI 53202

In re Application of
Herve H. Dourlens et al.
Application No. 10/137,767
Filed: May 2, 2002
For: BEARING ASSEMBLY AND METHOD

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

This is a decision on applicants' petition to withdrawal the holding of abandonment filed on July 27, 2004.

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

☒ Postcard receipt being dated January 23, 2004.

☐ USPTO return facsimile receipt dated _____, which references the application by serial number and the amendment that was filed on that date.

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

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

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

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

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

SNM/vdb: 8/26/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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J. SCOTT EDWARDS
557 NORTH PARK AVENUE
EASTON, CT 00612

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JAN 25 2006

**OFFICE OF PETITIONS**

In re Application of :
J. Scott Edwards :
Application No. 10/137,845 :
Filed: May 1, 2002 :
Attorney Docket No. N/A :

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed July 6, 2005, to withdraw the holding of abandonment. The petition was recently forwarded to this office for consideration.

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 "Request For Reconsideration of Petition under 37 CFR 1.181."

This application became abandoned for failure to timely reply to the non-final Office action mailed November 4, 2004. Accordingly, this application became abandoned on February 5, 2005. A Notice of Abandonment was mailed on June 14, 2005.

Petitioner contends a timely response was submitted to the Office on February 3, 2005. In support, the petition is accompanied by a copy a USPS "Postal Service Delivery Confirmation Receipt" that indicates an item was mailed via Priority Mail from the Bridgeport, CT Eastern Branch post office on February 3, 2005, and a copy of the papers purportedly deposited on that date.

It is noted that the "Postal Service Delivery Confirmation Receipt" does not identify what was sent, nor does it indicate an acknowledgment of receipt by the USPTO. Additionally, the "Postal Service Delivery Confirmation Receipt" and USPS Priority Mail service are not recognized by the USPTO for filing date purposes on the submission of documents.

The Office has a well established and well publicized practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the

paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. *See* MPEP 503.

Additionally, under 37 CFR 1.8, a person may state on certain papers directed to the Office (some exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for reply, the reply in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply. *See* MPEP 512.

Lastly, please note, 37 CFR 1.10, states, in part:

37 CFR 1.10 Filing of correspondence by "Express Mail".

> (a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.
>
> (2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

Also *see* MPEP 513.

It is noted that petitioner did not make use of any of the above-listed provisions in the submission of their documents.

Accordingly, the petition must be <u>dismissed</u>.

Petitioner should consider filing a petition to revive an abandoned application 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
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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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PATENT LAW GROUP LLP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE CA 95134

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JUN 12 2006

OFFICE OF PETITIONS

In re Application of :
Chiang, et al. :
Application No. 10/137,855 : ON PETITION
Filed: May 3, 2002 :
Attorney Docket No. PA2413US :
For: CONTINUOUS METHOD FOR DEPOSITING A FILM BY MODULATED ION-INDUCED ATOMIC LAYER DEPOSITION (MII-ALD)

This is a decision on the petition under 37 CFR 1.137(b), filed October 22, 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)." Petitioner is advised that this is not a final agency decision.

This application became abandoned for failure to timely reply to the final Office action, mailed February 19, 2003, which set an extendable three month period for reply. No extensions of time being obtained and no reply being filed, the application became abandoned on May 20, 2003. A Notice of Abandonment was mailed on October 8, 2003.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed.;

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

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The 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.

Petitioners are reminded that after a final Office action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (5) an RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's rejections, and thus place the case in *prima facie* condition for allowance. Examiner Timothy H. Meeks has indicated that the reply filed October 22, 2004 fails to place the application in *prima facie* condition for allowance. Please see the enclosed Advisory Action Before the Filing of an Appeal Brief for more details.

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

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

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

**By FAX:** (571) 273-8300 – ATTN: Office of Petitions

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

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

Enclosure: Advisory Action Before the Filing of an Appeal Brief

UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT LAW GROUP LLP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE CA 95134

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OCT 2 6 2006

OFFICE OF PETITIONS

In re Application of :
Chiang, et al. :
Application No. 10/137,855 :
Filed: May 3, 2002 :
Attorney Docket No. PA2413US :
For: CONTINUOUS METHOD FOR DEPOSITING A FILM BY MODULATED ION-INDUCED ATOMIC LAYER DEPOSITION (MII-ALD)

ON PETITION

This is a decision on the reconsideration petition under 37 CFR 1.137(b), filed July 5, 2006, to revive the above-identified application.

The petition is **dismissed**.

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

This application became abandoned for failure to timely reply to the final Office action, mailed February 19, 2003, which set an extendable three month period for reply. No extensions of time being obtained and no reply being filed, the application became abandoned on May 20, 2003. A Notice of Abandonment was mailed on October 8, 2003.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed.;

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

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may

require additional information where there is a question whether the delay was unintentional; and

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

The instant petition does not satisfy requirement (1) above.

The terminal disclaimer filed with the present petition has been approved. However, petitioners did not cancel the claims that were withdrawn from consideration (66 and 67) in the restriction set forth in the final rejection (election was by original presentation). Petitioners must cancel claims 66 and 67 before the petition can be granted.

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

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

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

**By FAX:** (571) 273-8300 – ATTN: Office of Petitions

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

Shirene Willis Brantley

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
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PATENT LAW GROUP LLP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE CA 95134

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SEP 17 2007

**OFFICE OF PETITIONS**

In re Application of :
Chiang, et al. :
Application No. 10/137,855 : ON PETITION
Filed: May 3, 2002 :
Attorney Docket No. PA2413US :
For: CONTINUOUS METHOD FOR DEPOSITING A FILM BY MODULATED ION-INDUCED ATOMIC LAYER DEPOSITION (MII-ALD)

This is a decision on the reconsideration petition under 37 CFR 1.137(b), filed November 8, 2006, 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 February 19, 2003, which set an extendable three month period for reply. No extensions of time being obtained and no reply being filed, the application became abandoned on May 20, 2003. A Notice of Abandonment was mailed on October 8, 2003.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioners have supplied (1) the reply in the form of an amendment that *prima facie* places the application in condition for allowance, (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) 272-3230.

This application is being referred to Technology Center AU 1762 for appropriate action by the Examiner in the normal course of business on the reply received November 8, 2006.

Telephone inquiries concerning this decision 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
WASHINGTON, D.C. 20231
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Paper No. 11

MEDTRONIC AVE, INC.
3576 UNOCAL PLACE
SANTA ROSA CA 95403

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SEP 1 2 2002

OFFICE OF PETITIONS

In re Application of
Fifer
Application No. 10/137,909
Filed: June 20, 2002
Attorney Docket No.: PA 1064US
FOR: STENT DELIVERY CATHETER
WITH RETENTION BANDS

ON
PETITION

This is a decision on the petition under 37 CFR 1.182, filed June 20, 2002, requesting that the above-identified application be accorded a filing date as of the date of submission of omitted Figures 7, 8, and 9. In addition, this decision will address the petition under 37 CFR 1.28, filed August 13, 2002, to change entity status and submit a fee deficiency.

The petition under 37 CFR 1.182 is **GRANTED**.

The petition under 37 CFR 1.28(c) is **GRANTED**.

The application was filed on May 3, 2002. On June 13, 2002, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application (Notice) informing petitioner that Figures 7, 8, and 9 appeared to have been omitted and a signed oath with surcharge was required.

In response to the Notice, a petition under 37 CFR 1.182, including 2 sheets of drawings containing Figures 1,2 3,4,5,6,7,8, and 9 was filed on June 20, 2002. An acceptable supplemental declaration and surcharge for its late filing was submitted on July 16, 2002. Petitioner's request that the above-identified application be accorded a filing date as of June 20, 2002, the date of deposit of the items noted as omitted in the Notice mailed June 13, 2002, is **granted**.

However, there is some question as to which figures petitioner desires to include among the official drawing figures for this application. Petitioner filed two sheets of drawings with the instant petition. Drawing figures 2,3,4,5, and 6, filed on May 3, 2002, while found also in drawing figures filed on June 20, 2002, are <u>not labeled in the same order</u>. Petitioner should determine whether the drawing figures filed on June 20, 2002 should supplant those filed on May 3, 2002 in their entirety. If so, petitioner should (1) inform the Office that the drawing figures filed on June 20, 2002 are those that petitioner wants to be used in examination, (2) file a preliminary amendment canceling the drawing figures filed on May 3, 2002 and (3) alter the specification if necessary.

Petitioner filed a request for acceptance of a fee deficiency submission under 37 CFR 1.28(c) on filed August 13, 2002 (certificate of mailing date August 8, 2002).

37 CFR 1.28(c) states: "The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full." Accordingly, the fee deficiency submission under 37 CFR 1.28 is hereby **accepted**.

The change of status to a large entity has been entered and made of record.

The application file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of June 20, 2002.

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
P.O. Box 1450
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Crockett & Crockett
Suite 400
24012 Calle De La Plata
Laguna Hills, CA 92653

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OFFICE OF PETITIONS

In re Application of Bloom et al. :
Application No. 10/137,910 : Decision on Petition
Filing Date: May 23, 2002 :
Attorney Docket No. 212/390 :

This is a decision on the petition under 37 CFR 1.137(a) and the petition under 37 CFR 1.137(b) filed June 13, 2006, to revive the above-identified application.

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

A decision on the petition under 37 CFR 1.137(b) will be **held in abeyance**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 22, 2005, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on October 22, 2005. A Notice of Abandonment was mailed May 19, 2006.

The petition under 37 CFR 1.137(a):

A delay resulting from an error, such as a typographical error or 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. The showing must demonstrate 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.

The petition states,

> The docketing paralegal is well trained and experienced with regard to the function and routine for logging in the correspondence and docketing and calendaring.

The petition fails to fully discuss the experience of the paralegal? For example, how many years had she worked at the law firm and how many years had she been performing the docketing and calendaring? Any request for reconsideration should fully discuss the reasons reliance on the paralegal was reasonable.

The petition under 37 CFR 1.137(b):

The current showing under 37 CFR 1.137(a) indicates a high likelihood that a request for reconsideration under 37 CFR 1.137(a) will be granted. Therefore, *as a courtesy*, the Office will hold a decision on the petition under 37 CFR 1.137(b) in abeyance.

Fees:

The fee required for a petition under 37 CFR 1.137(a) is $250 rather than $55. Therefore, $250 has been charged to petitioner's deposit account.

Since the merits of the petition under 37 CFR 1.137(b) have not been considered as of this date, the $750 fee for the petition has not been charged to petitioner's deposit account.

Payment for an extension of time is unnecessary when filing a petition to revive under 37 CFR 1.137. Therefore, the $1,080 charged to petitioner's deposit account for a 5 month extension of time will be credited back to the deposit account.

Time limit for Reconsideration:

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(a) and 137(b)."

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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OFFICE OF PETITIONS

Crockett & Crockett
Suite 400
24012 Calle De La Plata
Laguna Hills, CA 92653

In re Application of Bloom et al. :
Application No. 10/137,910 : Decision on Petition
Filing Date: May 23, 2002 :
Attorney Docket No. 212/390 :

This is a decision on the renewed petition under 37 CFR 1.137(a) filed August 25, 2006, to revive the above-identified application.

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

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 22, 2005, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on October 22, 2005. A Notice of Abandonment was mailed May 19, 2006.

The instant petition seeks revival of the application. Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(a). Therefore, the petition is granted.

Technology Center Art Unit 1642 will be informed of the instant decision and the application will be further examined in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fay Kaplun & Marcin, LLP
7th Floor, Suite 702
150 Broadway
New York, NY 10038

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JUN 23 2005

OFFICE OF PETITIONS

In re Application of
Draschwandtner, et al.
Application No. 10/137,921
Filed: May 2, 2002
Atty. Dkt. No.: 40101/04201

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a), filed May 16, 2005.

The petition is **DISMISSED**.

The provisions of 37 CFR 1.47 are only applicable to original oaths and declarations. The instant application was filed May 2, 2002 with a properly executed declaration. Accordingly, the instant petition under 37 CFR 1.47 is inappropriate.

It is noted that a declaration under 37 C.F.R. § 1.131 has been submitted, the merits of which will not be considered by the undersigned. The declaration under § 1.131 is not executed by each inventor. Presumably this compelled the petition under Rule 47. Petitioners should consider MPEP 715.03 wherein it is set forth who may make a § 1.131 declaration, including, but not limited to the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor.

It is not believed that further consideration under § 1.47 is required, however, any renewed petition with regard to § 1.47 must be submitted within two months of the mail date of this decision and should be titled "Renewed Petition under 37 CFR 1.47." Extensions of time under 37 CFR 1.136 are available.

This application is being returned to Technology Center 2100.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND, OH 44114

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JUN 15 2006
OFFICE OF PETITIONS

In re Application of
Adam Petrovich et al. :
Application No. 10/137,922 : ON PETITION
Filed: May 2, 2002 :
Attorney Docket Number: 645XA :

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**.

This application became abandoned for failure to pay the issue fee by May 1, 2006 in response to the Notice of Allowance mailed January 30, 2006. The instant petition and this decision precede the mailing of the Notice of Abandonment.

Petitioner files the instant petition under 37 CFR 1.137(b). [1]

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

The issue fee, publication fee and petition fee have been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter 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 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)).

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Paper No. 9

MEDTRONIC AVE, INC.
3576 UNOCAL PLACE
SANTA ROSA CA 95403

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SEP 16 2003

OFFICE OF PETITIONS

In re Application of
Donagh O'Shaughnessy, Tony Neary, James Coyle, Jeremy Whitty, and Seamus Ledwith
Application No. 10/137,934
Filed: May 3, 2002
Attorney Docket No. PA1067
Title: STENT BALLOON ASSEMBLY AND METHODS OF MAKING SAME

DECISION NOTING JOINDER AND DISMISSING PETITION UNDER 37 C.F.R. §1.47(a) AS MOOT

This is in response to the renewed petition under 37 C.F.R. 1.47(a)[1], filed May 12, 2003.

The petition is **DISMISSED AS MOOT**.

On May 3, 2002, the application was deposited, identifying Donagh O'Shaughnessy, Tony Neary, James Coyle, Jeremy Whitty, and Seamus Ledwith as joint inventors. The application was deposited without an executed declaration. On June 10, 2002, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration and a surcharge of $130.00 were required. This Notice set a two-month period for reply. No extensions of time were received.

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

In reply, applicant filed the original petition, accompanied by a declaration executed by each inventor save joint-inventor Whitty. This petition was dismissed via a decision mailed on March 18, 2003.

On May 12, 2003, petitioner submitted a request for reconsideration, , along with a declaration executed by the previously non-signing joint inventor Whitty.

This declaration has been reviewed and found in compliance with 37 §CFR 1.63.

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

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

Paul Shanoski

Paul Shanoski
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
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Paper No. 7

MEDTRONIC AVE, INC.
3576 UNOCAL PLACE
SANTA ROSA CA 95403

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MAR 1 8 2003

OFFICE OF PETITIONS

In re Application of
Donagh O'Shaughnessy, Tony Neary, James Coyle, Jeremy Whitty, and Seamus Ledwith
Application No. 10/137,934
Filed: May 3, 2002
Attorney Docket No. PA1067
Title: STENT BALLOON ASSEMBLY AND METHODS OF MAKING SAME

DECISION ON PETITION

This is a decision on the petition pursuant to 37 C.F.R. §1.47(a) [1], filed on August 13, 2002.

On May 3, 2002, the application was deposited, identifying Donagh O'Shaughnessy, Tony Neary, James Coyle, Jeremy Whitty, and Seamus Ledwith as joint inventors. The application was deposited without an executed declaration. On June 10, 2002, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration and a surcharge of $130.00 were required. This Notice set a two-month period for reply. No extensions of time were received.

With the instant petition, the petitioner has included the petition fee[2], the surcharge associated with the late filing of an oath or declaration, a copy of the declaration which was executed by each inventor save inventor Whitty, a statement of facts executed by one Catherine C. Maresh, and two (2) pages of drawings.

---

[1] A grantable petition under 37 C.F.R. §1.47(a) requires:

(1) the petition fee of $130;
(2) a surcharge of either $65 or $130 if the petition is not filed at the time of filing the application;
(3) a statement of the last known address of the non-signing inventors;
(4) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with a complete copy of the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
(5) a declaration which complies with 37 CFR §1.63.

2 The petition fee has been charged to petitioner's Deposit Account, as authorized in the peititon.

A one-month extension of time has been charged to petitioner's Deposit Account, to make timely this response.

Petitioner has met requirements (1), (2), (3), and (5) of 37 C.F.R. §1.47(a) above.

Regarding the fourth requirement, petitioner has not set forth any facts which establish that a diligent effort was undertaken to locate this non-signing inventor. Petitioner asserts that a letter was sent to the non-signing inventor on May 7, 2002. On June 11, 2002, the UPS package was returned as undeliverable. Petitioner asserts that a copy of the returned package was attached to the petition, but this attachment has not been located in the file.

The documentary evidence provided indicates that something was mailed to the last known address of the non-signing inventor, which was returned because the address was incorrect. However, there is no indication that Rule 47 applicant attempted to verify inventor Whitty's address or to determine his forwarding address, and to send the application papers to that address for consideration by inventor Whitty[3]. If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of an E-mail or Internet search.

Consequently, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

On renewed petition, the petitioner should include either a declaration executed by the non-signing inventor, or a statement of facts executed by a person with *firsthand knowledge of the events*, which sets forth the steps undertaken to attempt to locate this non-signing inventor.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.

Paul Shanoski

Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

---

3 See MPEP 409.03(d).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

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FEB 28 2003

OFFICE OF PETITIONS

In re Application of
Davis et al.
Application No. 10/137,953
Filed: May 3, 2002
Attorney Docket No. 10363-006003

DECISION ON PETITION

This is a decision on the "Petition to Grant Filing Date," filed October 15, 2002. This petition is properly treated as a request to accord a filing date of May 3, 2002, with page 74 considered a part of the original application disclosure by virtue of an incorporation by reference.

Application papers in the above-identified application were filed on May 3, 2002. On August 5, 2002, the Office of Initial Patent Examination mailed a "Notice to Comply with Requirements for Patent Applications containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures."[1] A filing date of May 3, 2002, was accorded the application. However, the Notice, *inter alia*, advised applicants that page 74 of the specification appeared to have been omitted.

In response, petitioner filed the instant petition, which included omitted page 74. Therein, petitioner does not dispute that page 74 was not among the papers filed on May 3, 2002. Rather, petitioner asserts that the page was present in this application by virtue of an incorporation by reference of prior application No. 08/888,429 (the grandparent of the present application), which contained page 74.

Page 74 of the specification, which admittedly, was not present on the filing date cannot be considered a part of the original disclosure of the application. However, 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), <u>without the need for a petition</u>. (emphasis supplied).

It is noted that the application transmittal letter submitted on filing of the instant application identified this application as a continuation of prior application No. 09/593,653, filed June

[1] Receipt of a separate response to the requirements related to the Sequence Listing is acknowledged.

13, 2000, which is a divisional of prior application No. 08/888,429, filed on July 7, 1997, which is a continuation-in-part of prior application No. 08/530,950, filed September 19, 1995, which is a continuation-in-part of prior application No. 08/446,083, filed May 19, 1995. The disclosures of the prior applications were incorporated by reference in the disclosure of this application. Obviously, if the specification contained a proper incorporation by reference of the prior application, page 74 of the specification is not new matter if it was a part of the disclosure of the prior application[2].

The petition is **DISMISSED** to the extent that no petition is necessary to amend the continuing application.

Since the present petition was not necessitated by any error on the part of the Office, the $130.00 petition fee will not be refunded.

The application, **with a filing date of May 3, 2002**, is being forwarded to **the Office of Initial Patent Examination** for completion of pre-examination processing. Thereafter, the application will be forwarded to a Technology Center for examination in due course, including consideration by the examiner of the petition filed October 15, 2002, as a preliminary amendment requesting entry of page 74.

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

Beverly Flanagan
Supervisory Petitions Attorney
Office of Petitions

[2] Of course, the examiner is expected to compare the disclosure of application No. 08/888,429 and determine whether page 74 contains new matter.

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P.O. Box 1450
Alexandria, VA 22313-1450
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WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

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APR 07 2005

**OFFICE OF PETITIONS**

In re Application of :
Shlomo Berliner et al :
Application No. 10/137,954 :
Filed: May 2, 2002 :
Attorney Docket No. 3842P2455 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 21, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 3, 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 December 4, 2004.

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

This matter is being forwarded to Technology Center AU 2682 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUL 09 2010

OFFICE OF PETITIONS

**ROGER C. MORRIS**
**3917 MAPLE VIEW DR.**
**JACKSONVILLE FL 32224**

In re Patent No. 7,006,164
Issue Date: February 28, 2006
Application No. 10/137,955
Filed: May 1, 2002
Attorney Docket No.

ON PETITION

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

The petition is **GRANTED**.

This patent expired on February 28, 2010, 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.

/dcg/
Diane C. Goodwyn
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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Paper No. 6

Mark W. Triplett
McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago IL 60606

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JUL 16 2003

OFFICE OF PETITIONS

In re Application of
Gary Allen Kemp et al.
Application No. 10/137,979
Filed: May 3, 2002
Attorney Docket No. 02-184-A
Title: SYSTEM AND METHOD FOR PERFORMING AUTOMATIC SPREAD TRADING

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(F)

This is a decision on the petition filed on May 16, 2003, pursuant to 37 C.F.R. §1.137(b), which is properly treated as a petition under 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.

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 17, 2003, a Notice of Rescission of Nonpublication Request was filed with the Office. Unfortunately, notification of the filing of the foreign or international application did not accompany this filing.

Petitioner states that the instant nonprovisional application is the subject of an international application which was filed on March 3, 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 an international application.

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 under a multilateral international agreement, that requires publication of applications 18 months after filing.

The petition is **GRANTED-IN-PART**.

The portions of the petition which request that the petition fee be waived due to the ambiguity in Form PTO/SB/36(10-01) is **DISMISSED**, for the reasons set forth below.

First, the abandonment did not stem from any ambiguity on the part of the PTO; the application went abandoned as a direct result of petitioner's failure to be aware of and/or fully and correctly comprehend the relevant laws and regulations. Reliance on a form cannot supplant a working knowledge of these aforementioned rules and regulations, for as a registered member of the patent bar, petitioner is expected to know the relevant laws and regulations pertaining to his practice and under which this Office operates, and he is charged with the responsibility of keeping himself up to date with any changes in these matters.

Concerning the petition under 37 C.F.R. §1.137(f), the petition is **GRANTED**.

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.

Petitioner has submitted the notification of 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.

The previous Request and Certification under 35 U.S.C. §122(b)(2)(B)(i), filed with the original application papers, has been rescinded. A Notice Regarding Rescission of Nonpublication

Request which sets forth the projected publication date of October 23, 2003 accompanies this decision on petition.

After this decision is mailed, the application will be forwarded to Technology Center 3600 for further processing.

Telephone inquiries concerning *this decision* should be directed to the undersigned at (703) 305-0011. Questions pertaining to this application should be directed towards the Office of Patent Publication at (703) 305-8497.

Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

Encl.

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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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Hutchens et al. | : | |
| Patent No. 7,112,453 | : | |
| Issue Date: September 26, 2006 | : | Decision on Petition |
| Application No. 10/138,008 | : | |
| Filing Date: April 30, 2002 | : | |
| Attorney Docket No. 016866-002320US | : | |

This is a decision in response to the petition filed November 20, 2006, requesting the application be accorded a filing date of April 30, 2002.

The petition is **granted**.

The application was filed April 30, 2002.

The application was properly accorded a filing date of April 30, 2002.

On June 21, 2002, petitioner filed a Request for Corrected Filing Receipt in order to correct the residence city of one of the inventors.

On August 19, 2002, the Office mailed a Corrected Filing Receipt correctly listing the residential addresses for the inventors. For unknown reasons, the filing date had been changed and was shown as April 5, 2002. Petitioner failed to note the change in filing date.

The Office normally allows the correction of a filing date for a patent when one is moving the filing date to an earlier date since prior arts concerns do not arise. In this case, the filing date is being moved to a later filing date. However, the instant application is a divisional of application no. 09/603,733, and is also a divisional of application no. 09/100,708. Therefore, although the filing date is being changed, the effective filing date remains unchanged, and the relief requested may be granted.

No petition fee is required and none has been charged.

Petitioner may wish to file a Request for Certificate of Correction pursuant to 37 CFR 1.322. Any such request should include a copy of the instant decision.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

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EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,112,453 | : | |
| Hutchens et al. | : | |
| Issue Date: September 26, 2006 | : | |
| Application No. 10/138,008 | : | DECISION ON PETITION |
| Filed: April 30, 2002 | : | |
| Atty Docket No. 026693-002320US | : | |

This is a notice regarding your letter entitled NOTIFICATION OF ERROR IN SMALL ENTITY STATUS AND PAYMENT OF DEFICIENCY OWED UNDER 37 CFR §1.28(c), filed July 13, 2007, notifying the Office of loss of entitlement to small entity status and requesting acceptance of a fee deficiency submission as provided for in 37 CFR 1.28.

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.

The instant request included an itemization and payment of the deficiency in fees since loss of entitlement to small entity status.

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

Payment of the deficiency has been treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

David A. Fox
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002

**MAILED**

JUN 2 4 2004

**Technology Center 2100**

In re Application of:
James GROSSMAN
Application No. 10/138,016
Filed: May 3, 2002
For: ACCESSING AND RECORDING INFORMATION VIA THE INTERNET FOR SPECIFIC PRODUCTS, SERVICES AND TRANSACTIONS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed February 26, 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 signer of the petition, David A. Fox, is not an attorney or agent of record; therefore he is not authorized to act on behalf of the attorney(s) of record, nor can he effect a change of address. Accordingly, the request is **DENIED.**

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: James Grossman
9 Woodland Drive
Westport, CT 06880

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 11-02

Paper No. 7

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON DC 20005-3502

**COPY MAILED**

NOV 14 2002

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Torben Bogh-Andersen | : DECISION GRANTING |
| Application No. 10/138,036 | : PETITION |
| Filed: 1 May, 2002 | : |
| Att'y Dckt. No. 81421-4009 | : |

This is a decision on the petition filed on 30 October, 2001, requesting that the above-identified application be accorded a filing date of 1 May, 2002.

The petition is **GRANTED**.

On 1 May, 2002, the application was filed.

On 23 May, 2002, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application" stating that the application had been accorded a filing date of 1 May, 2002, but that, *inter alia*, Page 10 of the specification (description and claims) appeared to have been omitted.

In response, on 11 June, 2002, petitioner filed a response to the Notice stating, *inter alia*, that no pages were actually missing from the application and that the application had been mispaginated, resulting in the omission of Page 10. Applicants also filed an additional repaginated copy of the specification. Accordingly, the application was accorded a filing date of 11 June, 2002, using the copy of the specification filed on 11 June, 2002.

In response, on 30 October, 2002, the present petition was filed. Petitioner asserts that the substitute specification was not

intended to be used for filing date purposes, but merely to show that no material had been omitted. Petitioner requests that the application be accorded a filing date of 1 May, 2002, using the application papers filed on that date.

Upon review, it is obvious from the response submitted on 11 June, 2002, that petitioners did not request a filing date of 11 June, 2002, using the application papers filed on that date. Accordingly, the application will be reprocessed with a filing date of 1 May, 2002, using the application papers filed on that date. The copy of the specification supplied on 11 June, 2002, will not be used for processing or examination, but will be retained in the application file.

Petitioner should note that the pages of the specification including claims and abstract, however, must be numbered consecutively starting with 1.[1]

As the petition was due to an error on the part of the USPTO, no petition fee is due.

To avoid further confusion, petitioner should submit an amendment prior to the first Office action to renumber the specification, starting with page 1 as the first page, so that the specification, including claims, and the abstract are numbered consecutively, starting with 1.

The application will be returned to the Office of Initial Patent Examination for reprocessing with a filing date of 1 May, 2001, using the application papers supplied on that date.

Telephone inquires 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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[1] 37 CFR 1.52(b)(5).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON DC 20005-3502

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NOV 21 2002
GROUP 3600

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Torben Bogh-Andersen | : DECISION GRANTING |
| Application No. 10/138,036 | : PETITION |
| Filed: 1 May, 2002 | : |
| Att'y Dckt. No. 81421-4009 | : |

This is a decision on the petition filed on 30 October, 2001, requesting that the above-identified application be accorded a filing date of 1 May, 2002.

The petition is **GRANTED**.

On 1 May, 2002, the application was filed.

On 23 May, 2002, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application" stating that the application had been accorded a filing date of 1 May, 2002, but that, *inter alia*, Page 10 of the specification (description and claims) appeared to have been omitted.

In response, on 11 June, 2002, petitioner filed a response to the Notice stating, *inter alia*, that no pages were actually missing from the application and that the application had been mispaginated, resulting in the omission of Page 10. Applicants also filed an additional repaginated copy of the specification. Accordingly, the application was accorded a filing date of 11 June, 2002, using the copy of the specification filed on 11 June, 2002.

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Petitioner should note that the pages of the specification including claims and abstract, however, must be numbered consecutively starting with 1.[1]

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To avoid further confusion, petitioner should submit an amendment prior to the first Office action to renumber the specification, starting with page 1 as the first page, so that the specification, including claims, and the abstract are numbered consecutively, starting with 1.

The application will be returned to the Office of Initial Patent Examination for reprocessing with a filing date of 1 May, 2001, using the application papers supplied on that date.

Telephone inquires 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

---

[1] 37 CFR 1.52(b)(5).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 11-14-08

**TO SPE OF** : ART UNIT 2611

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/138100 Patent No.: 7301984

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

**Certificates of Correction Branch**
**703-308-9390 ext.** 123

**Thank You For Your Assistance**

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

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

**Comments:** _____

**SPE** **Art Unit** 2611

10/138,100

OIPE IAP40
NOV 0 3 2008
PATENT & TRADEMARK OFFICE

Docket No.: SONYJP 3.0-920
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Letters Patent of:
Sugaya et al.

Patent No.: 7,301,984

Issued: November 27, 2007

For: WIRELESS COMMUNICATION SYSTEM USING AN IMPULSE SIGNAL TRAIN,A WIRELESSTRANSMISSION APPARATUS, A WIRELESS RECEPTION APPARATUS, A WIRELESS TRANMISSION METHOD, AND A WIRELESS RECEPTION METHOD

Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR CERTIFICATE OF CORRECTION PURSUANT TO 37 CFR 1.323**

Dear Sir:

Enclosed herewith is a Certificate of Correction with respect to the above-identified U.S. Patent. You are hereby authorized to charge Deposit Account No. 12-1095 in the amount of $100 to cover the required fee for filing a Certificate of Correction under § 1.323.

These errors were inadvertent, occurred in good faith and do not involve any changes which constitute new matter.

Certificate
NOV 0 5 2008
of Correction

NOV - 5 2008

We look forward to early return of the Certificate of Correction duly certified.

Dated: October 30, 2008 Respectfully submitted,

By

Bruno Polito
Registration No.: 38,580
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000

Attorney for Applicant

939426_1.DOC

NOV - 5 2008

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. 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. | : | 7,301,984 |
| APPLICATION NO. | : | 10/138,100 |
| ISSUE DATE | : | November 27, 2007 |
| INVENTOR(S) | : | Shigeru Sugaya and Jun Iwasaki |

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 face of Patent under Abstract (57), line 9, "signal" should read --signals--;

Column 2, line 10, "of transmission" should read --of the transmission--;

Column 3, line 25, "with an" should read --with a--;

Column 8, line 43, delete "83?" and "84?";

Column 8, line 43, "in the wireless reception unit to" should read --in the wireless reception unit (e.g., wireless reception unit of Fig. 24) to--;

Column 9, line 39, delete "82?";

Column 9, line 39, "unit)" should read --unit, e.g., unit of Fig. 24)--;

Column 9, line 56, "station" should read --stations--;

Column 12, line 59, "completes" should read --is completed--;

Column 13, line 37, "completes" should read --is completed--;

Column 17, line 25, "add-hock" should read --Ad-Hoc--.

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Bruno Polito
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

NOV - 5 2008

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2200 WELLS FARGO CENTER
90 SOUTH 7TH STREET
MINNEAPOLIS MN 55402

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AUG 1 2 2003

OFFICE OF PETITIONS

Applicant: Reichel et al.
Appl. No.: 10/138,111
Filing Date: May 1, 2002
Title: AIR QUALITY MONITORING AND SPACE MANAGEMENT SYSTEM COUPLED TO A PRIVATE COMMUNICATIONS NETWORK
Attorney Docket No.: 55607-240690
Pub. No.: US 2003/0051023 A1
Pub. Date: March 13, 2003

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on April 16, 2003.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains several material errors.

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

The misspelling of "the sensor assembly I 00" for "the sensor assembly 100" in paragraph 62, line 12, and "of about 1 ppm, Accuracy . . ." for "of about 1 ppm. Accuracy . . ." in paragraph 74, line 6 are minor typographical errors which are clearly understandable from reading the sentence and/or paragraph in which the terms are used, as the terms are not read in a vacuum. With respect to the sensor assembly the correct identifier (100) is used in the same paragraph and throughout the specification.

The misspelling of "accuracy is 1100 ppm or 5% of reading, whichever is greater . . ." for "accuracy is ± 100 ppm or 5% of reading, whichever is greater . . ." in paragraph 75, line 3 is a typographical error, which is not a material mistake because the technical disclosure and the claims are understandable, as the phrase is clearly a typographical error because the specification also sets a limit for a 5% deviation. The typographical error identified by applicant is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b).

The misspelling of "[t]he system of claim I comprising . . ." for "[t]he system of claim 1 comprising . . ." in dependent claim 26 is a minor typographical error, which is clearly understandable from reading the claim, as the terms are not read in a vacuum.

---

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

The misspellings are minor typographical errors, which are clearly understandable from reading the specification and claims, as words are not read in a vacuum. The mistakes do not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

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

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

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

By facsimile: 703-305-8568

The application is being forwarded to Technology Center 2863 to await further examination in due course.

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

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

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**THE PINEHURST OFFICE CENTER, SUITE #101**
**39400 WOODWARD AVENUE**
**BLOOMFIELD HILLS, MI 48304-5151**

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APR 27 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of
Alchas, Paul G.
Application No. 10/138,133
Filed: May 2, 2002
Attorney Docket No. P-4252C1

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 18, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed August 6, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on November 7, 2004. A Notice of Abandonment was mailed February 18, 2005.

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

This matter is being referred to Technology Center 3700 for further examination on the merits.

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

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

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MORRISON & FOERSTER LLP
1650 TYSON BOULEVARD
SUITE 400
MCLEAN, VA 22102

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JUN 13 2007

OFFICE OF PETITIONS

In re Application of
Xing SU, et al
Application No. 10/138,157
Filed: May 1, 2002
Attorney Docket No. 070702009100

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 April 6, 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 Peter J. Davis on behalf of all attorneys of record who associated with customer No. 25227.

All attorneys/agents associated with Customer Number 25227 have been withdrawn.

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

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

There are no Office actions pending at the present time.

