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

James H. Morris
Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210

COPY MAILED

MAR 2 6 2003

OFFICE OF PETITIONS

In re Application of	:	
Victor R. Watson	:	
Application No. 10/165,039	:	ON PETITION
Filed: June 6, 2002	:	
Attorney Docket No. S01022/80916	:	

This is in response to the "Petition Under 37 CFR 1.47(b)," filed January 27, 2003.

The petition is granted.

Petitioner has shown that the non-signing inventor, Victor Watson, has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the declaration/statement of facts of Philip R. Slingsby establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration. In addition, petitioner has shown that STMicroelectronics Limited has a proprietary interest in the above-identified application with the copy of the employment agreement showing that the inventor had an obligation to assign any patent rights to STMicroelectronics Limited. The petition fee has been paid. Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and demonstrated that petitioner has shown that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 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 Declaration. Notice of the filing of this application will also be published in the Official Gazette.

This application is being forwarded to Technology Center Art Unit 2185 for examination in due course.

Telephone inquiries regarding this communication 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

Victor Robert Watson
131 Mortimer Road
Itchen, Southampton SO19 2HJ
United Kingdom

COPY MAILED

MAR 2 6 2003

OFFICE OF PETITIONS

In re Application of
Victor Watson
Application No. 10/165,039
Filed: June 6, 2002
For: DECODING APPARATUS

Dear Mr. Watson:

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

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

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: James H. Morris
Wolf Greenfield & Sacks, P. C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARIA A. TREVISAN
WOLF, GREENFIELD & SACKS, P.C.
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210

COPY MAILED
JUN 04 2004
OFFICE OF PETITIONS

In re Application of :
Michael B. Brenner, et al. :
Application No. 10/165,049 : ON PETITION
Filed: June 7, 2002 :
Attorney Docket No. L00560/70010 (MAT) :

This is a decision on the petition, filed June 3, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 24, 2004, using a Certificate of Mailing under 37 CFR 1.8 dated March 22, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being referred to Technology Center AU 1648 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

IBM CORPORATION (RUS)
c/o Rudolf O Siegesmund Gordon & Rees, LLp
2100 Ross Avenue
Suite 2800
DALLAS TX 75201

COPY MAILED

FEB 19 2008

In re Application of	:	
Charles Gordon Hooks	:	
Application No. 10/165,092	:	ON PETITION
Filed: June 6, 2002	:	
Attorney Docket No. AUS920020141US1	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 4, 2007, to revive the above-identified application.

The petition is **GRANTED**.

his 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 August 21, 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 September 22, 2006. See MPEP 1215.04. The Notice of Abandonment was mailed May 25, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an appeal brief; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

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

The application file is being referred to Technology AU 2155 for appropriate action on the concurrently filed appeal brief.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEVEN D WESEMAN, ASSOCIATE GENERAL COUNSEL, IP
CABOT MICROELECTRONICS CORPORATION
870 NORTH COMMONS DRIVE
AURORA, IL 60504

COPY MAILED

MAR 2 2 2005

OFFICE OF PETITIONS

In re Application of
Kevin J. Moeggenborg, et al.
Application No. 10/165,100
Filed: June 7, 2002
Attorney Docket No. 100085

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 15, 2005 to withdraw the above-identified application from issue after payment of the issue fee.

It does not appear that the instant petition is signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of John Kilyk, Jr. 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. However, if Mr. Kilyk desires to receive correspondence regarding this file, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to Mr. Kilyk, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The petition is **GRANTED**.

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

---

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

The application is being referred to Technology Center AU 1765 for further processing of the request for continued examination under 37 CFR 1.114 filed March 15, 2005.

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

cc: JOHN KILYK, JR.
LEYDIG, VOIT & MAYER, LTD.
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FARSHAD JASON FARHADIAN
CENTURY IP LAW GROUP
P.O. BOX 7333
NEWPORT BEACH, CA 92658-7333

COPY MAILED
NOV 16 2007
OFFICE OF PETITIONS

In re Application of	:	
Amit Haller et al	:	
Application No. 10/165,150	:	ON PETITION
Filed: June 6, 2002	:	
Attorney Docket No. 1005-33-01 USP	:	

This is a decision on the petition under 37 CFR 1.137(b), filed August 6, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed November 7, 2005, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on February 8, 2006.

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

This matter is being referred to Technology Center AU 2616 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OIPE JC173
DEC 1 5 2003
PATENT & TRADEMARK OFFICE

RECEIVED
MAY 1 2 2003
Trask Britt

Paper No.

COPY MAILED
MAY 0 8 2003
OFFICE OF PETITIONS

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY, UTAH 84110

In re Application of
Larry D. Kinsman et al
Application No. 10/165,158
Filed: June 6, 2002
Attorney Docket No. 3397.4US (97-639.4)

ON PETITION

This is a decision on the petition, filed May 6, 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 April 15, 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 Irvin Dingle at (703) 306-5684.

After receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2825 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED
DEC 0 6 2006
OFFICE OF PETITIONS

In re Patent No. 7,016,744	:	
Issued: March 1, 2006	:	
Application No. 10/165,205	:	DECISION ON PETITION
Filed: June 7, 2002	:	
Attorney Docket No. 491.051US1	:	

This is a decision on the petition filed May 18, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the front page of the above-identified patent by way of a certificate of correction.

The request is **GRANTED**.

Petitioner states that the correct assignee's name is Sensopad Limited and that the incorrect assignee's name was included on the Fee(s) Transmittal form PTOL-85(b) at the time of payment of the issue fee. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee.

The request is accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that Sensopad Limited is the assignee of record. Accordingly, the petition is **granted**.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3211. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of the certificate of correction.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BINGHAM MCCUTCHEN LLP
THREE EMBARCADERO CENTER
SAN FRANCISCO CA 94111

COPY MAILED

AUG 10 2007

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Taber H. Smith et al :
Application No. 10/165,214 :
Filed: June 7, 2002 :
Attorney Docket No. 13989-002001 :

This is a decision on the petition, filed August 9, 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 19, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2812 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

STMICROELECTRONICS, INC.
MAIL STATION 2346
1310 ELECTRONICS DRIVE
CARROLLTON TX 75006

COPY MAILED

SEP 16 2005

OFFICE OF PETITIONS

In re Application of
Aaron Wade Wilson
Application No. 10/165,219
Filed: June 6, 2002
Attorney Docket No. 99-AD-020RE (1678-54-3)
Title: DATA PLACEMENT VARIATION COMPENSATION SYSTEM

DECISION ON PETITION
UNDER 37 C.F.R. §1.181

This is in response to the petition filed on February 28, 2005 requesting that the application be accorded a filing date of June 6, 2002.

The application was deposited on June 6, 2002. On July 22, 2002, the Office of Initial Patent Examination (OIPE) mailed a filing receipt, which indicated that the application had been accorded a filing date of June 6, 2002. On that same date, OIPE mailed a Notice to File Missing Parts of Reissue Application – Filing Date Granted which indicated that the application had been accorded a filing date of June 6, 2002, and set forth a requirement for the basic filing fee, an executed oath or declaration along with the associate surcharge, and that a statement of the assignee would be required, along with additional claim fees. The notice set a two-month period for reply.

On September 19, 2002, Applicant submitted the reissue filing fee, the surcharge associated with the late submission of an oath or declaration, the additional claim fees, and a reissue declaration, properly meeting the requirements of the notice.

OIPE then mailed an Updated Filing Receipt on October 9, 2002, which indicated that the application had been accorded a filing date of September 19, 2002.

In response, on February 28, 2005, Applicant filed the present petition. Applicants request that the application be accorded a filing date of June 6, 2002.

The file wrapper has been reviewed, and it appears that the application is entitled to a filing date of June 6, and the Updated Filing Receipt was mailed in error.

As such, the petition is **GRANTED**.

The Updated Filing Receipt of October 9, 2002 was mailed in error is hereby **VACATED**. The petition was properly taken as a petition to correct an action of the Office. As such, a petition fee will not be charged to Petitioner's Deposit Account.

After the mailing of this decision, the application will be forwarded to OIPE for further processing, with a filing date of June 6, 2002. OIPE will then mail a corrected filing receipt, before forwarding the application to the Office of Patent Publications for further processing into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

caj

Mailed : 8/31/06

In re Application of	:	DECISION ON
Elson B. Fish	:	PETITION
Serial No. 10/165,237	:	
Filed: June 7, 2002		
For: AEROSLIDE BEARING CYLINDER		

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed May 31, 2006.

On May 31, 2006, a two way restriction requirement was made by the examiner. The examiner took the position that the groupings of claims were related as combination and subcombination. Claims 1-3 and 21-31 were constructively elected by original presentation and claims 32-35 were withdrawn from consideration by the examiner.

On July 9, 2006, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct.

DECISION

Sections 803 and 806.05(c) of the MPEP state:

803 Restriction — When Proper
Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01) or distinct (MPEP § 806.05 - § 806.05(j)).

806.05(c) Criteria of Distinctness Between Combination and Subcombination
To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:
(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
(B) the subcombination can be shown to have utility either by itself or in

another materially different combination.

In the requirement for restriction, the examiner states that the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require that the plurality of substantially rounded filament surfaces at the continuous inner bearing surface and a portion of the resin material form the continuous inner bearing surface, as recited in claim 1, or that the plurality of circular filaments at the continuous inner bearing surface and a portion of the resin material form the continuous inner bearing surface, as recited in claim 23. The examiner further states that the subcombination has separate utility in another and materially different combination, such as an air duct.

Petitioner argues that the reasons noted in the office action are not correct and states that claim 32 (the combination) requires the particulars of the subcombination as claimed. However, a review of claims 1, 23, and 32 finds that this is not the case. The subcombination recited in claims 1 and 23 require additional elements, as correctly noted by the examiner. Therefore, the combination as claimed does not require the particulars of the subcombination as claimed.