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

April Wise
Petitions Examiner
Office of Petitions

cc: XING SU
21811 GRANDA AVENUE
CUPERTINO, CA 95014

cc: RAJ S. DAVE, PH.D.
DARBY & DARBY P.C.
1500 K STREET, N.W.
SUITE 250
WASHINGTON, D.C. 20005-1714

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Paper No. 5

**LEARY & ASSOCIATES**
**3900 NEWPARK MALL RD.**
**THIRD FLOOR, SUITE 317**
**NEWARK, CA 94560**

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AUG 05 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Amir Belson et al | : | |
| Application No. 10/138,175 | : | ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. BEL1020C1 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed July 17, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed May 31, 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 August 1, 2002.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

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

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

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SEP 15 2006

ELMORE CRAIG, P.C.
209 MAIN STREET
N. CHELMSFORD, MA 01863

| | |
|---|---|
| In re Application of | : |
| John C. Salerno | : |
| Serial No.: 10/138,183 | : PETITION DECISION |
| Filed: May 02, 2002 | : |
| Attorney Docket No.: 3230.1000-001 | : |

This is in response to the petition under 37 CFR 1.181, filed June 29, 2006, requesting withdrawal of Finality of the Office action of March 29, 2006.

**BACKGROUND**

A review of the file history shows that the examiner mailed a non-final Office action to applicants on May 02, 2002, setting forth a three month shortened statutory period for reply in which claims 1-41 were restricted and divided into 2 groups, Group I claims 1-19 and Group II claims 20-41. Applicants elected Group I claims 1-19 and the examiner rejected claims 1-16 under 35 U.S.C. 102 over Patten et al (WO 98/27230). Claims 17-19 were also rejected under 35 U.S.C. 103; specifically claim 17 was rejected over Patten et al in view of Bass et al (US 2001/0039014 A1), claim 18 was rejected over Patten et al in view of Stemmer et al (US 6117679), and claim 19 was rejected over Patten et al in view of Steinman (US 5849497). Claim 19 was also objected.

Applicant replied on November 19, 2004, by amending claim 19 and canceling claims 20-41. Applicant also presented arguments.

On April 18, 2005, the examiner mailed a final Office action, maintaining the 35 U.S.C.102 and 103 rejections made in the previous action. The objection to Claim 19 was withdrawn.

On July 18, 2005, the examiner had an interview with applicant's attorney and discussed the amendment and the possibility that the amendment would require further search as the previous claims encompassed the use of primers to both strands and, therefore, the amendments which excluded the use of primers to both the strands would not be entered after final as they would raise new issues.

In response thereto, applicant's filed an R.C.E. and an amendment on August 18, 2005, amending claim 1 and adding new claim 42 with the language "coding strands".

The examiner mailed a non-final Office action to applicant on October 26, 2005, maintaining the previous rejections and adding a rejection on Claim 42 as containing "new matter" since the coding strands were not previous described in the original set of claims or the specification. The examiner also included a provisional double patenting rejection over claims 1-19 over co-pending application 10/712806.

Applicant responded on January 24, 2006, with another amendment, amending claim 1 to include " the pre-regions of each double primer hybridize to either the coding strand or the non-coding strand, but not both" language and they also presented arguments to overcome the previous 35 U.S.C. 102 and 103 rejections. A terminal disclaimer was provided to overcome the obviousness-type double patenting rejection.

The examiner responded by mailing a final Office action on March 29, 2006, in which the previously made 35 U.S.C. 112, 102 and 103 rejections were maintained. The new matter rejection on claim 42 was also maintained. It was suggested that claim 42 was otherwise allowable over the prior art of record.

Applicant filed an amendment after final on May 26, 2006, amending claim 1 to add the limitation of claim 42 which included the language "pre-regions of each double primer hybridize to the *coding strand* of a polynucleotide within the basic set", canceling claim 42 and adding a new claim 43 which included the language "pre-regions of each double primer hybridize to the *non-coding strand* of a polynucleotide within the basic set".

The examiner mailed an advisory action on June 6, 2006 refusing to enter the amendment as there would be new issues involved, to which applicant filed this petition requesting entry of the amendment under 37 CFR 1.181.

**DISCUSSION**

The first issue for petition is whether or not the issue of new matter is a "new issue" that would require further consideration or search. Claim l as of the final Office action was directed to two embodiments: (1) a method using a double primer set that targeted the coding strand of the polynucleotides in the basis set and (2) a method using a double primer set that targeted the non-coding strand of the polynucleotides in the basis set. Double primer sets that targeted both the strands were explicitly excluded from the claim. Claim 42 was directed only to the first embodiment and was rejected under 35 U.S.C. 1 12, first paragraph as being directed to new matter. Claim 1 was amended to be limited to Claim 42 because the identical "new matter issue" was retained in amended claim 1 that was previously considered with respect to Claim 42. It cannot be said that, merely by including this limitation in claim 1, a new issue was raised with respect to "new matter". It is the same issue that was raised in the final Office action.

Applicant's arguments are convincing. The examiner had addressed the "issue" in the previous Office action with respect to art and 112 issues. Please note the Office action mailed March 29, 2006, page 16, where the examiner agrees that claim 42 is allowable over the prior art but has 112, first paragraph issues. Applicant has come back and inserted the same language in the amendment in claim 1 and new claim 43. This was in the claims before the Final rejection and the examiner had already addressed it. Thus, as it is not a "new issue", the amendment should be entered.

Applicant also argued amended claim 1 and new claim 43 do not add new matter.
Claim 42 was already examined and rejected under 35 U.S.C. 112 as containing "new matter" before the amendment was entered. The amendment after final cancels claim 42 and inserts that same language into claim 1 limiting it to one embodiment. New claim 43 is directed to the second embodiment of claim 1. Thus, "new issues" are not raised since the language in claim 1 was considered before the final Office action. It is clear that the rejection of "new matter" is not being considered here just whether it is a new issue. The new matter issue with respect to targeting a single strand was first raised in the final Office action, not by the Amendment filed on May 25. 2006. Thus, as it is not a new issue and does not require further consideration, the amendment should be properly entered.

The petition to enter the amendment is **GRANTED.**

**The application will be forwarded to the examiner for further consideration of the amendment filed 26 May 2006.**

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott
Director, Technology Center 1600

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MAR 12 2007

ELMORE CRAIG, P.C.
209 MAIN STREET
N. CHELMSFORD, MA 01863

| | |
|---|---|
| In re Application of | : |
| John C. Salerno | : |
| Serial No.: 10/138,183 | : PETITION DECISION |
| Filed: May 02, 2002 | : |
| Attorney Docket No.: 3230.1000-001 | : |

This is in response to the petition under 37 CFR 1.181, filed 29 June 2006, requesting entry of the after final amendment submitted 26 May 2006. The delay in acting upon this petition is regretted.

**BACKGROUND AND DISCUSSION**

A review of the file history shows that the examiner mailed a non-final Office action to applicant on May 02, 2002, in which claims 1-41 were restricted into 2 groups, Group I, claims 1-19, and Group II, claims 20-41. Applicant elected Group I, claims 1-19. The examiner rejected claims 1-16 under 35 U.S.C. 102 over Patten et al (WO 98/27230). Claims 17-19 were also rejected under 35 U.S.C. 103(a).

Applicant replied on November 19, 2004, by amending claim 19 and canceling claims 20-41. Applicant also presented arguments.

On April 18, 2005, the examiner mailed a final Office action to applicant, maintaining all the 35 U.S.C.102 and 103 rejections made in the previous action.

On July 18, 2005, the examiner had an interview with applicant's attorney.

On August 18, 2005, applicant filed RCE papers amending claim 1 and adding new claim 42.

The examiner mailed a non-final Office action to applicant on October 26, 2005, maintaining the previous rejections and rejecting claim 42 under 35 USC 112, first paragraph, for containing new matter. The examiner also included a provisional obviousness double patenting rejection over claims 1-19 over co-pending application 10/712,806.

Applicant responded on January 24, 2006, by amending claim 1 and presenting arguments in response to the 35 U.S.C. 102 and 103 rejections. A terminal disclaimer was provided to overcome the obviousness-type double patenting rejection.

The examiner mailed a Final Office action to applicants on March 29, 2006, which maintained the 35 U.S.C. 112, 102 and 103 rejections.

Applicant filed an amendment after Final rejection on May 26, 2006, amending claim 1, canceling claim 42 and adding a new claim 43.

On 9 June 2006, the examiner mailed an Advisory Action refusing to enter the amendment on the grounds that it raised new issues. Applicant then filed this petition requesting entry of the amendment under 37 CFR 1.181.

On September 15, 2006, the Office erroneously mailed an incomplete, premature, unsigned draft decision. The draft decision was inadvertently placed in the Office's electronic files and may have been mailed to applicants on 15 September 2006.

**DECISION**

The incomplete and premature draft petition decision dated 15 September 2006 is hereby withdrawn.

Because of the delays in promptly processing this petition, coupled with any inadvertent confusion that may have arisen in view of the erroneous processing of an incomplete, draft petition decision on 15 September 2006, the petition filed under 37 CFR 1.181 to enter the amendment on 26 May 2006 is **GRANTED.**

For these same reasons, the finality of the Office action mailed 29 March 2006 is hereby withdrawn.

The application will be forwarded to the examiner for further consideration of the amendment filed 26 May 2006 and for preparation of an Office action on the merits consistent with this decision, which may be a Final Office action.

Should there be any questions about this decision please contact Quality Assurance Specialist/Program Manager Julie Burke, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUL 25 2003

Paper No. 7

| | | |
|---|---|---|
| In re Application of | : | |
| Duane G. Schroeder et al. | : | |
| Serial No. 10/138,190 | : | DECISION ON PETITION |
| Filed: May 1, 2002 | : | TO MAKE SPECIAL |
| For: MATERIAL COMPACTION | : | |
| APPARATUS | : | |

Applicant's petition, filed July 21, 2003, requests that this application be rendered special for examination in that applicant is over sixty-five (65) years of age.

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(IV) of the Manual of Patent Examining Procedure (MPEP).

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Patterson, Thuente, Skaar and Christensen, PA
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

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Foley & Lardner
777 East Wisconsin Avenue
Suite 3800
Milwaukee, Wisconsin 53202-5308

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NOV 25 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re | : | |
| **Richter et al.** | : | |
| Application No. 10/138,198 | : | RECONSIDERATION OF |
| Filing Date: May 3, 2002 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No.054821-0838 | : | |

This decision is in response to applicants' PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) timely[1] filed on August 10, 2005 requesting that the Office adjust the PTA calculation at the time of the notice of allowance from a determination of zero (0) days to a determination of eighty-seven (87) days.

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

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for

[1]Issue fee paid on August 10, 2005.

reconsideration on other bases must be timely filed and must include payment of the required fee.

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

After the mailing of this decision, the file will be forwarded to the Office of Patent Publications for a prompt issuance of the patent. Any delays in issuing the application more than four months from the payment of the issue fee and all other requirements being satisfied will be added in the issue notification letter that is provided to applicants approximately three weeks prior to issuance of the application.

Applicants have provided the required $200.00 fee. No additional fees are required in the determination of this request.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, at 571-272-7757.

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

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| | | |
|---|---|---|
| In re<br>Richter et al.<br>Application No. 10/138,198<br>Filing Date: May 3, 2002<br>Patent No. 6982540<br>Atty Docket No. 054281-0838 | :<br>:<br>:<br>:<br>: | RECONSIDERATION OF<br>PATENT TERM ADJUSTMENT |

This decision is in response to applicant's "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT filed March 3, 2006 requesting that the Office review the PTA determination in light of submission of drawings after the mail date of the notice of allowance.

Applicants request for PTA reconsideration is GRANTED. The Office will adjust the PAIR calculation at the time of the issuance of the patent to reflect a determination of 2 days. In addition, the Office will *sua sponte* issue a certificate of correction reducing the PTA from a determination of 122 days to a determination of 2 days.

Applicants are given 30 days to reply to if applicants disagrees with the decision. No extensions of time are available under 37 CFR 1.136.

Applicants advised the Office of the submission of replacement drawings on August 10, 2005. Applicants further advised the Office that the submission of the drawings was not entered into the PALM record and accordingly the PTA determination did not reflect the drawing submission.

Applicants' arguments are persuasive. The record reflects the submission of drawings on August 10, 2005. Accordingly, the Office failed to reduce applicants PTA by 120 days pursuant to 37 CFR 1.704(c)(10).

After the mailing of this decision, the application will be forwarded to the Office of Patent Publications for a prompt issuance of a certificate of correction.

The Office has not assessed the $200.00 fee for the submission of this letter regarding PTA. The Office thanks for good faith and candor bringing this matter to the attention of the Office.

Any questions concerning this application should be directed to Kery Fries at 571-272-7757.

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

CC: Adjusted PAIR calculation
Draft Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 6,982,540 B1

DATED : Jan. 3, 2006

INVENTOR(S) : Richter 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 (122) days

Delete the phrase "by 122 days" and insert – by 2 days--

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**1515 N. COURTHOUSE ROAD, SUITE 500**
**ARLINGTON VA 22201-2909**

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|---|---|---|
| In re Application of | : | |
| Rajamani Ganesh | : | |
| Application No. 10/138,273 | : | DECISION GRANTING PETITION |
| Filed: May 3, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 02-4002 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 30, 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*** October 26, 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 the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2617 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment of the application.*

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BARNES & THORNBURG LLP
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204

MAILED

NOV 10 2009

OFFICE OF PETITIONS

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| In re Application of | : | |
| Low et al. | : | ON REQUEST FOR |
| Application No. 10/138275 | : | RECONSIDERAION OF |
| Filing or 371(c) Date: 05/02/2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 3220-70808 | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d) filed July 16, 2009. This matter is being properly addressed pursuant to 37 CFR 1.705(b). Applicant submits that the correct patent term adjustment to be indicated on the patent is 52 days, not zero (0) 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 § 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 specific to this decision should be directed to Attorney Derek Woods at (571) 272-3232.

*/ALESIA M. BROWN/*

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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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.

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**11 SOUTH MERIDIAN**
**INDIANAPOLIS, IN 46204**

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**OFFICE OF PETITIONS**

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| In re Application of | : | |
| **Philip S. LOW**, et al. | : | |
| Application No. 10/138,275 | : | DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. **3220-70808** | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 10, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 16, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 1644 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

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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 of the application.*

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| | | |
|---|---|---|
| In re Application of | : | |
| Low et al. | : | ON REQUEST FOR |
| Application No. 10/138275 | : | RECONSIDERAION OF |
| Filing or 371(c) Date: 05/02/2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 3220-70808 | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b) filed January 21, 2010. Applicant submits that the correct patent term adjustment to be indicated on the patent is 42 days, not zero (0) 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.

A review of Office records reveals that this Office errantly assessed an additional reduction of 49 days in connection with the filing of the Information Disclosure Statement ("IDS"), filed April 1, 2009, after filing a reply to the non-final Office action on February 11, 2009. The reduction of 49 days was assessed twice. The additional reduction of 49 days is in error and has been removed.

In view thereof, as of the time of allowance, the application is entitled to an overall patent term adjustment of zero (0) days (adjustments totaling 339 days less reductions totaling 589 days).

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

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office 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 specific to this decision should be directed to Attorney Derek Woods at (571) 272-3232.

Anthony Knight
Director
Office of Petitions

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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.

# PALM INTRANET

Day : Saturday
Date: 5/8/2010
Time: 21:11:55

| PTA Calculations for Application: 10/138275 | | | |
|---|---|---|---|
| Application Filing Date: | 05/02/2002 | PTO Delay (PTO): | 543 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 638 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 0 |
| PTO Delay Adjustment: | 49 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 153 | 05/08/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 49 | | |
| 137 | 01/13/2010 | MAIL NOTICE OF ALLOWANCE | | | |
| 136 | 01/08/2010 | ISSUE REVISION COMPLETED | | | |
| 135 | 01/08/2010 | DOCUMENT VERIFICATION | | | |
| 134 | 01/08/2010 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 133 | 01/08/2010 | NOTICE OF ALLOWABILITY | | | |
| 132 | 12/18/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 131 | 12/10/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 130 | 12/18/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 129 | 12/10/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 128 | 12/11/2009 | MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE - WITH ASSIGNED PATENT NO. | | | |
| 127 | 12/11/2009 | RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE - WITH ASSIGNED PATENT NO. | | | |
| 126 | 12/11/2009 | WITHDRAWAL PATENT CASE FROM ISSUE | | | |
| 125 | 12/10/2009 | PETITION ENTERED | | | |
| 124 | 12/10/2009 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 123 | 11/26/2009 | EMAIL NOTIFICATION | | | |
| 122 | 11/24/2009 | ISSUE NOTIFICATION MAILED | | | |
| 121.5 | 11/24/2009 | PTA 36 MONTHS | 175 | | |
| 121 | 12/15/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |

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|---|---|---|---|---|---|
| 121 | 12/15/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | 29 | | 111 |
| 120 | 11/18/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 120 | 11/18/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 119 | 11/17/2009 | DISPATCH TO FDC | | | |
| 119 | 11/17/2009 | DISPATCH TO FDC | | | |
| 118 | 11/17/2009 | EMAIL NOTIFICATION | | | |
| 118 | 11/17/2009 | EMAIL NOTIFICATION | | | |
| 117 | 11/10/2009 | MAIL-PETITION DECISION - DISMISSED | | | |
| 117 | 11/10/2009 | MAIL-PETITION DECISION - DISMISSED | | | |
| 116 | 11/09/2009 | PETITION DECISION - DISMISSED | | | |
| 116 | 11/09/2009 | PETITION DECISION - DISMISSED | | | |
| 115 | 07/16/2009 | PETITION ENTERED | | | |
| 115 | 07/16/2009 | PETITION ENTERED | | | |
| 114 | 07/22/2009 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 114 | 07/22/2009 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 113 | 07/21/2009 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 113 | 07/21/2009 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 112 | 07/20/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 112 | 07/20/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 111 | 07/16/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 111 | 07/16/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 110 | 07/16/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 110 | 07/16/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 109 | 07/08/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 109 | 07/08/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 108 | 04/20/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 108 | 04/20/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 107 | 04/17/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 107 | 04/17/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 106 | 04/01/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 106 | 04/01/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 105 | 04/01/2009 | ELECTRONIC INFORMATION DISCLOSURE | | 49 | 95 |

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|---|---|---|---|---|---|
| | | STATEMENT | | | |
| 105 | 04/01/2009 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | 49 | 95 |
| 104 | 04/01/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 104 | 04/01/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 103 | 03/31/2009 | ISSUE REVISION COMPLETED | | | |
| 103 | 03/31/2009 | ISSUE REVISION COMPLETED | | | |
| 102 | 03/31/2009 | SUBSTITUTE SPECIFICATION FILED | | | |
| 101 | 03/27/2009 | ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING | | | |
| 100 | 03/27/2009 | DOCUMENT VERIFICATION | | | |
| 99 | 03/27/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 98 | 03/27/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 97 | 03/26/2009 | NOTICE OF ALLOWABILITY | | | |
| 96 | 02/21/2009 | DATE FORWARDED TO EXAMINER | | | |
| 95 | 02/11/2009 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 94 | 01/06/2009 | MAIL NON-FINAL REJECTION | 1 | | 77 |
| 93 | 01/05/2009 | NON-FINAL REJECTION | | | |
| 92 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 91 | 11/18/2008 | REFERENCE CAPTURE ON IDS | | | |
| 90 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 89 | 11/19/2008 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 88 | 11/20/2008 | DATE FORWARDED TO EXAMINER | | | |
| 87 | 11/19/2008 | SUPPLEMENTAL RESPONSE | | 75 | 77 |
| 86 | 11/17/2008 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 85 | 11/20/2008 | DATE FORWARDED TO EXAMINER | | | |
| 84 | 11/17/2008 | SUPPLEMENTAL RESPONSE | | | |
| 83 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 82 | 09/05/2008 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 81 | 09/05/2008 | MISCELLANEOUS INCOMING LETTER | | | |
| 80 | 09/10/2008 | DATE FORWARDED TO EXAMINER | | | |
| | | | | | |

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|---|---|---|---|---|---|
| 79 | 09/05/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 78 | 09/10/2008 | DATE FORWARDED TO EXAMINER | | | |
| 77 | 09/05/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 76 | 09/10/2008 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 75 | 09/05/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 74 | 09/05/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 73 | 02/07/2008 | NOTICE OF APPEAL FILED | | 92 | 71 |
| 72 | 02/07/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 71 | 08/07/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 70 | 08/03/2007 | FINAL REJECTION | | | |
| 69 | 06/28/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 68 | 06/28/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 67 | 06/13/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 66 | 05/30/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 65 | 06/28/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 64 | 06/28/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 63 | 06/28/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | 24 | 58 |
| 62 | 06/28/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 61 | 06/13/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 60 | 06/04/2007 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 59 | 06/14/2007 | DATE FORWARDED TO EXAMINER | | | |
| 58 | 06/04/2007 | RESPONSE AFTER NON-FINAL ACTION | | 96 | 48 |
| 57 | 06/04/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 54 | 06/13/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 53 | 05/30/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |

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|---|---|---|---|---|---|
| 52 | 09/03/2002 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 51 | 09/03/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 49 | 05/30/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 48 | 11/30/2006 | MAIL NON-FINAL REJECTION | | | |
| 47 | 11/27/2006 | NON-FINAL REJECTION | | | |
| 46 | 09/27/2006 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 45 | 09/27/2006 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 44 | 10/06/2006 | DATE FORWARDED TO EXAMINER | | | |
| 43 | 09/27/2006 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 42 | 10/06/2006 | DATE FORWARDED TO EXAMINER | | | |
| 41 | 09/27/2006 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 40 | 10/06/2006 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 39 | 09/27/2006 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 38 | 03/23/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 37 | 03/21/2006 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 36 | 03/16/2006 | ADVISORY ACTION (PTOL-303) | | | |
| 35 | 03/16/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 34 | 03/02/2006 | DATE FORWARDED TO EXAMINER | | | |
| 33 | 02/28/2006 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 32 | 02/28/2006 | NOTICE OF APPEAL FILED | | 95 | 30 |
| 31 | 02/28/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 08/25/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 29 | 08/22/2005 | FINAL REJECTION | | | |
| 28 | 08/03/2005 | DATE FORWARDED TO EXAMINER | | | |
| 27 | 07/15/2005 | RESPONSE AFTER NON-FINAL ACTION | | 93 | 25 |
| 26 | 07/15/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 25 | 01/13/2005 | MAIL NON-FINAL REJECTION | | | |
| 24 | 01/10/2005 | NON-FINAL REJECTION | | | |
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|---|---|---|---|---|---|
| 23 | 11/18/2004 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 11/08/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | 65 | 18 |
| 21 | 11/08/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 20 | 11/08/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 19.7 | 08/13/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 08/13/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 18 | 06/04/2004 | MAIL RESTRICTION REQUIREMENT | 338 | | -1 |
| 17 | 06/01/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 15 | 08/21/2003 | PRELIMINARY AMENDMENT | | | |
| 14 | 04/20/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 13 | 09/15/2003 | RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS | | | |
| 12.7 | 04/07/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 04/07/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 08/21/2002 | PRELIMINARY AMENDMENT | | | |
| 10 | 09/09/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 9 | 09/06/2002 | APPLICATION IS NOW COMPLETE | | | |
| 8 | 08/12/2002 | ADDITIONAL APPLICATION FILING FEES | | | |
| 7 | 08/12/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 6 | 07/06/2002 | RECEIPT OF ACKNOWLEDGMENT LETTER | | | |
| 5 | 06/12/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 4 | 05/20/2002 | REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED | | | |
| 3 | 05/17/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 05/15/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 05/02/2002 | INITIAL EXAM TEAM NN | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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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#4

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JUL 01 2002

Office of the Director
Group 3600

Paper No. 4

Barnes & Thornburg
2600 Chase Plaza
10 LaSalle Street
Chicago, IL 60603

In re application of
John D. Pratt et al.
Application No. 10/138,283
Filed: May 3, 2002
For: PRESSURE RESPONSIVE BLOWOUT LATCH

**DECISION ON PETITION TO MAKE SPECIAL (COUNTER TERRORISM)**

This is in response to the petition filed on June 10, 2002 to make the above-identified application special on the basis of inventions for countering terrorism as set forth in MPEP § 708.02 XI.

The petition is **DISMISSED**.

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

Applicant's petition explains that the application "discloses a pressure sensing apparatus and method which would allow the release of the door or panel in the event of a pressure change, such as a loss of cabin pressure in either the passenger compartment or the flight deck area of the aircraft". It is argued that this inventive apparatus would counter terrorism by increasing the difficulty would-be terrorists would encounter when trying to gain access to aircraft flight decks. This argument is not agreed with. Nothing in the invention acts to directly counter terrorism, but would appear to provide an improvement in passenger safety by allowing entry in the event of a change in pressure. Indeed, such a device would conceivably make it easier for terrorists to gain access to the flight deck over a conventional lock by purposely causing a change in cabin pressure. MPEP § 708.02 XI lists examples of types of inventions that would qualify as countering terrorism. While a grantable petition is not limited to these examples, these examples all clearly act to counter terrorism. Thus, the argument by the applicant is not seen as being sufficient to accord special status to this application.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Petitioner should promptly submit such a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until any such renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

snm/snm : 7/1/02

**UNITED STATES PATENT & TRADEMARK FFICE** #6

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

MAILED

AUG 0 6 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Barnes & Thornburg
2600 Chase Plaza
10 Lasalle Street
Chicago, IL 60603

In re application of
John D. Pratt et al
Application No. 10/138,283
Filed: May 3, 2002
For: PRESSURE REPONSIVE BLOWOUT LATCH

: **DECISION ON RENEWED**
: **PETITION TO MAKE SPECIAL**
: **(COUNTERING TERRORISM)**

This is in response to the renewed petition filed on August 1, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications – inventions for countering terrorism as set forth in MPEP § 708.02 XI. A petition to make special was filed on June 10, 2002. That petition was dismissed in a petition mailed July 1, 2002 wherein it was held that the invention did not directly counter terrorism.

The Patent and Trademark Office will accord "special" status to patent applications relating to counter-terrorism inventions. 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.

Petitioner states that applicant's invention is an anti-terrorism measure such that it prevents terrorists from using a catastrophic failure strategy and helps to maintain structural integrity even after a decompression event.

It is maintained that applicant's invention does not satisfy the requirements stated above. A review of the specification of the invention reveals that it is silent with respect to any mention of preventing terrorism activity. The purpose of the invention is to enhance the safety of passengers by allowing the latching mechanism to release upon certain set of pressure conditions. The fact that a terrorist could create a catastrophic event in a plane not quipped with the latching d vice of th invention does not satisfy th requirements needed to grant a petition based on preventing terrorism.

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

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time are permitted under 37 CFR 1.136(a).

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

kjd: 8/2/02

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ALEXANDRIA, VA 22313-1450
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SEP 2 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE, 46TH FLOOR
1650 MARKET STREET
PHILADELPHIA PA 19103

In Re Application of
Hugues Herve Hoppe, et al.
Application Serial No. 10/138,289
Filed: May 1, 2002
For: **SYSTEMS AND METHODS FOR PROVIDING SIGNAL-SPECIALIZED PARAMETRIZATION**

DECISION ON PETITION TO ACCEPT COLOR DRAWINGS

This is a decision on the petition under 37 C.F.R. § 1.84(a)(2), filed May 1, 2002, requesting acceptance of color drawings.

The petition requests that the color drawings, although not specifically identified but noted as, figures 2A-2D, 5B-5D, 5F-5G, 5J-5K, 5N-5O, 6A-6B, 7A-7B, 8A-8B, 10A-10D and 11 be accepted in lieu of black and white drawings.

A grantable petition under 37 C.F.R. § 1.84(a)(2) must be accompanied by a fee set forth under 37 C.F.R. § 1.17(h), three (3) sets of the color drawings in question, a black and white photocopy of said drawings, and the specification must contain, or be amended to contain, the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings:

*" The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee."*

The petition was filed with the required 3 (three) sets of color drawings of figures 2A-2D, 5B-5D, 5F-5G, 5J-5K, 5N-5O, 6A-6B, 7A-7B, 8A-8B, 10A-10D and 11. The original specification reflects the required notification described above. The fee has been charged to Applicant's deposit account as requested on page 2 of the petition.

All requirements have been met. Accordingly the petition is **GRANTED**.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

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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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

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AUG 1 6 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of | : | |
| Hashida | : | |
| Patent No. 6,856,895 | : | |
| Issue Date: February 15, 2005 | : | Decision on Petition |
| Application No. 10/138,301 | : | |
| Filing Date: May 6, 2002 | : | |
| Attorney Docket No. Q69855 | : | |

This is a decision on the petition under 37 CFR 1.182, filed May 27, 2005, requesting issuance of duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The fee for a petition under 37 CFR 1.182 increased to $400 on November 1, 2004.[1]

The Publishing Division is directed to issue duplicate Letters Patent.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent. The patent file is being forwarded to Files Repository.

Telephone inquiries related to the petition should be directed to Petitions Attorney Steven Brantley at (571) 272-3203. Any questions concerning delays in the issuance of the duplicate Letters Patent should be directed to Krystal Paige at (703) 308-9250 ext. 139.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor, Room C-32 (FAX 703-746-4642)

---

[1] See Revision of Patent Fees for Fiscal Year 2005, 69 Fed. Reg. 52604 (Aug. 27, 2004) and Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 1287 Off. Gaz. Pat. Office 67 (Oct. 12, 2004).

UNITED STATES PATENT AND TRADEMARK OFFICE

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JEFFREY L. IHNEN
ROTHWELL FIGG ERNST & MANBECK
1425 K STREET, NW, SUITE 800
WASHINGTON, DC 20005

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DEC 17 2004

**OFFICE OF PETITIONS**

In re Application of :
Mark T. Keating et al :
Application No. 10/138,316 : NOTICE
Filed: May 6, 2002 :
Attorney Docket No. 2323-162

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 Irvin Dingle at (571) 272-3210.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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APR 2 9 2005

OFFICE OF PETITIONS

Applicant: Ferrari
Appl. No.: 10/138,326
Filing Date: May 6, 2002
Title: COMPOSITION COMPRISING AT LEAST ONE LIQUID FATTY PHASE STRUCTURED BY AT LEAST ONE SEMI-CRYSTALLINE POLYMER
Attorney Docket No.: 05725.1055-00
Pub. No.: US 2003/0021756 A1
Pub. Date: January 30, 2003

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on March 27, 2003, 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.

Inquiries relating to this matter may 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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/9/09

TO SPE OF : ART UNIT 10/138,336

SUBJECT : Request for Certificate of Correction for Appl. No10/138,336.: No.: 7,571,251--

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**

Should the change Be made?

RoChaun Johnson
Certificates of Correction Branch
571 272-0470

**Thank You For Your Assistance**

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

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

**Comments:** _____

SPE

2465
Art Unit

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BORDEN LADNER GERVAIS LLP
Anne Kinsman
WORLD EXCHANGE PLAZA
100 QUEEN STREET SUITE 1100
OTTAWA, ON K1P 1J9
CANADA

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Don Bowman | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7571251 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/04/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/138,336 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/06/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1051** 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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Orum & Roth LLC
53 W. Jackson Boulevard
Chicago IL 60604-3606

| | | |
|---|---|---|
| In re Application of | : | |
| DEAN, et al. | : | |
| Application No. 10/138,340 | : | DECISION ON PETITION |
| Filed: May 03, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 13115 | : | 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 July 16, 2006.

The request is **APPROVED**.

A review of the file record indicates that Catherine L. Gemrich: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Catherine L. Gemrich has 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).

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

A Review of the file discloses that a final Office action was mailed on May 25, 2006, which set forth a three month shortened statutory period for reply. Extensions of time under 37 CFR 1.136(a) were available. To date, there is no indication that a reply to the Office action of May 25, 2006 has been received.

The correspondence address remains unchanged.

Telephone inquires concerning this decision should be directed to Patricia Volpe at 571-272-6825.

David Bucci
Petitions Examiner
Office of Petitions

cc: Stephen Dean
6001 36th Avenue West
Everett, WA 98203-9280

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WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400 – INTERNATIONAL CENTRE
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3319

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DEC 16 2005
OFFICE OF PETITIONS

In re Application of :
Chang-Dong Feng :
Application No. 10/138,359 : ON PETITION
Filed: May 3, 2002 :
Attorney Docket No. R290.12-0017

This is a decision on the petition, filed December 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 November 28, 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 1753 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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APPLE INC./BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Gabriel Marcu | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7609413 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/138,363 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/02/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1455** 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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**INTELLECTUAL PROPERTY LAW GROUP**
**12 SOUTH FIRST STREET**
**SUITE 1205**
**SAN JOSE, CA 95113**

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JUN 22 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Belle L. Chou | : | |
| Application No. 10/138,370 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. SHENW.PT2 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed June 1, 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 July 26, 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 October 27, 2004.

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

This matter is being referred to Technology Center AU 3765.

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

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Paper No. 10

Guy R. Gosnell
Alston & Bird LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

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JUN 19 2003

OFFICE OF PETITIONS

In re Application of
Erland Wittkotter et al.
Application No. 10/138,383
Filed: May 2, 2002
Attorney Docket No. : 047347/259576

ON PETITION

This is a decision on the petition filed February 20, 2003 under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. § 365(c ) for the benefit of prior-filed International Application No. PCT/EP00/10750 filed October 31, 2000.

The petition is **DISMISSED.**

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;[1]

(2) the surcharge set forth in §1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on May 2, 2002 and was copending with the above-noted, prior filed international application, at the time of filing, for which priority is

[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 and indicating the relationship of the applications. Cross references to others related applications may be made when appropriate (see § 1.14).

claimed. A reference to the above-noted, prior-filed international application has been included in an amendment to the first sentence of the specification following the title which was filed concurrently with the instant petition under 37 CFR 1.78(a)(3).

The above reference to the above-noted, prior-filed international application was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e. , in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2).

A reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification has been included in an amendment filed on February 20, 2003. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction to 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.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment deleting the incorporation by reference statement is required.

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

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

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

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

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball in the Office of Petitions at (703) 305-4497.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions

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Paper No. 8 12

Alston & Bird LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

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JUL 0 9 2003

OFFICE OF PETITIONS

In re Application of
Erland Wittkotter et al.
Application No. 10/138,383
Filed: May 2, 2002
Attorney Docket No. 047347/259576

ON PETITION

This is a decision on the renewed petition filed June 30, 2003, by facsimile transmission, under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. § 365(c ) for the benefit of prior-filed International Application No. PCT/EP00/10256 filed October 31, 2000.

The petition is **GRANTED.**

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;[1]

(2) the surcharge set forth in §1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

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[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 and indicating the relationship of the applications. Cross references to others related applications may be made when appropriate (see § 1.14).

The instant pending application was filed on May 2, 2002 and was copending with the above-noted, prior filed international application, at the time of filing, for which priority is claimed. A reference to the above-noted, prior-filed international application has been included in an amendment to the first sentence of the specification following the title which was filed concurrently with the instant renewed petition under 37 CFR 1.78(a)(3).

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(2). Also, the reference to the prior-filed International Application was submitted during the pendency of the International application for which the benefit is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(3) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. § 120, the petition to accept an unintentionally delayed claim of benefit to prior-filed International Application No. PCT/EP00/10750.

A corrected Filing Receipt which includes the priority claim to the above-noted prior-filed international application, and the publication date of October 16, 2003, for the instant application accompanies this decision on petition.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball in the Office of Petitions at (703) 305-4497.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 25 2005

Robert Tellez
1306 N. Commerce
Ft. Worth TX 76016

| | |
|---|---|
| In re Application of<br>Robert Tellez<br>Application No. 10/138,395<br>Filed: May 03, 2002<br>For: INFLATABLE APPARATUS FOR COVERING A VEHICLE | DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT |

This is in response to the reply received March 21, 2005. This reply is being considered a petition to withdraw the holding of abandonment under 37 CFR 1.181. There is no fee for this petition.

The petition is **DENIED**.

A review of the file record indicates that the application was held abandoned for failing to file a proper response to the Final Office Action mailed August 10, 2004. A Notice of Abandonment was mailed on February 22, 2004.

Applicant argues that he did timely file proper papers in response to the Final Rejection mailed August 10, 2004 and to the Advisory Action mailed October 29, 2004.

The filing of an amendment after Final rejection, whether or not it is entered, does *not* stop the running of the statutory period for reply to the Final rejection *unless the examiner holds the claims to be in condition for allowance*. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

The Office Action mailed August 10, 2004 was a Final Office action. A proper reply under 37 CFR 1.113 to a Final Office Action 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. As indicated in the Advisory Action mailed October 29, 2004, the reply received October 07, 2004 (which included a Certificate of Mailing dated October 01, 2004) failed to place the application in condition for allowance. As noted in the Notice of Abandonment mailed February 22, 2004 the reply received February 03, 2005 (which included a certfificate of mailing dated January 10, 2005) failed to place the application in condition for allowance. As no Notice of Appeal (with appeal fee) or timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 have been received the Notice of Abandonment mailed February 22, 2005 is deemed proper.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $500. The fee for a petition under the unintentional standard is $1,500. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

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

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

Telephone inquiries should be directed to the Office of Petitions Staff at (571) 272-3282.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(571) 272-6611

SMN/rjc 07/21/05

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
www.uspto.gov

DEC 20 2005

Robert Tellez
1306 N. Commerce
Ft. Worth TX 76016

| | |
|---|---|
| In re Application of<br>Robert Tellez<br>Application No. 10/138,395<br>Filed: May 03, 2002<br>For: INFLATABLE APPARATUS FOR COVERING A VEHICLE | DECISION ON RENEWED PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT |

This is in response to the reply received October 17, 2005. This reply is being considered a renewed petition to withdraw the holding of abandonment under 37 CFR 1.181. There is no fee for this petition.

The petition is **DENIED**.

Applicant's renewed petition fails to include any additional information which would effect the petition decision mailed on July 25, 2005. Applicant indicates in the petition that it seems his invention has been accepted. It is not clear what the applicant means by this statement. The **current status** of the applicant's invention is **abandoned**.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (**1**) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (**2**) the petition fee required by 37 CFR 1.17(m); and (**3**) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $500. The fee for a petition under the unintentional standard is $1,500. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: 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 should be directed to the Office of Petitions Staff at (571) 272-3282.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(571) 272-6587

KJD/bkg 12/8/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robert Tellez
1306 N. Commerce
Ft. Worth TX 76016

COPY MAILED

JUL 03 2006

OFFICE OF PETITIONS

In re Application of
Tellez
Application No. 10/138,395
Filed: May 3, 2002
Attorney Docket No. N/A
For: INFLATABLE APPARATUS FOR COVERING A VEHICLE

ON PETITION

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

The petition is **dismissed**.

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

The above-identified application became abandoned for failure to properly reply to the final Office action of August 10, 2004, which set a shortened statutory period for reply of three (3) months for reply. Extensions of time were available under 37 CFR 1.136(a). A timely reply was received in the Office on October 7, 2004 (certificate of mailing date October 1, 2004). However, this reply failed to place this application in *prima facie* condition for allowance, as was explained in the October 29, 2004 Advisory Action. Applicant filed another amendment on February 3, 2005 (certificate of mailing date January 10, 2005). The amendment was reviewed, despite the fact that applicant did not purchase an extension of time. The amendment failed to place this application in *prima facie* condition for allowance, as indicated in the February 22, 2004 Notice of Abandonment. This application became abandoned on November 11, 2004.

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

date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

Regarding (1) above, petitioner has still not submitted a **proper** reply to the August 10, 2004 final Office action. Petitioner is reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (5) an RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's rejections, and thus place the case in *prima facie* condition for allowance. Both amendments after final failed to place the application in *prima facie* condition for allowance.

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

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

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

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

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail,

telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Applicant appears to be basing his petition on the fact that the October 7, 2004 (certiifcate of mailing date October 1, 2004) amendment was timely filed in the Office. There is no dispute as to whether or not the first amendment was timely filed. The problem is that the first and second amendments were not ***proper*** responses.

Petitioner's amendments after final failed to eliminate all of the Examiner's rejections. The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

Petitioner's failure to appreciate that the filing of a proposed amendments under 37 CFR 1.116 did not relieve petitioner of the burden of timely filing a notice of appeal or other proper response to avoid abandonment of the above-identified application is unfortunate, but it is not unavoidable delay. The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a) in the situation in which 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. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. At 53162, 1203 Off. Gaz. Pat. Office at 89 (response to comment 66).

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

## ALTERNATE VENUE

Petitioner is encouraged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An

"unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required $750.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). For petitioner's convenience, a blank PTO/SB/64 -- Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

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

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

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

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

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

enclosures: blank PTO/SB/64 -- Petition for Revival of an Application Abandoned Unintentionally under 37 CFR 1.137(b)

Privacy Act Statement

PTO/SB/64 (10-05)
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 UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
**Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____(identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.



This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

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.

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

| | |
|---|---|
| Signature | Date |
| Typed or printed name | Registration Number, if applicable |
| Address | Telephone Number |
| Address | |

Enclosures:
- ☐ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

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 as (571) 273-8300.

| | |
|---|---|
| Date | Signature |
| | Typed or printed name of person signing certificate |

# Privacy Act Statement

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

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

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robert Tellez
1306 N. Commerce
Ft. Worth TX 76016

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OCT 26 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Tellez :
Application No. 10/138,395 :
Filed: May 3, 2002 :
Attorney Docket No. N/A :
For: INFLATABLE APPARATUS FOR :
COVERING A VEHICLE

This is a decision on the reconsideration petition under 37 CFR 1.137(a), filed August 29, 2006 and resubmitted on August 31, 2006), to revive the above-identified application.

The petition is **dismissed**.

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

The above-identified application became abandoned for failure to properly reply to the final Office action of August 10, 2004, which set a shortened statutory period for reply of three (3) months for reply. Extensions of time were available under 37 CFR 1.136(a). A timely reply was received in the Office on October 7, 2004 (certificate of mailing date October 1, 2004). However, this reply failed to place this application in *prima facie* condition for allowance, as was explained in the October 29, 2004 Advisory Action. Applicant filed another amendment on February 3, 2005 (certificate of mailing date January 10, 2005). The amendment was reviewed, despite the fact that applicant did not purchase an extension of time. The amendment failed to place this application in *prima facie* condition for allowance, as indicated in the February 22, 2004 Notice of Abandonment. This application became abandoned on November 11, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the 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 petition lacks items (1) and (3).

Regarding (1) above, petitioner has still not submitted a **proper** reply to the August 10, 2004 final Office action. Petitioner is reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (5) a Request for Continued Examination (RCE). To be a proper reply, an amendment after final must eliminate all of the Examiner's rejections, and thus place the case in *prima facie* condition for allowance. Both amendments after final failed to place the application in *prima facie* condition for allowance.

**In any reconsideration petition, as his reply petitioner should submit a Notice of Appeal OR a Request for Continued Examination with an amendment that addresses the examiner's various rejections of the claims, as detailed in the August 10, 2004 final Office action and the Advisory action, mailed October 29, 2004.**

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

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

> The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an

application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner now seems to argue that since the Office accepted and cashed his $250.00 check for the Rule 137(a) petition fee, that the Office should revive the application.

Petitioner is informed that any revival petition under 37 CFR 1.137 must be accompanied by the petition fee.

The phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R.Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770 ("[the fees set forth in this section are due on filing the petition").

**The collection of a Rule 137 petition fee does not secure an outcome . It is merely enables the Office to consider the points raised in a petition under 37 CFR 1.137 .**

Petitioner still has not shown that the delay was unavoidable.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

**Petitioner is strongly urged to file a petition under 37 CFR 1.137(b). The petition fee is $750.00. Please submit a proper reply to the August 10, 2004 final Office action with the petition under 37 CFR 1.137(b).**

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**By hand:** U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

**By FAX:** (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON TX 76028

**COPY MAILED**

FEB 15 2007

**OFFICE OF PETITIONS**

In re Application of
Tellez
Application No. 10/138,395
Filed: May 3, 2002
Attorney Docket No. N/A
For: INFLATABLE APPARATUS FOR COVERING A VEHICLE

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 26, 2006 (certificate of mailing date December 19, 2006), to revive the above-identified application.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to properly reply to the final Office action of August 10, 2004, which set a shortened statutory period for reply of three (3) months for reply. Extensions of time were available under 37 CFR 1.136(a). A timely reply was received in the Office on October 7, 2004 (certificate of mailing date October 1, 2004). However, this reply failed to place this application in *prima facie* condition for allowance, as was explained in the October 29, 2004 Advisory Action. Applicant filed another amendment on February 3, 2005 (certificate of mailing date January 10, 2005). The amendment was reviewed, despite the fact that applicant did not purchase an extension of time. The amendment failed to place this application in *prima facie* condition for allowance, as indicated in the February 22, 2004 Notice of Abandonment. This application became abandoned on November 11, 2004.

Applicant has submitted a reply in the form of a RCE and amendment, an acceptable statement of the unintentional nature of the delay in responding to the August 10, 2004 final Office action, and the petition fee.

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. In the event that practitioner has no knowledge that the delay was in fact unintentional, practitioner should make a

reasonable inquiry to ascertain that, in fact, the delay was unintentional. If practitioner discovers that the delay was intentional, practitioner must so notify the Office.

Having satisfied all requirements under 37 CFR 1.137(b), the petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center A.U. 3673 for further examination.

Telephone inquiries concerning this decision 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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Paper No. 5

WILLIAM D. HALL, ESQ.
10330 RIVER ROAD
SUITE 200
POTOMAC, MD 20854

**COPY MAILED**

**JUL 14 2003**

**OFFICE OF PETITIONS**

In re Application of
Martell et al.
Application No. 10/138,418
Filed: May 6, 2002
For: ROUTE GUIDANCE FOR VEHICLES

ON PETITION

This decision concerns the June 18, 2003 petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

On May 24, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, giving Applicants an extendable 2-month period for submitting an oath or declaration. No extension of time under 37 CFR 1.136(a) was obtained, and the oath or declaration was not submitted on or before December 24, 2002. The application became abandoned on July 24, 2002.

The instant petition authorizes the Office to charge the $650 petition fee to a credit card;[1] encloses a "Combined Declaration and Power of Attorney" executed by both of the two inventors named in this application; and includes a statement that the entire delay in submitting the declaration from its due date until the filing of a grantable §1.137(b) petition was unintentional. The petition is thus granted.

The application file is being forwarded to Technology Center 3600 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

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[1] **The petition authorizes $1,640, while the petition fee is only $650 (small entity). The overpayment of $990 has been credited to the same credit card.**

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

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Everett Lee Mitchell | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7614191 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/10/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/138,444 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/02/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 11/02/09

**TO SPE OF** : ART UNIT 2465

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10138454 Patent No.: 7551628

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 9C62-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.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

2465

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE

Art Unit

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



PATENT NO. : 7,551,628

APPLICATION NO. : 10/138,454

ISSUE DATE : Jun. 23, 2009

INVENTOR(S) : Helen A. Holder

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:

In column 7, line 32, in Claim 13, insert - - a - - before "processor".

In column 7, line 36, in Claim 13, delete "configured" and insert - - configure - -, therefor.

In column 8, line 2, in Claim 14, delete "instruction" and insert - - instructions - -, therefor.

In column 8, line 6, in Claim 15, insert - - received - - before "instructions.

In column 8, line 7, in Claim 16, after "processing" insert - - comprises - -, therefor.

In column 8, line 20, in Claim 18, delete "net work" and insert - - network - -, therefor.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
Fort Collins, CO 80528

This collection of information is required by 37 CFR 1.322, and 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 Patent, 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.*

8. The method of claim 7 wherein processing the instruction further includes the step of transforming the instruction into machine control commands.

9. The method of claim 7 further including the steps of:

transmitting an instruction including at least one identification number from a wireless device to the control device using a wireless protocol, wherein the instruction controls a plurality of machines;

processing the instruction in at least one dongle; and

transmitting the processed instruction to the machine connected to the dongle.

10. The method of claim 9 wherein processing the instruction further includes the step of determining if the at least one identification number transmitted with said instruction matches a dongle identification number associated with the dongle and, if so, processing the received instruction.

11. The method of claim 7 further including the steps of:

receiving a response from the machine; and

transmitting the response to the control device.

12. The method of claim 7 wherein receiving the instruction further includes the step of directly receiving the instruction from the control device using short range radio links.

13. A system for transmitting instructions to a machine using a dongle placed in a communication path and connected to the machine, the dongle selectively passes signals including instructions to the machine in response to wireless receipt of a valid address and the instruction, the dongle comprising:

a network interface configured to receive instructions from an access point;

a memory for storing said received instructions;

processor for processing the received instructions to result in processed instructions; and

a machine interface configured to transmit said processed instructions to the machine;

wherein the processed instructions configured the machine to perform at least one fabrication operation.

14. The system of claim 13 wherein the processing comprises transforming the received instruction into machine control commands.

15. The system of claim 13 wherein the received instructions include at least one identification number, and wherein the instructions controls a plurality of machines.

16. The system of claim 15 wherein the processing determining if the at least one identification number matches a dongle identification number associated with the dongle and, if so, transmitting the processed instructions from the dongle to the machine.

17. The system of claim 13 wherein the machine interface is further configured to receive a response from the machine and wherein the network interface is configured to transmit the response to the access point.

18. A dongle, with embedded computing capability, placed in a communication path and capable of passing information from a control device through an access point to a fabrication machine, the dongle comprising:

a net work interface configured to receive instructions and an associated identification number from an access point;

a machine interface configured to interface with the fabrication machine;

a memory for storing instructions; and

a processor configured to execute the instructions, wherein the processed instructions configure the fabrication machine to perform at least one fabrication operation.

19. The dongle of claim 18 wherein said processor is configured to process the received instructions for transforming the received instructions into machine control commands.

20. The dongle of claim 18 wherein said processor is configured to process the received instructions for determining if an identification number transmitted with said instructions matches a dongle identification number associated with the dongle.

* * * * *

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. 4

| | |
|---|---|
| In re Application of Rudski, Lewis | : |
| | : DECISION GRANTING PETITION |
| Application No. 10/138,490 | : TO REMAIL AN OFFICE |
| Filed: 05/06/2002 | : COMMUNICATION AND RESTART |
| Attorney Docket No. DesignYourOwn-1 | : PERIOD FOR REPLY |

This is a decision on the petition filed on February 13, 2003, requesting that the Office communication mailed on June 7, 2002 be remailed and the shortened statutory period for reply set forth in the Office communication be restarted on the new mail date.

The petition is granted.

Petitioner provided a statement that the Office communication in question was never received. The entire portion of the reply period had elapsed when applicant's attorney checked the status of their docket. Since the PTO correspondence was mailed through the Brentwood Post Office, the PTO is granting this petition and restarting the period of time to comply.

Accordingly, the Office communication in question will be remailed and the period for reply that was originally set forth in the Office communication will be restarted to run from the new mail date of the Office communication.

Kevin Little 3/11/03

Kevin Little
Office of Initial Patent Examination
(703) 308-1863

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Commissioner for Patents
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Paper No. 11

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

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SEP 0 8 2003

OFFICE OF PETITIONS

In re Application of
DAUNERT et al.
Application No. 10/138,503
Filed: May 6, 2002
Attorney Docket No. 3798-0107P

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed May 30, 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 1, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The present petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. A Communication Regarding Rescission of Nonpublication Request which sets forth the projected publication date of December 18, 2003, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 1641 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: A Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing.

Docket No.: CIT.PAU.06 **Patent Application**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Roukes et al.

Serial No.: 10/138,538

Filed: May 3, 2002

For: APPARATUS AND METHOD FOR ULTRASENSITIVE NANOELECTROMECHANICAL MASS DETECTION

Examiner: Miller, Rose Mary

Group Art Unit: 2856

**RESPONSE TO DECISION ON PETITION**
**under 37 CFR 1.137(b)**

Publishing Division
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

In response to the Decision on Petition under 37 CFR 1.137(b) dated January 21, 2004, Applicant hereby encloses the following:

(1) A copy of the Decision on Petition under 37 CFR 1.137(b) dated January 21, 2004;

(2) A completed Issue Fee Transmittal Form (PTOL-85b).

The issue fee in the amount of $665, publication fee in the amount of $300, and fee for ten (10) copies of the patent in the amount of $30 were previously submitted on January 12, 2004.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 01-1960 for any additional fee required or overpayment.

Respectfully submitted,

Daniel L. Dawes
Registration No. 27,123
MYERS DAWES ANDRAS & SHERMAN LLP
19900 MacArthur Blvd, 11th Floor
Irvine, CA 92612
Tel: (949) 223-9600
Fax: (949) 223-9610

*CERTIFICATE OF MAILING*
*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:* ***Publishing Division, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450*** *on Jan. 28, 2004.*

*By Nancy V. McElrath*

*Signature* *Date* 1-28-04

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Paper No. 10

Daniel L. Dawes
Myers, Dawes & Andras, LLP
19900 MacArthur Blvd., Ste. 1150
Irvine, CA 92612

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JAN 21 2004

OFFICE OF PETITIONS

| ENTERED ON DOCKET | RESPONSE DUE |
|---|---|
| 1-26-04 | 2-21-04 |
| ACTION NOTED | |
| MOM | |

In re Application of
Michael L. Roukes, et. al.
Application No. 10/138,538
Filed: May 3, 2002
Attorney Docket No. CIT.PAU.06

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 12, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed August 12, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned after midnight November 12, 2003.

In response to the Notice of Allowance, petitioner submitted with the instant petition $665 for the petition to revive fee, $665 for the issue fee, $300 for the publication fee and $30 for ten (10) advance soft copies.

Since the requirements for a grantable petition have been met, the petition is **GRANTED**.

There is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

The application file is being forwarded to the Publishing Division for further processing into a patent.

Telephone inquiries concerning this decision should be directed to Andrea Smith at (703) 308-6711.

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Blank Issue Fee Transmittal Form (PTOL-85b)

MYERS DAWES ANDRAS & SHERMAN LLP
19900 MacArthur Boulevard, 11th Floor
Irvine, CA 92612

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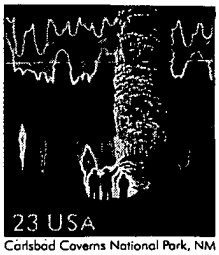


Daniel L. Dawes, Esq.
MYERS DAWES ANDRAS & SHERMAN LLP
19900 MacArthur Blvd, 11th Floor
Irvine. CA 92612

© USPS 2002 recycled

**The official stamp of the PTO hereon acknowledges receipt of the following mailed on Jan. 28, 2004:**

Serial No.: 10/138,538
Filing Date: May 3, 2002
Applicant: Roukes et al.
Docket No.: CIT.PAU.06
Title: Apparatus and Method for Ultrasensitive Nanoelectromechanical Mass Detection

(1) Response to Decision on Petition under 37 CFR 1.137(b)
(2) Copy of Decision on Petition under 37 CFR 1.137(b)
(3) Issue Fee Transmittal Form (PTOL-85b)
(4) Certificate of Mailing by First Class Mail

DLD

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30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3800

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JUL 0 5 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re | : DECISION |
| Tomioka, et al. | : ON |
| Application No. 10/138,576 | : APPLICATION |
| Filed: May 6, 2002 | : FOR |
| Patent No. 6,863,391 | : PATENT TERM ADJUSTMENT |
| Issued: March 8, 2005 | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R 1.705(d)", filed May 2, 2005, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The petition is **DISMISSED.** Patentees are given **two (2) months** to respond to this decision. No extensions of time will be granted under 37 C.F.R. § 1.136(a).

On March 8, 2005, the above-identified application matured into U.S. Patent No. 6,707,476. The patent issued with a Patent Term Adjustment of two hundred forty-one (241) days.

Patentees assert entitlement to a patent term adjustment of three hundred twenty-six (326) days on the basis that the PTO improperly assessed applicant delay of eighty-five (85) days for filing a "COMBINED DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION", after the Office mailed a Notice of Allowance. Patentee states that the declaration and power of attorney was a duplicate of one previously filed, and as such, no Applicant delay should be assessed.

Patentees state that the patent is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of two hundred forty-one (241) days based on an adjustment for PTO delay of two hundred thirty-four (234) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and ninety-two (92) days pursuant to 35 U.S.C. 154(b)(iv) and 37 C.F.R. § 1.703(a)(6), reduced by Applicant's delay of eighty-five (85) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(10). The adjustment of 85 days is at issue.

The adjustment of 85 days has been found to be correct. The Office file is the official record of the papers originally filed in this application. A petitioner alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Patentees have not supplied a copy of the date stamped, itemized postcard receipt, evidencing that the declaration and power of attorney was previously filed on August 2, 2002. See MPEP 503.

The Office acknowledges submission of the $200.00 fee set forth in 37 C.F.R. § 1.18(e).

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

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Paper No. 3

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OFFICE OF PETITIONS

MORRISON & FOERSTER
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

In re Application of
Gregory W. Starr et al
Application No. 60/289,268
Filed: May 6, 2001
Attorney Docket No. 306813002300

DECISION GRANTING
PETITION

This is a decision on the paper styled "REQUEST FOR A CORRECTED FILING RECEIPT" filed June 14, 2002, requesting that the above-identified application be accorded a filing date of May 6, 2001, rather than the presently accorded filing date of May 8, 2001. The petition is properly treated as a petition under 37 CFR 1.10(c).

Applicants request the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on May 6, 2001, pursuant to the requirements of 37 CFR 1.10. In support, applicants provided, inter alia, a copy of the receipt for Express Mail label No. EL308350796US. The same Express Mail number appears on the copy of the original transmittal letter found in the present application. It is noted that while the "date-in" on the copy of the Express Mail receipt is not legible, it includes a "San Francisco, USPS" receipt stamp dated "May 6, 2001".

In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on May 6, 2001.

The petition is granted.

No petition fee is required and none has been charged.

The application is being returned to the Office of Initial Patent Examination for correction of the filing date to May 6, 2001.

Telephone inquiries specific to this matter should be directed to Wan Laymon at (703) 306-5685.

Sherry Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Received from < 415 2687522 > at 9/5/02 2:57:36 PM [Eastern Daylight Time]

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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 |
|---|---|---|---|---|---|---|---|
| 60/289,268 | 05/06/2001 | | 150 | 306813002300 | 7 | | |

CONFIRMATION NO. 2156

CORRECTED FILING RECEIPT

*OC000000008843715*

20872
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

Date Mailed: 08/16/2002

Receipt is acknowledged of this provisional Patent Application. It will not be examined for patentability and will become abandoned not later than twelve months after its filing date. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Gregory W. Starr, San Jose, CA;
Wanli Chang, Saratoga, CA;

If Required, Foreign Filing License Granted 06/28/2001

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Programmable loop bandwidth in phase locked loop (PLL) circuit

---

**LICENSE FOR FOREIGN FILING UNDER**
**Title 35, United States Code, Section 184**
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

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The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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Paper No. 3

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SAN FRANCISCO, CA 94105-2482

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OFFICE OF PETITIONS

In re Application of
Gregory W. Starr et al
Application No. 60/289,268
Filed: May 6, 2001
Attorney Docket No. 306813002300

DECISION GRANTING PETITION

This is a decision on the paper styled "REQUEST FOR A CORRECTED FILING RECEIPT" filed June 14, 2002, requesting that the above-identified application be accorded a filing date of May 6, 2001, rather than the presently accorded filing date of May 8, 2001. The petition is properly treated as a petition under 37 CFR 1.10(c).

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The petition is granted.

No petition fee is required and none has been charged.

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Sherry Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|---|
| 60/289,268 | 05/06/2001 | | 150 | 306813002300 | 7 | | |

CONFIRMATION NO. 2156

CORRECTED FILING RECEIPT

*OC000000008643715*

20872
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

Date Mailed: 08/16/2002

Receipt is acknowledged of this provisional Patent Application. It will not be examined for patentability and will become abandoned not later than twelve months after its filing date. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

**Applicant(s)**

Gregory W. Starr, San Jose, CA;
Wanli Chang, Saratoga, CA;

**If Required, Foreign Filing License Granted** 06/28/2001

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Programmable loop bandwidth in phase locked loop (PLL) circuit

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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**

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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.

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**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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Paper No. 080204

ARARAT KAPOUYTIAN
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105

AUG 2 4 2004

| | | |
|---|---|---|
| In re Application of: | : | |
| GREG STARR | : | DECISION ON REQUEST TO WITHDRAW FROM RECORD |
| Serial No.: 10/138,600 | : | |
| Filed: May 3, 2002 | : | |
| Attorney Docket No.: **306812002700** | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed April 14, 2004.

The request is **DISMISSED** as moot.

A review of the application file record reveals a proper revocation and power of attorney to the attorneys of Fish & Neave was filed on February 20, 2004. As such, the power of attorney for the attorneys and agents requesting withdrawal has already been revoked. Accordingly, the present request is moot, and must be dismissed.

All future communications form the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Inquiries related to this decision should be directed to Jose G. Dees at (571) 272-1569.

Jose G. Jose, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020

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Paper No. 6

**MAIL**

DEC 1 6 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

J. Mark Smith
DORR, CARSON, SLOAN & BIRNEY, P.C.
3010 East 6th Avenue
Denver, CO 80206

In re Application of
Scott SHATTUCK, et al
Application No. 10/138,607
Filed: May 3, 2002
For: A SYSTEM SUPPORTING UNIFIED EVENT HANDLING IN ECMASCRIPT

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

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.

The request is **GRANTED**.

All future communication 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 U.S. Patent and Trademark Office (the Office) of any change in correspondence address to ensure receipt of all communications from the Office.

For Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
(703) 305-9750

cc: J. Mark Smith, Esq.
Pendleton, Friedberg, Wilson & Hennessey, P.C.
303 East 17th Avenue
Suite 1000
Denver, CO 80203-1263

UNITED STATES PATENT AND TRADEMARK OFFICE

#8

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AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APR 17 2003

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20004

| | |
|---|---|
| In re Application of | : |
| Dario C. Alteri | : |
| Serial No.: 10/138,618 | : PETITION TO MAKE SPECIAL |
| Filed: May 6, 2002 | : |
| Attorney Docket No.: 044574-5022-03 | : |

This is in response to the petition filed March 13, 2003, to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on actual infringement.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, II. 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

Crystal Mall 1, 7th Floor
1911 South Clark Street
Arlington, VA 22202
Tel.: 703-308-8362
Fax: 703-746-5195

**USPTO**

# Fax

| | | | |
|---|---|---|---|
| **To:** | Sally Teng | **From:** | Examiner Canella |
| **Fax:** | 202-739-3001 | **Pages:** | 21 |
| **Phone:** | | **Date:** | 6/20/03 |
| **Re:** | 10/138,618 | **CC:** | |

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

• **Comments:**

| Interview Summary | Application No. 10/138,618 | Applicant(s) Altieri |
|---|---|---|
| | Examiner Karen Canella | Art Unit 1642 |

All participants (applicant, applicant's representative, PTO personnel):

(1) *Karen Canella* (3) _____

(2) *Sally Teng* (4) _____

Date of Interview *Jun 20, 2003*

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy is given to 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:

Claim(s) discussed: *1-59*

Identification of prior art discussed:

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

*The examiner notes that t claims 1-59 are canceled according to the transmital sheet.*

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Karen A. Canella
Examiner's signature, if required

**********
*** TX REPORT ***
**********

TRANSMISSION OK

| | |
|---|---|
| TX/RX NO | 0749 |
| CONNECTION TEL | 912027393001 |
| SUBADDRESS | |
| CONNECTION ID | |
| ST. TIME | 06/20 14:02 |
| USAGE T | 01'11 |
| PGS. | 3 |
| RESULT | OK |

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Paper No. 8

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DEC 1 6 2003

**Technology Center 2100**

J. Mark Smith
DORR, CARSON, SLOAN & BIRNEY, P.C.
3010 East 6th Avenue
Denver, CO 80206

| | | |
|---|---|---|
| In re Application of<br>Scott SHATTUCK, et al<br>Application No. 10/138,631<br>Filed: May 3, 2002<br>For: A SYSTEM SUPPORTING OBJECT-ORIENTED CONSTRUCTS IN ECMASCRIPT | : | DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY |

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.

The request is **GRANTED**.

All future communication 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 U.S. Patent and Trademark Office (the Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
(703) 305-9750

cc: J. Mark Smith, Esq.
Pendleton, Friedberg, Wilson & Hennessey, P.C.
303 East 17th Avenue
Suite 1000
Denver, CO 80203-1263

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400

MAILED

MAR 10 2009

OFFICE OF PETITIONS

In re Application of :
Muntz, et al. :
Application No. 10/138,644 : DECISION
Filed: 6 May, 2002 :
Attorney Docket No. 10013045-1 :

This is a decision on the petition, filed on 29 December, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 C.F.R. §1.181 is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

Petitioners always are directed to the Commentary at MPEP §711.03(c )(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181. Petitioners must, *inter alia*, provide statements and documentary support as set forth in the Commentary at MPEP §711.03(c )(I).

## BACKGROUND

The record reflects as follows:

This application was held abandoned for Petitioner's failure to reply timely and properly following the 26 August, 2008, decision of the Board of Patent Appeals and Interferences (BPAI), with reply due absent advance request and fee for extension of time on or before 26 October, 2008.

Thus, the application was held abandoned by operation of law after midnight 26 October, 2008.

The Office mailed the Notice of Abandonment on 5 November, 2008.

On 29 December, 2008, Petitioner filed a petition pursuant to 37 C.F.R. §1.181, with, *inter alia*, an averment that:

- following rejection (35 U.S.C. §103) of all pending Claims 1-7, 9-10, 12-15, 17-20, and 22-30, Petitioner filed a Notice of Appeal (with fee) and Appeal Brief (with fee);
- thereafter, the Examiner in his Answer withdrew the rejection as to claims 2-6, 14-15, 18, 24-30;
- the BPAI decision upheld the Examiner's rejection.

Petitioner argues that consistent with the guidance in the Commentary at MPEP §1214.06, the Examiner could:

- via Examiner's amendment convert from dependent to independent claims on which he had withdrawn rejections; or
- set a one-month period within which Petitioner might convert from dependent to independent claims on which the Examiner had withdrawn rejections.

In any case, argues the Petitioner, deeming the application abandoned without having chosen or other of the alternatives set forth was improper.

The record is silent as to the entry of an Examiner's amendment, and evidences no mailing of an Office action directing amendment of allowable claims.

The guidance in the Commentary at MPEP §711.03(c )(I), provides in pertinent part:

***

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
>
> 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 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.[1]

***

The record evidencing no mailing of an Office action and, in the alternative, no Examiner's amendment, Petitioner need make no further showing to satisfy the requirements under the rule.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

## STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.[3],[4]

---

1 *See*: MPEP §711.03(c ) (I)(A).

2 See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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 The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter.

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c )(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Allegations as to the Request to
Withdraw the Holding of Abandonment

The record evidences a satisfactory presentation of the showing requirements under the Rule.

## CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **granted**, and the 5 November, 2008, Notice of Abandonment is **vacated**.

The instant application is released to the Technology Center/AU 2439 *for further processing as necessary in due course consistent with this decision and the guidance in the Commentary at MPEP §1214.06.*

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[5]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

---

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.))

[5] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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JUL 2 0 2009

OFFICE OF PETITIONS

In re Application of
Nalepa, et al.
Application No. 10/138,664
Filed: May 3, 2002
Atty. Dkt. No.: BR-7256

: LETTER REGARDING PTA

This letter is in response to the "STATEMENT REGARDING PTAENT TERM ADJUSTMENT," filed August 12, 2008. The Office thanks applicants for their good faith and candor in bringing this to our attention.

The Determination of Patent Term Adjustment mailed May 12, 2008 indicated that the above-identified application was entitled to a patent term adjustment ("PTA") of 655 days. Applicants indicate this adjustment is greater than expected by applicants. Applicants further indicate that the time between the filing of a Notice of Appeal and the submission of a compliant Appeal Brief should not be counted in the calculation of Patent Term Adjustment, and appears to have been added to the Adjustment in the present application. Applicants further advise that terminal disclaimers, which may affect the adjustment, have been filed in this application.

**The correct Patent Term Adjustment ("PTA") at the time of the allowance is 572 days as discussed herein.**

The adjustment of 616 days under 37 CFR 1.702(a)(1) in connection with the mailing of the non-final Office action on March 10, 2005 was correctly calculated. The adjustment of 46 days pursuant to 37 CFR 1.702(a)(2) in connection with the mailing of the Notice of Allowance on May 12, 2008 was correctly calculated. Further, the reductions to date of 217 days were also correctly calculated.

The error noted by applicants concerning the appeal brief has been corrected. A Notice of Appeal was filed June 29, 2006. An appeal brief was filed August 29, 2006. The appeal brief was defective, as noted by the Office on November 14, 2006. A compliant appeal brief was filed November 22, 2006. Thus, in accordance with 37 CFR 1.702(a)(4), the application is entitled to an adjustment of 127 days, and not 210 days. The adjustment commenced March 23, 2007, the day after the date that is four months after the date that an appeal brief in compliance with 37 CFR 41.37 was filed, and ended July 27, 2007, the date that an action under 35 USC 132 (the non-final Office action) was mailed. See, 37 CFR 1.703(a)(4).

Accordingly, as of the time of allowance, the application is entitled to an adjustment of 572 days (adjustments totalling 789 days less reduction of 217 days).