Petitioner further argues that the subcombination is a composite bearing cylinder, not an air duct, and has the same use as the combination. However, petitioner has not presented any evidence or arguments to establish that the alternate use for the subcombination set forth by the examiner could not be accomplished. Therefore, it is considered that the subcombination has a separate utility.

Because the combination as claimed does not require the particulars of the subcombination as claimed and the subcombination has separate utility, the examiner has properly established that the inventions are distinct as claimed. Accordingly, the petition for withdrawal of the restriction requirement is **DENIED.**

Jacqueline M. Stone

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

BARNES & THORNBURG, L.L.P.
PO BOX 2786
CHICAGO IL 60690

UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 19 2007

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

In re Application of	:
Christophe Bonny	:
Serial No.: 10/165,250	: PETITION DECISION
Filed: June 7, 2002	:
Attorney Docket No.: Q102464	:

This is in response to the petition under 37 CFR 1.181, filed August 28, 2007 and refiled December 7, 2007, requesting restarting of the period for response.

A Final Office action was mailed to applicant's former attorney of record, MINTZ LEVIN COHEN FERRIS GLOVSKY and POPEO, PC on February 28, 2007, and was returned to the Office as undelivered on March 8, 2007. It appears that no attempt was made to remail the Office action. On December 3, 2007 a new Power of Attorney to the above was received and entered. A Notice of abandonment was mailed to the former attorney of record on November 13, 2007. In view of the failure of the Office action mailed February 28, 2007, to be properly received by applicant or the Attorney of Record, the Office action will be remailed and the Notice of Abandonment is hereby rescinded.

The petition is **GRANTED.**

The period for response to the Office action originally mailed February 28, 2007, is vacated. The Office action will be remailed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES 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.

GEN PROBE INCORPORATED
10210 GENETIC CENTER DRIVE
SAN DIEGO CA 92121

COPY MAILED

FEB 13 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of
Nanibhushan Dattagupta et al
Application No. 10/165,281
Filed: June 7, 2002
Attorney Docket No. GP056-05.RE2

This is a decision on the petition, filed February 6, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on June 3, 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 1634 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 08-02

Paper No. 4

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET NW
WASHINGTON DC 20037-1526

COPY MAILED

AUG 30 2002

OFFICE OF PETITIONS

In re Application of	:	
Joel A. Drewes	:	
Application No. 10/165,301	:	DECISION GRANTING PETITION
Filed: 10 June, 2002	:	
Atty Docket No. M4065.0508/P508	:	

This is a decision on the petition filed on 26 July, 2002, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application be accorded a filing date of 10 June, 2002, with 17 sheets of drawings as a part of the original disclosure.

On 10 June, 2002, the application was filed.

On 15 July, 2002, Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application" stating that the application had not been accorded a filing date because the application was deposited without drawings and that the filing date of the application would be the date of receipt of the drawings.

In response, on 26 July, 2002, the present petition, a $130.00 petition fee, and 17 sheets of drawings were filed. Petitioner argues that 17 sheets of drawings were filed with the other application papers on 10 June, 2002, and that the drawings were misplaced in the U.S. Patent and Trademark Office (Office). In support of the petition, a copy of petitioner's postcard receipt was supplied with the petition. The postcard receipt, which shows an "Office-date" stamp of 10 June, 2002, and identifies the application by inventor's name, attorney docket number, and invention title, and acknowledges receipt of, *inter alia*, 17 sheets of drawings. Petitioner requests that the application, including 17 sheets of drawings, be accorded a filing date of 10 June, 2002.

Upon review of the record, no sheets of drawings deposited on 10 June, 2002, have been located among the application papers. However, the evidence is convincing that the application papers deposited on 10 June, 2002, included 17 sheets of drawings, which were subsequently misplaced in the USPTO. Therefore, the application, including 17 sheets of drawings, was complete on filing and entitled to a filing date of 10 June, 2002.

In view of the above, the petition is granted. The application will be processed with the 17 sheets of drawings submitted with the present petition. The petition fee is unnecessary and will be credited to counsel's deposit account, No. 04-1073.

The "Notice" mailed on 15 July, 2002, was sent in error and is hereby withdrawn.

The application is being returned to Initial Patent Examination Division for processing with a filing date of 10 June, 2002, using the application papers filed on that date, and the 17 sheets of drawings supplied on 26 June, 2002, and for an indication on the bib-data sheet that 17 sheets of drawings were present on filing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/165301

Paper No.: —

DATE : ~~8/25/05~~ 11/17/05

TO SPE OF : ART UNIT 2812

SUBJECT : Request for Certificate of Correction on Patent No.: 6849464 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:

SPE

Art Unit 2812

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAMES C. SCOTT , ESQ
ROETZEL & ANDRESS
1375 E.9TH STREET
ONE CLEVELAND CENTER, 10TH FLOOR
CLEVELAND OH 44114

COPY MAILED
SEP 14 2006
OFFICE OF PETITIONS

In re Patent No. 6,729,648	:	
Issued: 4 May, 2004	:	
Application No. 10/165,333	:	ON PETITION
Filed: 7 June, 2002	:	
Atty Dckt No. 109770.0003	:	

This is a decision on the petition filed on 15 February, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **granted**.

The processing fee of $130.00 and certificate of correction fee of $100.00 will be charged to counsel's deposit account as authorized in the present petition.

Telephone inquires concerning this matter may be directed to the undersigned at 571.272.3231. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at 703.305.8309.

The application is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

WELLS ST. JOHN ROBERTS GREGORY & MATKIN PS
601 WEST FIRST AVENUE
SUITE 1300
SPOKANE, WA 99201-3828

COPY MAILED

APR 17 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Hasan Nejad et al :
Application No. 10/165,352 :
Filed: June 6, 2002 :
Attorney Docket No. MI22-1942 :

This is a decision on the petition, filed April 16, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 13, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2818 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12

COPY MAILED

APR 17 2003

OFFICE OF PETITIONS

Date : April 17, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 10/165,352**

Applicant(s) : Hasan Nejad et al
Application No. : 10/165,352
Filed : June 6, 2002

The above-identified application has been assigned Patent No. 6,555,395 and an issue date of April 29, 2003.

It is hereby directed that this application be withdrawn from issue at the request of the applicant. Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of April 29, 2003:

> **"All reference to Patent No. 6,555,395 to Hasan Nejad et al of Idaho for METHODS OF FORMING MAGNETORESISTIVE MEMORY DEVICE ASSEMBLIES appearing in the Official Gazette of April 29, 2003 should be deleted since no patent was granted."**

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

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis (CDS), CM1-6A07
Tamara K. Greene, PK3-910

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 05/26/07

TO SPE OF : ART UNIT 1647

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/165353** Patent No.: **7196176**

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

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

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

Angela Green
Certificates of Correction Branch
703.308.9380 ext. 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

1649
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson, PC
P.O. Box 1022
Minneapolis, MN 55440-1022

COPY MAILED

DEC 30 2005

OFFICE OF PETITIONS

In re Application of	:	
Peter S. Adamson	:	DECISION ON PETITION
Application No. 10/165,377	:	UNDER 37 CFR 1.137(b)
Filed: June 6, 2002	:	
Attorney Docket No.	:	
10559/774001/P14069	:	

This is a decision on the petition under 37 CFR 1.137(b), filed September 19, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on May 23, 2005, for failure to submit a timely and proper response to the nonfinal Office action mailed on February 22, 2005, which set a three (3) month shortened statutory period for reply.

The Office notes that 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 this paragraph was unintentional" be submitted. The statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

John G. Posa
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, PC
280 N. Old Woodward Ave., Suite 400
Birmingham MI 48009

COPY MAILED

OCT 0 7 2002

OFFICE OF PETITIONS

In re Application of
Morris, et al.
Application No. 10/165,468
Filed: June 7, 2002
Attorney Docket No. JMO-10202/29
For: COMPACT SUTURE PUNCH WITH MALLEABLE NEEDLE

ON PETITION

This is a decision on the petition filed August 5 2002 (certificate of mailing date July 29, 2002), requesting that the Notice to File Corrected Application Papers (Notice), mailed July 10, 2002, be withdrawn insofar as it alleges that Figure 52 was omitted on filing. The petition will be treated under 37 CFR 1.53(e).

The application was filed on June 7, 2002. However, on July 10, 2002, the Office of Initial Patent Examination mailed a Notice stating, *inter alia*, that the application had been accorded a filing date of June 7, 2002, and advising applicants that Figure 52 described in the specification appeared to have been omitted.

In response, the present petition was filed. The petition does not allege and is not accompanied by any evidence that any sheet of drawing containing the labels "Fig. 52" was present in the Office on June 7, 2002. However, petitioners explain that Figure 52 was not missing on June 7, 2002. Petitioners claim that the application, filed June 7, 2002, included a sheet of drawings containing three figures, but only two were labeled -- Fig. 50 & Fig 51. Applicants state that the unlabeled figure is "Fig. 52" described in the specification. The petition is accompanied by a copy of the sheet of drawing in question showing the correct figure labels.

It is obvious from the petition that no drawing was actually missing on June 7, 2002. Rather, the drawing of Fig. 52 was simply unlabeled as a result of petitioners' filing error. However, the Notice mailed July 10, 2002, was correct in stating that Figure 52 described in the specification appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn.

The petition is dismissed.

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.

A preliminary amendment adding the label "Fig. 52" to the mislabeled drawing figure should be filed prior to first action on the merits.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 7, 2002, using only the sheets of drawings filed on that date. Petitioners are still required to file substitute drawings in compliance with 37 CFR 1.84 within the period set by the Notice, mailed July 10, 2002.

Telephone inquiries concerning this decision 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
WWW.USPTO.GOV

COPY MAILED

Paper No. 6

JUN 17 2003

OFFICE OF PETITIONS

CORNING INCORPORATED
SP-TI-3-1
CORNING NY 14831

In re Application of
William R. Clark
Application No. 10/165,472
Filed: June 7, 2002
Attorney Docket No. SP02-131

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b) filed August 26, 2002, in response to the Notice to File Missing Parts mailed July 12, 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).