As applicants are advising us of a potential error in providing too much patent term adjustment in this application, no fee is due in connection with this matter.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Ms. Drabnis appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party in whose behalf she acts. If, Ms. Drabnis desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Ms. Drabnis, 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 application file is being forwarded to the Division of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculation

CC: Mary H. Drabnis
McGlinchey Stafford PLLC
4703 Bluebonnet Blvd.
Baton Rouge, LA 70809

Day : Saturday
Date: 7/18/2009

# PALM INTRANET

Time: 07:16:54

| PTA Calculations for Application: 10/138664 | | | |
|---|---|---|---|
| Application Filing Date: | 05/03/2002 | PTO Delay (PTO): | 872 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 217 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 572 |
| PTO Delay Adjustment: | -83 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 66 | 07/18/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 127 | | |
| 65 | 07/18/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 210 | |
| 54 | 05/12/2008 | MAIL NOTICE OF ALLOWANCE | 46 | | 44 |
| 53 | 05/09/2008 | ISSUE REVISION COMPLETED | | | |
| 52 | 05/02/2008 | ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING | | | |
| 51 | 05/02/2008 | DOCUMENT VERIFICATION | | | |
| 50 | 04/28/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 49 | 04/28/2008 | NOTICE OF ALLOWABILITY | | | |
| 48 | 11/27/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 47 | 04/25/2008 | PARALEGAL TD ACCEPTED | | | |
| 46 | 04/24/2008 | TERMINAL DISCLAIMER FILED | | 149 | 44 |
| 45 | 02/21/2008 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 11/27/2007 | RESPONSE AFTER NON-FINAL ACTION | | 31 | 39 |
| 43 | 11/27/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 42 | 11/27/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 41 | 11/27/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 40 | 10/04/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 39 | 07/27/2007 | MAIL NON-FINAL REJECTION | 210 | | 32 |
| 38 | 07/23/2007 | NON-FINAL REJECTION | | | |
| 37 | 01/10/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 36 | 01/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 35 | 11/22/2006 | APPEAL BRIEF FILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 34 | 11/14/2006 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 33 | 09/07/2006 | DATE FORWARDED TO EXAMINER | | | |
| 32.1 | 08/29/2006 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 32 | 08/29/2006 | APPEAL BRIEF FILED | | | |
| 31 | 06/29/2006 | NOTICE OF APPEAL FILED | | 37 | 25 |
| 30 | 06/29/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 29 | 05/23/2006 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 28 | 05/22/2006 | ADVISORY ACTION (PTOL-303) | | | |
| 27 | 04/26/2006 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 04/24/2006 | AMENDMENT AFTER FINAL REJECTION | | | |
| 25 | 02/23/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 24 | 02/21/2006 | FINAL REJECTION | | | |
| 23 | 12/15/2005 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 12/05/2005 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 21 | 09/07/2005 | MAIL NON-FINAL REJECTION | | | |
| 20 | 09/06/2005 | NON-FINAL REJECTION | | | |
| 19 | 06/28/2005 | DATE FORWARDED TO EXAMINER | | | |
| 18 | 06/10/2005 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 17 | 06/10/2005 | REFERENCE CAPTURE ON IDS | | | |
| 16.7 | 06/10/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 06/10/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 15 | 06/10/2005 | PRELIMINARY AMENDMENT | | | |
| 14 | 03/10/2005 | MAIL NON-FINAL REJECTION | 616 | | -1 |
| 13 | 03/07/2005 | NON-FINAL REJECTION | | | |
| 12 | 01/25/2004 | REFERENCE CAPTURE ON IDS | | | |
| 11.7 | 01/05/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 01/05/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 12/16/2004 | MISCELLANEOUS INCOMING LETTER | | | |
| 9 | 04/14/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 8 | 10/24/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 7.7 | 06/16/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
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|---|---|---|---|---|---|
| 7 | 06/16/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6.7 | 09/30/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 09/30/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 07/01/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 06/18/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 06/13/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 05/14/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 05/03/2002 | 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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BATON ROUGE, LA 70801

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Christopher J. Nalepa | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7578968 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/25/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/138,664 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/03/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1378** 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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010304

Mark A. Navarre
Law Office of Mark Navarre
P.O. Box 537
Urbana OH 45502

| | | |
|---|---|---|
| *In re* Application of<br>Michael Stumpf<br>Application No.: 10/138,673<br>Filed: May2, 2002<br>For: SYSTEM AND METHOD FOR AUTOMATICALLY JUDGING THE SEALING EFFECTIVENESS OF A SEALED COMPARTMENT | :<br>:<br>:<br>:<br>:<br>: | **WITHDRAWAL FROM ISSUE**<br>*37 C.F.R. § 1.313* |

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 C.F.R. § 1.313(b)(3).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon 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 Fee(s) 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 and Fee(s) Due in order to prevent abandonment of the application.

Telephone inquiries should be directed Hezron Williams, Supervisory Patent Examiner, at (571) 272-2208.

The examiner will notify applicant of the new status of this application in an Office action to be issued promptly.

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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**BARRY W. CHAPIN, ESQ.**
**CHAPIN & HUANG, L.L.C.**
**WESTBOROUGH OFFICE PARK**
**1700 WEST PARK DRIVE**
**WESTBOROUGH MA 01581**

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JUL 0 3 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Liskov et al. | : | |
| Application No. 10/138,680 | : | DECISION ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. CIS01-30(4843) | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 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 November 9, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed August 9, 2006. Accordingly, the date of abandonment of this application is 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 payment of the issue fee of $1400.00, (2) the petition fee of $1500.00; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6052 or in his absence, the undersigned at (571) 272-7099.

This application is being referred to Publishing Division for processing into a patent.

David Bucci
Petitions Examiner
Office of Petitions

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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

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AUG 27 2008

**OFFICE OF PETITIONS**

In re Application of :
Polly Stecyk, et. al. :
Application No. 10/138,690 : ON PETITION
Filed: May 2, 2002 :
Attorney Docket No. 705397.51 :

This is a decision on the petition under 37 CFR 1.137(b), filed on March 5, 2008, to revive the above-identified application.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114, with the $810 filing fee; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 2623, for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted on November 28, 2007 in accordance with 37 CFR 1.114.

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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NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02210-2604

MAILED

APR 2 6 2005

Technology Center 2100

In re Application of BIGWOOD et al
Application No.: 10/138,725
Filing Date: May 3, 2002
For: METHODS AND APPARATUS FOR VISUALIZING RELATIONSHIPS AMONG TRIPLES OF RESOURCE DESCRIPTION FRAMEWORK (RDF) DATA SETS

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition filed October 14, 2004 under 37 CFR §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. §708.02, Section VIII, which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 CFR §1.102(d), states in relevant part, "A new application (one which has not received any examination by the examiner) may be granted special status. . . ."

A review of the application file reveals that a first Office action on the merits was mailed October 7, 2004, before the present petition was filed. Thus, the application is not eligible for special status.

Accordingly, the petition to make special is **DISMISSED**.

Any request for reconsideration must be filed within TWO (2) MONTHS from the mailing date of this decision.

The application will be returned to the examiner for continued processing.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
571-272-3599

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#4

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ONE LIBERTY PLACE, 46TH FLOOR
1650 MARKET STREET
PHILADELPHIA PA 19103

MAIL

MAR - 4 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
HOPPE, HUGUES HERVE, ET AL
Serial No.: 10/138,751
Filed: May 1, 2002
For: **SYSTEMS AND METHODS FOR OPTIMIZING GEOMETRIC STRETCH OF A PARAMETRIZATION SCHEME**

DECISION ON PETITION
*ACCEPTANCE OF COLOR DRAWINGS*

This is a decision on the petition under 37 C.F.R. § 1.84(a)(2), filed, May 1, 2002, requesting acceptance of color drawings.

The petition requests that the color drawings identified in Figures 1A, 1B, 2A, 2B, 3A – 3G, 4A, 4B, 5A, 5B, 6, 7, 8A, 8B, 9A –9D, 10A – 10D, and 11A –11D, be accepted in lieu of black and white drawings.

A grantable petition under 37 C.F.R. §1.84(a)(2) must be accompanied by a fee set forth under 37 C.F.R. § 1.17(h), 3(three) set of the color drawings in question, and the specification must contain, or be amended to contain, the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings:

*"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."*

The application file is being forwarded to the Group technical support staff for entry of the proposed amendment filed with this petition. From there, the application file will be forwarded to Drafting Division, Drawing Review Branch for review of the drawing figures in light of this decision

The petition is **GRANTED**.

Krista Zele
Special Program Examiner
Technology Center 2100
Communications

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| | | |
|---|---|---|
| In re Application of | : | |
| Susan L. Zander, et al. | : | |
| Application No. 10/138,768 | : | DECISION ON PETITION |
| Filed: May 3, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 020239-000600US | : | 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 5, 2006.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Townsend and Townsend and Crew, LLP has been revoked by the assignee of the patent application on December 15, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: NATE GEMETTI
SCOTISH RE (U.S.), INC.
13840 CALLANTYNE CORPORATE PLACE
SUITE 500
CHARLOTTE, NC 28277

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

COPY MAILED

JUL 27 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Susan L. Zamder, et al. | : | |
| Application No. 10/138,768 | : | DECISION ON PETITION |
| Filed: May 3, 2002 | : | TO WITHDRAW |
| Attorney Docket No. A9255 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 29, 2009.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Sughrue Mion, PLLC has been revoked by the assignee of the patent application on July 7, 2009. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: NEAL FEIVELSON, ESQ.
LOVELLS, LLP
590 MADISON AVENUE
NEW YORK, NY 10022

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) |
|---|---|---|---|---|
| 6845271 | 2005-01-18 | 10138791 | 2002-05-03 | 9844.17220-CIP 2 |

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 | /Thomas J. Krumenacher/ | Date (YYYY-MM-DD) | 2008-02-25 |
| Name | Thomas J. Krumenacher | Registration Number | 56736 |

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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6845271
Issue Date: January 18,2005
Application No. 10138791
Filed: May 3,2002
Attorney Docket No. 9375.17220-CIP 2

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 25,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 25,2009 . 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. 5

JAMES A HARRISON
PO BOX 160727
AUSTIN TX 78716

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**JAN 2 4 2003**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of<br>Hooman Darabi and Ken Evans<br>Application No. 10/138,801<br>Filed: May 3, 2002<br>Attorney Docket No. BP 2123<br>Title: HIGH SPEED OPERATIONAL AMPLIFIER DESIGN | : | DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a) |

This is in response to the petition under 37 CFR 1.47, filed September 19, 2002, which is being treated as a petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **GRANTED**.

The above-identified application was filed on May 3, 2002, without, *inter alia*, a fully executed declaration. Accordingly, on June 12, 2002, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely this petition, applicant purchased a one month extension of time and included a Certificate of Mailing dated September 12, 2002. With the instant petition, applicant filed a copy of a declaration signed by inventor Hooman Darabi, but lacking a signature from inventor Ken Evans.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

With the instant petition, attorney James A. Harrison included a copy of a cover letter dated April 15, 2002, transmitting the application papers and declaration and assignment documents to the last known address of Evans. According to Harrison, no executed declaration from Evans has been received.

The declaration filed September 19, 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 Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The application file is being forwarded to the Technology Center 2600 for examination.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Garlick Harrison & Markison
P.O. Box 670007
Dallas, Texas 75367

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JEFF KNIRCK
868 JASMINE DR.
SUNNYVALE, CA 94086

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OCT 02 2003

OFFICE OF PETITIONS

In re Application of
Jeffrey G. Knirck
Application No. 10/138,816
Filed: May 6, 2002
Attorney Docket No.

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 21, 2003, to revive the above-identified application.

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 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on April 3, 2003.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 2800 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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JUL 30 2004

Paper No. 6

In re Application of
Cheng-Chung Tsai
Application No. 10/138,827
Filed: May 6, 2002
Attorney Docket No. Lyp2002

DECISION ON PETITION

The petition filed on June 23, 2004 to revive this application as having been abandoned unintentionally under 37 CFR 1.137(b) has been referred to the undersigned by the Office of Petitions for consideration as a petition under 37 CFR 1.181 to withdraw the holding that this application is abandoned for failure to file a reply to the Office letter dated September 16, 2003. There is no fee for a petition under 37 CFR 1.181.

The petition is dismissed.

Petitioner states that this application is not abandoned because a reply to the Office letter in question was in fact filed. Petitioner further states that the reply was timely filed by reason of a concurrently filed request for a one month extension in the form of a check for the $55.00 extension fee.

In support of these allegations, petitioner has submitted a copy of the reply alleged to have been filed, a copy of the check for the extension fee, and a copy of a mailing label that appears to be a R.O.C. (Taiwan) post office label for "Express Mail Service." This evidence does not adequately support petitioner's allegation that a reply to the Office letter in question was timely filed.

Correspondence is considered to be filed in the Office when it is received in the Office. 37 CFR 1.6. An exception to 37 CFR 1.6 is created for certain kinds of correspondence by 37 CFR 1.8. However, there is no evidence that petitioner's correspondence was mailed utilizing the certificate of mailing provisions of 37 CFR 1.8, which requires, *inter alia*, that the correspondence have a certification affixed thereto stating that the correspondence was mailed in an envelope that was properly addressed and was deposited with the United States Postal Service with sufficient postage for United States first class mail. It appears from petitioner's allegations that the correspondence was not deposited with the United States Postal Service. In addition, there is no evidence that the required certification was affixed to the reply.

37 CFR 1.10 also creates an exception to 37 CFR 1.6. However, 37 CFR 1.10 also requires, *inter alia*, the utilization of the Express Mail Post Office to Addressee service provided by the United States Postal Service, and that the correspondence have affixed thereto the label number of the United States Postal Service's Express Mail label that has been used for the mailing. Again, it does not appear that the reply alleged to have been filed was deposited with the United States Postal Service, or that the provisions of 37 CFR 1.10 was otherwise complied with.

Finally, it is noted that there is no evidence accompanying the petition that would associate the particular correspondence alleged to have been filed with the R.O.C. (Taiwan) post office label that petitioner has included in the petition. At best, the label shows that "something" was mailed", but does not show that the particular reply for this particular application was mailed.

For the foregoing reasons, the petition cannot be granted under 37 CFR 1.181. In accordance with the directions from the Office of Petition, the application is being returned to the Office of Petitions so that the petition can be considered pursuant to 37 CFR 1.137(b).

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

Cheng-Chung Tsai
235 Chung-Ho
Box 8-24
Taipei, TAIWAN
R.O.C.

VIA AIR MAIL

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Paper No. 7

Cheng-Chung Tsai
235 Chung-Ho Box 8-24
Taipei TW TAIWAN

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OFFICE OF PETITIONS

In re Application of :
Cheng-Chung Tsai :
Application No. 10/138,827 :
Filed: May 6, 2002 :
Attorney Docket No. Lyp2002 :

ON PETITION

This is a decision on the petition, filed June 23, 2004, 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 September 16, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) was obtained. A Notice of Abandonment was mailed on April 16, 2004. In response, on June 23, 2004, the present petition was filed.

The application file is being forwarded to Technology Center AU 3728 for consideration of the response filed June 23, 2004.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9220. All other inquiries regarding this application should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Office Action

JUL 30 2004

Paper No. 6

In re Application of
Cheng-Chung Tsai
Application No. 10/138,827
Filed: May 6, 2002
Attorney Docket No. Lyp2002

DECISION ON PETITION

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OFFICE OF PETITIONS

The petition filed on June 23, 2004 to revive this application as having been abandoned unintentionally under 37 CFR 1.137(b) has been referred to the undersigned by the Office of Petitions for consideration as a petition under 37 CFR 1.181 to withdraw the holding that this application is abandoned for failure to file a reply to the Office letter dated September 16, 2003.. There is no fee for a petition under 37 CFR 1.181.

The petition is dismissed.

Petitioner states that this application is not abandoned because a reply to the Office letter in question was in fact filed. Petitioner further states that the reply was timely filed by reason of a concurrently filed request for a one month extension in the form of a check for the $55.00 extension fee.

In support of these allegations, petitioner has submitted a copy of the reply alleged to have been filed, a copy of the check for the extension fee, and a copy of a mailing label that appears to be a R.O.C. (Taiwan) post office label for "Express Mail Service." This evidence does not adequately support petitioner's allegation that a reply to the Office letter in question was timely filed.

Correspondence is considered to be filed in the Office when it is received in the Office. 37 CFR 1.6. An exception to 37 CFR 1.6 is created for certain kinds of correspondence by 37 CFR 1.8. However, there is no evidence that petitioner's correspondence was mailed utilizing the certificate of mailing provisions of 37 CFR 1.8, which requires, *inter alia*, that the correspondence have a certification affixed thereto stating that the correspondence was mailed in an envelope that was properly addressed and was deposited with the United States Postal Service with sufficient postage for United States first class mail. It appears from petitioner's allegations that the correspondence was not deposited with the United States Postal Service. In addition, there is no evidence that the required certification was affixed to the reply.

37 CFR 1.10 also creates an exception to 37 CFR 1.6. However, 37 CFR 1.10 also requires, *inter alia*, the utilization of the Express Mail Post Office to Addressee service provided by the United States Postal Service, and that the correspondence have affixed thereto the label number of the United States Postal Service's Express Mail label that has been used for the mailing. Again, it does not appear that the reply alleged to have been filed was deposited with the United States Postal Service, or that the provisions of 37 CFR 1.10 was otherwise complied with.

Finally, it is noted that there is no evidence accompanying the petition that would associate the particular correspondence alleged to have been filed with the R.O.C. (Taiwan) post office label that petitioner has included in the petition. At best, the label shows that "something" was mailed", but does not show that the particular reply for this particular application was mailed.

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For the foregoing reasons, the petition cannot be granted under 37 CFR 1.181. In accordance with the directions from the Office of Petition, the application is being returned to the Office of Petitions so that the petition can be considered pursuant to 37 CFR 1.137(b).

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

Cheng-Chung Tsai
235 Chung-Ho
Box 8-24
Taipei, TAIWAN
R.O.C.

VIA AIR MAIL

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www.uspto.gov

MICHAEL A. SHIPPEY, PH. D.
LAW OFFICES OF KARLA SHIPPEY
4848 LAKEVIEW AVENUE, SUITE E
YORBA LINDA, CA 92886

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,778,380 | : | |
| Issue Date: August 17, 2004 | : | |
| Application No. 10/138,828 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Patentee(s): William P. Murray, Jr. | : | |

This is a decision in response to the communication filed October 27, 2008, transmitting a copy of a previously mailed petition under 37 CFR 1.378(c) to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent. The original petition has not been located; however, a decision on the copy follows.

The petition is **GRANTED**.

This patent expired on August 17, 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 petition is not signed by a registered patent attorney or agent of record. However, in accordance with 37 CFR 1.34, the signature of Thomas M. Freiburger 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. If Mr. Freiburger desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to the petitioner herein; however, all future correspondence regarding this patent will be directed solely to the above-noted correspondence address of record.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2).

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. Nonetheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office. Receipt is acknowledged of the requisite maintenance fee and surcharge.

In view of the above, the 3 ½ year maintenance fee in this case is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Petitioner will not receive future correspondence related to maintenance fees for the patent unless a "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) are submitted.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: THOMAS M. FREIBURGER
P.O. BOX 1026
TIBURON, CA 94920

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: APR 18 2005

February 8, 2005

Re application of:
BEISTLINE, et al.
Serial No.: 10/138,837
Filed: May 3, 2002
For: CARPET CONSTRUCTIONS AND METHOD

DECISION ON PETITION

This is a decision on the PETITION TO ACCEPT COLOR DRAWINGS OR PHOTOGRAPHS 37 C.F.R. 1.84(a)(2) or (b)(2), filed December 27, 2004. The petition includes (1) the fee as required by 37 CFR 1.17(h), (2) three sets of the color photographs, (3) an amendment to the specification which includes the language set forth in 37 CFR 1.84(a)(2)(iv), and (4) an explanation stating why color photographs are necessary.

A review of the application record indicates that all of the requirements for acceptance of color photographs have been met.

The Petition is **GRANTED**.

Terrel Morris
Supervisory Patent Examiner
Group Art Unit 1771

Milliken & Company
P.O. Box 1927
Spartanburg, SC 29304

Pet. Dec.

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Mailed: 5/19/05

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Paper Number

In re application of
Michael J. Bull et al.
Serial No. 10/138,846
Filed: May 2, 2002
For: PROCESS FOR PREPARING AN ALUMINUM ALLOY SHEET WITH IMPROVED BENDABILITY AND ALUMINUM ALLOY SHEET PRODUCED THEREFROM

DECISION ON PETITION

This is a response to the PETITION UNDER 37 C.F.R. §1.181(a) TO WITHDRAW HOLDING OF ABANDONMENT, filed July 19, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment mailed June 29, 2004, be withdrawn since the applicant did not receive the Office letter mailed October 17, 2003.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, TMOG 1156 O.G. 53, November 16, 1993, (see also MPEP 711.03(c) - NEW PROCEDURE TMOG 1170 O.G. 114). A review of the petitioner's evidence indicates that the request has merit. The evidence presented is sufficient to establish that the applicant or any authorized representative of the applicant did not receive the Office letter mailed October 17, 2003. The evidence provided includes a statement by the petitioner that the Office letter mailed October 17, 2003 was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Office letter mailed October 17, 2003 was not received. Also provided is a copy of the attorney's application docket records where the Office letter mailed October 17, 2003 would have been posted had it been timely received.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the examiner for prompt remailing of the Office letter originally mailed October 17, 2003 and restarting of the period of response from the remail date thereof.

The Petition is **GRANTED**.

JStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

CHRISTOPHER C. DUNHAM
COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

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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**STEPHANIE L. SEIDMAN**
**FISH & RICHARDSON P.C.**
**12390 EL CAMINO REAL**
**SAN DIEGO, CA 92130**

**COPY MAILED**

DEC 1 4 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,814,953 | : | |
| Issue Date: November 9, 2004 | : | |
| Application No. 10/138,866 | : | LETTER |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. 17108-004002/1013B | : | |

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 matter is being referred to Files Repository.

Wan Laymon
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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Paper No.

THOMAS Q. HENRY
WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY, LLP
BANK ONE TOWER/CENTER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

COPY MAILED

APR 1 9 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hans List | : | |
| Application No. 10/138,869 | : | ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. 7404-609 | : | |

This is in response to the communication filed by facsimile transmission on April 13, 2004, which included a copy of a petition to withdraw the above-identified application from issue under 37 CFR 1.313(c)(2), a Request for Continued Examination (RCE), an Information Disclosure Statement (IDS), and a Revocation and Power of Attorney filed March 3, 2004. The original papers cannot be located; however, a decision on the copies provided follows.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on March 2, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

The Revocation and Power of Attorney has been accepted and PTO records have been updated accordingly.

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

---

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is 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).

The application is being forwarded to Technology Center AU 3736 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT and TRADEMARK OFFICE
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. 3

AUG 19 2002

| | | |
|---|---|---|
| In re Application of | : | |
| William J. Roth | : | DECISION |
| Serial No. 10/138,874 | : | ON |
| Filed: May 03, 2002 | : | PETITION |
| For: ELECTROCHEMICAL METHOD FOR | : | |
| TREATING WASTEWATER | : | UNDER 708.02,V |

This is in response to the petition filed July 02, 2002, requesting that the above-identified application be granted Special Status under Sections 708.02 (V) of the MPEP and 37 CFR 1.102(c).

The petition has been considered and found to comply with the requirements set forth under the above-noted section. Accordingly the petition is **GRANTED.**

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Werner Schroeder
C/O Alluna Group, Inc.
3862 Midshore Drive
Naples, FL 34109

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. None

SMITH PATENT CONSULTING CONSULTING, LLC
P.O. BOX 2726
ALEXANDRIA VA 22301

COPY MAILED
AUG 0 3 2005
OFFICE OF PETITIONS

In re Application of
Robert A. Van Wyk
Application No. 10/138,920
Filed: May 6, 2002
Title: METHOD AND SYSTEM FOR MONITORING FLUID TEMPERATURE DURING ARTHROSCOPIC ELECTROSURGERY

DECISION ON PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition under 37 CFR §1.137(b)[1], filed April 12, 2005, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.112 in a timely manner to the non-final Office action mailed October 17, 2003, which set a shortened statutory period for reply of 3 months. A response was received on January 12, 2004, and on January 22, 2004, a Notice of Non-Compliant Amendment was mailed. A second amendment was received on April 21, 2004, along with a two-month extension of time. On May 26, 2004, a notice was sent which indicated that the amendment would not be entered as an additional $43 was required. This notice set a one-month period for response. No further repliers were received, and the above-identified application became abandoned on June 27, 2004. A Notice of Abandonment was mailed on September 21, 2004.

With the present petition, Petitioner has submitted the petition fee, an amendment, the deficient $43, and the proper statement of unintentional delay.

1 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:
(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Petitioner has met all requirements for a grantable petition under 37 C.F.R. §1.137(b). As such, the petition is **GRANTED**. 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.

The Power of Attorney and Correspondence Address Indication has been entered and made of record.

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States Patent and Trademark Office**

Encl.

UNITED STATES PATENT AND TRADEMARK OFFICE

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**LAHIVE & COCKFIELD, LLP**
**28 STATE STREET**
**BOSTON MA 02109**

COPY MAILED

OCT 1 4 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gary L. Olson et al | : | |
| Application No. 10/138,935 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. PPI-106CP3 | : | |

This is a decision on the petition, filed October 13, 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 2, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

The examiner of Technology Center AU 1654 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** :October 3, 2005

**TO SPE OF** : ART UNIT 1654

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,919,307

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Magdalene Talley

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9309 ext. 116***

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:**

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Bruce Campell — **SPE**

1654 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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CROSBY HEAFEY ROACH & MAY
P.O. BOX 7936
SAN FRANCISCO, CA 94120-7936

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MAR 07 2005

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| Paul Husted et al | : | |
| Application No. 10/138,953 | : | ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. 25053.01600 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed February 22, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure submit the Issue fee and formal drawings in a timely manner in reply to the Notice of Allowance mailed June 10, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on September 11, 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 forwarded to the Publishing Division.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

John W. Carpenter
Two Embarcadero Center, Suite 2000
San Francisco, CA 94111

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 10

**LORD CORPORATION**
**PATENT & LEGAL SERVICES**
**111 LORD DRIVE**
**CARY, NC 27512**

**COPY MAILED**

JUN 22 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Helmut W. Kucera et al | : | |
| Application No. 10/138,957 | : | ON PETITION |
| Filed: May 4, 2002 | : | |
| Attorney Docket No. IR-2486(NBA) CIP | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed September 16, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 12, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 13, 2004.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

The file is being forwarded to Technology Center AU 1742.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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COMMISSIONER FOR PATENTS
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WASHINGTON, DC 20231
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Paper No. 4

MAILED

MAR 2 4 2003

Technology Center 2600

BAKER & DANIELS
205 W. JEFFERSON BOULEVARD
SUITE 250
SOUTH BEND IN 46601

In re Application of
Steven D. Hekkel et al
Application No. 10/138,965
Filed: May 3, 2002
For: **MOBILE INFRARED 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 February 27, 2003.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents in this application are removed from record.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc: Steven D. Hekkel
Dyna-Tak, Inc.
810 - 169th Place
Hammond, IN 46324

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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**KRIEGER INTELLECTUAL PROPERTY, INC.**
**P.O. BOX 1073**
**CAMAS WA 98607**

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FEB 0 3 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Keroksky et al. | : | |
| Application No. 10/139,036 | : | DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : | UNDER 37 CFR 1.78(a)(6) |
| Attorney Docket No. SLA1110 | : | |

This is a decision on the petition under 37 CFR 1.78(a)(6), filed December 1, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional applications set forth in the concurrently filed amendment.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional applications is submitted after expiration of the period specified by 37 CFR 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(6).

The instant nonprovisional application was pending at the time of filing of the reference to the prior-filed provisional applications as required by 37 1.78(a)(5)(iii). Additionally, the instant nonprovisional application was filed within twelve months of the filing date of the prior-filed provisional applications, Application No. 60/319,018, filed November 30, 2001, and Application No. 60/311,436, filed August 9, 2001, for which priority is claimed.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(6) in that (1) a reference to the above-noted, prior-filed provisional 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)(5)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3)

the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional applications satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed 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. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed 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 provisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3206. Any other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center AU 2613 for appropriate action on the amendment submitted December 1, 2005, including consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional applications.

Liana Chase
Petitions Examiner
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

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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WALL & TONG, LLP/
ALCATEL-LUCENT USA INC.
595 SHREWSBURY AVENUE
SHREWSBURY NJ 07702

COPY MAILED

MAR 0 2 2009

OFFICE OF PETITIONS

In re Application of :
Grosz et al. :
Application No. 10/139,058 : DECISION ON PETITION
Filed: May 3, 2002 :
Attorney Docket No. Grosz 2-4-9 :

This is a decision on the petition filed November 20, 2008 to withdraw the holding of abandonment pursuant to 37 CFR 1.181(no fee).

The petition under 37 CFR 1.181 is **GRANTED**.

This above-identified application became abandoned for failure to timely file a proper response after the Board of Patent Appeals and Interferences rendered a decision on September 2, 2008. The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action ( § 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences pursuant to 37 CFR §1.304. Petitioner could have filed an appeal to a Court or a civil action. A Notice of Abandonment was mailed on November 5, 2008.

Petitioner asserts that a reply in the form of an RCE and amendment were submitted in response to the Board of Appeals decision on November 3, 2008. In support, petitioner has provided a Electronic Acknowledgement Receipt.

A review of the written record shows the Office received an RCE, the RCE fee and an amendment on November 3, 2008. The reply submitted on November 3, 2008 was timely because the two month period for reply expired on November 2, 2008 which fell on a Sunday. Thus a reply submitted on Monday November 3, 2008 is considered timely. See 37 CFR 1.304(b).

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

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 is being referred to Art Unit 2613 for review of the RCE and amendment submitted on November 3, 2008 in the normal course of business.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

Cc: Patterson & Sheridan, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

Fish and Richardson
500 Arguello Street, Suite 500
Redwood City, CA 94063

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OCT 14 2003
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mei Chuah, et al | : | |
| Application No. 10/139,064 | : | DECISION GRANTING PETITION |
| Filed: May 2, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 12587-013001 | : | |

This is a decision on the petition, filed October 2, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on July 12, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 2171 for examination in due course.

Marianne E. Morgan

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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MAILED
FROM DIRECTORS OFFICE
JUL 26 2005
TECHNOLOGY CENTER 3600

JAMES RAY & ASSOCIATES
2640 Pitcairn Road
Monroeville PA 15146

In re Application of
Stefan Pagowski
Application No. 10/139,082
Filed: May 03, 2002
For: GEARING SYSTEM FOR AN ELECTRICAL PLUG BUS DOOR OPERATOR

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment filed with the United States Patent and Trademark Office (USPTO), on March 25, 2005. There is no fee for this petition.

The petition is **DENIED**.

A review of the file record indicates that the application was held abandoned for failing to file a proper response to the Final Office Action mailed July 29, 2004. A Notice of Abandonment was mailed on March 09, 2005.

Applicant states that a response to the Final Office Action mailed July 29, 2004 was filed November 29, 2004. Applicant contends that since he did not receive an Advisory Action until February 14, 2005, a time after the January 29, 2005 date upon which the application became abandoned that the Abandonment should be withdrawn and the application returned to pending status.

The filing of an amendment after Final rejection, whether or not it is entered, does *not* stop the running of the statutory period for reply to the Final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

The Office Action mailed July 29, 2004 was a Final Office action. A proper reply under 37 CFR 1.113 to a Final Office Action 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. As indicated in the Advisory Action mailed February 10, 2005, the reply received January 7, 2005 (which included a Certificate of Mailing dated November 29, 2004) failed to place the application in condition for allowance. As no Notice of Appeal (with appeal fee) or timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 have been received the Notice of Abandonment mailed March 09, 2005 is deemed proper.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $500. The fee for a petition under the unintentional standard is $1,500. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries should be directed to the Office of Petitions Staff at (571) 272-3282.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(571) 272-6611

SMN/rjc 07/20/05

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Commissioner for Patents
United States Patent and Trademark Office
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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK NC 27709

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**OFFICE OF PETITIONS**

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| In re Application of | : | |
| O'Dougherty et al. | : | DECISION ON APPLICATION |
| Application Number: 10/139,104 | : | FOR |
| Filed: 05/03/2002 | : | PATENT TERM ADJUSTMENT |
| Atty. Dkt. No. 2771-522-CIP | : | |

This is a decision on the "PETITION UNDER 37 CFR 1.181 FOR REVIEW AND CORRECTION OF PATENT TERM ADJUSTMENT PURSUANT TO 35 U.S.C. 154(b) IN U.S. PATENT APPLICATION NO. 10/139,104," filed on November 11, 2009, which is treated as a request under 37 CFR 1.705(b). Applicants request that the initial determination of patent term adjustment be corrected by an adjustment of 273 days from 153 days to 426 days.

The application for patent term adjustment is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136.

On October 7, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 153 days.

The subject application was timely filed on November 11, 2009.[1]

[1] A review of Office PALM records indicates that the issue fee was paid on December 23, 2009.

Applicants assert entitlement to a period of adjustment for Office delay, from October 23, 2008, the date a Notice of Appeal was filed, to August 11, 2009, the date a decision of the Board of Patent Appeals and Interferences was mailed in co-pending Application No. 11/074,408, or 292 days. Applicants note that a period of adjustment for Office delay of 19 days, for the mailing of an examiner's answer on May 12, 2009, four months and 19 days after the date an appeal brief was filed on December 23, 2008, was previously entered. Therefore, applicants aver that an additional period of adjustment of 273 (292 - 19) days should be entered.

Applicants assert entitlement to this period of Office delay because the examiner's reason for allowance stated that the allowance of this application "is made in conjunction with and based on the Board Decision of 8/11/09 in co-pending application 11/074,408." The petition further states:

> Applicants submit that the Board Decision of August 11, 2009 should be considered a "final decision" or a "decision in the review reversing an adverse determination of patentability" by the Board of Patent Appeals and Interferences applicable to the Present Application for purposes of calculation of patent term adjustment.

Applicants' argument has been considered, but is not persuasive.

37 CFR 1.703(e) states, in pertinent part, that if an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e).

The subject application was neither reviewed by the Board of Patent Appeals and Interferences (BPAI) nor remanded by a panel of the BPAI, as set forth in 37 CFR 1.702(e). In asserting that the Board decision in another application should be considered "a decision in the review reversing an adverse determination of patentability," applicant ignores the fact that there was no

final decision of the BPAI made in this application, as required by 37 CFR 1.703(e).

Pursuant to 35 U.S.C. 154(b)(1)(C)(iii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability. As there was no Board decision in this application, applicants are not entitled to additional patent term adjustment under 37 CFR 1.702(e).

In view thereof, the petition is **DISMISSED**.

In view thereof, no change will be made in the determination of patent term adjustment at the time of the mailing of the notice of allowance.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.

Anthony Knight
Director
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Docket Administrator (Room 3J-219)
Lucent Technologies Inc.
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

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OFFICE OF PETITIONS

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| In re Application of | : |
| Timofei Nikita Kroupenkine | : DECISION ON PETITION |
| Application No. 10/139,124 | : UNDER 37 CFR 1.78(a)(3) |
| Filed: May 2, 2002 | : |
| Atty Docket No. 8 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on October 4, 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 May 6, 2004, and reflected in the present 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(s), unless previously submitted;[1]

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

> **(2)** the 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). Also, the reference to the prior-filed applications was submitted during the pendency of the instant nonprovisional application. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

*The granting of the petition to accept the delayed benefit claim to the prior-filed application(s) 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(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) 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 Art Unit 2873 for processing of the Request for Continued Examination filed October 14, 2004 and consideration by the Examiner of the amendments filed May 6, 2004 and October 4, 2004, including applicant's claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and

(2) for the benefit of priority to the prior-filed nonprovisional applications.

Telephone inquiries related to this decision should be directed to Sherry D. Brinkley at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances Hicks
Frances M. Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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**KNOBBE MARTENS OLSON & BEAR LLP**
**2040 MAIN STREET**
**FOURTEENTH FLOOR**
**IRVINE, CA 92614**

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|---|---|---|
| In re Application of | : | |
| Rich, Kathryn A. | : | |
| Application No. 10/139,139 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. ISTA.036A3 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the undersigned at (703) 306-0482. Any telephone inquiries after September 28, 2004 should be directed to (571) 272-3206.

This matter is being referred to Technology Center 1600 for processing of the concurrently filed Request for Continued Examination and amendment.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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CROMPTON, SEAGER & TUFTE, LLC
1221 NICOLLET AVENUE
SUITE 800
MINNEAPOLIS, MN 55403-2420

Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Will Wood | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7638179 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/139,140 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/03/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **0** 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

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ONE INTERNATIONAL PLACE
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OFFICE OF PETITIONS

In re Application of
Watson et al.
Application No. 10/139,143
Filed: May 2, 2002
Title: DEVICE AND METHOD FOR TREATING CONDITIONS OF A JOINT
Attorney Docket No. CDSI-P02-011

: DECISION ON PETITION UNDER 37 CFR § 1.182

This is a decision on the petition under 37 CFR 1.182 filed October 11, 2002, requesting that the paper copy of the amended application submitted via the electronic filing system on June 3, 2002 be used for the patent application publication, since the submission submitted in compliance with the Office electronic filing system was erroneously deleted by the Office.

The petition is DISMISSED as moot.

Applicant's submission via the electronic filing system on June 3, 2002 has not been deleted and is pending in the Office's electronic filing system.

The application file is being returned to Office of Initial Patent Examination for further processing for review of the "Response to Notice to File Missing Parts of Application".

Telephone inquiries specific to this matter should be directed to Mark O. Polutta at (703) 308-8122.

Mark O. Polutta

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

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**OFFICE OF PETITIONS**

In re Application of :
Brett T. Hannigan, et al. :
Application No.: 10/139,147 : ON PETITION
Filed: May 2, 2002 :
Attorney Docket No.: P0627 :

This is a decision on the petition, filed August 4, 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 July 2, 2008, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 3621 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

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 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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Nixon Peabody LLP (F5 PATENTS)
Gunnar G. Leinberg
1100 Clinton Square
Rochester, NY 14604

Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : David E. Sloat | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7640347 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/139,149 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/02/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **777** 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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RICK OLIVADOTI
290 RIVERSIDE DRIVE
APT. 3C
NEW YORK, NY 10025

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**OFFICE OF PETITIONS**
ON PETITION

In re Application of :
Rick Olivadoti :
Application No. 10/139,155 :
Filed: May 3, 2002 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.137(b), filed July 28, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed November 17, 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 February 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 $475 extension of time submitted with the petition on July 28, 2004 was subsequent to the maximum extendable period for reply, 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.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application is being forwarded to Technology Center AU 1772 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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P.O. Box 1450
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**RICK OLIVADOTI**
**APT. 3C**
**290 RIVERSIDE DRIVE**
**NEW YORK, NY 10025**

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|---|---|---|
| In re Application of | : | |
| Rick Olivadoti | : | |
| Application No. 10/139,155 | : | DECISION ON PETITION |
| Filed: May 05, 2002 | : | |
| Attorney Docket No. | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 07, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed, January 19, 2005, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 20, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (four (4) years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on February 23, 2005. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). Likewise, as Rick Olivadoti was the party having the right to reply at the date of abandonment, Rick Olivadoti should explain why this application became abandoned while it was under their control and what efforts were made to further reply of itself and with whom this matter was discussed outside of Rick Olivadoti. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), Rick Olivadoti and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is

pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, four (4) years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

Michelle R. Eason
Paralegal Specialist
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

**RICK OLIVADOTI**
**APT. 3C**
**290 RIVERSIDE DRIVE**
**NEW YORK NY 10025**

**COPY MAILED**

SEP 04 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Rick Olivadoti | : | |
| Application No. 10/139,155 | : | DECISION ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed June 9, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the notice of Non-Compliant Amendment mailed January 19, 2005, which set a shortened statutory period for reply of one (1) month. No extensions of time were obtained. Accordingly, the application became abandoned on February 20, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

The petition filed January 7, 2009 was dismissed in a decision mailed April 27, 2009, for failing to provide a proper statement of unintentional delay. Specifically, petitioner had failed to properly address the delay in reply that originally resulted in the abandonment and the delay in

filing an initial petition under 37 CFR 1.137(b) to revive the application. Reference is made to the petition decision mailed April 27, 2009 for specifics of explaining the delays.

The instant renewed petition fails to acceptably address the delay in responding to the Notice of Non-Compliant Amendment and the delay in filing the initial petition. Petitioner explains his involvement in defending his patent 6,059,247 in court and how this was consuming all his time and interest. Petitioner has not indicated when he first became aware of the abandonment of his application. The application went abandoned in early 2005and petitioner has not adequately explained why it took him four years to file a petition to revive the application. Critical to determining whether the extended delay was unintentional is establishing when and how petitioner became aware of the abandoned status of the above identified application.

Petitioner must respond to the following questions:

1. When did petition become aware that his application was abandoned?
2. How did petitioner become aware that his application was abandoned?
3. Why did petitioner neglect prosecution of this application in favor of defending his patent in court?

Any renewed petition must answer the above three questions.

Petitioner's comments regarding publishing of his application are noted but have no bearing on the instant petition.

Any renewed petition may be addressed as follows:

By Mail:
Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6842.

Carl Friedman
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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**OFFICE OF PETITIONS**

**RICK OLIVADOTI**
**APT. 3C**
**290 RIVERSIDE DRIVE**
**NEW YORK NY 10025**

| | | |
|---|---|---|
| In re Application of | : | |
| Rick Olivadoti | : | |
| Application No. 10/139,155 | : | ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. | : | |

This is a decision on the second renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed September 21, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment, mailed January 19, 2005. The Notice set a period for reply of one (1) month from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 20, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (1).

Applicant had filed an amendment on December 17, 2004. This amendment was considered to be non-compliant due to the fact that the claim 8 text had not been included in the claim listing. The petition decision mailed April 27, 2009 and the petition decision mailed September 4, 2009 had failed to note that the petition filed January 7, 2009 and the renewed petition filed June 10, 2009 did not include a proper amendment and thus the petitions were missing item (1), the required reply. The failure to indicate the missing proper response is regretted. In a telephone conversation with applicant, the undersigned noted this omission and explained that a proper amendment was still required. The instant second renewed petition tries to address this but is not done properly. Petitioner still needs to provide a proper claim amendment in compliance with 37 CFR 1.121. This amendment could be similar to the one submitted December 17, 2004. In this claim amendment, petitioner merely needs to add the text of claim 8 after "8. (Withdrawn)". The submissions of claim 8 provided with the instant petition are not acceptable. The undersigned will be happy to assist in any questions concerning the drafting of an appropriate amendment.

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) 272-6842.

Carl Friedman
Petitions Examiner
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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OFFICE OF PETITIONS

**RICK OLIVADOTI**
**APT. 3C**
**290 RIVERSIDE DRIVE**
**NEW YORK NY 10025**

| | | |
|---|---|---|
| In re Application of | : | |
| Rick Olivadoti | : | |
| Application No. 10/139,155 | : | ON PETITION |
| Filed: May 3, 2002 | : | |
| Attorney Docket No. | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed November 16, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely reply to the Notice of Non-compliant Amendment mailed January 19, 2005, which set a period for reply of one (1) month. Accordingly, by operation of law, the above-identified application became abandoned on February 20, 2005.

The petition decision mailed October 29, 2009 dismissed the petition under 37 CFR 1.137(b) filed September 21, 2009 for failure to provide the required proper response under 37 CFR 1.137(b).

The instant renewed petition includes a proper amendment.

The renewed petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a proper amendment; (2) the petition fee of $810; and (3) the required statement of unintentional delay have been received. Accordingly, the amendment is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

The application file is being referred to Technology Center Art Unit 1745 for appropriate action on the merits.

Carl Friedman
Petitions Examiner
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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**COCHRAN FREUND & YOUNG LLC**
**2026 CARIBOU DR**
**SUITE 201**
**FORT COLLINS CO 80525**

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SEP 20 2007

OFFICE OF PETITIONS

In re Application of :
Craig Harrison :
Application No. 10/139,158 : DECISION ON PETITION
Filed: May 2, 2002 :
Attorney Docket No. REAL.01USU1 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 15, 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 October 14, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on January 15, 2006. A Notice of Abandonment was mailed on May 24, 2006. While this application was held abandoned for failure to timely reply to the non-final Office action of October 14, 2005, it appears that the case was abandoned earlier for failure to timely reply to the Notice to File Missing Parts of Nonprovisional Application, mailed June 14, 2002. Although the transmittal letter references the filing of an executed oath, the executed oath was not found among the papers filed on July 12, 2002 in response to the Notice of June 14, 2002 and was further overlooked by the Office when the Notice to File Corrected Application papers was mailed on August 2, 2002.

Nevertheless, the petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply in the form of an amendment/remarks, drawings, and an executed oath, (2) the petition fee of $750, and (3) an adequate statement of unintentional delay. Accordingly, the failure to timely reply to the non-final Office action of October 14, 2005 is accepted as being unintentionally delayed.

This application is being referred to Technology Center AU 3629 for appropriate action in the normal course of business on the reply received January 15, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions

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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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON VA 22209-3873

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NOV 2 2 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Kanamori, et al. :
Application No. 10/139,214 :
Filed: May 7, 2002 :
Attorney Docket No. 396.41617X00 :
For: CATALYSTS AND PROCESSES FOR PRODUCING AROMATIC AMINES

This is a decision on the petition under 37 CFR 1.181, filed November 9, 2006, requesting that the Office withdraw the holding of abandonment of the above-identified application.

The petition under 37 CFR 1.181 is **GRANTED**.

This application was held abandoned for failure to respond in a timely manner to the final Office action, mailed March 7, 2006, which set forth an extendable three (3) month period for reply. The Office contended that this application became abandoned on June 8, 2006 for failure to reply to the March 7, 2006 final Office action. A Notice of Abandonment was mailed on September 12, 2006.

Petitioners assert that an amendment after final, a Notice of Appeal and required fee, and a request for a three month extension of time and required fee were timely received in the Office on September 7, 2006. The undersigned finds this assertion completely convincing as these documents are present in the application file and Office financial records shows that the required fees were charged.

Therefore, the petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

Accordingly, the application file will be forwarded to Technology Center A.U. 1754 for consideration of the September 7, 2006 amendment after final and to process the Notice of Appeal.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Alexandria, VA 22313-1450
www.uspto.gov

OGILVY RENAULT LLP
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL QC H3A2Y-3 CA CANADA

In re Application of:
Sofia, Kamilia et al.
Serial No. 10/139,216
Filed: May 7, 2002
Docket: 3581-86US
Title: METHOD AND APPARATUS FOR SELF-PACED INTEGRATED PROCEDURE TRAINING USING A REAL-TIME, FULL-SCOPE SIMULATION

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed on Oct. 2, 2007 under 37 CFR § 1.181. Petitioner requests that the finality of the rejection mailed on Aug. 8, 2007 be withdrawn as premature.

The petition is dismissed as moot.

*Background*

In response to the applicant's arguments responding the non-final Office action filed on May 18, 2007, the examiner issued a Final Rejection on Aug. 8, 2007. On Oct. 2, 2007, the applicant filed the current petition requesting withdrawal the finality of the Office action of Aug. 8, 2007. Petitioner opines that the final rejection of Aug. 8, 2007 contains new grounds of rejection. On Dec. 10, 2007, the applicant filed a Request for Continued Examination.

*Discussion*

The present petition filed on Oct. 2, 2007, requests withdrawal of the finality of the Office Action mailed on Aug. 8, 2007 as premature. In the petition, there are no specific arguments made as to exactly which part of the final rejection of Aug. 8, 2007 constitutes new grounds of rejection that the non-final Office action of Jan. 22, 2007 failed to include. The non-final Office action of Jan. 22, 2007 rejected all claims under 35 USC 103 as unpatentable over Engdahl U.S. Pat, 6,282,455 in view of Wall et al, U.S. Pat. 6,371,795 and Bullen U.S. Pat. 6,033,226 and Daniel U.S. Pat. 6,289,299. In the final Office action of Aug. 8, 2007, the same rejection

remains. There does not appear to be any new grounds of rejection in the final Office action of Aug. 8, 2007. Petitioner also fails to specifically point out where the alleged new grounds of rejection are in the final Office action. Since, all pending claims have been twice rejected, the final Office action is deemed to be proper in accordance with MPEP 706.07(a)[1]. On Dec. 10, 2007, the applicants also filed a Request for Continuing Examination under 37 CFR §1.114. Therefore, the finality of the Office Action mailed on Aug. 8, 2007 is operatively withdrawn, and the applicant is now able to argue the merits of the examiner's rejections in subsequent amendments (37 CFR § 1.114(d))[2].

*Decision*

In view that the contested claims are now pending before the examiner, the petitioners' request for relief is moot. Therefore, the petition to withdraw the finality of the Aug. 8, 2007 Office Action is dismissed as moot.

Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED AS MOOT.

Frederick R. Schmidt, Director
Technology Center 3700

[1] MPEP 706.07(a) states in part: "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)."
[2] 37 CFR §1.114(d) states: If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered.

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**YOUNG & THOMPSON**
**745 SOUTH 23RD STREET**
**2ND FLOOR**
**ARLINGTON, VA 22202**

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| | | |
|---|---|---|
| In re Application of | : | |
| Decroix, Claude | : | |
| Application No. 10/139,234 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. 2001-1047 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 19, 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 May 20, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on August 21, 2004. A Notice of Abandonment was mailed January 10, 2005.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This matter is being referred to Technology Center 3700 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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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BRUNDIDGE & STANGER, P.C.
2318 MILL ROAD, SUITE 1020
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Atsumu Hirabayashi | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7645983 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/139,241 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/07/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1010** 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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c/o BIGGERS & OHANIAN, LLP
P.O. BOX 1469
AUSTIN TX 78767-1469

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| | | |
|---|---|---|
| In re Application of | : | |
| Bhogal et al. | : | |
| Application No. 10/139,269 | : | DECISION ON PETITION |
| Filed: 1 December, 2005 | : | |
| Attorney Docket No. | : | |
| AUS92002003US1 | : | |

This is a decision on the "Petition to Restart the Time Period for Response to Office Action," filed 1 December, 2005.

The petition is **GRANTED**.

On 1 July, 2005, the Office mailed a non-final Office action, which set a three-month shortened statutory period for reply. In the apparent absence of a timely filed response, the application was held abandoned on 2 October, 2005. The filing of the present petition precedes the mailing of Notice of Abandonment.

In the petition, applicants asserted that the practitioner did not receive the non-final Office action. Specifically, the practitioner asserts that the Office action was returned to the USPTO as undeliverable.

A review of the record indicates that the USPTO mailed the nonfinal Office action to the correct correspondence address; however, it was inexplicably returned to the USPTO on 1 August, 2005. For this reason, the practitioner did not receive the nonfinal Office action of 1 July, 2005.

As such, the holding of abandonment is **withdrawn**. The application is restored to pending status.

Although petitioners request the time period for reply to the Office action mailed on 1 July, 2005, petitioners further state that "In an effort to move the case forward, Applicants also submit herewith a Response to the Office Action of July 1, 2005." As petitioners have filed a response, the Office action will not be remailed. Rather, the reply filed with the present petition will be treated as a timely-filed response to the Office action mailed on 1 July, 2005.

The application will be referred to the Technology Center for consideration of the response filed with the present petition.

This matter is being referred to Technology Center Art Unit 2176 for further action consistent with this decision.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3231. Any other questions regarding the status of the application or the examination process should be directed to the Technology Center.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P. O. BOX 3001
BRIARCLIFF MANOR, NY 10510

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DEC 1 3 2005

**OFFICE OF PETITIONS**

In re Application of :
Scott E. Hall, et al. :
Application No. 10/139,293 :
Filed: May 2, 2002 :
Attorney Docket No. US020142 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 17, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed April 1, 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 at midnight on July 1, 2005.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment and a Request for Continued Examination (RCE); (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the petition filed October 17, 2005 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being forwarded to Technology Center 2800, Art Unit 2834 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

cc: Clark A. Puntigam
Jensen & Puntigam, P.S.
2033 6th Ave., #1020
Seattle, WA 98121

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAY 1 0 2006

In re Application of:
YASUHARA *et al.*
Serial No.: 10/139,324
Filed: May 07, 2002
Attorney Docket No.: **222835US2**

DECISION ON PETITION

This is a decision on the petition filed on May 12, 2004, under 37 C.F.R. § 1.181, requesting the Commissioner to invoke his supervisory authority to compel reconsideration by the examiner of her statement of reasons for allowance. The petition is before of the Director of Technology Center 2800 for review.

The petition is **DISMISSED**.

Petitioner asserts that in the Reasons for Allowance set forth in the Notice of Allowability of April 21, 2004, constitutes an error because the examiner inappropriately mischaracterizes the invention by placing unwarranted interpretation of the claims on record.

As set forth in 37 CFR 1.104(e) and MPEP 1302.14, an examiner may set forth his or her reasoning in support of his or her allowance of the claims. While petitioner may disagree with the examiner's statements, such does not clearly demonstrate that there is an error on the part of the PTO. See In re Volk, 634 F.2d 607, 207 USPQ 1086, (CCPA 1980) (examiner's contested construction of the allowed claims was not expunged from the record, and was permitted to stand). Moreover, petitioner's comments on the examiner's statements would generally not be referred to the examiner since the examiner's statement should not create an estoppel. Only applicant's statements should create an estoppel. See MPEP 1302.14, which states:

> "The application file generally will not be returned to the examiner after the entry of such comments made by applicant on the examiner's statement of reasons for allowance."

Petitioner supplies reasons in support of his contention that the interpretation of the examiner is in error. As such, petitioner has exercised, by way of the instant communication (and may still exercise), his right under 37 CFR 1.104(e), to place his comments on the record in reply to the examiner's statements..

Petitioner may wish to consider **promptly** filing comments under 37 CFR 1.104(e).

The application file is being forwarded to Publishing Division to be processed into a patent.

Inquiries regarding this decision should be directed to Clayton E. LaBalle, Special Program Examiner, at (571) 272-1594.

Sharon A. Gibson, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No. 8

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OFFICE OF PETITIONS

**MORGAN LEWIS & BOCKIUS**
**1111 PENNSYLVANIA AVENUE NW**
**WASHINGTON DC 20004**

| | | |
|---|---|---|
| In re Application of | : | |
| Seok Woo Lee et al | : | |
| Application No. 10/139,355 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. 049128-5069 | : | |

This is a decision on the petition, filed August 26, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on August 4, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to 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 2673 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 7

Platon N. Mandros, Esq.
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

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FEB 05 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Frederick Gruhl and<br>Erin Jessica Lindsay<br>Application No. 10/139,367<br>Filed: May 7, 2002<br>Attorney Docket No. 033528-003<br>Title: MINIMAL INVASIVE ENDOSCOPIC<br>METHODS AND APPARATUS FOR<br>HARVESTING BLOOD VESSELS | DECISION ACCORDING STATUS<br>UNDER 37 C.F.R. §1.47(a) |

This is in response to the petition under 37 C.F.R. § 1.47(a)[1], filed November 6, 2002.

The petition is **GRANTED**.

The above-identified application was filed on May 7, 2002, with an unexecuted declaration and with drawings that were not in compliance with 37 CFR § 1.84. Frederick Gruhl and Erin Jessica Lindsay were named as joint inventors. Accordingly, on June 6, 2002, applicants were mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration, a surcharge for its late filing and substitute drawings. 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).

In response, rule 47 applicants filed a declaration executed by joint inventor Lindsay on behalf of herself and on behalf of nonsigning inventor Gruhl, with the instant petition (and fee); paid the surcharge for late filing under 1.16(e); and filed substitute drawings. Pursuant to the accompanying authorization to charge any necessary fees, a three-month extension of time to make timely the response is being charged to Deposit Account No. 92-4800.

Rule 47 applicants maintain that status under § 1.47(a) is proper because inventor Gruhl has refused to join in the application.

---

[1] 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 (oath or declaration, and specification, claims, 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.

In support thereof, applicants submitted a declaration of Bethany Klinke describing steps undertaken to have the refusing inventor review the application and execute the declaration, and his refusals to do so. Further, a letter in which inventor Gruhl expresses his reasons for not signing the declaration for patent.

Having considered the evidence, it is concluded that applicants have shown that inventor Gruhl has refused to join in the application. The declaration filed November 6, 2002, and the petition have been reviewed and found in compliance with 37 CFR §§ 1.63 and 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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601 PENNSYLVANIA AVENUE NW
SUITE 900 SOUTH BUILDING
WASHINGTON, DC 20004

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JUL 1 8 2005

**OFFICE OF PETITIONS**

In re Application of :
Eiichiro Yagi, et al. :
Application No. 10/139,395 :
Filed: May 7, 2002 :
Attorney Docket No. TOS-123-USA-D :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 11, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Restriction Requirement mailed February 24, 2004, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 25, 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 (Restriction Requirement); (2) the petition fee; (3) the required statement of unintentional delay have been received. Accordingly, the petition filed March 11, 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 1600, Art Unit 1651 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 11

FEB 25 2004

Bradley N. Ruben, PC
Suite 5A
463 First Street
Hoboken, NJ 07030-1859

| | | |
|---|---|---|
| In re Application of | : | |
| James R. Stabile et al. | : | DECISION ON PETITION |
| Application No. 10/139,419 | : | |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 107AD-002A | : | |

This is a decision on the petition filed October 21, 2003, requesting that the holding of abandonment in the above-identified application be withdrawn.

The petition to withdraw the holding of abandonment is GRANTED.

A nonfinal Office action was mailed April 14, 2003, setting a three-month shortened statutory period for filing a response. In the absence of a response, the application was held abandoned and a Notice of Abandonment was mailed October 21, 2003.

Petitioner asserts that a response was timely filed by facsimile transmission on June 3, 2003. To support the assertion, petitioner submitted 1) a copy of a response entitled "Response and Amendments" which bears a Certificate of Transmission under 37 C.F.R. § 1.8(a) dated June 3, 2003 and 2) a copy of the sending unit's report confirming successful transmission of the Response and Amendments on June 3, 2003.

A review of the application file record reveals that the above-identified response is not of record in the application file and cannot be located. However, 37 CFR § 1.8(b) provides for accepting a correspondence as being timely filed if it is transmitted in accordance with 37 CFR § 1.8(a), and is reproduced below:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered

> timely if the party who forwarded such correspondence: (1) informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence; (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and (3) includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition, meets the conditions of 37 CFR § 1.8(b) to establish the previous timely filing of the response.

The application file is being forwarded to the technical support staff for processing the Response and Amendments. From there, it will be returned to the examiner for further prosecution.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

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Bradley N. Ruben
Suite 5A
463 First Street
Hoboken, NJ 07030

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OFFICE OF PETITIONS

In re Application of:
James R. Stabile
Application No.: 10/139,419
Filed: May 6, 2002
Atty's Docket No.: 107AD-002A

DECISION ON PETITION UNDER
37 CFR 1.137(b)

This is a decision on the petition for revival of the above-entitled application under 37 CFR 1.137(b), filed August 08, 2005.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice Of Allowance mailed February 10, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned at midnight on May 10, 2005.

On August 08, 2005, applicant filed the petition for revival under 37 CFR 1.137(b) considered herein. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of payment of the issue and publication fees. Accordingly, the issue and publication fee payments are accepted as having been unintentionally delayed.

The application is being referred to the Office Of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned.

Anthony Smith
Attorney-Advisor
United States Patent & Trademark Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

Copied from 10130419 on 05/09/2006

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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Date : August 21, 2006

Patent No. :7,039,919
Inventor(s) :Pruitt et al.
Issued :August 1, 2006
Title :HIGH THROUGHPUT ASSAY FOR IDENTIFICATION OF GENE
:EXPRESSION MODIFIERS
Docket No. :03551.0095

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of 37 CFR 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B. After payment of the issue fee, correction of assignment data submitted on the PTOL-85B can only be done by Certificate of Correction under 37 CFR 1.323, with a request under 37 CFR 3.81(b).

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.

See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

*Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.*

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: 571-273-8300
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

A certificate of correction will be issued to correct the remaining errors noted in your request. Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

Angela Green
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308-9380 ext. 123

HODGSON RUSS LLP
ONE M&T Plaza
STE 2000
Buffalow, NY 14203-2391

CBN/arg

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HODGSON RUSS LLP
SUITE 2000
ONE M & T PLAZA
BUFFALO NY 14203-2391

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In re Patent No. 7,083,919 :
Issue Date: 08-01-2006 :
Application No. 10/139,420 : ON PETITION
Filed: 05-06-2002 :
Attorney Docket No. 03551.0095 :

This is a decision on the request under 37 CFR 3.81(b), filed October 20, 2006, to correct the assignment information on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

The matter is being referred to the Certificate of Correction Branch for processing of the Certificate of Correction.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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| SERIAL NUMBER | REQUEST DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/139,426 | 4/30/03 | IU-MENG TOM HO | 13176.405C1 |

Title:
**FERROELECTRIC MEMORY**

| Art Unit | Paper Number |
|---|---|
| | |

Correspondence Address:
CARL A. FOREST
DUFT, GRAZIANO & FOREST, P.C.
1790 - 30TH STREET
SUITE 140
BOULDER, CO. 80301-1018

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: 530,628

Grant Date: 01-May-03

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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**KIMBERLY A. CHASTEEN**
**PO BOX 1243**
**YORKTOWN VA 23692**

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NOV 1 2 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,854,162 | : | |
| Issue Date: February 15, 2005 | : | |
| Application No. 10/139,465 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 031495.0001 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed September 22, 2009 to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks none of the items listed above.

However, the petition must be signed by:

(1) An attorney or agent of record appointed in compliance with § 1.34(b);
(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);
(3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;
(4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undividing part interest; or

**(5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.**

The instant petition was signed by only one of the two listed inventors. A renewed petition with the signatures of both inventors is required.

Additionally, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

If this petition is not renewed or if renewed and not granted, then petitioner may request a refund of the maintenance and surcharge fees paid. The fee for requesting reconsideration is not refundable.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Telephone inquiries should be directed to the undersigned at (571)-272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Laura Emerson
108 Lynette Drive
Williamsburg, VA 23188

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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LAURA EMERSON
108 LYNETTE DRIVE
WILLIAMSBURG VA 23188

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,854,162 | : | |
| Issue Date: February 15, 2005 | : | |
| Application No. 10/139,465 | : | DECISION ON PETITION |
| Filed: May 6, 2002 | : | |
| Title: Door Hinge Cover | : | |

This is a decision on the renewed petition under 37 CFR 1.378(c), filed November 20, 2009 to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on February 16, 2009 for failure to pay the three and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

The Revocation of Power of Attorney and the request for Change of Correspondence Address has been accepted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**HARNESS DICKEY & PIERCE**
**P.O. BOX 828**
**BLOOMFIELD HILLS, MI 48303**

**COPY MAILED**

FEB 14 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Yeun Chol Jung et al | : | |
| Application No. 10/139,469 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 9242-000006 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 25, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 25, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 26, 2003.

The RCE filed on January 25, 2005 is not proper since the prosecution in this application has not closed, i.e., the application is under appeal, under final, allowed, or has an Office action that otherwise closes prosecution of the application.. See MPEP 706.07(h)(III).

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2874.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

DEC 18 2002

Paper No. 5

| | | |
|---|---|---|
| In re Application of | : | |
| Richard S. Norek | : | |
| Serial No. 10/139,494 | : | DECISION ON PETITION |
| Filed: May 6, 2002 | : | TO MAKE SPECIAL |
| For: FORMING GAS TURBINE | : | |
| TRANSITION DUCT BODIES | : | |
| WITHOUT LONGITUDINAL | : | |
| WELDS | : | |

Applicant's petition, filed via facsimile on December 5, 2002, requests that this application be rendered special for examination in that applicant is over sixty-five (65) years of age.

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(IV) of the Manual of Patent Examining Procedure (MPEP).

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Phillip E. Decker
Decker Law Office
1 New Hampshire Ave., Suite 125
Portsmouth, NH 03801

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OFFICE OF THE STAFF JUDGE ADVOCATE
U.S. ARMY MEDICAL RESEARCH AND MATERIEL COMMAND
ATTN: MCMR-JA (MS. ELIZABETH ARWINE)
504 SCOTT STREET
FORT DETRICK MD 21702-5012

4/3/09

| | |
|---|---|
| *In re* Application of: | |
| PASCHAL, CHARLES R. JR. et al | |
| Serial No.: 10/139,513 | |
| Filed: May 7, 2002 | DECISION ON PETITION |
| Docket: MMA98-35 01CON | |
| Title: CONVERTIBLE PATIENT ISOLATION POD | |

This is a decision on the petition filed on March 20, 2009 seeking reconsideration and withdrawal of the finality of the Office action mailed December 23, 2008. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is dismissed as untimely.

The record shows that:

1) On July 31, 2008, the examiner mailed a non-final Office action. In the rejection, claims 1-6, 10 and 14-17 were rejected under 35 U.S.C. 112, first paragraph, claim 14 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite; claims 1-3, 6, 10 and 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Scott and claims 4-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Scott along with Chen '457. In addition, the examiner held that Heimlich valves are old and well known in the prior art.

2) On October 13, 2008, the applicant submitted a Reply under 37 CFR 1.111 with amendment to the claims and traversed the rejection. In addition, the applicant added new limitations regarding "integrated unidirection flow control valve" at least in the independent claims 1 and 14.

3) In response, on December 23, 2008, the examiner mailed a final Office action. In the final rejection, claims 1-3, 6, 10 and 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Scott, along with Heimlich '159. Claims 4-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Scott along with Heimlich and Chen '457. The examiner also indicated that the addition of Heimlich '159 patent in the rejection was necessitated by the applicant's amendment.

4) On March 3, 2009, the applicant submitted Rule 116 amendment and traversed the rejection. It is noted there was no amendment to the claims filed with the Rule 116 amendment of March 3, 2009. In the Rule 116 amendment, the applicant argued the propriety of the finality of the Office action of December 23, 2008.
5) On March 19, 2009, the examiner issued an advisory action indicating the applicant's traversal of rejection failed to overcome the rejection under the prior art references.
6) On March 20, 2009, the present petition was filed. Petitioner requests withdrawal of the finality of the final Office action.

In the March 20, 2009 petition, petitioner requests the finality of the Office action of December 23, 2008 be reconsidered and withdrawn because the applicant believes that the final rejection of December 23, 2009 is premature. A review of the record shows that the instant petition was filed more than two months after the mailing date of the final Office action of December 23, 2008. Pursuant to 37 CFR 1.181(f)[1], the petition is not timely filed since the petition was not filed within two months of the action complained of. As the petition was not timely filed, the requested withdrawal of finality of the Office action of December 23, 2008 will not be granted. Under the circumstances, the final rejection stands.

With regard to the amendment after final on March 3, 2009, the examiner has considered the applicant's arguments and mailed an advisory action on March 19, 2009. The applicant should file a notice of appeal in preparation for an appeal. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

In view of the record, petitioner's request to withdraw the finality of the Office action dated March 20, 2009 is dismissed as untimely.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3764 awaiting a notice of appeal and an appeal brief. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181".

PETITION DISMISSED AS UNTIMELY.

Donald T. Hajec, Director
Technology Center 3700

---

[1] 37 CFR 1.181(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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P.O. Box 1450
Alexandria, VA 22313-1450
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**WITHROW & TERRANOVA, P.L.L.C.**
**100 REGENCY FOREST DRIVE**
**SUITE 160**
**CARY NC 27518**

COPY MAILED

JUN 09 2008

| | | |
|---|---|---|
| In re Patent No. 6,834,084 | : | |
| Issue Date: December 21, 2004 | : | |
| Application No. 10/139,560 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 2867-161 | : | |

This is a decision on the petition filed March 3, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to Carl Friedman at (571) 272-6842. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Carl Friedman
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

SPE K. Cuneo

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/139,597

Paper No.: _____

DATE : 6/23/05

TO SPE OF : ART UNIT 2841

SUBJECT : Request for Certificate of Correction on Patent No.: 6900529

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

*Lamonte M. Newsome*

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-305-8309***

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:**

Paula Bradley — SPE

2833 — Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

2635-110
LSW

UNITED STATES 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.

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington VA 22201

**COPY MAILED**

**DEC 1 2 2003**

**OFFICE OF PETITIONS**

In re Application of
Kawai, et al.
Application No. 10/139,639
Filed: May 7, 2002
Attorney Docket No. 2635-110

ON PETITION

This is a decision on the petition styled "PETITIONS UNDER RULE 182, 183, 313 AND/OR 312 TO WITHDRAW APPLICATION FROM ISSUANCE FOR ENTRY OF RULES 48(B) AMENDMENT TO INVENTORSHIP CAUSED BY CANCELLATION OF CLAIMS", filed December 9, 2003, requesting that the above-identified application be withdrawn from issue after payment of the issue fee.

The petition is **DISMISSED**.

37 CFR 1.313(c) provides that:

Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(2) Consideration of a submission pursuant to 37 CFR 1.114; or
(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865, 14873 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47, 54 (Apr. 11, 2000).

The circumstances of the above-identified application do not fall within any of the exceptions of 37 CFR 1.313. In this regard, petitioner is requesting that the inventorship of this application be amended pursuant to the provisions of 37 CFR 1.312 and 37 CFR 1.48(b), which is after payment of the issue fee. However, after payment of the issue fee, an amendment to the application is inappropriate.

See 37 CFR 1.312. Petitioner may wish to file a renewed petition under 37 CFR 1.313(c)(2) withdrawing the application from issue, submit a Request for Continued Examination under 37 CFR 1.114, and a renewed petition under 37 CFR 1.312 and 37 CFR 1.48(b).

Petitioner is advised that the amendment under 37 CFR 1.312 and the petition under 37 CFR 1.48(b) should be included in a separate paper. Note 37 CFR 1.47(c).

Petitioner is also reminded that any renewed petition must be promptly submitted and 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 Fax:** (703) 872-9306

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

Sherry D. Brinkley

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 16

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington VA 22201

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DEC 12 2003

**OFFICE OF PETITIONS**

In re Application of
Kawai, et al.
Application No. 10/139,639
Filed: May 7, 2002
Attorney Docket No. 2635-110

ON PETITION

This is a decision on the petition styled "PETITIONS UNDER RULE 182, 183, 313 AND/OR 312 TO WITHDRAW APPLICATION FROM ISSUANCE FOR ENTRY OF RULES 48(B) AMENDMENT TO INVENTORSHIP CAUSED BY CANCELLATION OF CLAIMS", filed December 9, 2003, requesting that the above-identified application be withdrawn from issue after payment of the issue fee.

The petition is **DISMISSED**.

37 CFR 1.313(c) provides that:

Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(2) Consideration of a submission pursuant to 37 CFR 1.114; or
(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865, 14873 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47, 54 (Apr. 11, 2000).

The circumstances of the above-identified application do not fall within any of the exceptions of 37 CFR 1.313. In this regard, petitioner is requesting that the inventorship of this application be amended pursuant to the provisions of 37 CFR 1.312 and 37 CFR 1.48(b), which is after payment of the issue fee. However, after payment of the issue fee, an amendment to the application is inappropriate.

See 37 CFR 1.312. Petitioner may wish to file a renewed petition under 37 CFR 1.313(c)(2) withdrawing the application from issue, submit a Request for Continued Examination under 37 CFR 1.114, and a renewed petition under 37 CFR 1.312 and 37 CFR 1.48(b).

Petitioner is advised that the amendment under 37 CFR 1.312 and the petition under 37 CFR 1.48(b) should be included in a separate paper. Note 37 CFR 1.47(c).

Petitioner is also reminded that any renewed petition must be promptly submitted and 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 Fax:** (703) 872-9306

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

Sherry D. Brinkley
Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 20

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington VA 22201

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DEC 31 2003

OFFICE OF PETITIONS

In re Application of
Kazuhide Kawai, et al.
Application No. 10/139,639
Filed: May 7, 2002
Attorney Docket No. 2635-110

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.313(c)(2), filed December 24, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on November 25, 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 relating to this decision should be directed to the undersigned at (703) 305-9220.