The above-identified application was filed June 7, 2002 without an oath or declaration. Accordingly, on July 12, 2002, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and surcharge for its late filing. In reply, the instant petition was filed.

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.

In support of the request to accord 37 CFR 1.47(b) status in the instant application, petitioners submitted a statement of the last known address of non-signing inventor William R. Clark, proof that Mr. Clark received copies of the application papers and that therefore he is aware of the filing of the above application. Petitioners have also provided proof of proprietary interest. However, the petition lacks items(2) and (6).

An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is required and as to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

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 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

COPY MAILED

JUL 18 2003

OFFICE OF PETITIONS

CORNING INCORPORATED
SP-TI-3-1
CORNING NY 14831

In re Application of
William R. Clark
Application No. 10/165,472
Filed: June 7, 2002
Attorney Docket No. SP02-131

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(b)

This is in response to the renewed petition filed under 37 CFR 1.47(b) by facsimile transmission on July 16, 2003 and the supplement submitted by facsimile transmission on July 17, 2003.[1]

The petition is **GRANTED**.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been sent a copy of the application papers. Specifically, the statement of Juliana Agon, Attorney for Corning Lasertron Inc., establishes that a copy of the application papers was sent to the non-signing inventor, William R. Clark, and that inventor Clark refused to sign and return the declaration. In addition, petitioner declares that Corning Lasertron Inc. has a proprietary interest in the above-identified application demonstrated by a copy of an agreement whereby the inventor and the principals of Lasertron[2] entered into an Invention, Non-Disclosure and Non-Competition Agreement (Employment Agreement). Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64[3] and has demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor. 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 communication should be directed to the undersigned Petitions Attorney at (703) 305-4497.

Patricia Faison Ball
Senior Petitions Attorney
Office of Petitions

---

[1]A petition under 37 CFR 1.47(b) was filed August 26, 2002 and dismissed in a decision dated June 17, 2003.

[2]Petitioners have provided proof of the name change of the company to Corning Lasertron, Inc. dated October 31, 2000.

[3]A declaration by the attorney of record is provided attesting to the fact that William Juan, Clerk is an officer of the corporation and thus empowered to sign the declaration.

UNITED STATES 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 11

WILLIAM R. CLARK
6 CEDAR LANE
TYNGSBORO, MA 01879

COPY MAILED

JUL 18 2003

OFFICE OF PETITIONS

LETTER

In re Application of
William R. Clark
Application No. 10/165,472
Filed: June 7, 2002
Attorney Docket No. SP02-131
For: THREE-TERMINAL AVALANCHE PHOTODIODE

Dear Mr. Clark:

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

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

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

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

Patricia Faison Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc:

CORNING INCORPORATED
SP-TI-3-1
CORNING NY 14831

SPE C. Tsang

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/165,495

Paper No.: _____

DATE : 8/18/05

TO SPE OF : ART UNIT 1625

SUBJECT : Request for Certificate of Correction on Patent No.: 6822116

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

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance

Lamonte M. Newsome
Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

Cecilia Tsang — **SPE**

1625 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

NOV 0 5 2004

OFFICE OF PETITIONS

ACORN CARDIOVASCULAR, INC.
P.O. BOX 2903
MINNEAPOLIS MN 55402

In re Application of :
Michael J. Girard et al :
Application No. 10/165,504 :
Filed: June 7, 2002 :
Attorney Docket No. 11998.31US01 :

ON PETITION

This is a decision on the petition, filed November 1, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on October 18, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ACORN CARDIOVASCULAR, INC.
P.O. BOX 2903
MINNEAPOLIS MN 55402

COPY MAILED

NOV 0 5 2004

OFFICE OF PETITIONS

In re Application of :
Michael J. Girard et al :
Application No. 10/165,504 : DECISION ON PETITION
Filed: June 7, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 11998.31US01 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 1, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684,

207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

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

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment[1] deleting the incorporation by reference statement for Application No. 09/593,251, filed June 13, 2000, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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

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

---

[1] *Note* 37 CFR 1.121

By hand: Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

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

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

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ACORN CARDIOVASCULAR, INC.
P.O. BOX 2903
MINNEAPOLIS, MN 55402

COPY MAILED

JAN 3 2005

OFFICE OF PETITIONS

In re Application of
Girard et al
Application No. 10/165,504
Filed: June 7, 2002
Attorney Docket No. 11998.31US01

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed November 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

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

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant pending application was filed on June 7, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

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

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

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

Any inquiries concerning this decision may be directed to Karen Creasy at (571) 272-3208.

The examiner of Technology Center Art Unit 3736 will consider applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 09/593,251, filed June 13, 2000.

Karen Creasy

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIXON & VANDERHYE PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

COPY MAILED

MAR 2 8 2006

OFFICE OF PETITIONS

In re Application of
Tove Martel Ida Elsa Christensen et al
Application No. 10/165,528
Filed: June 7, 2002
Attorney Docket No. 550-350

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

This is a decision on the petition, filed March 24, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on December 13, 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 1761 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Mar9\165528.wpd

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APR - 8 2004

Todd E. Garabedian, Ph. D.
WIGGIN & DANA
One Century Tower
New Haven, CT 06508

In re Application of	:	
DIANE KRAUSE et al	:	DECISION ON PETITION
Serial No. : 10/165,533	:	
Filing Date : June 7, 2002	:	
Attorney Docket No.: 102227-200		

This is in response to "Petition under 37 CFR 1.84(a)(2) Regarding Submission of Color Drawings" filed March 24, 2004.

Review shows that requirements under 37 CFR 1.84(a)(2) have been met. Accordingly, the petition is granted.

Petition Granted.

Cecilia Tsang
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

#11

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

MAILED
FROM DIRECTORS OFFICE

MAY 17 2005

TECHNOLOGY CENTER 3600

McHale & Slavin, P.A.
2855 PGA Blvd.
Palm Beach Gardens, FL 33410

In re Application of
Roy J. Dixon, et al.
Application No. 10/165,539
Filed: June 8, 2002
For: ANTI-THEFT DEVICE FOR MOTOR VEHICLES

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition filed October 4, 2004 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action mailed February 6, 2004, and a Notice to that effect was mailed on September 22, 2004.

Petitioner states that a response was filed on February 17, 2004 by facsimile transmission. In support thereof, petitioner has included a copy of a response. The response includes a Certificate of Transmission that is signed by Susan Hess, and is dated February 17, 2004. Petitioner has also submitted a copy of the "Activity Report" printed from petitioner's facsimile machine. However, the "Activity Report" does not specify what was submitted. Therefore, petitioner must rely on the Certificate of Transmission for proof that a response was timely filed.

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

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

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

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

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

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

RAR/rwg: 11/20/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCHALE & SLAVIN, P.A.
2855 PGA BLVD
PALM BEACH GARDENS FL 33410

COPY MAILED

AUG 0 3 2006

OFFICE OF PETITIONS

In re Application of	:	
Dixon et al.	:	
Application No. 10/165,539	:	ON PETITION
Filed: June 8, 2002	:	
Attorney Docket No. 1532.002	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 17, 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 response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 3600 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

ROBERT E. KREBS
THELEN REID & PRIEST LLP
P.O. BOX 640640
SAN JOSE, CA 95164-0640

COPY MAILED

JUN 1 6 2004

OFFICE OF PETITIONS

In re Application of
Tosey, Joseph Peter Robert
Application No. 10/165,598
Filed: June 7, 2002
Attorney Docket No. 034300-364

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed March 10, 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**.

As stated in a telephone conversation with the petitioner on June 10, 2004, the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on June 9, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

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

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was rescinded on December 23, 2003. The above-identified application published on April 8, 2004.

Petitioner requests waiver of the petition fee due to incorrect information provided by employees of the USPTO during various telephone conversations. Petitioner is reminded that official communication with the Office must be carried out in writing. 37 CFR 1.2. Oral advice or statements by Office employees are not binding. See In re Sivertz, 227 USPQ 255,256 (Comm'r Pat. 1985). Accordingly, the petition fee will not be waived.

This application is being forwarded to Technology Center Art Unit 2173 for examination in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-0482.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5
COPY MAILED

MAY 30 2003

OFFICE OF PETITIONS

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

In re Application of
Reed, Potter, Hejaz & Purohit
Application No. 10/165,599
Filed: June 7, 2002
Attorney Docket No. 674519-2023
For: HALOGENATED SULPHAMATE-, PHOSPHONATE-, THIOPHOSPHONATE-, SULPHONATE- AND SULPHONAMIDE-COMPOUNDS AS INHIBITORS OF STEROID SULPHATASE

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

This is in response to the petition under 37 CFR 1.47(a), filed February 13, 2003.

The petition under 37 CFR 1.47(a) is granted.

Petitioners have shown that the non-signing inventor, Hetam Hejaz, has constructively refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the petition, signed by attorney of record Thomas J. Kowalski, and the exhibits to the petition establish that the attorney of record mailed the application papers, including the specification, claims and drawings, to the inventor at his last known address, but the inventor failed to respond to the request that he sign the declaration. Petitioners have submitted a declaration in compliance with 37 CFR 1.63 and 1.64.

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

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

After this decision is mailed, the above-identified application will be forwarded to Technology Center 1600 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HETAM HEJAZ
P.O. BOX NO. 19973
DUBAI
UNITED ARAB EMIRATES

COPY MAILED

MAY 30 2003

OFFICE OF PETITIONS

In re Application of
Reed, Potter, Hejaz & Purohit
Application No. 10/165,599
Filed: June 7, 2002
Attorney Docket No. 674519-2023
For: HALOGENATED SULPHAMATE-, PHOSPHONATE-, THIOPHOSPHONATE-, SULPHONATE- AND SULPHONAMIDE-COMPOUNDS AS INHIBITORS OF STEROID SULPHATASE

LETTER

Dear Mr. Hejaz:

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

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

ATTORNEY OF RECORD: FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
FROM DIRECTORS OFFICE

NOV 17 2004

TECHNOLOGY CENTER 3600

Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 943041050

In re Application of
Mark Falsom et al.
Application No. 10/165,606
Filed: June 6, 2002
For: METHODS AND SYSTEMS FOR LASER DIODE IGNITION OF FIELD WEAPONRY

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicants' petition to withdrawal the holding of abandonment filed on June 2, 2004.

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

☒ Postcard receipt being dated January 20, 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.

KJD/vdb: 10/26/04

KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640

MAILED

APR 11 2005

Technology Center 2100

In re Application of:
Calvin Lue
Application No. 10/165,619
Filed: June 7, 2002
For: WEB BROWSER

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed January 7, 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 is signed by David B. Ritchie alone and does not contain a clear indication that Mr. Ritchie is authorized to sign on behalf of the other attorneys of record and is signing on behalf of the other attorneys of record. Furthermore, there is no indication that Applicant has been notified of the request for withdrawal.

Accordingly, the request is **DENIED**.

All future communications from the United States Patent and Trademark Office (Office) will continue to be directed to the above-listed address until otherwise notified by applicant.

Applicant is reminded of the obligation to promptly notify the Office of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews

For Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

BRIGGS AND MORGAN, P.A.
2400 IDS CENTER
MINNEAPOLIS MN 55402

COPY MAILED

APR 2 9 2003

OFFICE OF PETITIONS

In re Application of
Raymond J. Menard
Application No. 10/165,624
Filed: June 7, 2002
Attorney Docket No. 33135.15

: 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 17, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 365(c) for the benefit of prior-filed PCT Application No. PCT/US01/18734, filed June 8, 2001, set forth in the amendment filed March 17, 2003.

The petition is **DISMISSED**.

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

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]

---

[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 petition does not comply with item (1).

The instant application was filed on June 7, 2002 and was pending at the time of filing of the instant petition.

The reference to the prior-filed application was not included in the manner specified in 37 CFR 1.78(a)(2)(i) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim of a prior National Stage of an international application: "This application is a continuation of U.S. Application No. X, which is the National Stage of International Application No. PCT/US--/--, filed --." A benefit claim that merely states: "This application claims the benefit of International Application No. PCT/US--/--, " does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The amendment filed March 17, 2003 fails to state the relationship of PCT Application No. PCT/US01/18734, filed June 8, 2001, to the instant application.

For the above-noted reason, the petition under 37 CFR 1.78(a)(3) cannot be granted.

In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile transmission to the number indicated below and to the attention of Karen Creasy **.**

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

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

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

By Fax: (703) 308-6916
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

BRIGGS AND MORGAN, P.A.
2400 IDS CENTER
MINNEAPOLIS MN 55402

COPY MAILED

OCT 2 8 2003

OFFICE OF PETITIONS

In re Application of
Raymond J. Menard
Application No. 10/165,624
Filed: June 7, 2002
Attorney Docket No. 33121.18

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed by facsimile transmission on May 16, 2003, and supplemented on October 14, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to PCT Application No. PCT/US01/18734, filed June 8, 2001, set forth in the amendment filed October 14, 2003.

The petition is **GRANTED**.

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

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on June 7, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed PCT application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed PCT application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed PCT application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. §§ 120 and 365(c). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed PCT application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

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

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

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 2632 for consideration by the examiner of applicant's claim under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to the above-noted, prior-filed PCT application.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS MN 55402

COPY MAILED

NOV 03 2005

OFFICE OF PETITIONS

In re Application of	:	
Raymond Menard	:	DECISION ON PETITION
Application No. 10/165,624	:	UNDER 37 CFR 1.137(b)
Filed: June 7, 2002	:	
Attorney Docket No. 33135.15	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 13, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on September 15, 2004, for failure to pay the issue fee and the publication fee as required by the Notice of Allowance and Fee(s) Due mailed on June 14, 2004, which set a three (3) month statutory period for reply. A Notice of Abandonment was mailed on May 4, 2005.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (703) 305-8497.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROBERT W STROZIER, P.L.L.C
PO BOX 429
BELLAIRE TX 77402-0429

COPY MAILED
OCT 24 2005
OFFICE OF PETITIONS

In re Application of :
Randy L. Wreyford :
Application No. 10/165,634 :
Filed: June 7, 2002 :
Attorney Docket No. 96600/13DIV :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed October 12, 2005, to revive an unavoidably abandoned application, and in the alternative, a petition under 37 CFR 1.137(b), to revive an unintentionally abandoned application.

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

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

The above-identified application became abandoned for failure to timely pay the issue fee and the publication fee in response to the Notice of Allowance and Fee(s) Due ("Notice of Allowance") mailed on May 18, 2004, which set a three-month statutory period to respond. The above-identified application became abandoned on August 19, 2004. A Notice of Abandonment was mailed on September 26, 2005. The Office notes that the present petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) (Form PTO/SB/64) is unexecuted. However, the certificate of mailing on the petition references the petition. Therefore, the petition is presumed ratified by the signature on the certificate of mailing. Additionally, applicant's attorney signed a "Statement Concerning Revival," which accompanied the petition under 37 CFR 1.137(b). If this presumption is incorrect, applicant must notify this Office immediately.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the

issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

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

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[1] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[3] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[4]

---

[1] 35 U.S.C. § 133.

[2] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[3] See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

With regard to requirement (3):

In the present petition, applicant asserts that the USPTO mailed the Notice of Allowance to applicant's attorney's old address. Applicant avers that his attorney changed the address in the PAIR system and via paper and that the PAIR system was updated prior to the mailing date of the Notice of Allowance.

A review of the written record indicates that the USPTO properly mailed the Notice of Allowance to the address of record as it existed on May 18, 2004. Moreover, the record reveals that applicant's attorney did not change the correspondence address with the USPTO until July 16, 2004, almost two months after the mailing of the Notice of Allowance. Therefore, it appears that applicant did not receive the Notice of Allowance because his attorney failed to file a timely change of correspondence address with the USPTO prior to mailing of the Notice of Allowance.

The belated notification to the Office of the change of correspondence address does not constitute proper notification as to establish unavoidable delay. An applicant is responsible for promptly notifying the Office of any change of address. The Office further notes that where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of "unavoidable" delay requires a showing that applicant exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application.[5] Furthermore, 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.[6]

Because applicant did not provide a sufficient showing that the delay was unavoidable within the meaning of 35 USC § 151 and 37 CFR 1.137(a), the petition is **dismissed**.

Petition Under 37 CFR 1.137(b)

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from seeking relief by filing a petition under 37 CFR 1.137(b) on the basis of unintentional delay.

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

(1) The reply required to the outstanding Office action or notice, unless previously filed.

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

---

[5] MPEP 711.03(c)(III)(C)(2)

[6] 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).

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and

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

Applicant met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Applicant submitted the required reply in the form of payment of the issue fee and publication fee and authorized the Office to charge the Deposit Account for any necessary fees. Accordingly, the petition under 37 CFR 1.137(b) is **granted**.

The Office finance records indicate that applicant paid a $1,330.00 issue fee. The Office notes that because the amount of the issue fee due is determined by the fees set forth in 37 CFR 1.18, which are in effect as of the date of submission of payment of the fee, the amount due at the time of payment may differ from the amount indicated on the Notice of Allowance. See MPEP 1306. Thus, an applicant is encouraged, at the time of submitting payment of the issue fee, to determine whether the amount of the issue fee due has changed to avoid the application from becoming abandoned for failure to pay the balance of the issue fee due. Id. The fee due at the time of the payment of the issue fee, i.e. October 12, 2005, was $1,400.00. Therefore, the Office charged counsel's Deposit Account for the difference owed in the amount of $70.00, as authorized. Additionally, the Office will charge the $500.00 fee for the filing of the petition under 37 CFR 1.137(a) to counsel's Deposit Account, as authorized.

This matter is being referred to the Office of Publications.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

COPY MAILED

APR 0 2 2003

OFFICE OF PETITIONS

In re Application of
Karl E. Gierskcky et al
Application No. 10/165,667
Filed: June 7, 2002
Attorney Docket No. 11567/46004

NOTICE

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

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

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

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 1623.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

INTEL CORPORATION
P.O. BOX 5326
SANTA CLARA CA 95056-5326

COPY MAILED
AUG 16 2006
OFFICE OF PETITIONS

In re Application of	:	
Hau-Riege et al.	:	DECISION ON PETITION TO
Application No. 10/165,679	:	WITHDRAW HOLDING OF
Filed: 6 June, 2002	:	ABANDONMENT
Atty Docket No. P13228	:	

This is a decision on the petition filed on 4 February, 2004, to withdraw the holding of abandonment in the above-identified application.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

The application was held abandoned for failure to timely respond to the non-final Office action mailed on 4 April, 2003. Notice of Abandonment was mailed on 22 January, 2004.

Petitioners assert that an amendment was timely filed. In support, petitioner has supplied a copy of an amendment, which petitioners assert was filed on 3 July, 2003.

37 CFR 1.8(b) states:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with

> prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition lacks item (3).

In this regard, it is noted that although petitioners state that a copy of the facsimile confirmation confirming that 15 pages were sent on 2 July, 2003, and a copy of the Transmittal Form dated 2 July, 2003, with a Certificate of Transmission dated 2 July, 2003, were filed with the petition, a review of the documents filed on 4 February, 2004, reveals that the above-mentioned pages were not among the papers received with the petition. A close inspection of the file suggests that several pages of the petition may have been lost after receipt at the USPTO.

Therefore, the petition is dismissed without prejudice to reconsideration pending submission of a duplicate copy of the petition filed on 4 February, 2004.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. **This period may not be extended.**[1]

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

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

---

[1] 37 CFR 1.181(f).