After the application is received in the Office of Petitions, the file will be forwarded to Technology Center AU 2832 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the petitions under 37 CFR 1.312 and 1.48(b) filed December 24, 2003.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**ROTHWELL, FIGG, ERNST & MANBECK**
**1425 K STREET, N.W.**
**SUITE 800**
**WASHINGTON DC 20005**

COPY MAILED

AUG 14 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| James Yik et al | : | |
| Application No. 10/139,644 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. 2816-101 | : | |

This is a decision on the petition, filed August 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 June 10, 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 2128 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

John F. Hayden
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500

MAILED

JUN 0 5 2005

Technology Center 2100

In re Application of:
Hieu C. Le
Application No. 10/139,649
Filed: May 7, 2002
For: MARKETING DATA DELIVERY SYSTEM

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed April 06, 2005.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed April 06, 2005 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

For James R. Matthews

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

cc: Toby Tsuchida
ATABOK JAPAN, INC.
Special Assistant to CEO, Director
Corporate Strategy
29 Crafts Street, Suite 300
Newton, MA 02458

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

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto CA 94304-1018

COPY MAILED

JAN 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Pu, Lee, Ahn, Sadler, Tong, and Ma :
Application No.: 10/139,661 :
Filed: May 2, 2002 :
Attorney Docket No: 404302000600 :
For: AUTHENTICATION SERVER USING MULTIPLE METRICS FOR IDENTITY VERIFICATION :

DECISION ACCORDING STATUS UNDER RULE 47(a)

This is in response to the petition under 37 CAR 1.47(a), filed January 9, 2003.

The petition is **GRANTED**.

The above-identified application and papers have been reviewed and found in compliance with 37 CAR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

A "Notice to File Missing Parts of Non-Provisional Application" ("Notice") was mailed to petitioner on June 10, 2002, indicating that petitioner neglected to file a proper oath or declaration in compliance with 37 CFR 1.63. The Notice also advised petitioner that a $65.00 surcharge was also due because a proper oath or declaration was not timely filed. The Notice set forth a period of reply of two months from the mailing date of the Notice and indicated that extensions of time for reply were available pursuant to 37 CAR 1.136(a). On January 9, 2002, petitioner filed the instant petition under 37 CAR 1.47(a) along with a request for an extension of time within the fifth month.

By statements and documentary evidence, petitioner has established inventors Pu and Ma are unavailable to join the above-cited application. The above-cited application is, therefore, 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 will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this matter should be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

AMGEN INC.
MAIL STOP 28-2-C
ONE AMGEN CENTER DRIVE
THOUSAND OAKS CA 91320-1799

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JUL 31 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Dirk M. Anderson et al | : | |
| Application No. 10/139,662 | : | ON PETITION |
| Filed: May 2, 2002 | : | |
| Attorney Docket No. 2624-C | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 28, 2005, 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 May 18, 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)(II)(A)(2)(b). No timely extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is August 19, 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 Notice of Appeal filed with the petition on November 28, 2005[1] and a subsequently filed Request for Continued Examination (RCE) and fee of $790, and the submission required by 37 CFR 1.114, on June 28, 2006; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats.

[1] In view of the filing of a Request for Continued Examination on June 28, 2006, the appeal is withdrawn. *Note MPEP* 706.07(h)(x).

1988). Since the $1,020 and $2,160 extension of time fees submitted on November 28, 2005 and June 28, 2006 were subsequent to the maximum extendable period for reply, these fees are unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

This application is being referred to Technology Center AU 1644 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Frances Hicks
Petitions Examiner
Office of Petitions

SPE: Meng Ai An

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/3/02

TO SPE OF : ART UNIT 2195

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/139,669 Patent No.: 6976261

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.

- [x] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** _____

MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

**SPE** — **Art Unit** 2195

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 221313-1450
WWW.USPTO.GOV

Mailed: APR 18 2005

HYP
Paper No.

*In re* Application of Jon B. Schneider
Serial No.: 10/139,680
Filed: May 7, 2002

Title: MAGNETIC LAYER WITH HIGH-PERMEABILITY BACKING

**DECISION ON PETITION UNDER** *37 CFR 1.48(a)*

This is a decision on the PETITION TO CORRECT INVENTORSHIP IN A NON-PROVISIONAL PATENT APPLICATION filed November 15, 2004 to correct inventorship under 37 CFR 1.48(a) by adding the name of Orval D. Ogden, Jr. to the list of inventors of the instant application.

It is noted that the applicant has met the requirements of 37 C.F.R. § 1.48(a) by (1) submitting a request to correct the inventorship that sets forth the desired inventorship change; (2) providing a statement from each person being added as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (3) providing a declaration of the actual inventors as required by 37 C.F.R. § 1.63; (4) providing the processing fee set forth in 1.17(i); and, (5) providing the written consent of the assignee.

The request is **GRANTED**.

The application file is being forwarded to the appropriate section of the Patent and Trademark Office for correction of the record.

Harold Y. Pyon 2/16/05
Supervisory Patent Examiner
Art Unit 1772
Technology Center 1700

Brian J. Hairston
CONNOLLY BOVE LODGE & HUTZ, LLP
1990 M Street, N. W., Suite 800
Washington, DC 20036-3425

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NOV 2 1 2008

**OFFICE OF PETITIONS**

DAVID L. HAUSER
EDWARDS LIFESCIENCES LLC
ONE EDWARDS WAY
LEGAL DEPT.
IRVINE CA 92614

In re Patent No. 6,908,481
Issue Date: June 21, 2005
Application No. 10/139,741
Filed: May 2, 2002
Attorney Docket No. 501015.20503

: DECISION ON PETITION AND
: REQUEST FOR CERTIFICATE OF
: CORRECTION

This is a decision on (a) the petition filed February 18, 2008, which is being treated as a petition under 37 CFR 1.78(a)(3) and 37 CFR 1.55(c), seeking to add a claim for priority under 35 U.S.C. §§120 and 365(c) for the benefit of priority to prior-filed non-provisional and PCT applications, and under 35 U.S.C. § 119(a)-(d) for the benefit of priority to a prior-filed foreign application, as set forth in the instant petition; and (b) a request for a Certificate of Correction that has been filed concurrently with the above noted petition, seeking to add a claim for priority under 35 U.S.C. §§120 and 365(c) to prior-filed non-provisional and PCT applications.

***As to the benefit claim under 37 CFR 1.78(a)(3) & 37 CFR 1.55(c):***

As the delayed claim under 37 CFR 1.78(a)(3) for the benefit of priority to prior-filed non-provisional and PCT applications as set forth in the petition has been treated under the Certificate of Correction Request, only the request under 37 CFR 1.55(c) for the benefit of priority to a prior-filed foreign application has been considered below.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The non-provisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is

claimed, by the application number, country, and the filing date, and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where there is a question whether the delay was unintentional); and

(5) the above-identified non-provisional application must be filed within 12 months of the filing date of the foreign application.

The delayed claim for priority under 37 CFR 1.55 must be made during the pendency of the later filed application. See *MPEP § 201.14(a)*. The instant petition has been filed subsequent to the issuance of the '741 application as a patent. The instant petition is therefore **DISMISSED** as UNTIMELY.

A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patented continuing application if the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the parent application prior to issuance of the patent and the requirements of 37 CFR 1.55(a) are met. However, a claim to foreign priority benefits cannot be perfected via a certificate of correction if the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance and the requirements of 37 CFR 1.55(a) are not met. In this latter circumstance, the claim to foreign priority benefits can be perfected only by way of a reissue application in accordance with the rationale set forth in Brenner v. State of Israel, 158 USPQ 584. See *MPEP § 201.16*.

***As to the Request for a Certificate of Correction***:

The instant application was filed May 2, 2002. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed application(s) after issuance of the application into a patent. *See* MPEP 1481.

Where 35 U.S.C. 120 and 365(c) priority based on an international application is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate (see MPEP §

201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application); and
(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§120 and 365(c) to the above-noted, prior-filed application(s) satisfies the conditions (A) – (D) above, **the petition is GRANTED**. It is noted that the certificate of correction mailed on June 10, 2008 is in accordance with this decision.

The petitioner's remark concerning the typographical error in the Office records concerning the serial number of the parent application 09/345,824 has been noted. A corrected Filing Receipt, incorporating the requested change and which includes the priority claim to the above-noted, prior-filed nonprovisional application(s), accompanies this decision on petition.

As authorized, the $1,410 surcharge fee, as well as the $100 certificate of correction fee, have been charged to petitioner's Deposit Account No. 50-1225.

Any inquiries concerning this decision may be directed to Ramesh Krishnamurthy at (571) 272-4914.

David Bucci
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/139,741 | 05/02/2002 | 3738 | 816 | 501015.20503 | 29 | 2 |

**CONFIRMATION NO. 5583**

**CORRECTED FILING RECEIPT**

DAVID L. HAUSER
EDWARDS LIFESCIENCES LLC
ONE EDWARDS WAY
LEGAL DEPT.
IRVINE, CA 92614

*OC000000032543079*

Date Mailed: 11/21/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Alain Cribier, Maromme, FRANCE;

**Power of Attorney:**
Harry Ahn--40243

**Domestic Priority data as claimed by applicant**

This application is a CON of 09/795,803 02/28/2001 ABN
which is a CON of 09/345,824 06/30/1999 ABN
which is a CON of PCT/EP97/07337 12/31/1997

**Foreign Applications**
EUROPEAN PATENT OFFICE (EPO) 96402929.2 12/31/1996

**If Required, Foreign Filing License Granted:** 06/10/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/139,741**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

VALUE PROSTHESIS FOR IMPLANTATION IN BODY CHANNELS

**Preliminary Class**

623

## 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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 08/13/07

TO SPE OF : ART UNIT 2192

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/139759** Patent No.: **7181512**

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.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

TUAN DAM
SUPERVISORY PATENT EXAMINER
**SPE**

2192
**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
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DIW Aug-05

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET, SUITE 540
SAN FRANCISCO CA 94105

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AUG 2 5 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,796,720 | : | |
| Issued: 28 September, 2004 | : | |
| Application No. 10/139,762 | : | ON PETITION |
| Filed: 7 May, 2002 | : | |
| Attorney Docket No. 09100.026 | : | |

This is a decision on the petition under 37 CFR 1.182, filed on 22 June, 2005, requesting the issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

Since it is U.S. Patent and Trademark Office practice to assure mailing of all papers on the date indicated, there is a strong presumption that papers duly addressed and indicated as mailed, such as the Letters Patent in this application, are timely delivered to the addressee. To overcome this presumption, a verified statement with supporting evidence, such as any records which would disclose the receipt of other correspondence mailed from the U.S. Patent and Trademark Office on or about 28 September, 2004, but fail to disclose receipt of the Letters Patent mailed on that date, should be promptly submitted. Further, copies of records on which receipt of the Letters Patent would have been entered had it been received are required.

However, if the loss of the Letters Patent was not the fault of the U.S. Patent and Trademark Office or if petitioner simply wishes to avoid overcoming the above-noted presumption, a petition may be filed under 37 CFR 1.182 accompanied by a petition fee of $400.00 requesting a duplicate Letters Patent. Upon receipt of the petition and petition fee, the request for a duplicate Letters Patent will be granted.

Although petitioners' counsel states that the original Letters Patent has not been received, petitioners have not provided any supporting documentation showing that the original Letters Patent was not received.

Nevertheless, as petitioners have submitted authorization to charge the petition fee, the petition is granted.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent. The file is being forwarded to the Files Repository since it is not necessary for issuance of a duplicate Letters Patent.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor, Room C-32
(FAX 703-746-4642)

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
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HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Theodora Salcedo | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7064189 | : RECALCULATION of PATENT |
| **Issue Date** | : 06/20/2006 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/139,785 | : OF WYETH |
| **Filed** | : 05/07/2002 | : |
| | | : |

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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APR 1 1 2004

ROBERT K. CERPA
MORRISON & FOERSTER LLP
35TH FLOOR
555 W. 5TH STREET
LOS ANGELES CA 90013

| | |
|---|---|
| In re Application of | : |
| Andrei V. Blokhin et al | : |
| Serial No.: 10/139,798 | : SUSPENSION OF ACTION |
| Filed: May 6, 2002 | : |
| Attorney Docket No.: 37646200510 | : |

This is in response to the petition under 37 CFR 1.103, filed January 26, 2004, to suspend prosecution of the above identified application for six months.

Applicant seeks suspension of the examiner's action on this application for a period of six months because of financial difficulties.

BACKGROUND

This application was filed May 6, 2002, and was forwarded to an examiner after initial processing. The examiner of this application issued a first Office action on July 24, 2003, setting forth rejections under 35 U.S.C. 103(a), 102(a) and 112, first and second paragraphs. Applicants replied on January 26, 2004, including a three month extension of time and fee therefor. This petition was filed with the response.

DISCUSSION

37 CFR 1.103. Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in §1.17(I). Action will not be suspended when a reply by applicant to an Office action is required.

M.P.E.P. 709 relates to suspension of action in an application. 37 CFR 1.103 permits the Office to suspend action upon petition by applicants for **good and sufficient cause** (emphasis added). Applicants state that they are attempting to raise additional operational funds and continuing other avenues of research and development and that they wish to postpone patent prosecution expenses while maintaining pendency of the application.

Patent applications and the patents issuing therefrom are considered to be valuable business assets. To delay the issuance of a patent by suspension of prosecution would be perceived as diminishing the value of the asset. Further, the financial circumstances of applicant are not considered to provide a "good and sufficient" reason for suspension of action.

DECISION

**The petition to suspend action is DENIED**. Applicant has not presented a "good and sufficient cause" warranting suspension of action by the examiner.

**The application will be forwarded to the examiner of record for further consideration not inconsistent with this decision.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Offic facsimile number 703-872-9306.

Jasemin C. Chambers for

Bruce Kisliuk
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20060627

DATE : June 12, 2006

TO SPE OF : ART UNIT 2878

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/139837 Patent No.: 6,841,772

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:**

SPE

2878

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
Washington, D.C. 20231
www.uspto.gov

Paper No. 12

Ivor R. Elrifi, Esq.
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.
One Financial Center
Boston, MA 02111

**COPY MAILED**

**FEB 25 2003**

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of<br>Kumud Majumder<br>Application No. 10/139,854<br>Filed: May 6, 2002<br>Attorney Docket No. 15966-675CON2<br>(CURA-175CO<br>Title: NOVEL POLYPEPTIDES AND<br>NUCLEIC ACIDS ENCODING SAME | DECISION ACCORDING STATUS<br>UNDER 37 C.F.R. § 1.47(b) |

This is in response to the "Petition for Filing Patent Application under 37 C.F.R. § 1.47(b)," filed December 2, 2002.

The petition under 37 C.F.R. § 1.47(b) is **GRANTED**.

The above-identified application was filed on May 6, 2002, with an unexecuted declaration naming Kumud Majumder as sole inventor. Accordingly, on May 30, 2002, applicant was 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 a declaration executed by Christopher McLeod, as agent for assignee CuraGen Corporation, on behalf of non-signing sole inventor Kumud Majumder; and paid the surcharge for late filing. To make this response timely, applicant submitted a petition for extension of the period for response to December 30, 2002 (and petition fee).

Applicant maintains that status under § 1.47(b) is proper because sole inventor Majumder has refused to join in the application. In support thereof, rule 47(b) applicant submits, *inter alia*:

- the employment agreement between inventor Majumder and rule 47(b) applicant CuraGen Corporation;
- 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;
- a statement of the last known address of inventor Majumder;
- a statement that inventor Majumder was an employee of assignee CuraGen Corporation at the time the invention was conceived and reduced to practice; and
- a statement that the filing of the application is necessary to preserve the rights of the CuraGen Corporation or to prevent irreparable damage.

The declaration filed December 2, 2002, has been reviewed and found in compliance with §§ 1.63 and 1.64.

Having reviewed the petition, it is concluded that petitioner has met the requirements for acceptance of this declaration under § 1.47(b)[1].

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 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 May 30, 2002, also required formal drawings in compliance with 37 C.F.R. 1.81 and compliance with the requirements of 37 C.F.R. 1.821-1.825).

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson

Nancy Johnson
Petitions Attorney
Office of Petitions

---

[1] 37 C.F.R. §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

DR. KUMUD MAJUMDER
2398 HIGH RIDGE RD.
STAMFORD, CT 06903

**COPY MAILED**

**FEB 25 2003**

**OFFICE OF PETITIONS**

In re Application of
Kumud Majumder
Application No. 10/139,854
Filed: May 6, 2002
Attorney Docket No. 15966-675CON2
(CURA-175CO
Title: NOVEL POLYPEPTIDES AND
NUCLEIC ACIDS ENCODING SAME

LETTER

Dear Dr. Majumder:

You are named as a 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 sole inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Paper No. 7

Thomas E. Wettermann
McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago IL 60606

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AUG 2 9 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>THOMAS J. POORMAN<br>Application No. 10/139,861<br>Filed: May 6, 2002<br>Attorney Docket No. 01-1018 | DECISION GRANTING PETITION<br>UNDER 37 CFR 1.137(b) |

This is a decision on the petition, filed May 28, 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 October 3, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The present petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of December 11, 2003, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 2875.

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Notice Regarding Rescission of Nonpublication Request and Notice of Foreign Filing

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**J.C. PATENTS, INC.**
**4 VENTURE, SUITE 250**
**IRVINE, CA 92618**

**COPY MAILED**

JUN 09 2005

**OFFICE OF PETITIONS**

ON PETITION

| | | |
|---|---|---|
| In re Application of | : | |
| Joseph Neev | : | |
| Application No. 10/139,862 | : | |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. BEAM-01 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed September 14, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed February 9, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on May 11, 2004.

The Revocation of Power of Attorney filed on September 14, 2004 has been entered and made of record (copies attached).

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachments: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**LAW OFFICE OF RICHARD B. CATES**
**2629 MANHATTAN AVENUE**
**PMB-273**
**HERMOSA BEACH, CA 90254**

MAILED

JUN 07 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,020,528 | : | |
| Issue Date: March 28, 2006 | : | |
| Application No. 10/139,862 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. NEEVJ-1112PAT | : | |

This is a decision in response to a petition filed April 19, 2010, under 37 CFR 1.378(c), to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on March 29, 2010, for failure to pay the 3 ½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

Further, The Revocation and Power of Attorney filed on April 19, 2010 is hereby accepted and made of record. However, petitioner should also note that the mere filing of a power of attorney and/or a change of correspondence address will not affect the fee address. Therefore, if petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which may be mailed regarding maintenance fees for the above-identified patent the "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) should be submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6059.

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

Enclosure: Notice 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 |
|---|---|---|---|
| 10/139,862 | 05/06/2002 | Joseph Neev | YBEAM-01 |

**CONFIRMATION NO. 5153**

**POA ACCEPTANCE LETTER**

56549
Law Office of Richard B. Cates
2629 Manhattan Avenue
PMB-273
Hermosa Beach, CA 90254

*OC000000041959485*

Date Mailed: 06/04/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/19/2010.

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.

/atkelley/

---

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

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/139,862 | 05/06/2002 | Joseph Neev | YBEAM-01 |

**CONFIRMATION NO. 5153**

**POWER OF ATTORNEY NOTICE**

23900
J C PATENTS
4 VENTURE, SUITE 250
IRVINE, CA 92618

*OC000000041959456*

Date Mailed: 06/04/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/19/2010.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/atkelley/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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**AMIN, TUROEY & CALVIN LLP**
**1900 E. 9TH STREET**
**24TH FLOOR, NATIONAL CITY CENTER**
**CLEVELAND, OH 44114**

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JUN 26 2008
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Alexander Gantman, et al | : | |
| Application No. 10/139,873 | : | DECISION ON PETITION |
| Filed: May 6,2002 | : | |
| Attorney Docket No. 020081 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 1, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, July 24, 2006, which set a shortened statutory period for reply of A three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 25,2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1540; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 2135 for appropriate action by the Examiner in the normal course of business on the reply received April 1, 2008.

April Wise
Petitions Examiner
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Jan-06

ALBERT WAI-KIT CHAN
LAW OFFICES OF ALBERT WAI-KIT CHAN, LLC.
WORLD PLAZA, SUITE 604
141-07 20TH AVENUE
WHITESTONE NY 11357

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JAN 2 7 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Salvatore Olivero | : | |
| Application No. 10/139,876 | : | ON PETITION |
| Filed: 7 May, 2002 | : | |
| Atty Docket No. 917-US | : | |

This is a decision on the petition filed on 13 December, 2005, under 37 CFR 1.137(b), which, in view of petitioner's statement that the Office action was never received, is first treated as a petition under 37 CFR 1.181, to withdraw the holding of abandonment of the above-identified application.

The petition to withdraw the holding of abandonment is **GRANTED**.

The petition under 37 CFR 1.137(b) is **DISMISSED AS MOOT**.

The application was held abandoned for failure to timely respond to the Office action requiring restriction and/or election mailed on 28 October, 2004, which set a one (1) month shortened period for reply. Notice of Abandonment was mailed on 14 December, 2005.

Petitioner asserts that a revocation and power of attorney and change of correspondence address were submitted on 16 September, 2004, but were never entered by the Office. Petitioner further asserts that the Office action mailed on 28 October, 2004, was sent to an old address.

Petitioner asserts that the Office action mailed on 28 October, 2004, was never received because it was not mailed to the current correspondence address as indicated on the revocation and power of attorney and change of correspondence address filed on 16 September, 2004. A review of the record reveals that a

revocation and power of attorney by the assignee, accompanied by a change of correspondence was received on 16 September, 2004, but was never entered.

It is noted that the cover sheet and first page of revocation and new power of attorney miscaptions the application number as "10/139,976". Under current Office procedure, a response that has an incorrect serial number is handled in accordance with MPEP 508.03. If a paper having an incorrect serial number contains sufficient information to identify the correct application and was timely received at the USPTO, the holding of abandonment will be withdrawn.

The inventor's name, title of invention, and filing date, attorney docket number, examiner's name, and Art Unit are correctly stated on the revocation and power of attorney filed on 16 September, 2004. Additionally, the second and third pages of the revocation and power of attorney correctly caption the application number. In reviewing the papers which were submitted, it is therefore concluded that there was sufficient information thereon to associate the papers with the instant file.

It therefore appears that the Office erred in not entering the revocation and power of attorney and change of correspondence filed on 16 September, 2004, and that the Office action mailed on 28 October, 2004, was not mailed to the proper address.

The holding of abandonment is withdrawn, the Notice of Abandonment mailed on 26 September, 2005, is vacated.

The revocation and power of attorney and change of correspondence address have been accepted.

As the holding of abandonment has been withdrawn, the petition fee is unnecessary, and will be credited to counsel's deposit account, No. 50-1891, as authorized in the present petition.

It is noted that petitioner has filed a response to the Office action requiring restriction and/or election with the present petition.

The file is being referred to Technology Center 1632 for further processing.

All other inquiries regarding this decision may be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cf: Notice Regarding Change of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

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**COOLEY GODWARD KRONISH, LLP**
**ATTN: Patent Group**
**Suite 1100**
**777 – 6th Street, NW**
**Washington, DC 20001**

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FEB 07 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In Re Application Of | : | |
| Salvatore Oliviero et al. | : | |
| Application No. 10/139,876 | : | DECISION ON PETITION |
| Filed: May 7, 2002 | : | TO WITHDRAW |
| Attorney Docket No. SIEN-001/00US 307535-2001 | : | 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 January 18, 2008.

The request is **NOT APPROVED**.

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

Applicant is advised that the power of attorney submitted on November 18, 2005 is not proper since it fails to satisfy the provisions of 37 CFR 3.73(b). Compliance with 37 CFR 3.73(b) has not been satisfied in that a statement was not enclosed setting forth a reel and frame number or chain of title where the recorded assignment appears in the assignment records of the Office. If assignee of the entire interest under 37 CFR 3.71 desires to intervene in this application or appoint counsel to represent him, then the appropriate power of attorney documents must be submitted. *Note* 37 CFR 3.73(b).

All future communications from the office will continue to be directed to the above-listed address until otherwise notified by applicant.

There are currently no pending Office actions.

Telephone inquires concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Enrica Bruno Patent Law
150 S. Los Robles Avenue
Ste. 920
Pasadena, CA 91101

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OCT - 7 2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

In re Application of
Alberto Rivarossa et al.
Serial No.: 10/139,878
Filed: May 7, 2002
Attorney Docket No.: 2039-0163P

: PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed June 24, 2004, for withdrawal of abandonment of the above identified application based on a timely response to the Office Action of June 16, 2003.

A review of the file history shows that the examiner mailed an Office action to applicants on June 16, 2003, setting a three month shortened statutory period for reply. Upon failure to receive a reply the Office mailed a Notice of Abandonment to applicants on April 22, 2004. Applicants state that there was a timely response filed on September 16, 2003 and have provided a copy of the response, a request to charge Deposit Account No. 02-2448 for $504.00 for additional claims, and a copy of the facsimile cover sheet and confirmation receipt dated September 16, 2003. In view of the evidence, the Notice of Abandonment is withdrawn and the application is restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**The application will be forwarded to the examiner for further action .**
**The fee of $504 will be charge to Deposit Account No. 02-2448 per request of applicant.**

Should there be any questions about this decision please contact Jean F. Vollano, by letter addressed to Director, TC 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0648 or by facsimile sent to the general Office facsimile number.

Jean F Vollano for
Bruce Kisliuk
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** 5

**DATE** : 8/8/07

**TO SPE OF** : ART UNIT 1775

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/139893 Patent No: 7052762 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.

- ☒ 1 **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

/Jennifer McNeil/ SPE 1794 2

**SPE** **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 8/8/07

**Paper No.:** ___

**TO SPE OF** : ART UNIT 1775

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 01/139893 Patent No: 7052762 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:** _____

/Jennifer McNeil/ SPE 1794

**SPE** **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Mail Date: 05/20/2010

| | | |
|---|---|---|
| **Applicant** | : Ian Edward Davis | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7649885 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/139,912 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/06/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **954** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : August 01, 2008

TO SPE OF : ART UNIT 2136

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/139924 Patent No.: 7249262 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**.

DO NOT SENT TO ATTORNEY

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within 7 days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**
[redacted]

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

| | |
|---|---|
| x **Approved** | **All** changes apply. |
| ☐ **Approved in Part** | Specify below which changes **do not** apply. |
| ☐ **Denied** | State the reasons for denial below. |

**Comments:** _____

/Nasser moazzami/ Supervisory Patent Examiner Art Unit 2136

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PTCL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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Paper No. 8

Mitchell D. Bittman, Esq.
Sequa Corporation
Three University Plaza
Hackensack, NJ 07601

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DEC 1 0 2003

**OFFICE OF PETITIONS**

In re Application of
James T. Cash
Application No. 10/139,927
Filed: May 7, 2002
Attorney Docket No. MT-128

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 3, 2003, to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed August 23, 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 after midnight October 23, 2002.

In response to the Notice to File Corrected Application Papers, petitioner submitted with the instant petition $1,330 for the petition to revive fee, and nineteen (19) sheets of formal drawings consisting of Figures 1-20.

Since the requirements for a grantable petition have been met, the petition is **GRANTED**.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this decision should be directed to Andrea Smith at (703) 308-6711.

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CC: Kevin S. Lemack
Nields & Lemack
176 E. Main Street - Suite 7
Westboro, MA 01581

BB

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APR 1 1 2004

ROBERT K. CERPA
MORRISON & FOERSTER LLP
35TH FLOOR
555 W. 5TH STREET
LOS ANGELES CA 90013

| | |
|---|---|
| In re Application of | : |
| Andrei V. Blokhin et al | : |
| Serial No.: 10/139,[redacted] 978 | : SUSPENSION OF ACTION |
| Filed: May 6, 2002 | : |
| Attorney Docket No.: 37646200510 | : |

This is in response to the petition under 37 CFR 1.103, filed January 26, 2004, to suspend prosecution of the above identified application for six months.

Applicant seeks suspension of the examiner's action on this application for a period of six months because of financial difficulties.

BACKGROUND

This application was filed May 6, 2002, and was forwarded to an examiner after initial processing. The examiner of this application issued a first Office action on July 24, 2003, setting forth rejections under 35 U.S.C. 103(a), 102(a) and 112, first and second paragraphs. Applicants replied on January 26, 2004, including a three month extension of time and fee therefor. This petition was filed with the response.

DISCUSSION

37 CFR 1.103. Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in §1.17(f). Action will not be suspended when a reply by applicant to an Office action is required.

M.P.E.P. 709 relates to suspension of action in an application. 37 CFR 1.103 permits the Office to suspend action upon petition by applicants for **good and sufficient cause** (emphasis added). Applicants state that they are attempting to raise additional operational funds and continuing other avenues of research and development and that they wish to postpone patent prosecution expenses while maintaining pendency of the application.

Match and Return

Patent applications and the patents issuing therefrom are considered to be valuable business assets. To delay the issuance of a patent by suspension of prosecution would be perceived as diminishing the value of the asset. Further, the financial circumstances of applicant are not considered to provide a "good and sufficient" reason for suspension of action.

DECISION

**The petition to suspend action is <u>DENIED</u>**. Applicant has not presented a "good and sufficient cause" warranting suspension of action by the examiner.

**The application will be forwarded to the examiner of record for further consideration not inconsistent with this decision.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Offic facsimile number 703-872-9306.

Jasemin C. Chambers for

Bruce Kisliuk
Director, Technology Center 1600

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KILLWORTH, GOTTMAN, HAGAN & SCHAEFF, L.L.P.
ONE DAYTON CENTRE, SUITE 500
DAYTON, OH 45402-2023

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| | | |
|---|---|---|
| In re Application of | : | |
| Er-Xuan Ping | : | |
| Application No. 10/139,987 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. MIO 0088 VA | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed February 23, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before February 17, 2004. Accordingly, this application became abandoned on February 18, 2004.

This application is being forwarded to Publishing Division.

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

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Paper No. 5

**PETER F. WEINBERG**
**GIBSON DUNN & CRUTCHER**
**SUITE 4100**
**1801 CALIFORNIA STREET**
**DENVER, CO 80202**

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NOV 0 5 2002

**OFFICE OF PETITIONS**

In re Application of :
Robert C. Badali et al :
Application No. 10/140,008 : NOTICE
Filed: May 8, 2002 :
Attorney Docket No. 56419-00001 :

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 3629.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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JUL 26 2006

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR,
ARLINGTON, VA 22203

| | |
|---|---|
| In re Application of | : |
| Michael Levy et al | : |
| Serial No.: 10/140,015 | : PETITION DECISION |
| Filed: April 29, 2002 | : |
| Attorney Docket No.: 273/076US | : |

This is in response to the petition under 37 CFR §§ 1.144 and 1.181, filed June 19, 2006, requesting the Director to invoke his supervisory authority under 37 CFR § 1.1.81 and withdraw the final restriction requirement.

**BACKGROUND**

A review of the file history shows that the examiner mailed a non-final Office action to applicants on October 2, 2003, setting a three month shortened statutory period for reply in which:

Claims 1-3,6-9, 12-13, 15 and 17 were found to be allowable,
Claims 4,5,10, 11, 14, 18 were rejected under 35 U.S.C. 112 second paragraph,
Claims 19, 23 were rejected under 35 U.S.C. 102(b) over Barley et al US 3465083,
Claims 20 and 24 were rejected under 35 U.S.C. 102(b) over Lafon US 3122,478 and
Objected to claims 21, 22, 25-36 as being improperly dependent.

Applicants filed a response on February 02, 2004 amending the rejected claims and adding new claims 37-40.

Claims 1-19, 21, 22, 24, 25, 27, 29-40 were subsequently allowed on March 24, 2004.

Applicants then filed an RCE on June 24, 2004 with a one page IDS and then again on July 29, 2004, filed an amendment canceling claims 20-23, 26, 28 and 37-40 and amending the claims 1-6, 8-19, 24, 25 and 28, along with arguments and another one page IDS.

Examiner Spear mailed a non–final rejection to applicants on March 07, 2005, in which:

Claims 1-19, 24,25, 27, 29-36 were rejected under 35 USC 102(b) as being anticipated by Mattei et al, US 4439420,
Claims 27 and 29 were rejected under 35 U.S. C. 102(b) as being anticipated by US 5702,695,
Claims 27, 29-36 were rejected under 35 U.S.C. 103(a) over Clokie US 5702695 in view of

EP 0884,052A1 and Klaveness et al US 6331289 B1.

On May 17, 2005, examiner Spear had an interview with the applicants' attorney to discuss an amendment inserting "at least about 80%" to overcome the rejection. The Examiner would check to see if that would be new matter. However there is no record that the new matter was ever addressed.

In response to the interview on June 07, 2005, applicants filed an amendment to the claims along with their arguments.

Due to the retirement of Examiner Spears the case was transferred to another examiner who on September 19, 2005, restricted the amended claims into five Groups as follows:

| | |
|---|---|
| I. | Claims 1-11, drawn to a method of bone hemostasis using a copolymer of at least 80%, classified in class 514, subclass 772.3, |
| II. | Claims 12 and 16-18, drawn to a kit comprising a bandage, tape, gloves and a bone hemostasis agent, classified in class 206, subclass 440. |
| III. | Claims 19, 24 and 25, drawn to an agent (for the intended use of bone hemostasis, classified in class 424, subclass 98+ |
| IV. | Claims 27 and 29-36, drawn to an agent (for the intended use of bone hemostasis comprising at least 80% of a copolymer of oxyethylene and oxypropylene and a medication, classified in class 424, subclass 426. |
| V. | Claims 41-44, drawn to a method of bone hemostasis using a copolymer, classified in class 514, subclass 772.3. |

In response applicants amended the claims by adding new limitations, elected claim 19 And argued that claim 19 (as amended) now was a generic or a linking claim for Groups II-IV. Applicants also, at the same time elected a species "polyoxyethylene-polyoxypropylene-polyoxyethylene triblock co-polymer" and stated that claims 1-12, 16-19, 24,25, 27, 29-36, 41-47 read on the species. They also argued that examination of Groups II-IV would not constitute an undue burden even though they are separately patentably distinct, and in the interest of compact prosecution and public interest, should be examined together.

The case was again reassigned to another examiner, who on February 17, 2006, mailed a non-final Office action to applicants in which:

The restriction was maintained and made Final,

Claims 19, 24 and 25 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over JP 032265858.

In response on June 19, 2006, applicants filed arguments, an amendment and this petition for review by the Technology Center Director to withdraw the restriction requirement.

**DISCUSSION**

Applicants state that no "serious burden exists "to search and examine all of claims 1-12, 16-19, 24-25, 27, 29-36 and 41-47 because their subject matter has already been examined by a previous examiner and that the several amendments made during the prosecution only narrow the claims further and do not broaden them. The examiner argues that these are patentably distinct groups and argues that the search is burdensome to search and examine all Groups

.

A review of the claims suggests that the inventive concept on which patentability of all claims rests is the bone hemostasis agent composition and that all other claim limitations are known or conventional, such as added medicaments, provision as a kit, etc. In view of this, patentability of the article/composition claims should be determined collectively and these claims, constituting Groups II-IV are rejoined as a single Group. In like manner the method claims for using the bone hemostasis agent should not be separated from each other and Groups I and V are rejoined as a single Group. The restriction requirement is therefore:

Group I, claims 1-11 and 41-44, drawn to a method of bone hemostasis; and
Group II, claims 12, 16-19, 24-25, 27, 28-36 and (newly added) 45-47, drawn to a bone hemostasis agent.

Group II is considered to be elected based on applicants' previous election of claim 19 (original Group III) and upon determination of allowability of the claims of Group II, the claims of Group I will be considered for rejoinder.

Applicants' petition is **GRANTED-IN-PART .**

**The application will be forwarded to the examiner for further action not inconsistent with this decision of the response filed June 19, 2006, and the IDS filed July 13, 2006, .**

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 Kisliuk
Director, Technology Center 1600

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John S. Egbert
Harrison & Egbert
412 Main Street, 7th Floor
Houston, TX 77002

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APR 25 2007

**OFFICE OF PETITIONS**

In re Application of
Felix L. Sorkin
Application No.: 10/140,017
Filed: May 7, 2002
For: U.S. Patent No.: 6,874,821

: DECISION
: DISMISSING PETITION

This is in response to the "Petition to Publish a Corrected Letters Patent Under 37 CFR § 1.183" to Reprint Patent" dated 14 April 2005.

The petition is dismissed.

The disclosure of the above-identified application was printed as U.S. Patent 6,874,821 with the following error, as identified by Petitioner: the drawings published were the informal drawings originally filed, instead of formal drawings supplied with payment of the issue fee received by the Office on 30 April 2004.

**37 CFR § 1.322 Certificate of correction of Office mistake.**

> (a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:
> (i) At the request of the patentee or the patentee's assignee;
> . . .
> (b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR § 1.322(b) indicates that the Office may issue a corrected patent in lieu of a certificate of correction, where a corrected patent is considered more appropriate in form than a certificate of correction. Office practice is to regard a "corrected patent" a complete republication of the patent that removes the prior mistake(s), includes no certificate of correction, and contemplates updating of databases if necessary.

Although Petitioner filed this petition under 37 CFR § 1.183, this petition is being treated under 37 CFR § 1.322(b).

Petitioner has not identified any substantive differences between the published informal drawings and the submitted formal drawings (such as differences in subject matter displayed), making a remedy achievable via a certificate of correction. A certificate of correction can be printed in a shorter amount of time than a corrected patent. Since the text of the patent was correctly printed and no significant change will be introduced through replacement of the original drawings, a certificate of correction is deemed the appropriate form to correct the Office errors in the patent. Accordingly, this request is dismissed, and a corrected patent will not be issued.

Petitioner has demonstrated this error has been incurred through the fault of the Office, and therefore Petitioner's submitted Petition Fee of $400.00 is being refunded through deposit in Deposit Account 08-0879.

As Petitioner appears to have additionally requested a re-printing of the Patent, this file is being returned to the Office of Patent Publication for further processing of the certificate of correction, and a reprint of the red-ribbon copy of the patent using the formal drawings. The application is being forwarded to Ms. Marietta Joyce, Team Leader, Certificates of Correction, for the following:

1. issuance of an appropriate certificate of correction; and
2. a single reprinting of the red-ribbon copy using the formal drawings.

Telephone inquiries regarding this communication should be directed to Samuel Broda at (571) 272-7711.

Hiram Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

OIPE JC101
APR 2 2 2005
PATENT & TRADEMARK OFFICE

DAC
ZFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: SORKIN, Felix L.

PATENT NO.: 6874821

ISSUED: April 5, 2005

TITLE: COUPLER APPARATUS FOR USE WITH ANGLED POST-TENSION CABLES IN PRECAST CONCRETE SEGMENTAL CONSTRUCTION

PETITION TO PUBLISH A CORRECTED LETTERS PATENT UNDER 37 C.F.R. § 1.183

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

U.S. Serial No.: 10/140,017
Filed on: May 7, 2002

Dear Sirs:

In accordance with 37 C.F.R. § 1.183, the following is a statement of facts and petition for re-publishing a corrected Official Letters Patent so as to include the correct drawings.

1. The present Letters Patent issued on April 5, 2005.

2. The formal drawings associated with this application are incorrect. The formal drawings were submitted on April 28, 2004. See Transmittal of Formal Drawings and acknowledgment post card, indicating receipt by the U.S. Patent and Trademark Office on April 30, 2004. (Exhibit A, copies of the formal drawings)

3. Applicant notes that the set of drawings in the Letters Patent are inconsistent. The published drawings are free-hand drawings with dubious line quality and clarity. The formal drawings of April 30, 2004 are superior drawings with compliant format for publication. (See Exhibit B, the published drawings)

4. Applicant has since investigated the activity of the U.S. Patent and Trademark Office with regard to processing the drawings. The Transaction History does not recognize

04/25/2005 AWONDAF1 00000025 10140017
01 FC:1462 400.00 OP
Adjustment date: 04/26/2007 AKELLEY
04/25/2005 AWONDAF1 00000025 10140017
01 FC:1462 -400.00 OP
Refund Ref:
04/26/2007 0030039939
Credit Card Refund Total: $400.00
Am Exp...: XXXXXXXXXXX5005

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Wolf, Block, Schorr & Solis Cohen LLP
1650 Arch Street
Philadelphia, PA 19103

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OFFICE OF PETITIONS

In re Application of
Bran
Application No. 10/140,029
Filed: May 6, 2002
Docket No. Verte.077A

: DECISION GRANTING PETITION

This decision is in response to Applicant's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705 (b)" filed on December 18, 2006 requesting that the Office adjust the PTA determination at the time of the mailing of the Notice of Allowance from 451 days to 521 days.

Applicant's petition to correct PTA is **GRANTED.** The Office will adjust the PTA at the time of the mailing of the notice of allowance to reflect FIVE HUNDRED AND TWENTY-ONE (521) days. The Office will provide a copy of the adjusted PTA determination with this decision.

Applicant argues that the Office calculated the Office improperly assessed a seventy day reduction under 37 CFR 1.704(b) because applicant did not respond to the Office non-final action within three months. Applicants assert that the Office re-mailed the Office action to the proper address and restarted applicants' clock to the date Of February 17, 2006. Applicant assert that the responded to the non-final action on May 17, 2006.

Applicant's arguments are persuasive. The record reflects that the Office did restart the clock for applicant's reply to the non-final rejection to February 17, 2006. Applicants replied within three months as required under 37 CFR 1.704(b). Accordingly, the applicants did not fail to engage in any reasonable efforts to conclude prosecution of the application. Accordingly the overall determination is 521 days as applicant requested.

After the mailing of this decision, the Office will forward the application to the Office of Patent Publications for a prompt issuance of the patent. Any delays purusuant to 37 CFR 1.702(a)(4) or 1.702(b) will be reflected in the issue notification letter that is mailed to applicant approximately three weeks prior to issuance of the application.

The Office has assessed the $200.00 fee. No additional fees are required in deciding this petition matter.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: Copy of Adjusted Pair Calculation

PALM INTRANET

Day : Saturday
Date: 2/3/2007
Time: 10:34:43

| PTA Calculations for Application: 10/140029 | | | |
|---|---|---|---|
| Application Filing Date: | 05/06/2002 | PTO Delay (PTO): | 521 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 70 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 521 |
| PTO Delay Adjustment: | 70 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 45 | 02/03/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | 70 | | |
| 35 | 09/26/2006 | MAIL NOTICE OF ALLOWANCE | | | |
| 34 | 09/22/2006 | ISSUE REVISION COMPLETED | | | |
| 33 | 09/22/2006 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 32 | 09/18/2006 | NOTICE OF ALLOWABILITY | | | |
| 31 | 07/12/2006 | DATE FORWARDED TO EXAMINER | | | |
| 30 | 07/06/2006 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 29 | 04/06/2006 | MAIL NON-FINAL REJECTION | | | |
| 28 | 04/03/2006 | NON-FINAL REJECTION | | | |
| 27 | 01/25/2006 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 01/19/2006 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 25 | 01/05/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 24 | 01/05/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 23 | 10/19/2005 | MAIL NON-FINAL REJECTION | | | |
| 22 | 10/17/2005 | NON-FINAL REJECTION | | | |
| 21 | 08/01/2005 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 07/27/2005 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 19 | 07/07/2005 | MAIL RESTRICTION REQUIREMENT | | | |
| 18 | 07/01/2005 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 17 | 05/23/2005 | DATE FORWARDED TO EXAMINER | | | |
| 16 | 05/17/2005 | RESPONSE AFTER NON-FINAL ACTION | | 70 | 11 |
| 15 | 02/17/2005 | MAIL NOTICE OF RESTARTED RESPONSE PERIOD | | | |
| 14 | 02/16/2005 | LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES) | | | |
| 13 | 02/16/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |

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| 12 | 02/16/2005 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 11 | 12/08/2004 | MAIL NON-FINAL REJECTION | 521 | | -1 |
| 10 | 12/07/2004 | NON-FINAL REJECTION | | | |
| 9 | 11/10/2003 | MISCELLANEOUS INCOMING LETTER | | | |
| 8 | 11/04/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 7 | 03/25/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 09/10/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 07/09/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 06/27/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 06/19/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 05/17/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 05/06/2002 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Choi, Wai Ming | : | |
| Application No. 10/140,032 | : | ON PETITION |
| Filed: May6, 2002 | : | |
| Attorney Docket No. 156.0183 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 25, 2004 to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed January 29, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on April 30, 2004. A Notice of Abandonment was mailed September 20, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This matter is now being referred to Technology Center 1700 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 10

Brian M. Hoffman
FENWICK & WEST L.L.P.
Silicon Valley Center
801 California Street
Mountain View, CA 94041

MAILED

JUN 18 2004

Technology Center 2100

In re Application of:
William E. Sobel
Application No. 10/140,149
Filed: May 6, 2002
For: ALTERATION OF MODULE LOAD LOCATIONS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed June 03, 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 June 03, 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.

for James R. Matthews

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

cc: Edward J. Radlo
SONNENSCHEIN NATH & ROSENTHAL LLP
685 Market Street, 6th Floor
San Francisco, CA 94105

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AUG 3 2004

STEVEN P. O'CONNOR
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I STREET, N.W.
WASHINGTON DC 20005-3315

| | |
|---|---|
| In re Application of | : |
| THOMAS | : |
| Serial No.: 10/140,172 | : Decision on Petition |
| Filing Date: 5/7/02 | : |
| Attorney Docket No. AM1000250 | : |

This Petition under 37 CFR 1.144 was filed on 3 February 2004. It was only recently brought to the attention of the deciding official. The delay in acting upon this petition is regretted.

**BACKGROUND**

A review of the file history shows that the Office made a three-way Restriction Requirement between cell culture, a method of culturing cells and an antibiotic and within Group I, eight-way restriction to a specific type of virus.
The groupings are reproduced below:

> Restriction to one of the following inventions is required under 35 U.S.C. 121:
>
> I Claims 1-29 and 55, drawn to a cell culture, classified in class 435, subclass 325.
> II. Claims 30-50, drawn to a method of culturing cells, classified in class 435, subclass 325.
> III. Claims 51-54, drawn to an antibiotic, classified in class 435, subclass 404.
>
> * Group 1, claims 3, 4, 22 and 23, and Group 11, claims 49-50 are further restricted to one of the following:
> A. Equine infectious anemia virus IEIAVI
> B. Maedi-visna virus
> C. Progressive pneumonia virus
> D. Caprine arthritis-encephalitis virus
> E. Feline immunodeficiency virus (FIV)
> F. Simian immunodeficiency virus (SIV)

G. Human immunodeficiency vinzs (HIV) type I
H. Human immunodeficiency virus (HIV) type II

The Examiner supported this restriction because she reasoned that the search was divergent and the inventions were distinct.

> The restriction between the different viruses is required because a search for one virus will not necessarily reveal the other viruses. The viruses have varying structural characteristics and growth requirements. Because these inventions are distinct for the reasons given above and the literature search required for one group is not co-extensive for any other group, and it therefore burdensome, restriction for examination purposes as indicated is proper.

Relevant portions of the independent claims are reproduced below:

> 1. A cell culture, comprising at least one lentivirus-infected host cell and a growth promoting amount of an antibiotic consisting essentially of neomycin or a biologically compatible salt or derivative thereof.
>
> 3. The cell culture of claim 1, wherein said host cell is infected with at least one lentivirus selected from the group consisting of equine infectious anemia virus, Maedi-visna virus, progressive pneumonia virus, caprine arthritis-encephalitis virus, feline immunodeficiency virus (FIV), simian immunodeficiency virus, and human immunodeficiency virus (HIV) Types I and II.
>
> 4. (original) The cell culture of claim 3, wherein said virus is selected from the group consisting of feline immunodeficiency virus (FIV), simian immunodeficiency virus, and human immunodeficiency virus (HIV) Types I and II.

Applicants elected Group I and feline immunodeficiency virus with traverse.

In the first Office action on the merits, the examiner considered the traversal, rejoined three other groups (simian immunodeficiency virus and Human immunodeficiency viruses I and II ) with the one elected Feline immunodeficiency virus. The restriction requirement was made final.

This Petition was filed 3 February 2004.

Subsequent to the filing of the petition, a Final Office action was mailed by the Office.

**DISCUSSION**

The application, file history and petition have been considered carefully.

The petitioner requests reconsideration of the restriction imposed on the subset of claims 3, 4, 22 and 23 within Group I.

The Petitioner points to MPEP 802.01 which states that in order for a restriction to be proper, the claimed inventions must be independent and distinct. MPEP 802.01 defines "independent" and "distinct" as follows:

> INDEPENDENT
>
> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.
>
> DISTINCT
>
> The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects. It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

It is noted that the Examiner has agreed in part to the traversal and rejoined the immunodeficiency viruses as follows:

> lentiviruses and that half of the species are immunodeficiency viruses, and should therefore be kept as one invention. In response to Applicant's arguments, the immunodeficiency viruses will be examined together (FIV, SIV, HIV type I and II). However, a search for the other non-immunodeficiency viruses is burdensome. Therefore, the restriction is deemed proper and made Final.

With the remaining issue is the restriction between the elected invention of immunodeficiency viruses and the other groups: Equine infectious anemia virus Infectious Equine Anemia Virus, Maedi-visna virus, Progressive pneumonia virus, Caprine arthritis-encephalitis virus. All 8 viruses have been grouped in the class of viruses called lentivirus based upon their structure and functional similarities. It would be incorrect to say that these viruses are unrelated. The viruses can be used together, as demonstrated by Claims 30, a method using at least one of the viruses of claim 49.

Moreover, the scope of the groups overlap. Claims 1 and 17 encompass cell cultures comprising a host cell infected with at least one lentivirus. Thus the independent claims encompass two or more of the various lentiviruses. The lentivirus of claims 1 and 17 may be one of the eight viruses listed in dependent claims 3, 4, 22 and 23, or it may be one or more other lentivurses not specifically recited in the claims. The scope of the Groups listing the eight lentiviruses does not add up to the full scope of Claims 1 or 17. The unusual groupings, in which only a subset of claims in the dependency chain were subjected to the additional restriction, point to this error.

For these reasons, restriction to only these particular lentiviruses is not proper. The Office may not use restriction under 35 USC 121 as a means to narrow the scope of an invention.

**DECISION**

The petition is **GRANTED** for the reasons set forth above.

The final Office action is withdrawn in view of the restriction requirement being withdrawn. A new Office action consistent with this decision will follow.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, PO Box 1450, Alexandria VA 22313-1450 or by telephone at (571) 272-1600.

Jasemine C. Chambers

Jasemine Chambers
TC1600 Group Director

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/140,218 | 05/08/2002 | Koji Matsumoto | Q69916 | 6297 |

23373 7590 03/28/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

| EXAMINER |
|---|
| CHANG, AUDREY Y |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2872 | |

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 03172005

MAR 2 8 2005

Sughrue Mion, PLLC
2100 Pennsylvania Ave., N.W.
Suite 800
Washington, DC 20037

| | | |
|---|---|---|
| In re Application of | : | |
| Matsumoto et al. | : | NOTICE OF WITHDRAWAL |
| Appl. No. 10/140,218 | : | FROM ISSUE |
| Filing Date: May 8, 2002 | : | UNDER 37 CFR § 1.313 |
| Atty Docket No. Q69916 | : | |

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to 37 CFR § 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

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 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 related to this decision should be directed to supervisory patent examiner Drew A. Dunn at (571) 272-2312.

The above-identified application is being forwarded to the examiner for appropriate action.

Janice A. Falcone

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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MAY 19 2008

Joseph Zucchero
KEOWN & ZUCCHERO, LLP
500 West Cummings Park
Suite 1200
Woburn, MA 01801

In re Application of :
AGRAWAL, Sudhir :
Serial No.: 10/140,228 :Decision on Petition
Filed : May 7, 2002 :
Attorney Docket No.: IDRA-747US1:

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on April 24, 2008 requesting reconsideration of the restriction requirement.

**BACKGROUND**

This application was filed under 35 USC 111(a) and as such, is entitled to US restriction practice per Chapter 800.

On May 6, 2005, the examiner mailed a restriction requirement in which the original claims 1-18 were divided into 2 groups. The examiner further required applicants to select a single sequence Claim 10 for examination.

On July 1, 2005, Applicants elected Group I (Claims 1-10), and SEQ ID No 23 as the oligonucleotide sequence with traverse. Applicant asserted the MPEP 803.04 provides for a reasonable number of nucleic acid sequences to be permitted.

On June 12, 2006 the examiner considered the traversal and clarified the record to note that the corresponding target sequence to which the elected antisense binds will also be examined. The examiner noted the broader claims would be treated as linking claims and any sequences under an allowed scope would be rejoined. The examiner addressed applicant's remarks and the examiner made the restriction requirement FINAL. The claims were rejected under 35 USC 112, 2nd paragraph; and under 35 USC 102(b), 102(e) and 103.

On September 12, 2006, applicants filed a response to the outstanding Office action.

On December 22, 2006, the examiner mailed a FINAL rejection of Claims 1-9. The claims were again rejected under 112, 2nd paragraph; and under 102(b), 102(e) and 103.

On May 2, 2007, applicants filed a request for continued examination and amended the claims.

On August 8, 2007, the examiner rejected pending Claims 1, 3-10 on new grounds of Written Description, 112 2nd paragraph and 35 USC 102.

On November 8, 2007, the applicant filed a response and amendments to the claims.

On January 24, 2008, the examiner mailed a FINAL rejection of Claims 1, 3-10. The claims were again rejected under 112, 2nd paragraph; and under 102(b), 102(e) and 103.

On February 15, 2008, applicant filed an after final amendment.

On March 14, 2008, the examiner mailed an advisory action indicating the proposed amendments would be entered however; certain rejections had not been overcome.

On April 24, 2008, applicant filed a second request for continued examination and this petition to request that the Office reconsider the restriction requirement.

**DISCUSSION**

The petition and extensive file history have been carefully considered.

The petition requests withdrawal of the restriction requirement to elect a single EGFR oligonucleotide sequence and cites MPEP 803.04.

Consideration of MPEP 803.04 in view of the March 27, 2007 OG Notice.

The petition asserts that the examination is inconsistent with Manual of Patent Examining Procedure (MPEP) 803.04. The petition states that the restriction improperly limited election to only one nucleotide sequence, instead of 10 nucleotide sequences and limited examination to only the one elected sequence together with only two patentably indistinct sequences instead of all antisense oligonucleotides corresponding to a single gene encoding a single protein. The petition cites MPEP 803.04 directed to the 1996 OG Notice, which granted a partial waiver for independent and distinct inventions. This argument has been reviewed but is not convincing.

An OG Notice published March 27, 2007 rescinded the 1996 OG Notice that provided for a partial waiver of the requirements for restriction practice by permitting examination of a reasonable number, up to ten, independent and distinct polynucleotide molecules in a single 35 USC 111(a) or 35 USC 371 application. The Notice indicated that the standard of independence and distinctness would be applied to polynucleotide claims filed in an application under 35 USC 111(a).

Additionally, the March 27, 2007 OG Notice specifically spoke to the issue of burden of searching more than one independent and distinct invention.

The petition asserts that SEQ ID NO: 1-23 must be examined together the invention is directed to four (4) specific regions of the EGFR mRNA which are useful for antisense therapy. The petition asserts there is overlap in the regions and overlap in the sequence themselves. The response asserts that SEQ ID NO: 23 has been searched and is patentable over the cited art. The response then suggests there is no undue burden to search SEQ ID NO:s 5-7 and 11-14 which fall in the same region of EGFR as SEQ ID NO: 23.

This argument has been reviewed but does not appear to be supported by the evidence in the specification. As depicted in the table below and in the specification, pages 13-17, each of the sequences of SEQ ID NO: 5-7 and 11-14 do not appear to overlap as suggested by the petition.

| SEQ ID NO: | Complementary Region | Antisense Sequence |
|---|---|---|
| 23 | (HIV) | UGCTAGGTTTCCTCCCUUUC |
| 5 | 2428-2447 | GTCCACTCTTGTCCTCAATG |
| 6 | 2996-3015 | TCCAACACTTGACCATCACC |
| 7 | 3182-3201 | CTGGCTCCAGCTCTACTTCC |
| 11 | 2407-2426 | ACTTTAATGCAGACTGGAAT |
| 12 | 2417-2436 | GTCCTCAATGACTTTAATGC |
| 13 | 2444-2463 | AGCTTGAAAACTCTGCCGTC |
| 14 | 2457-2476 | TATGATCTGTCACAGCTTGA |

The arrangement of the fragments of SEQ ID No 5-7 and 11-14 along the EGFR sequence, depicted below, shows that these fragments are not co-extensive with each other. The petition does not indicate where on the EGFR sequence that SEQ ID NO: 23 is presented.

2407-2426
2417-2436
2428-2447
2444-2463
2457-2476
2996-3015
3182-3201

The petition then asserts it would be even less of a burden to search the remaining 15 sequences which fall in the 3 other claimed regions. This argument is confusing. It is unclear why there would be less burden to examine sequences outside of a particular region. The search required would not overlap and would not be coextensive with the search previously performed which would suggest an undue burden of search.

As provided by 37 CFR 1.141, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim. However no generic claim is allowable at this time and the claims to the elected species are rejected under 35 USC 112, 2nd paragraph; and under 35 USC 102(b), 102(e) and 103.

Thus, for the reasons provided above, the requirement to the elected sequence, SEQ ID NO: 23 has been affirmed.

**DECISION**

The petition is **DENIED** for the reasons set forth above.

Claims 11-18 and SEQ ID Nos 1-22 remain withdrawn from consideration.

The application will be forwarded to the examiner for consideration of the papers filed 4/24/08 and preparation of an Office action consistent with this decision.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

John LeGuyader
Director, Technology Center 1600
jb/jg

OIPE JC99
MAR 1 2 2004
PATENT & TRADEMARK OFFICE

PATENT

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David Muhs et al. Examiner: Lee S. Lum

Serial No.: 10/140,231 Group Art Unit: 3611

Filed: May 7, 2002

For: TRAILER AND FUEL TANK ASSEMBLY

Docket No.: 1059.1104102

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GROUP 3600

## TRANSMITTAL SHEET

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By: _____
Brian N. Tufte

We are transmitting herewith the attached:

[X] Supplemental Information Disclosure Statement, Form PTO-1449 and 22 cited references.

[X] Certification for Information Disclosure Statement

[X] Please charge any deficiencies or credit any overpayment in the enclosed fees to Deposit Account No. 50-0413.

Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349

16-0 OIPE JC99 MAR 1 2 2004 PATENT & TRADEMARK OFFICE

3611 #13 Pet to W/D abd DW

PATENT

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant: | David Muhs et al. | Examiner: | Lee S. Lum |
| Serial No.: | 10/140,231 | Group Art Unit: | 3611 |
| Filed: | May 7, 2002 | Confirmation No.: | 8095 |
| For: | TRAILER AND FUEL TANK ASSEMBLY | | |
| Docket No.: | 1059.1104102 | | |

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By: _____
Brian N. Tufte

We are transmitting herewith the attached:

[X] Request For Reconsideration - Notice of Abandonment

[X] Copies of the return postcard with the USPTO stamp indicating receipt of amendment on July 7, 2003, Transmittal, Amendment in response to office action of April 4, 2003

[X] Copy of previously submitted Information Disclosure Statement filed on October 27, 2003 and received by the USPTO on October 29, 2003

[X] Please charge any deficiencies or credit any overpayment in the enclosed fees to Deposit Account No. 50-0413.

Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | | |
|---|---|---|---|
| Applicant: | David Muhs et al. | Examiner: Lum, Lee S. | |
| Serial No.: | 10/140,231 | Group Art Unit: 3611 | |
| Filed: | May 7, 2002 | Confirmation No.: 8095 | |
| For: | TRAILER AND FUEL TANK ASSEMBLY | | |
| Docket No.: | 1059.1104102 | | |

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**REQUEST FOR RECONSIDERATION - NOTICE OF ABANDONMENT**

Mail Stop Non-Fee Amendment
Assistant Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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By: _____
Brian N. Tufte

Dear Sir:

This Request for Reconsideration is being filed in response to the Notice of Abandonment mailed February 2, 2004. In the Notice of Abandonment, the Examiner indicates that the above-referenced application has been abandoned because Applicants failed to file a timely reply in response to the Office Letter mailed on April 4, 2003.

After reviewing the file, Applicants did file an "AMENDMENT" in response to the Office Action dated April 4, 2003. This Amendment was filed under Rule 1.8 on July 1, 2003, which is within the three month shortened statutory period for response. Enclosed herewith is a copy of: (1) the return post card with the USPTO stamp indicating

that the Patent Office did received the AMENDMENT on July 7, 2003; (2) the transmittal sheet that accompanied the AMENDMENT; and (3) the AMENDMENT itself. As can be seen, Applicants did file a timely reply to the Office Letter mailed on April 4, 2003.

In addition, and in the Notice of Abandonment, the Examiner makes reference to the Request for Refund filed on July 1, 2003. However, the Examiner did not make reference to the Supplemental IDS that was filed on October 27, 2003. In the event that the Examiner does not have a copy of the Supplemental IDS, enclosed herewith is a copy of the Supplemental IDS for consideration by the Examiner.

In view of the foregoing, it is clear that no abandonment in fact occurred. Thus, Applicants respectfully request reconsideration of the holding of abandonment. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the undersigned attorney at (612) 573-2002.

Respectfully submitted,

David Muhs et al.

By their attorney,

Dated: March 9, 2004

Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349

#14
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OFFICE OF THE DIRECTOR
TC 3600

Crompton, Seager & Tufte, LLC
1221 Nicollet Avenue
Suite 800
Minneapolis, MN 55403-2420

In re Application of
David Muhs et al
Application No. 10/140,231
Filed: May 7, 2002
For: TRAILER AND FUEL TANK ASSEMBLY

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is a decision on applicants' petition to withdrawal the holding of abandonment filed on March 12, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☒ Postcard receipt being dated July 7, 2003.

☐ USPTO return facsimile receipt dated _____, which references the application by serial number and the amendment that was filed on that date.

☐ Certificate of Mailing/Transmission signed on _____. and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

KENNETH J. DORNER
~~SPECIAL PROGRAMS EXAMINER~~
TECHNOLOGY CENTER 3600

KJD/vdb: 5/25/04

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| | | |
|---|---|---|
| In re Application of | : | |
| Muhs, et al. | : | |
| Application No. 10/140,231 | : | DECISION ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. 1059.1104102 | : | |

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed October 26, 2006.

The petition is **GRANTED**.

The above-identified application was held abandoned for failure to timely file a proper response to the final Office action mailed August 25, 2005. This Office action set a shortened statutory period for reply of three (3) months. The Office mailed a Notice of Abandonment on October 10, 2006.

A review of the application file reveals the presence of an Notice of Appeal together with the appropriate fee, filed February 24, 2006, made timely by obtaining a three month extension of time. In addition, the application file also contains a Pre-Appeal Brief Request for Review. Accordingly, it is obvious that the Notice of Abandonment was mailed in error.

In view thereof, **the holding of abandonment is withdrawn**.

The Notice of Abandonment is hereby **VACATED**.

The matter is being forwarded to Group Art Unit 3611 for review of the Notice of Appeal and Pre-Appeal Brief Request for Review, both filed on February 24, 2006.

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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**ARMSTRONG WORLD INDUSTRIES, INC.**
**2500 COLUMBIA AVENUE**
**P.O. BOX 3001**
**LANCASTER PA 17604-3001**

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| | | |
|---|---|---|
| In re Application of | : | |
| Lenox et al | : | |
| Application No. 10/140,241 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. A148 1750.1 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 24, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed April 22, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on July 23, 2004.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Patent Publication.

Karen Creasy

Karen Creasy
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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**A PROFESSIONAL LAW CORPORATION**
**SUITE 38-E**
**17961 SKY PARK CIRCLE**
**IRVINE, CA 92614-6364**

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AUG 2 5 2005

**OFFICE OF PETITIONS**

In re Application of :
Mark Robert Jacoby :
Application No. 10/140,277 :
Filed: May 6, 2002 :
Attorney Docket No. JACOBY-1 :

DECISION ON PETITION
37 CFR 1.137(b)

This is a decision on the petition under 37 CFR §1.137(b), filed November 26, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due mailed October 29, 2003, which set a non-extendable statutory period for reply of three (3) months. On the same date, a Notice of Allowability was mailed which set a non-extendable statutory period for reply of three (3) months and required formal drawings. Accordingly, the application became abandoned on January 30, 2004. A Notice of Abandonment was mailed on March 1, 2004 to the above address of record.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR §1.137(b) in that (1) the required reply including the issue fee ($685) and publication fee ($300) at the time of filing the petition and formal drawings; (2) the petition fee of $685.00 (for a small entity) at the time of filing the petition; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed October 29, 2003 is accepted as having been unintentionally delayed. A copy of the PTO-948 Draftsman Review Form approving the drawings submitted November 26, 2004 is attached.

This matter is being referred to the Office of Patent Publication to be processed into a patent.

Telephone inquiries concerning this decision should be directed to Angela Ortiz at (571) 272-6051, or in her absence, the undersigned at (571) 272-3217.

Frances Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions
Attachment: PTO-948 Draftsman Review Form

OIPE JC19
NOV 2 6 2004
PATENT & TRADEMARK OFFICE

DAC #7

PTO/SB/64 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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# PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional) JACOBY-1

First named inventor: Mark Robert Jacoby

Application No.: 10/140,277 Art Unit: 3711

Filed: May 6, 2002 Examiner: Stephen Luther Blau

Title: ADJUSTABLE SHAFT-EXTENSION APPARATUS FOR GOLF CLUB PUTTERS

Attention: Office of Petitions
**Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☑ Small entity-fee $ 685 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ 985.

☐ has been paid previously on _____.
☑ is enclosed herewith.

RECEIVED
DEC 0 1 2004
OFFICE OF PETITIONS



This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

08/25/2005 AKELLEY 00000007 060930 10140277

01 FC:2453 685.00 DA
02 FC:2501 685.00 DA
03 FC:8001 30.00 DA
04 FC:1504 300.00 DA

Mail to Palm Location 7580, Certificates of Correction
South Tower - 9A22

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.:** 7

**DATE** : February 06, 2007

**TO SPE OF** : ART UNIT 1642

10/140293

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7115556 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Mail To:

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance**

Elisha Evans
**Certificates of Correction Branch**
***Tel. No. 703-**308-9390 EXT 110*

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:**
Examiner's Amendment dated 7/17/2006 does not appear to have been entered.

(SPE)
**SPE**

1642
**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

**Terry M. Gernstein**
**1015 Salt Meadow Lane**
**McLean VA 22101**

MAILED

JUL 06 2010
OFFICE OF PETITIONS

In re Patent No. 6,955,171 :
Issue Date: October 18, 2005 :
Application No. 10/140,304 :
Filed: May 7, 2002 :
Attorney Docket No. :

ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed March 31, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on October 19, 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.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

The patent file is being forwarded to Files Repository.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Doug Hole
10835- 120 Street Edmonton
Alberta, Canada T5H 3P9

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) |
|---|---|---|---|---|
| 6,921,338 | 2005-07-26 | 10/140,306 | 2002-05-07 | 01-016 |

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 | /Jennifer M Brumbaugh/ | Date (YYYY-MM-DD) | 2010-01-12 |
| Name | Jennifer M. Brumbaugh | Registration Number | 48465 |

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
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www.uspto.gov

In re Patent No. 6921338
Issue Date: July 26,2005
Application No. 10140306
Filed: May 7,2002
Attorney Docket No. GKNG 1100 PUS

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 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 January 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

**Sawyer Law Group, PC**
**2465 E. Bayshore Road, Suite No. 406**
**Palo Alto, CA 94303**

| | | |
|---|---|---|
| In re Application of | : | |
| Vinay Bannai et al. | : | |
| Application No. 10/140,308 | : | DECISION ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. M12769US/2674P | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 5, 2009, to revive the above-identified application.

The petition is **GRANTED**

The application became abandoned for failure to file a proper reply in a timely manner to the non-final Office action mailed December 17, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 18, 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 after non-final, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

This application is being referred to Technology Center AU 2416 for appropriate action by the Examiner in the normal course of business on the reply received August 5, 2009.

Carl Friedman
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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TOWNSEND AND TOWNSEND AND CREW LLP/ 015114
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

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MAR 17 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Lin, et al. | : | |
| Application No. 10/140,312 | : | ON PETITION |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 15114-093200US | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed February 28, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee and publication fee, if applicable, on or before January 20, 2006. Accordingly, this application became abandoned on January 21, 2006.

This application is being forwarded to Publishing Division for processing into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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AUG 2 8 2006

**OFFICE OF PETITIONS**

ON PETITION

| | | |
|---|---|---|
| In re Application of | : | |
| Lin, et al. | : | |
| Application No. 10/140,312 | : | |
| Filed: May 6, 2002 | : | |
| Attorney Docket No. 15114-093200US | : | |

This is in response to "Petition For Refund of Petition Fees," filed June 5, 2006, requesting the petition fee of $1,500.00 that accompanied the petition under 37 CFR 1.137(b), filed February 28, 2006, be refunded.

This application became abandoned for failure to timely pay the issue fee and publication fee, if applicable, on or before January 20, 2006. Accordingly, this application became abandoned on January 21, 2006. A petition under 37 CFR 1.137(b) was filed on February 28, 2006, requesting the revival of the unintentionally abandoned application. The petition to revive under 37 CFR 1.137(b) was granted on March 17, 2006. Petitioner now requests the refund of the $1,500.00 petition fee, submitted February 28, 2005.

Petitioner states:

> "Applicant filed a petition to revive the application on February 28, 2006, submitting along with the petition the fee of $1,500.00. (see attached Exhibit E). Since Applicant did not receive the NOA until after the issue fee due date had past, Applicant could not have made timely payment of the issue fee. Accordingly, as the abandonment of the application was through no fault of the Applicant, Applicant believes it is entitled to a refund of the petition fee of $ 1,500.00."

Petitioner now appears to contest the holding of abandonment. However, petitioner had the opportunity to contest the holding of abandonment previously, by the filing of a petition under 37 CFR 1.181, to withdraw the holding of abandonment. Such a petition does not require the submission of a fee. However, petitioner voluntarily chose to file a petition under 37 CFR 1.137(b), requesting the revival of the unintentionally abandoned application. It is noted that the petition under 37 CFR 1.137(b), filed February 28, 2006, is signed by C. Bart Sullivan, a registered practitioner, who thereby acknowledged the statement required under 37 CFR 1.137(b)(3) 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. Furthermore, the $1,500.00 petition fee was required under 37 CFR 1.137(b)(2). Therefore, the petition to revive, filed February 28, 2005, was properly reviewed, decided and granted according to the requirements of 37 CFR 1.137(b). As such, a refund of the $1,500.00 petition fee is not appropriate.

Accordingly, the petition is dismissed.

The application will be returned to Publishing Division.

Telephone inquiries should 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

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**KEATING & BENNETT, LLP**
**10400 EATON PLACE**
**SUITE 312**
**FAIRFAX, VA 22030**

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APR 25 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,667,073 | : | |
| Issued : December 23, 2003 | : | |
| Application No. 10/140,318 | : | DECISION GRANTING PETITION |
| Filed: May 7, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 50626.28 | : | |

This is a decision on the petition, filed November 18, 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 July 15, 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.

This application matured into Patent No. 6,667,073 on December 23, 2003. Therefore, no further action is required.