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

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

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

DEC 12 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Dr. Michael Ben-Levi
8490 Fountain Avenue, #102
West Hollywood, CA 90069

In re Application of	:	DECISION ON PETITION
Michael Ben-Levi	:	TO MAKE APPLICATION
SERIAL NO: 10/165,703	:	SPECIAL (AGE)
FILED: June 8, 2002	:	
FOR: AUTOMATIC PATIENT TURNER	:	

This is a decision on your petition submitted on August 7, 2002, to make the above-referenced application special on the basis that applicant is over 65 years of age.

The petition has been found to comply with all requirements of section 708.02, part IV of the Manual of Patent Examining Procedures, and will be GRANTED for that reason.

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.

The application is being forwarded to the examiner for accelerated examination consistent with the provisions of section 708.02 of the MPEP.

Randolph G. Rees
for Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600

Kd/nlw

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 18

MICHAEL BEN-LEVI
104 SOUTH HAYWORTH AVENUE, #202
LOS ANGELES, CA 90048

COPY MAILED

SEP 14 2004

OFFICE OF PETITIONS

In re Application of
Michael Ben-Levi
Application No. 10/165,703
Filed: June 8, 2002
For: AUTOMATIC PATIENT TURNER

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

This is a decision on the petition, filed September 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 November 12, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

Upon receipt of the file in the Office of Petitions and association of the instant petition, RCE, request for reconsideration and decision on petition with the file, the file will be forwarded to Technology Center AU 3673 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed request for reconsideration.

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
www.uspto.gov

FERNANDEZ AND ASSOCIATS LLP
1047 EL CAMINO REAL, SUITE 201
MENLO PARK, CA 94025

COPY MAILED

JUN 0 6 2007

OFFICE OF PETITIONS

In re Application of :
LIN, Shang-Hung :
Application No. 10/165,716 : DECISION ON PETITION
Filed: June 7, 2002 : TO WITHDRAW
Attorney Docket No. 79981-201001/US : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 4, 2006.

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

A review of the file record indicates that the power of attorney to FERNANDEZ & ASSOCIATES LLP has been revoked by the assignee of the patent application on August 14, 2006 and August 24, 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: **GREENBERG TRAURIG LLP (SV)**
2450 COLORADO AVE, SUITE 400E
IP DOCKETING DEPARTMENT
SANTA MONICA, CA 90404

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20070805

DATE : August 6, 2007

TO SPE OF : ART UNIT 2624

SUBJECT : Request for Certificate of Correction on Patent No.: 7215834

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

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

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

LN

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:

Matthew C. Bella

MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

SPE: Matthew Bella **Art Unit** 2624

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THE HOOVER COMPANY
101 EAST MAPLE STREET
NORTH CANTON, OH 44720

COPY MAILED

NOV 16 2007

OFFICE OF PETITIONS

In re Application of
Timothy T. Hertrick, et al.
Application No. 10/165,731
Filed: June 7, 2002
Attorney Docket No. 2604

ON PETITION

This is a decision in response to the petition, filed July 11, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Mark L. Weber appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. A courtesy copy of this decision is being mailed to petitioner. However, if Mr. Weber desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. All future correspondence regarding this application file will be directed solely to the address of record.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 21, 2005, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on July 22, 2005. A Notice of Abandonment was mailed November 2, 2005. On July 11, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

Accordingly, the petition is **GRANTED**.

The application is being referred to Technology Center AU 1744 for consideration of the amendment filed July 11, 2007.

[1] 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While the statement is not made by an attorney of record, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: MARK L. WEBER
FIRST NATIONAL TOWER, FOURTH FLOOR
AKRON, OH 44308

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Oct-09

MICHAEL, BEST & FRIEDRICH LLP
100 EAST WISCONSIN AVENUE
SUITE 3300
MILWAUKEE WI 53202

MAILED

OCT 07 2009

OFFICE OF PETITIONS

In re Application of :
Hertrick et al. :
Application Number: 10/165731 :
Filing Date: 06/07/2002 :
For: LIQUID DISTRIBUTION SYSTEM :
FOR A CLEANING MACHINE :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)[1] filed on August 14, 2009.

The petition is **GRANTED**.

This application became abandoned on July 11, 2009, for failure to timely submit the issue and publication fees in response to the Notice of Allowance and Fee(s) Due mailed on April 10, 2009, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on August 21, 2009.

Receipt of the issue and publication fees paid on August 14, 2009 is acknowledged.

---

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

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

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

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

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

The address in the petition is different from the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record.

The application is referred to the Office of Data Management for processing into a patent.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Cc: KENNETH J. STACHEL
7005 COCHRAN ROAD
GLENWILLOW OH 44139

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

MICHAEL, BEST & FRIEDRICH LLP
100 EAST WISCONSIN AVENUE
SUITE 3300
MILWAUKEE, WI 53202

Mail Date: 04/21/2010

Applicant	: Timothy T. Hertrick	: DECISION ON REQUEST FOR
Patent Number	: 7617563	: RECALCULATION of PATENT
Issue Date	: 11/17/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/165,731	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/07/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2121** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Dominic M. Kotab
ZILKA-KOTAB, PC
P.O. Box 721120
San Jose, CA 95172-1120

MAIL

APR 2 8 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Umair A. Khan, et al.
Application No. 10/165,734
Filed: June 06, 2002
For: SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR WIRELESS ENABLEMENT OF THE WORLD WIDE WEB USING A WIRELESS GATEWAY

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed February 14, 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 is **GRANTED**.

Because there was no request for a correspondence address change, all future communications from the U.S. Patent and Trademark Office (Office) ***will continue to be*** addressed to the above-mentioned address until further notice. Applicant is reminded of the obligation to provide the Office with any change of correspondence address to ensure receipt of all correspondence.

James R. Matthews

for Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

APR 2 8 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

ZILKA-KOTAB, PC
P.O. Box 721120
San Jose, CA 95172-1120

In re Application of:
Umair A. KHAN, et al.
Application No. 10/165,734
Filed: June 6, 2002
For: SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR WIRELESS ENABLEMENT OF THE WORLD WIDE WEB USING A WIRELESS GATEWAY

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed February 14, 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 is **GRANTED**.

Because there was no request for a correspondence address change, all future communications from the U.S. Patent and Trademark Office (Office) ***will continue to be*** addressed to the above-mentioned address until further notice. Applicant is reminded of the obligation to provide the Office with any change of correspondence address to ensure receipt of all correspondence.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 05

JAN 17 2003

Norman R. Klivans
SKJERVEN MORRILL MacPHERSON LLP
Suite 700
25 Metro Drive
San Jose CA 95110-1349

In re Application of:	:	
Heung Kyu Kwon	:	
Application No. 10/165,736	:	DECISION ON REQUEST TO WITHDRAW FROM RECORD
Filed: June 07, 2002	:	
For: METHOD FOR MANUFACTURING FLIP CHIP PACKAGE DEVICES WITH A HEAT SPREADER	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed November 27, 2002.

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

The request meets all the above requirements. The request was signed by Norman R. Klivans, an attorney of record in the above identified application and there is no outstanding Office action requiring a response by the applicant.

The request is approved.

The application currently has no attorney of record.

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

Inquiries related to this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.

Lissi Mojica Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Mr. John Castellano
Harness, Dickey & Pierce
12355 Sunrise Valley Drive, Suite 350
Reston, VA 20191

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : **JANUARY 19, 2006**

TO SPE OF : ART UNIT **2653**

SUBJECT : Request for Certificate of Correction for Appl. No.: **10165786** Patent No.: **6943989B2**

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: _____

DWAYNE BOST
SUPERVISORY PATENT EXAMINER
SPE

2627
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

EDWARD W. BULCHIS
DORSEY & WHITNEY LLP
1420 FIFTH AVENUE, SUITE 3400
SEATTLE, WA 98101

COPY MAILED
NOV 0 3 2005
OFFICE OF PETITIONS

In re Application of :
Joseph M. Jeddeloh :
Application No. 10/165,787 :
Filed: June 7, 2002 :
Attorney Docket No. 501150.01

ON PETITION

This is a decision on the petition, filed October 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 August 29, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2186 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON P.C.
CITIGROUP CENTER 52ND FLOOR
153 EAST 53RD STREET
NEW YORK, NY 10022-4611

COPY MAILED

AUG 18 2005

OFFICE OF PETITIONS

In re Application of	:	
Stephen A. Livesey, et. al.	:	
Application No. 10/165,790	:	ON PETITION
Filed: June 7, 2002	:	
Attorney Docket No. 13659-014003	:	

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

In response to the final Office action mailed December 17, 2004, petitioner hereby submits $750 for the petition to revive fee, an amendment, a terminal disclaimer, and the statement of unintentional delay.

Since petitioner has met the requirements to revive this application, pursuant to 37 CFR 1.137(b), the petition is **GRANTED**.

37 CFR 1.137(d) requires a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted on the above application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above application. Since the application is a utility or plant application filed after June 8, 1995, a terminal disclaimer is not required. Accordingly, the terminal disclaimer filed with the instant petition is unnecessary and the fee will not be charged to petitioner's deposit account.

This application is being referred to Technology Center Art Unit 1651 for processing the Request for Continued Examination under 37 CFR 1.114 filed June 13, 2005, and for review of the amendment filed with the instant petition.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Dec-09

FINNEGAN/KCI
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001

COPY MAILED

DEC 15 2009

OFFICE OF PETITIONS

In re Application of :
Livesey et al. :
Application Number: 10/165790 : ON PETITION
Filing Date: 06/07/2002 :
Attorney Docket Number: :
ALL.0100N3

This is a decision on the "PETITION TO WITHDRAW TERMINAL DISCLAIMER UNDER 37 CFR § 1.182," filed on October 9, 2009.

The petition is **dismissed as moot**.

Petitioners request that a terminal disclaimer filed with a petition under 37 CFR 1.137(b) on July 28, 2005, be withdrawn. Petitioners state that they "believe that the terminal disclaimer was not entered," and that the subject "request is being filed solely to clarify the record."

A review of the record indicates that a petition to revive under 37 CFR 1.137(b) was filed on August 1, 2005 (certificate of mailing date July 28, 2005), along with a terminal disclaimer.

On August 18, 2005, a decision was mailed granting the petition and stating that, because the instant application is a utility or plant application filed after June 8, 1995, a terminal disclaimer is not required.

The terminal disclaimer has been placed in the file, but has not been accepted. Accordingly, the petition is dismissed as moot.

Under the circumstances of this request, the petition fee will be refunded to counsel.

The application is being referred to Technology Center Art Unit 1651 for further processing.

Telephone inquires should be directed to the undersigned at 571.272.3231.

D Wood

Douglas Wood
Senior Petitions Attorney
Office of Petitions

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

Paper No.3

Charles S. Vann
1425 Drake Ave.
Burlingame, CA 94010

NOV 06 2002

In re Application of	:	
Charles S. Vann	:	
Application No. 10/165,797	:	DECISION ON PETITION
Filed: June 6, 2002	:	TO MAKE SPECIAL
For: MULTIAXEL WINDMILL	:	

This is a decision on the petition under 37 C.F.R. § 1.102, filed June 6, 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 M.P.E.P. § 708.02, Section V: Environment.

A grantable petition to make an application special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section V, for an invention which materially enhances the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining elements - air water and soil, must be accompanied by affidavits or declarations under 37 C.F.R. § 1.102 by the applicant or his/her attorney or agent explaining how the invention contributes to the maintenance or restoration of one of these life sustaining elements.

The petition was accompanied by a declaration from the inventor, Charles S. Vann, explaining that the claimed invention is directed to a multiaxel windmill that will replace environmentally-damaging power sources such as coal and oil and will help maintain the environment by conserving our coal and oil reserves.

For the above stated reasons, 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 she should make a rigid search for such, 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, she should consider such application simultaneously with this application and should state in the official letter of such application that 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.

Hien H. Phan, Special Program Examiner
Technology Center 2800

UNITED STATES 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.

DAVID A. FOX, ESQ.
CANTOR COLBURN LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

COPY MAILED

NOV 17 2004

OFFICE OF PETITIONS

In re Application of:	:	
Dale w. Malik	:	
Application No. 10/165,814	:	DECISION ON
Filed: June 7, 2002	:	PETITION
Title of Invention:	:	
ADULT HUMAN OLFACTORY STEM CELLS	:	

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

This Petition is hereby **granted**.

The above-identified application became abandoned pursuant to 35 USC 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 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[1]; (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 Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition has been found in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 USC 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

---

[1] The filing of a petition under this section will not relieve application of the obligation to reply to any outstanding Office action.

The application file is an Image File Wrapper ("IFW") and, as such, no forwarding of the file is necessary. AN electronic message will be sent to the Publishing Division for publishing of the application in due course.

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

Derek L. Woods
Attorney Advisor
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

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
BELLSOUTH I.P. CORP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

COPY MAILED

JAN 1 3 2005

OFFICE OF PETITIONS

In re Application of :
Dale W. Malik :
Application No. 10/165,831 :
Filed: June 7, 2002 :
Attorney Docket No. 36968/273934-BS02189 :

DECISION DISMISSING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed November 3, 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).

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of David A. Fox appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. However, if Mr. Fox desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

The petition is dismissed as **MOOT**.

The instant nonprovisional application became the subject of a counterpart application filed in an eighteen-month country on June 6, 2003. A review of the file record discloses that a Notification of International Filing and a request to rescind was received in the USPTO on July 7, 2003.

Since notification of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii), including a notice of rescission under 35 U.S.C. 122(b)(2)(B)(ii), was received within forty-five days after the date the counterpart application was filed, the application is not abandoned. As such, the filing of a petition to revive is unnecessary and is dismissed as involving a moot issue. *See* Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C.

122(b)(2))(B)(ii)-(iv), 1272 OG 1 (July 1, 2003), available at http://www.uspto.gov/web/patents/patog/week26/.

Under the circumstances, no petition fee has been charged to counsel's deposit account as authorized.

This application is being forwarded to Technology Center AU 2143 for examination in due course.

Any inquiries concerning this decision 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

cc: David A. Fox
Cantor Colburn LLP
55 Griffin Rd S
Bloomfield, CT 06002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JOHN S. PRATT ESQ.
KILPATRICK STOCKTON LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

COPY MAILED

NOV 29 2005

OFFICE OF PETITIONS

In re Application of	:
David D. Oakey et al	:
Application No. 10/165,842	: DECISION GRANTING PETITION
Filed: June 7, 2002	: UNDER 37 CFR 1.313(c)(2)
Atty Dkt No. IRC312 14060/274475	:

This is a decision on the petition, filed November 18, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 13, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1771 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

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

UNITED STATES 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 BRIAN S STEINBERGER
101 BREVARD AVENUE
COCOA FL 32922

COPY MAILED

NOV 20 2006

OFFICE OF PETITIONS

In re Application of :
Huang et al. :
Application No. 10/165,843 :
Filed: 06/07/2002 :
Attorney Docket No. UCF-329 :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 24, 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)." No additional petition fee is necessary.

The application became abandoned for failure to file a timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action of March 11, 2005, which set a three (3) month shortened statutory period for reply. Petitioner obtained an extension of time for response within the second month. Accordingly, the application became abandoned on August 12, 2005. A Notice of Abandonment was mailed on March 21, 2006.

The provisions of 37 CFR 1.137(b) 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 reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the

issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The 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 § 1.20(d)) required pursuant to paragraph (d) of this section.

The present petition does not satisfy requirement (1) above.

The Office has not located a reply to the final Office action with the present petition. Petitioner must submit an appropriate reply with any renewed petition. In a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(1) A Notice of Appeal and appeal fee;

(2) An amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance;

(3) The filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995; or

(4) The filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

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

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

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

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAW OFFICES OF BRIAN S STEINBERGER
101 BREVARD AVENUE
COCOA FL 32922

COPY MAILED

JAN 0 4 2007

OFFICE OF PETITIONS

In re Application of	:	
Huang et al.	:	
Application No. 10/165,843	:	DECISION ON PETITION
Filed: 06/07/2002	:	
Attorney Docket No. UCF-329	:	

This is a decision on the renewed petition under 37 CFR 1.137(b), filed December 14, 2006, to revive the above-identified application.

The application became abandoned for failure to file a timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action of March 11, 2005, which set a three (3) month shortened statutory period for reply. Petitioner obtained an extension of time for response within the second month. Accordingly, the application became abandoned on August 12, 2005. A Notice of Abandonment was mailed on March 21, 2006.

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 this paragraph was unintentional" be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of an RCE and an amendment and paid the requisite fees. Accordingly, the petition under 37 CFR 1.137(b) is **granted.**

This matter is being referred to Technology Center Art Unit 1753.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Chittibabu et al.
Serial No. : 10/165877
Filed : June 10, 2002
Title : PHOTOVOLTAIC CELL

Art Unit : Unknown
Examiner : Unknown

Commissioner for Patents
Washington, D.C. 20231

PETITION TO MAKE SPECIAL UNDER 37 CFR §1.102(C)

Applicants hereby petition that the above application be made special and requests advanced examination based on the conditions set forth in M.P.E.P. §708.02(vi).

The invention will materially contribute to the discovery or development of energy resources, namely, solar energy. In particular, the invention relates to photovoltaic cells having cross-linked semiconductor particles having good integrity and stability. As a result, in some circumstances, the particles need not be sintered at high temperatures, thereby increasing the selection of materials that can be used for substrates. For example, the substrates can include materials with relatively low temperature stability such as polymeric materials. Such polymeric materials can also make the cells relatively light in weight.

Flexible polymeric substrates are amenable to low temperature, continuous or semi-continuous manufacturing processes with relatively high throughput rates. As a result, manufacturing can be performed with relatively inexpensive processing techniques and materials, and unit cost can be relatively cost-effective and cost-competitive. Flexible photovoltaic cells can be used, for example, in canopies for defense, commercial, residential, and agricultural applications.

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EL 940 766 191 US

I hereby certify under 37 CFR §1.10 that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

June 10, 2002
Date of Deposit

Signature

Leroy Jenkins
Typed or Printed Name of Person Signing Certificate

PETITION GRANTED

Richard Crispino
Special Program Examiner
Technology Center 1700

JUN 14 2005

OIPE JC10 JAN 07 2005 PATENT & TRADEMARK OFFICE

01-10-05

1615 IFW

PTO/SB/83 (09-03)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	10/165,896
Filing Date	June 10, 2002
First Named Inventor	Roberto Luis Bruno Penteado
Art Unit	1615
Examiner Name	Unassigned
Attorney Docket Number	217400

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPROVED
SPRE, TC1600
2/14/05

Please withdraw me as attorney or agent for the above identified patent application, and

☐ all the attorneys/agents of record.

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☒ the attorneys/agents associated with Customer Number 23460

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are: See 37 CFR 10.40 (c) (1) (vi).

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☒ Change the correspondence address and direct all future correspondence to:

☐ Customer Number:

OR

☒ Firm *or* Individual Name	Lewis F. Gould,Jr., Esq., Duane Morris LLP				
Address	One Liberty Place				
Address					
City	Philadelphia	State	Pennsylvania	Zip	19103-7396
Country	US				
Telephone	(215) 979-1000			Fax	(215) 979-1020
Name	Paul J. Filbin				
Signature	Paul J. Filbin	Registration No.	51,677		
Date	1/7/05	Telephone No.	(312) 616-5600		

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S.W.
WASHINGTON DC 20375-5320

COPY MAILED

APR 1 9 2005

OFFICE OF PETITIONS

In re Application of	:	
Marc Currie	:	DECISION ON PETITION
Application No. 10/165,913	:	
Filed: 11 June, 1992	:	
Atty Docket No. NC 83,576	:	

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 18 March, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

---

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

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

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

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The 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)).