Telephone inquiries concerning this decision should 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
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**ROBERT W STROZIER, P.L.L.C**
**P.O. BOX 429**
**BELLAIRE, TX 77402-0429**

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APR 21 2005

OFFICE OF PETITIONS

In re Application of
Robert A. MARTIN
Application No. 10/140,358
Filed: May 6, 2002
Attorney Docket No. 95897/01C2

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed October 4, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 2, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 3, 2004. A Notice of Abandonment was mailed on August 25, 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 election; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Although the petition indicates that the reply of formal drawings and an issue fee were enclosed, these items were not filed with the petition and the appropriate reply in the form of an election was filed. Accordingly, the reply to the non-final Office action of December 2, 2003 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Betsy Deppe at (571) 272-6052 or in her absence, the undersigned at (571) 272-3217.

This matter is being referred to Technology Center AU 2841 for appropriate action on the concurrently filed reply.

Frances Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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**WILSON & HAM**
**2530 BERRYESSA ROAD**
**PMB 348**
**SAN JOSE, CA 95132**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Thirumalpathy Balakrishnan et al | : | |
| Application No. 10/140,395 | : | DECISION ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. RSTN-016 | : | |

This is a decision on the petition, filed January 19, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the non-final Office action mailed June 26, 2006, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on January 30, 2007, subsequent to the filing of the present petition.

Petitioner asserts that the Office action dated June 26, 2006 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the non-received Office action would have been entered had it been received must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 2193 for re-mailing the Office action of June 26, 2006. The period for reply will run from the mailing date of the Office action.

Frances Hicks
Petitions Examiner
Office of Petitions

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Commissioner for Patents
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Alexandria, VA 22313-1450
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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Corum et al. :
Application No. 10/140,407 :
Filed: May 6, 2002 :
Attorney Docket Number: TI-33379 (032350.

This is a decision on the petition under 37 CFR 1.137(b), filed December 20, 2004, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply to the non-final Office Action of June 17, 2004. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on September 18, 2004. This decision precedes the mailing of a Notice of Abandonment.

This Petition is hereby **Granted**.

Pursuant to petitioner's request deposit account No. 20-0668 will be charged the $1500 unintentional petition to revive fee.

The office hereby acknowledges the receipt of the Amendment submitted with the instant petition.

This application is being forwarded to Technology Center 2800 for further processing.

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Sabin Harris
PO Box 4441
Utica, NY 13505

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**OFFICE OF PETITIONS**

In re Application of Harris :
Application No.10/140,409 :
Filing Date: May 9, 2002 :
For: Weather Lottery Game :

Decision on Petition

This is a decision on the petition filed November 9, 2006, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition is **dismissed.**

A non-final Office action was mailed August 19, 2004.

A reply was filed September 21, 2004.

An Office action was mailed February 24, 2005. The Office action stated the prior reply was not fully responsive and gave petitioner an extendable time period on one month or thirty days, whichever is longer, to file a fully responsive reply.

A reply was filed March 10, 2005.

On June 15, 2005, the Office mailed a Notice titled, "Failure to Acceptably Respond to Notice of Non-Compliant Amendment (37 CFR 1.121) *No New Time Period for Reply is Provided.*" The Notice stated the application would become abandoned unless petitioner corrected the deficiency and obtained a proper extension of time.

A reply was filed June 24, 2005. However, the reply was not accompanied by payment for an extension of time. Therefore, a timely and proper reply was not filed in response to the Office action mailed February 24, 2005, and the application became abandoned as of midnight on March 24, 2005. The fact the Technology Center may have failed to recognize the application was abandoned does not alter the fact the application was abandoned as a matter of law.

Even if the application had not become abandoned during March of 2005, the application would currently be abandoned for reasons that follow.

An Office action was mailed September 22, 2005. The Office action stated the prior reply was not fully responsive and gave petitioner an extendable time period on one month or thirty days, whichever is longer, to file a fully responsive reply.

A reply was filed October 21, 2005.

An Office action was mailed December 22, 2005. The Office action stated the prior reply was not fully responsive and gave petitioner an extendable time period on one month or thirty days, whichever is longer, to file a fully responsive reply.

A reply was filed January 20, 2006.

As shown by an Office action mailed July 26, 2006, the examiner determined the reply was not fully responsive. The examiner determined a new time period for reply should not be set.

The Office action mailed July 26, 2006, stated, with emphasis added,

> Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency **and obtains an extension of time** under 37 CFR 1.136(a).

Despite language in the July 26, 2006, petitioner could not obtain an extension of time as of July 26, 2006, because more than 6 months had expired since the prior Office action had been mailed on December 22, 2005.

Petitioner filed a reply on August 3, 2006. Petitioner does not contend petitioner obtained an extension of time. Therefore, the reply filed August 3, 2006, clearly would not have prevented the application from becoming abandoned.

For the reasons above, even if the application had not become abandoned as of midnight on March 24, 2005, the application would have become abandoned as of midnight on January 23, 2006.

The instant petition must be dismissed because petitioner has failed to prove the application is not abandoned.

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 CFR 1.137(b) must be accompanied by the required reply (a fully responsive reply to prior Office actions), the required petition fee ($750 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Attached: Form PTO/SB/64

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OFFICE OF PETITIONS

3D Systems, Inc.
26081 Avenue Hall
Valencia, CA 91355

In re Application of
Sherwood
Application No. 10/140,426
Filed: May 7, 2002
Attorney Docket No.: USA.314
For: FLASH CURING IN SELECTIVE DEPOSITION MODELING

DECISION GRANTING STATUS UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed July 24, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Michael Thomas Sherwood 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(b). This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 10

JOSEPH F. POSILLICO
SYNNESVEDT & LECHNER LLP
2600 ARAMARK TOWER
1101 MARKET STREET
PHILADELPHIA, PA 19107-2950

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OFFICE OF PETITIONS

In re Application of
Hacker
Application No. 10/140,429
Filed: May 6, 2002
Attorney Docket No. P-24,926 A USA

ON PETITION

This decision concerns the December 3, 2003 petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

## Background

The application, upon filing, lacked the application basic filing fee and a properly signed oath or declaration.

On June 3, 2002, a "Notice to File Missing Parts of Nonprovisional Application" ("6/3/02 Notice") was mailed, setting forth an extendable 2-month period for submitting the missing items. In other words, Applicant had until January 3, 2003 to submit the missing items, provided that the appropriate extension of time (up to 5 months) under 37 CFR 1.136(a) was obtained.[1]

The instant petition encloses: a declaration signed by the inventor; the $130 surcharge for late filing of a proper oath/declaration; and the $740 basic filing fee for the application. Since these items were filed during the 6th month after the mailing of the 6/3/02 Notice, the filing of these items would have been timely if accompanied by a 4-month extension of time ($1,480).

The $1,330 payment enclosed with the petition and intended for paying the petition fee for a §1.137(b) petition is not sufficient for covering the 4-month extension-of-time fee. Unfortunately, while the December 3, 2003 Amendment Transmittal Letter authorizes the USPTO to charge "any additional filing fees required under 37 CFR 1.16," no such authorization is included with respect to the $150 deficiency in the extension-of-time fee required by 37 CFR 1.17(a)(4).

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[1] See MPEP 710.02(d) (Rev. 1, Feb. 2003) (The 2-month time period for reply to a Notice of Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions of time of up to 5 months . . . are permitted.).

Moreover, the Office is unable to locate any "constructive petition" in the application file for the requisite extension of time.[2] Given that the December 3, 2003 submission does not include sufficient payment to be construed as the extension-of-time fee, the application became abandoned on August 4, 2003.

**Petition under 37 CFR 1.137(b)**

A grantable petition under 37 CFR 1.137(b), in the instant case, must be accompanied by: (1) the basic filing fee; a proper oath or declaration and the surcharge for late filing of such an oath/declaration; (2) the petition fee; and (3) a statement that the entire delay in filing these items from the due date until the filing of a grantable §1.137(b) petition was unintentional.

The instant petition meets the above requirements and is thus granted. The application is now complete.

Finally, receipt with the petition of a preliminary amendment is acknowledged.

The file is being forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

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[2] 37 CFR 1.136(a)(3).

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005-3096

| | | |
|---|---|---|
| In re application of | : | **DECISION ON PETITION** |
| James Weidner et al. | : | **TO MAKE SPECIAL** |
| Application No. 10/140,434 | : | **(ACCELERATED** |
| Filed: May 8, 2002 | : | **EXAMINATION)** |
| For: PROPERTY/CASUALTY INSURANCE AND TECHNIQUES | : | |

This is in response to the petition filed on September 9, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

**SUMMARY**: Petition to Make Special **GRANTED**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/vdb: 7/27/04

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 8

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1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2401

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APR 1 6 2003

OFFICE OF PETITIONS

In re Application of
David E. Kimmel et al
Application No. 10/140,439
Filed: May 8, 2002
Attorney Docket No. 027970.102-US00

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 31, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/387,496, filed September 1, 1999, set forth in the data sheet filed March 31, 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

[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).

> 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 May 8, 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 application data sheet, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

*The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date*.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 2131 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 09/387,496, filed September 1, 1999.

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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GOODWIN PROCTER LLP
135 COMMONWEALTH DRIVE
MENLO PARK CA 94025

| | | |
|---|---|---|
| In re Patent No. 7,521,539 | : | |
| Goddard, et al. | : | DECISION DISMISSING |
| Application No. 10/140,470 | : | REQUEST FOR |
| Issue Date: April 21, 2009 | : | RECONSIDERATION OF |
| Filed: May 6, 2002 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. GNE-3330.160US | : | UNDER 37 CFR 1.705 |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b), filed June 16, 2009. The petition is properly treated under 37 CFR 1.705(d).

Patentee requests that the determination of patent term adjustment be corrected from five hundred forty-seven (547) days to nine hundred one (901) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 547 days.

**BACKGROUND**

This application was filed on May 6, 2002. On April 25, 2006, a request for continued examination (RCE) was filed. On April 21, 2009, the application matured into U.S. Patent No. 7,521,539, with a revised patent term adjustment of 547 days. The Office determined that the 354 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b),[1] overlaps with the 725 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37

[1] As of the filing of the RCE on April 25, 2006, the application was pending three years and 354 days.

CFR 1.702(a)(1)[2,3] accorded prior to the filing of the request for continued examination. As such, the Office allowed only entry of the adjustment of 725 days for Office delay. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of 178 days, the patent issued with a revised patent term adjustment of 547 (725 - 178) days.

On June 16, 2009, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 901 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 1079 (725 + 354) days as these periods do not occur on the same day. Further, given the applicant delay of 178 days, patentee asserts entitlement to 901 (1079 - 178) days of patent term adjustment.

**OPINION**

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

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[2] 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

> (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
> (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

[3] A first Office action was not mailed until June 30, 2005, fourteen months and 725 days after the application filing date, May 6, 2002.

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[4] *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. 54366 (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*

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[4] 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.

*Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), May 6, 2002, and ending on the date of filing of a request for continued examination (RCE), April 25, 2006 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 725 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. There were no Office delays subsequent to the filing of the request for continued examination. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 354 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the filing date of the application.

All of the 354 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 725 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 725 days and the 354 days is neither permitted nor warranted. 725 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

**CONCLUSION**

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 547 days.

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 50-4634 as authorized. This fee is required and will not be waived.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Technology Center 2100

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Paper No. 5

Josephine Young
JONES & ASKEW
191 Peachtree Street, N.E.
37th Floor
Atlanta, GA 30303-1769

| | |
|---|---|
| In re Application of:<br>Bret David Ahlstrom<br>Application No.: 10/140,521<br>Filed: May 7, 2002<br>For: A METHOD FOR DISPLAYING EDITABLE CHARACTERS IN A DIVIDED TABLE CELL | DECISION ON REQUEST TO WITHDRAW AS ATTORNEY |

This is a decision on the Request to Withdraw from Representation filed September 4, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agnet.

The singer of the petition, Josephine Young is not appointed as an attorney or agent of record. Therefor he is not authorized to act on behalf of the attorneys or record, nor can he effect a change of address.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

All future communications from the Office will be directed to the above-listed address until otherwise notified by applicant.

James R. Matthews

JM

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED
OCT 0 4 2006
OFFICE OF PETITIONS

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

| | | |
|---|---|---|
| In re Application of | : | |
| Meens | : | |
| Application No. 10/140,524 | : | DECISION ON PETITION |
| Filed: May 7, 2002 | : | TO WITHDRAW |
| Attorney Docket No. ARSI-008 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 26, 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 Carol M. LaSalle 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). The power of attorney filed on September 22, 2006 does not include a proper chain of title. The notice regarding the Power of Attorney mailed September 26, 2006 is hereby **VACATED**.

Telephone inquiries concerning this decision should be directed to April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: HENDRIK JOZEF MARIA MEENS
NIEUWENBROEK 8, NL-6002 WH WEERT
THE NEVERLANDS

cc: David W. Laub, Esq.
Proskauer Rose, LLP
1001 Pennsylvania Avenue, NW
Suite 400 South
Washington, DC 20004-2533

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 |
|---|---|---|---|
| 10/140,524 | 05/07/2002 | Hendrik Jozef Maria Meens | AS-Meens |

**CONFIRMATION NO. 6362**

*OC000000020655537*

*OC000000020655537*

24353
BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

Date Mailed: 10/02/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/26/2006.

- 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.

---

April M Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

COPY OF PAPERS ORIGINALLY FILED

03 CO

Attorney's Docket No.: 4860.P2437C

OIPE JC2 AUG 13 2002 PATENT & TRADEMARK OFFICE

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| In re Application of: | Examiner: Not Yet Assigned |
| Cornelius et al. | Art Unit: 2827 |
| Application No.: 10/140,529 | |
| Filed: May 6, 2002 | |
| For: DEPOPULATION OF A BALL GRID ARRAY TO ALLOW VIA PLACEMENT | |

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

on August 5, 2002
Date of Deposit

Deborah A. McGovern
Name of Person Mailing Correspondence

DMcGovern 8-5-02
Signature Date

Assistant Commissioner for Patents
Customer Service Center
Initial Patent Examination Division
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS
(FILING DATE GRANTED)

Sir:

In response to the Notice to File Corrected Application Papers (Filing Date Granted) mailed June 7, 2002, please find enclosed:

(1) substitute drawings in compliance with 37 C.F.R. § 1.84; and

(2) a copy of the Notice to File Corrected Application Papers;

If any additional fee is required, please charge Deposit Account No. 02-2666. A duplicate of this Response is enclosed for deposit account charging purposes.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 8/5/2002

Kevin G. Shao
Reg. No. 45,095

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

AUG 1 3 2002

COPY OF PAPERS ORIGINALLY FILED

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/140,529 | 05/06/2002 | William P. Cornelius | 4860.P2437C |

**CONFIRMATION NO. 6855**

**FORMALITIES LETTER**

*OC000000008251440*

James C. Scheller, Jr.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

Date Mailed: 06/07/2002

## NOTICE TO FILE CORRECTED APPLICATION PAPERS

### *Filing Date Granted*

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given **TWO MONTHS** from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a)

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
  - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. ( 5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

***A copy of this notice MUST be returned with the reply.***

M. Marmol

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

COPY OF PAPERS ORIGINALLY FILED

| Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533)(Large Entity) | Docket No. PB0120 |
|---|---|

In Re Application Of: **H. Samartzidou, et al.**

| Serial No. | Filing Date | Examiner | Group Art Unit |
|---|---|---|---|
| **10/140,545** | **May 7, 2002** | **To be assigned** | **1645** |

Invention:

**Design of Artificial Genes for Use as Controls in Gene Expression Analysis Systems**

OIPE JC10 JUL 2 2 2002 PATENT & TRADEMARK OFFICE

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

This is a response to the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533) mailed on **June 25, 2002**
*Date*

Enclosed herewith for filing are the following:

☒ A copy of the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533) (REQUIRED)

☐ An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date.

☒ A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date.

☐ An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date.

☐ A verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the United States Patent and Trademark Office.

☒ Other (list):

**copy of this transmittal letter for charging purposes**
**return postcard**



P31LARGE/REV03

| Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533)(Large Entity) | Docket No. PB0120 |
|---|---|

In Re Application Of: **H. Samartzidou, et al.**

| Serial No. | Filing Date | Examiner | Group Art Unit |
|---|---|---|---|
| **10/140,545** | **May 7, 2002** | **To be assigned** | **1645** |

Invention:

**Design of Artificial Genes for Use as Controls in Gene Expression Analysis Systems**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

☒ Completion of application fees as calculated below:

| | |
|---|---|
| ☐ Utility application filing fee | |
| ☐ Design application filing fee | |
| ☐ Total number of independent claims = _____ | |
| ☐ Total number of claims = _____ | |
| ☐ Multiple dependent claims | |
| ☒ Surcharge for late payment of filing fee and/or late filing of original declaration or oath | **$130.00** |
| ☐ Petition and fee for filing by other than all the inventors or a person not the inventor | |
| ☐ Fee for processing an application filed with a non-English language specification | |
| ☐ Fee for processing and retention of application | |
| Total completion of application fees | **$130.00** |

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the above-identified Notice to File Missing Parts of Application. The requested extension is as follows (check time period desired). If an additional time extension is required, please consider this a petition therefor.

☐ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

from: _____ *Date* until: _____ *Date*

| | |
|---|---|
| Total time extension fees | **$0.00** |
| Total fees due | **$130.00** |



P31LARGE/REV02

| Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533) (Large Entity) | Docket No. PB0120 |
|---|---|

In Re Application Of: **H. Samartzidou, et al.**

| Serial No. | Filing Date | Examiner | Group Art Unit |
|---|---|---|---|
| **10/140,545** | **May 7, 2002** | **To be assigned** | **1645** |

Invention:

**Design of Artificial Genes for Use as Controls in Gene Expression Analysis Systems**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

The fee of **$130.00** is to be paid as follows:

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **500-588**
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **500-588**

A duplicate copy of this sheet is enclosed.

*Signature* Dated: **July 17, 2002**

**Royal N. Ronning, Jr.**
**Amersham Biosciences Corp**
**800 Centennial Avenue**
**Piscataway, New Jersey 08855**

**(732) 457-8423**
**Reg. No.: 32,529**

I certify that this document and fee is being deposited on **July 17, 2002** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

*Signature of Person Mailing Correspondence*

**Melissa Leck**

*Typed or Printed Name of Person Mailing Correspondence*

cc:

#4

COPY OF PAPERS ORIGINALLY FILED

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/140,545 | 05/07/2002 | Hrissi Samartzidou | PB0120 |

Amersham Biosciences Corp.
800 Centennial Avenue
Piscataway, NJ 08855

OIPE JC10 JUL 22 2002 PATENT & TRADEMARK OFFICE

**CONFIRMATION NO. 6547**
**FORMALITIES LETTER**
*OC000000008349001*

Date Mailed: 06/25/2002

# NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

**FILED UNDER 37 CFR 1.53(b)**

***Filing Date Granted***

**Items Required To Avoid Abandonment:**

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.

**Items Required To Avoid Processing Delays:**

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

**SUMMARY OF FEES DUE:**

Total additional fee(s) required for this application is **$130** for a Large Entity

- **$130** Late oath or declaration Surcharge.

07/24/2002 BNGUYEN1 00000031 500588 10140545

01 FC:105 130.00 CH

RECEIVED JUL - 1 2002 ROYAL N. RONNING, JR.

*A copy of this notice MUST be returned with the reply.*

M. Manual

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

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Docket Clerk
P.O. Box 800889
Dallas, TX 75380

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JAN 23 2006

OFFICE OF PETITIONS

In re Application of

Veerasamy, et al.

Application No. 10/140,559

Filed: May 7, 2002

Attorney Docket No. SAMS01-00192

DECISION ON PETITION

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed on December 19, 2005.

The petition is **granted**.

This application was held abandoned on August 27, 2005, after no reply was received to the final Office action mailed May 27, 2005. The notices set forth a shortened statutory period for reply of three months from its mailing date. A Notice of Abandonment was mailed October 17, 2005. The instant petition was filed on December 19, 2005. Petitioner maintains that the final Office action was never received and provides a copy of the relevant docket records as proof of the same.

Section 711.03(c)(II) of the *Manual of Patent Examining Procedure* ("MPEP") provides that in order to establish non-receipt of an Office action so as prove that the imposition of a holding of abandonment is improper, petitioner must: 1) provide a statement to the Office indicating that the Office action was not received by petitioner; 2) include in the statement an attestation to the fact that a review of the file jacket and docket records maintained by petitioner indicates that the Office action was not received; and 3) provide a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

Petitioner has met the burden of proof as established by Section 711.03(c)(II) of the MPEP. The holding of abandonment is, therefore, withdrawn.

The application file is being forwarded to Technology Center 2600, GAU 2681 for resetting of the time period for responding to the Notice of Allowance and Issue Fee Due and Notice of Allowability.

Questions concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MYERS DAWES ANDRAS & SHERMAN, LLP**
**19900 MACARTHUR BLVD., SUITE 1150**
**IRVINE CA 92612**

COPY MAILED

JAN 0 5 2007

OFFICE OF PETITIONS

In re Application of :
**FLORES** :
Application No. 10/140,585 : DECISION ON PETITION
Filed: May 7, 2002 : TO WITHDRAW
Attorney Docket No. STR1.PAU.03 : 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 2, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Daniel L. Dawes of MYERS DAWES ANDRAS & SHERMAN LLP has been revoked by the applicant of the patent application on December 1, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **DAVID FLORES**
**STRATEGY CENTRIC**
**3009 BERN DRIVE**
**LAGUNA BEACH, CA 92651**

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 |
|---|---|---|---|
| 10/140,585 | 05/07/2002 | David R. Flores | STR1.PAU.03 |

**CONFIRMATION NO. 7670**

*OC000000021851083*

23386
MYERS DAWES ANDRAS & SHERMAN, LLP
19900 MACARTHUR BLVD.,
SUITE 1150
IRVINE, CA 92612

Date Mailed: 01/05/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/01/2006.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

---

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

UNITED STATES 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 FLORES
STRATEGY CENTRIC
3009 BERN DRIVE
LAGUNA BEACH, CA 92651

COPY MAILED

JUL 23 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>David R. Flores<br>Application No. 10/140,585<br>Filed: May 7, 2002<br>Attorney Docket No. STR1.PAU.03 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b), filed on April 19, 2007, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed October 12, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3623, 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

UNITED STATES 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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JAN 2 0 2006

OFFICE OF PETITIONS

BRIDGESTONE AMERICAS HOLDINGS, INC.
1200 FIRESTONE PARKWAY
AKRON, OH 44317

In re Application of Koch et al. :
Application No. 10/140,607 :
Filing Date: May 7, 2002 :
Attorney Docket No. P99098US2A :

Decision on Petition

This is a decision on the petition filed September 9, 2005, which is being treated as a petition under 37 CFR 1.183 to waive the need for the signatures of all the inventors on 37 CFR 1.131 declarations.

The petition is **dismissed**.

Petitioner only authorized the Office to charge $130 for the petition fee.

The fee necessary is $400 for a petition under 37 CFR 1.183. 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. The instant petition is properly treated under 37 CFR 1.183.

Even if the petition could properly have been treated under 37 CFR 1.47, the petition fee would have still been insufficient. The current petition fee required for a petition under 37 CFR 1.47 is $200.

Authorization to charge the full $400 to petitioner's deposit account for the petition should be filed if petitioner desires for the Office to consider the merits of the petition.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183." 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
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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

**MYERS BIGEL SIBLEY & SAJOVEC**
**P O BOX 37428**
**RALEIGH, NC 27627**

COPY MAILED

JUL 0 8 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jonathan S. Lindsey et al | : | |
| Application No. 10/140,654 | : | NOTICE |
| Filed: May 8, 2002 | : | |
| Attorney Docket No. 5051-543 | : | |

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 PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

**PHILIP S. JOHNSON**
**JOHNSON & JOHNSON**
**ONE JOHNSON & JOHNSON PLAZA**
**NEW BRUNSWICK NJ 08933-7003**

**COPY MAILED**

DEC 01 2003

**OFFICE OF PETITIONS**
ON PETITION

In re Application of :
Takehisa Matswuda et al :
Application No. 10/140,655 :
Filed: May 8, 2002 :
Attorney Docket No. ETH1651 :

This is a decision on the petition, filed November 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 November 24, 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 1711 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).

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LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

**COPY MAILED**

FEB 14 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| LINDEMANN et al | : | |
| Application No.: 10/140,680 | : | DECISION ON PETITION |
| Filing Date: May 8, 2002 | : | UNDER 37 CFR 1.137(B) |
| Attorney Docket No.: 432251 [55366 (71789)] | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 15, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 20, 2005, which set a statutory three (3) month period for response. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, by operation of law, the above-identified application became abandoned on July 21, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of arguments; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action mailed April 20, 2005 is accepted as having been unintentionally delayed.

This application is being referred to Technology Center AU 1631 for appropriate action on the reply in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3303.

Bryan Lin

Bryan Lin
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA, GA 30007-1355

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Donna B. Malone, et. al. | : | |
| Application No. 10/140,684 | : | ON PETITION |
| Filed: May 7, 2002 | : | |
| Attorney Docket No. 99490 | : | |

This is a decision on the petition under 37 CFR 1.137(b), on September 28, 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 May 8, 2006. A Notice of Abandonment was mailed on September 13, 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; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to the Office of Publications for further processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

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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www.uspto.gov

March 26, 2004

Joe H. Shallenburger
Steinberg & Raskin
1140 Avenue of the Americas, 15th Floor
New York, NY 10036-5803

In re application of
Heikkinen, Jukka DECISION ON PETITION
Serial No.: 10/140,688
Filed: May 8,2002
For: SLIDE BEARING FOR A ROLL IN A PAPER/BOARD OR FINISHING MACHINE, AND METHOD FOR MAKING THE SAME

This is a decision on the petitions received on February 2, 2004, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed June 11, 2002. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned August 13, 2002. The notice of abandonment was mailed January 21, 2004.

On February 2, 2004, the office received a communication from the attorney of record. Enclosed was an acknowledgement that the attorney responded to the Notice to File Missing Parts on August 9, 2002.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts on August 9, 2002.

The petition is hereby GRANTED.

The application will be completed with the documents received on August 9, 2002 and released to Technology Center 3682.

The office regrets any inconvenience this may have caused the client.

Telephone inquiries concerning this matter may be directed to Doshie E. Day at (703) 308-3640.

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

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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GREGORY L BRADLEY
MEDRAD INC
ONE MEDRAD DRIVE
INDIANOLA PA 15051

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OFFICE OF PETITIONS

In re Application of :
Haury et al. :
Application No. 10/140,707 : DECISION ON PETITION
Filed: May 7, 2002 :
Attorney Docket No. VI/98-007.D :

This is a decision on the petition under 37 CFR 1.137(b), filed August 24, 2004, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office Action mailed February 18, 2004. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on May 19, 2004. This decision precedes the mailing of a Notice of Abandonment.

This petition is hereby **GRANTED**.

Deposit account 13-2530 will be charged the petition to revive fee in the amount of $1330.

The Office hereby acknowledges the receipt of the amendment submitted with the instant petition.

This application is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (571)272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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**E I DU PONT DE NEMOURS AND COMPANY**
**LEGAL PATENT RECORDS CENTER**
**BARLEY MILL PLAZA 25/1128**
**4417 LANCASTER PIKE**
**WILMINGTON, DE 19805**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yuan et al. | : | |
| Application No. 10/140,737 | : | ON PETITION |
| Filed: May 8, 2002 | : | |
| Attorney Docket No. FA0970USNA | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 22, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed June 2, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on September 3, 2004. A Notice of Abandonment was mailed December 8, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This matter is being referred to Technology Center 1700 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

In re Application :
Milani, et al. :
Application No. 10/140,775 : PATENT TERM ADJUSTMENT
Filed: May 6, 2002 :
Dkt. No.: 3473 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)," filed December 27, 2005.

Applicant herein has not disputed the patent term adjustment (PTA) accorded to date (449 days). Instead, the instant application for patent term adjustment requests reconsideration under 37 CFR 1.703(b) of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date. A decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term for Office failure to issue the patent within three years. *See*, 37 CFR 1.703(b).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Applicants are reminded that if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in

determining whether periods of delay overlap under 35 USC 154(b)(2)(A).

Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. *See*, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR § 1.703(f). *See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The required application fee of $200.00 has been charged to Deposit Account No. 23-1925. No additional fee will be required if applicants are solely requesting reconsideration of additional time related to failing to issue the patent within three years in accordance with 37 CFR 1.702(b).

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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P.O. BOX 10395
CHICAGO, IL 60610

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,033,632 | : | |
| Issued: April 25, 2006 | : | |
| Application No. 10/140,775 | : | PATENT TERM ADJUSTMENT |
| Filed: May 6, 2002 | : | |
| Dkt. No.: 3473 | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)," filed May 8, 2006.

The application for patent term adjustment (PTA) is hereby **DISMISSED**.

The above-identified application matured into U.S. Patent No. 7,033,632 on April 25, 2006. The instant request for reconsideration was timely filed May 8, 2006 in accordance with 37 C.F.R. § 1.705(d). The patent issued with a PTA of 448 days. Applicants argue that the adjustment of 448 days should be increased 354 days related to the Office's failure to issue the patent within three years from the date the application was filed.

At the time of issuance, the patent was entitled to an adjustment of 354 days. As patentee was previously reminded, if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A).

Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent **will not** result in any additional patent term adjustment. *See*, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR § 1.703(f). *See, also, Revision of*

*Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

Receipt is hereby acknowledged of the required application fee of $200.00. No additional fee is due in connection with this matter.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery Fries
Senior Patent Attorney
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Townsend and Townsend and Crew, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

In re Application of:
Kumar GAJJAR, et al.
Application No. 10/140,778
Filed: May 7, 2002
For: SYSTEMS AND METHODS FOR DYNAMIC ALIGNMENT OF ASSOCIATED PORTIONS OF A CODE WORD FROM A PLURALITY OF ASYNCHRONOUS SOURCES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed August 23, 2004.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED.**

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

cc: Krish Gupta
Director, Senior Counsel, Office of the General Counsel
EMC Corporation
176 South Street
Hopkinton, MA 01748

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

MAR - 4 2003

UR
PAPER NO.6

| | | |
|---|---|---|
| In re Application of | : | |
| Philip R. Emery et al. | : | DECISION |
| Serial No. 10/140,779 | : | ON |
| Filed: May 08, 2002 | : | PETITION |
| For: MULTILAYER COMPOSITE FOR THE DRY | : | UNDER 708.02,VIII |
| TRANSFER OF GRAPHICS TO RECEPTIVE | : | Small Entity |
| SUBSTRATES | : | |

This is in response to the petition filed October 01, 2002, requesting that the above-identified application be granted Special Status, but the applicant did not specify a Section (I through XII) of M.P.E.P. 708.02 for authority.

The petition to grant Special Status has been considered under Sections 708.02 (VIII) of the MPEP and 37 CFR 1.102(c) (fee paid).

The petition has been considered and found 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

Samuels, Gauthier & Stevens LLP
225 Franklin Street, Suite 3300
Boston, MA 02110

617-426-9180 ext 113

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trad mark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

708.02, VIII

Date: 1/23/03

To: SPE, Art Unit 1734

From: Director's Office, SPRE ROY

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____ by COB 1/27/03.

| | 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?** | [✓] | [✓] |
| If "no", please list all reasonable, additional classes/subclasses | | |
| ~~156/230, 240, 241, 247, 277, 284~~ | | |
| ~~427/146, 147, 148~~ | | |
| **b. Publications? (If applicable)** N/A | [ ] | [ ] |
| If "no", please list all reasonable publications | | |
| **c. Foreign patent IPC classes/subclass? (If applicable)** N/A | [ ] | [ ] |
| If "no", please list all reasonable, additional IPC classes/subclasses | | |
| **d. Database searches, e.g., Chemical Abstract? (If applicable)** N/A | [ ] | [ ] |
| If "no", please list all reasonable, additional databases | | |
| **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 f r 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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 7

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

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SEP 0 6 2002

OFFICE OF PETITIONS

In re Application of
Vicari, et al.
Application No. 10/140,802
Filed: May 7, 2002
Attorney Docket No.SF01361
For: METHODS FOR TREATING CANCER

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.53(e), filed July 19, 2002, requesting in effect, partial withdrawal of the Notice of Incomplete Nonprovisional Application, mailed June 12, 2002,insofar as it pertains to the lack of accordation of a filing date to the above-identified application.

The application was deposited on May 7, 2002. On June 12, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners that no filing date had been accorded to the application papers deposited on May 7, 2002 because no drawing was present, as is required by 35 USC 113.

In response to the Notice, petitioners timely filed, *inter alia*, the present petition.

It is noted that the above-identified application contains method claims. As stated in MPEP 601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC 113 (first sentence.)

MPEP 601.01(f) also states that:

> A non provisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figures in the specification, but filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g), so long as the application contains something that can be construed as a written description.

This application contains numerous method claims. Therefore, the above-identified application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g).

MPEP 601.01(g) states that if an application is filed without all of the drawing figures referred to in the specification, a "Notice of Omitted Items" is mailed indicating that the application has

been accorded a filing date.

In view of the above, the "Notice" mailed June 12, 2002 was mailed in error with respect to the lack of accordation of a filing date and is hereby partially withdrawn.[1]

The petition under 37 CFR 1.53(e) to accord a May 7, 2002 filing date is **granted**.

Pursuant to petitioners' authorization, deposit account no. 19-0365 will be credited the $130.00 petition fee.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of **May 7, 2002**. Thereafter, the application will be forwarded to Technology Center 1600 for consideration of the Preliminary Amendment and the substitute specification, both filed July 19, 2002, that delete any reference to the drawing figures.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The Notice was correct in requiring petitioners to submit a signed declaration. The Office received a signed declaration on July 19, 2002.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : April 08, 2008

**TO SPE OF** : ART UNIT 1646

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/140806 Patent No.: 7309764 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**.

**DO NOT SENT TO ATTORNEY**

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

**You can fax the Directors/SPE response to 571-270-9990**

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

SPE — 1646 Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Arnold & Porter LLP (24126)
Attn: IP Docketing Dept.
555 Twelfth Street, N.W.
Washington, DC 20004-1206

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Audrey Goddard | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7335745 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/26/2008 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/140,807 | : OF WYETH |
| **Filed** | : 05/07/2002 | : |
| | | : |

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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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

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OFFICE OF PETITIONS

In re Application of :
Takuya Ishida, et al. :
Application No. 10/140,834 : ON PETITION
Filed: May 9, 2002 :
Atty Docket No. 112760 :

This is a decision on the petition, filed November 24, 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 August 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2116 for further processing of the request for continued examination under 37 CFR 1.114 filed November 24, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: " Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date : November 24, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Takuya Ishida, et al.
Application No. : 10/140,834
Filed : May 9, 2002

The above-identified application has been assigned Patent No. 6,829,661 and an issue date of December 7, 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 December 7, 2004:

> "All reference to Patent No. 6,829,661 to HEIKYUNG MIN, ET AL. of JAPAN for DATA TRANSFER CONTROL DEVICE, ELECTRONIC EQUIPMENT, AND DATA TRANSFER CONTROL METHOD appearing in the Official Gazette of December 7, 2004, should be deleted since no patent was granted."

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Paul Harrison, Crystal Park 3-44I (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite II00 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-9I0 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane K.Davis, P/OCS, CM1-6A07
Tamara K. Greene, PK3-910

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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McNEES WALLACE & NURICK LLC
100 PINE STREET
P O BOX 1166
HARRISBURG, PA 17108-1166

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| | |
|---|---|
| In re Application of | : |
| Atul Natverlal Shah | : |
| Application No. 10/140,852 | : DECISION GRANTING PETITION |
| Filed: May 7, 2002 | : UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 122807/11790 | : |

This is a decision on the petition, filed September 14, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on April 11, 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 1762 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
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), 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).*