Application No. 10/165,913

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 decision.

This application became abandoned on 31 October, 2004, for failure to file a proper reply to the Notice of Appeal filed on 30 March, 2004, which set a two (2) month shortened period for reply. A five (5) month extension of time was filed on 29 October, 2004. However, no Appeal Brief was timely filed. An amendment after final rejection was filed on 15 October, 2004, but the examiner determined the amendment did not *prima facie* place the case in condition for allowance, and an Advisory Action notifying applicant was mailed on 3 November, 2004. Notice of Abandonment was mailed on 15 December, 2004.

The petition lacks the required reply. The only proper reply to a Notice of Appeal is an Appeal Brief and fee, an amendment placing the application in *prima facie* condition for allowance, or a request for continued examination (RCE) accompanied by a proper submission under 37 CFR 1.114, or a continuing application. The examiner has determined that the amendment filed on 18 March, 2005, does not place the case in *prima facie* condition for allowance. A copy of the Advisory Action is enclosed for petitioner's reference. Petitioner must submit a proper reply to the final Office action mailed on 30 January, 2004, with any renewed 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 FAX: (703) 872-9306
Attn: Office of Petitions

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

Application No. 10/165,913

The petition fee of $1,500.00 has been charged to counsel's deposit account, No. 50-0281, as authorized in the present petition.

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

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: 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
DIW Jun-05

NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S.W.
WASHINGTON DC 20375-5320

COPY MAILED

JUN 1 5 2005

OFFICE OF PETITIONS

In re Application of	:	
Marc Currie	:	DECISION ON PETITION
Application No. 10/165,913	:	
Filed: 11 June, 2002	:	
Atty Docket No. NC 83,576	:	

This is a decision on the renewed petition under 37 CFR 1.137(b),[1] filed on 5 May, 2005, to revive the above-identified application.

The petition 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 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)).

Application No. 10/165,913

This application became abandoned on 31 October, 2004, for failure to file a proper reply to the Notice of Appeal filed on 30 March, 2004, which set a two (2) month shortened period for reply. A five (5) month extension of time was filed on 29 October, 2004. However, no Appeal Brief was timely filed. An amendment after final rejection was filed on 15 October, 2004, but the examiner determined the amendment did not *prima facie* place the case in condition for allowance, and an Advisory Action notifying applicant was mailed on 3 November, 2004. Notice of Abandonment was mailed on 15 December, 2004. The petition filed on 18 March, 2005, was dismissed on 19 April, 2005.

The present petition styled under 37 CFR 1.137(b) has not been signed. However, registered patent attorney George A. Kap's name has been printed in the space for a signature on the Certificate of Mailing or Transmission (37 CFR 1.8(a)) on the petition form. Since the Certificate of Mailing on the petition form has been signed by petitioner's counsel, the petition will be considered to be ratified by the signature on the Certificate of Mailing or Transmission.

Petitioner has submitted an Appeal Brief as the required reply.

The application is being referred to Technology Center 2872 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Kent A. Rowald
Bracewell & Patterson
PO Box 61389
Houston, TX 77208-1389

COPY MAILED

NOV 1 9 2003

OFFICE OF PETITIONS

In re Application of :
Paul B. Fellencer :
Application No. 10/165,923 :
Filed: June 10, 2002 :
Attorney Docket No. 25646.006 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 22, 2003, to revive the above-identified application.

The petition is Granted.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed July 10, 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 September 11, 2002.

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

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

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 200407

William R. Evans
C/O Ladas & Parry
26 West 61st Street
New York, New York 10023

NOV 30 2004

In re Application of Lin et al. :
Application Number: 10/165,934 :
Filing Date: June 10/2002 : ON PETITION
For: DEVICE HAVING A CAPACITOR ON A DIE :

This is a decision on the petition under 37 C.F.R. § 1.181, filed April 8, 2004 (resubmitted on May 18, 2004) requesting the Director to invoke supervisory authority to instruct the Examiner to issue a new action. Applicant alleges that the prior rejection was based on dictionary definition of the word "on" without proper citation, without the context of common usage, and without the understanding of a person of experience in the field of the invention.

BACKGROUND

The Examiner issued a Final Rejection on January 13, 2004. In response to the Final Rejection, Applicant filed a request for reconsideration under 37 C.F.R. § 1.116 on March 3 2004. On April 5, 2004 an advisory action was issued by the Office, in this action the examiner further explained his position by quoting a dictionary definition of the term at issue. On April 8, 2004 this petition along with a second request for reconsideration under 37 C.F.R 1.116 was filed.

REGULATION AND PRACTICE

M.P.E.P 1201 Introduction

1201 Introduction

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. **Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.**

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990)

OPINION

The issue at hand is one of claim interpretation and the rejection of claims based on prior art. This type of issue is not petitionable and is decided by the Board of Patent Appeals and Interferences.

Since the petition is improper for the reason stated above, it is **DENIED**.

Conclusion

It is noted the Applicant has filed a Request for Continued Examination and Amendment on May 18, 2004. Therefore, the application is being forwarded to the Examiner for further action.

Sharon Gibson
Director Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SEP 12 2002

Paper No. 5

In re Application of	:	
Anthony J. Antonious	:	DECISION ON
Serial No. 10/165,947	:	PETITION
Filed: June 11, 2002	:	TO MAKE SPECIAL
For: METALWOOD TYPE GOLF CLUB	:	
HEAD HAVING EXPANDED SECTIONS	:	
EXTENDING THE BALL-STRIKING	:	
CLUBFACE	:	

Applicant's petition, filed June 11, 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

E. Rollins-Cross, Director
Technology Center 3700

John L. Welsh
Welsh & Flaxman LLC
2341 Jefferson Davis Hwy., Suite 112
Arlington, VA 22202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

WELSH & FLAXMAN LLC
2450 CRYSTAL DRIVE, SUITE 112
ARLINGTON, VA 22202

COPY MAILED

MAR 15 2004

OFFICE OF PETITIONS

In re Application of
Anthony J. Antonious
Application No. 10/165,947
Filed: June 11, 2002
Attorney Docket No. AJA-445

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 January 30, 2004, to accept an unintentionally delayed claim under 35 U.S.C. ? 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/641,705, filed August 1, 2002, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

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

> (1) the reference required by 35 U.S.C. ? 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
> (2) the surcharge set forth in ? 1.17(t); and
> (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition complies with items (1) through (3) above. However, in view of the Advisory Action mailed February 12, 2004, which indicated that the amendment did not *prima facie* place the application in condition for allowance for the reasons noted therein, petitioner must now submit a request for continued examination (RCE) under the provisions of 37 CFR 1.114, or file an amendment that *prima facie* places the application in condition for allowance, or file a continuing application pursuant to the provisions of 37 CFR 1.53(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:[1] 2011 South Clark Place
Crystal Plaza Two, Lobby
Room 1B03
Arlington, VA 22202

By FAX: [2] (703) 872-9306
ATTN: Office of Petitions

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

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

---

[1] Effective December 1, 2003, the Office of Petitions can no longer directly receive hand-carried correspondence. The centralized location for hand-carried correspondence is the Customer Window now located at the address given.

[2] Effective December 1, 2003, the Office of Petitions can no longer directly receive facsimile transmissions of correspondence.

UNITED STATES 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

WELSH & FLAXMAN LLC
2450 CRYSTAL DRIVE, SUITE 112
ARLINGTON, VA 22202

COPY MAILED

APR 26 2004

OFFICE OF PETITIONS

In re Application of
Anthony J. Antonious
Application No. 10/165,947
Filed: June 11, 2002
Attorney Docket No. AJA-445

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed March 23, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed January 30, 2004.

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 11, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after

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

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

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

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 3711 for processing the Request for Continued Examination (RCE) filed on February 27, 2004 and for appropriate action on the amendment filed January 30, 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 application.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 10-02

4

Paper No. 4

NASH & TITUS, LLC
SUITE 1000
3415 BROOKEVILLE ROAD
BROOKEVILLE MD 20833

COPY MAILED

OCT 3 0 2002

OFFICE OF PETITIONS

In re Application of	:	
Vook et al.	:	
Application No. 10/165,975	:	ON PETITION
Filed: 10 June, 2002	:	
Atty's Dkt No. Army 114A	:	

This is a decision on the petition filed on 6 September, 2002, requesting that the above-identified application be accorded a filing date of 10 June, 2002, with Page 2 of the specification (description and claims) as a part of the original disclosure.

The petition is granted.

The application was filed on 10 June, 2002. However, on 10 July, 2002, Initial Patent Examination Division mailed a "Notice" stating, *inter alia*, that the application had been accorded a filing date but that Page 2 of the specification (description and claims) appeared to have been omitted.

In response, on 6 September, 2002, petitioners filed Page 2 of the specification and the present petition. Petitioners argue that Page 2 of the specification was filed with the other application papers on 10 June, 2002, but was subsequently misplaced in the U.S. Patent and Trademark Office (Office). In support, a copy of petitioners' postcard receipt was supplied with the present petition. The postcard receipt bears a USPTO Office stamp dated "06/10/02", and showing the above-identified application number, and identifies the application by first named inventor's name, invention title, and docket number, and itemizes the filing of, *inter alia*, Patent Application including 74 pages and 21 sheets drawings. Petitioners request that the application, including Page 2 of the specification, be accorded a filing date of 10 June, 2002.

A review of the record reveals that Page 2 of the specification is not located among the application papers deposited on 10 June, 2002. However, the evidence is convincing that the application papers deposited on 10 June, 2002, included Page 2 of the specification and that page was subsequently misplaced in the Office. Therefore, the application, including Page 2 of the specification, is entitled to a filing date of 10 June, 2002. The "Notice" mailed on 10 July, 2002, is vacated to the extent that it stated that Page 2 of the specification appeared to have been omitted.

In view of the above, the petition is granted. The petition fee of $130.00 will be refunded to counsel's deposit account, No. 21-0380.

The application will be processed using the application papers filed on 10 June, 2002, and the copy of Page 2 of the specification supplied on 6 September, 2002.

Receipt is acknowledged of the substitute specification filed on 6 September, 2002. The substitute specification is not part of the original disclosure and must be reviewed by the examiner for new matter.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 10 June, 2002, using the application papers filed on 10 June, 2002, and the copy of Page 2 of the specification (description and claims) supplied on 6 September, 2002.

Telephone inquires should be directed to the undersigned at 703 308-6918.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

Fish & Richardson, P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500

MAILED

DEC 06 2002

Technology Center 2100

In re Application of: Timothy Huneycutt)
Application No. 10/165,990) **DECISION ON REQUEST FOR**
Filed: June 11, 2002) **WITHDRAWAL AS ATTORNEY**
For: UTILITY METERING SLIDER BAR)

This is a decision on the Request To Withdraw from Representation filed November 14, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

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.

BEST AVAILABLE COPY

for Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Philips McFall McCaffrey
McVay & Murrah, P.C.
One Leadership Square
211 North Robinson, 12th Floor
Oklahoma City, OK 73102

BEST AVAILABLE COPY

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : February 15 2007

TO SPE OF : ART UNIT 3634 patent No.: 7131547 /10166002

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

3634
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. 10

DAVID J. FRENCH
BOX 2486, STN. D
OTTAWA K1P -5W6 CA CANADA

COPY MAILED

DEC 0 8 2004

OFFICE OF PETITIONS

In re Application of	:	
Andre Choquette	:	
Application No.10/166,027	:	ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. HUOT-0511.US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Petitioner explains that while a Notice of Abandonment was not mailed in the above-identified application, the declaration filed in response to the Notice mailed July 12, 2002 was defective, as it was "not correctly signed by the inventor". Petitioner submits a copy of a declaration executed by the inventor and an amendment, and requests revival of this application.

This decision ratifies the ensuing prosecution and allowance of the application.

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

The application is being returned to Technology Center AU 3725, for further processing of the request for continued examination under 37 CFR 1.114 filed December 19, 2003, including consideration of the amendment filed October 20, 2004.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Barry E. Bretschneider
Morrison & Foerster LLP
Suite 5500
2000 Pennsylvania Avenue,N.W.
Washington, DC 20006-1888

COPY MAILED

SEP 19 2005

OFFICE OF PETITIONS

In re Patent No. 6,870,870	:	
Sakata et al.	:	DECISION ON REQUEST
Issue Date: March 22, 2005	:	FOR
Application No. 10/166,032	:	RECONSIDERATION OF
Filed: June 11, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No. 204552023600	:	and
	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION
	:	

This is a decision on the "PETITION UNDER 37 CFR 1.705(d)," filed May 13, 2005. Patentees request that the patent term adjustment indicated in the patent be corrected from one hundred eleven (111) days to one hundred forty-four (144) days.

The request for reconsideration of patent term adjustment under § 1.705(d) is **GRANTED**.

On March 22, 2005, application No. 10/166,032 matured into U.S. Patent No. 6,870,870. The instant request for reconsideration filed May 13, 2005, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 111 days. Pursuant to 37 CFR § 1.704(c)(10), the PTA was reduced by 20 days for submission of an amendment under 1.312 and by 33 days for submission of a "miscellaneous incoming letter" after the mailing of the notice of allowance. Patentees disagree with the reduction of 33 days.

Patentees state that the miscellaneous letter was a Request for Corrected Notice of Recordation of Assignment filed on September 30, 2004. Patentees assert that such a Request was previously filed on October 15, 2002, and that the error originated with the Office, which failed for nearly two years to take action on patentees' request. Patentees maintain that the filing of the paper does not constitute a failure by patentees to engage in prosecution as would require reduction of the patent term adjustment.

For reasons other than those stated by patentees, it has been determined that the filing of the Request for Corrected Notice of Recordation of Assignment should not have caused a reduction in the patent term adjustment. Such a request is not a paper filed in or acted on in the prosecution of the application. Rather, such a Request should be directed to the Assignment Branch[1] and entered in the assignment records for the case, without effect on the prosecution of the application. Under the circumstances, the 33 days of patent term adjustment will be reinstated.

The Request filed September 30, 2004, has been removed from the prosecution history of the application and forwarded to the Assignment Branch for appropriate action.

In view thereof, it is concluded that the patent should have issued with a revised Patent Term Adjustment of one hundred forty-four (144) days.

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 03-1952, as authorized. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ONE HUNDRED FORTY-FOUR (144)** days.

---

[1] Pursuant to § 3.27, documents and cover sheets to be recorded should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications or with a request under § 3.81.

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

Kery A Fries

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

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE NW
WASHINGTON, DC 20005-3934

COPY MAILED
JUL 31 2006
OFFICE OF PETITIONS

In re Patent No. 6,813,003	:	
Issue Date: November 2, 2004	:	
Application No. 10/166,062	:	DECISION ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. 1857.0850000	:	

This is a decision on the petition, filed, November 3, 2005, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the front page of the Letters Patent by way of a certificate of correction.

The request is **GRANTED**.

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.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Law Offices of Dr. Melvin Blecher
4329 Van Ness St., NW
Washington, DC 20016-5625

COPY MAILED
SEP 14 2006
OFFICE OF PETITIONS

In re Application of :
Theoharis C. Theoharides :
Application No. 10/166,088 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. 51275/116 :

This is a decision on the petition under 37 CFR 1.137(b), filed on May 25, 2006, to revive the above-identified application.

The above application became abandoned for failure to file a timely response to the final Office action mailed November 3, 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) under 37 CFR 1.114 with the $395 filing fee and an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

The Office also acknowledges receipt of $510 for a three months extension of time filed May 25, 2006. However, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $510 extension of time submitted with the petition on was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card, in due course.

This application is being revived for consideration of the RCE filed May 25, 2006.

The application file is being referred to Technology Center Art Unit 1615.

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

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

COPY MAILED

SEP 1 0 2008

OFFICE OF PETITIONS

In re Patent No. 7,291,491	:	
Issue Date: November 6, 2007	:	
Application No. 10/166,098	:	ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. 02139.000013.1	:	

This is a decision on the petition filed March 13, 2008, which is being treated as a petition under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction.

The petition is **DISMISSED**.

Petitioner requests issuance of a certificate of correction in the name of "The Burnham Institute, La Jolla, CA" as the assignee.

37 CFR 3.81(b), effective June 25, 2004, reads:

> *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter [emphasis added]. *See also* MPEP 1481.01.

U.S. Patent and Trademark Office assignment records do not disclose that an assignment to The Burnham Institute was recorded on before the date of issuance of this patent. Also, the petition does not state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent. Accordingly, since the record does not show that the assignment was submitted for recordation before issuance of this patent, issuance of a certificate of correction to correct the assignee would not be proper.

Furthermore, since the petition has been processed, the processing fee set forth in § 1.17(i) ($130.00) has been charged to deposit account no. 50-3939 as authorized in the petition.

Telephone inquiries concerning this decision on petition should be directed to Christopher Bottorff at (571) 272-6692.

Christopher Bottorff
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.

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

COPY MAILED

DEC 0 8 2004

OFFICE OF PETITIONS

In re Application
Hogan et al.
Application No. 10/166,162
Filed: June 10, 2002
Atty Docket No. 396/361

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed October 18, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from seventeen (17) days to thirty nine (39) days.

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

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is thirty nine **(39)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 16, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 17 days. On October 18, 2004, applicants timely[1] submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 39 days. Applicants dispute the reduction of 84 days attributed to their delay in responding to the Notice to File Missing Parts of Application mailed July 15, 2002. Applicants state that their response was received in the Office on December 16, 2002, and thus, the delay should have led to a reduction of 62 days, not 84 days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

---

[1] PALM records indicate that the Issue Fee was also received in the Office on October 18, 2004 (both with certificates of mailing dated October 13, 2004).

Applicants are correct. Their response to the Notice to File Missing Parts of Application mailed July 15, 2002, is of record in the application with a date of receipt by the Office of December 16, 2002. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 84 days. However, the response was filed outside of the three-month period under 37 CFR 1.704(b), three months and 62 days later. Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application, but only by 62 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is thirty nine (39) days (135 - (34 + 62)).

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

The Office will forward the file to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

Kery A. Fries
for

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

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
10/166,162	06/10/2002	Brendan Hogan	396/361	3375

757 7590 01/14/2005

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

EXAMINER
POPOVICS, ROBERT J

ART UNIT	PAPER NUMBER
1724	

DATE MAILED: 01/14/2005

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

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:

Dss
Paper No. _____

In re Application: Hogan et al.
Serial No.: 10/166,162
Filed: June 10,2002

DECISION ON PETITION UNDER *37 CFR 1.48*

Title: COMBINATION FILTER ASSEMBLY

This is a decision on the PETITION TO CORRECT INVENTORSHIP IN A NON-PROVISIONAL PATENT APPLICATION filed October 18, 2004 and submission of statement of Anthony David Harman filed January 13, 2005 to correct inventorship under 37 CFR 1.48(a) by adding the names of Anthony David Harman 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.

12-2-13-05

Duane S. Smith
Supervisory Patent Examiner
Art Unit 1724
Technology Center 1700

Michael E. Milz
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MORRISON & FOERSTER
2000 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006-1888

COPY MAILED

JAN 18 2006

OFFICE OF PETITIONS

In re Patent No. 6,780,546	:	
Issue Date: August 24, 2004	:	
Application No. 10/166,172	:	LETTER
Filed: June 11, 2002	:	
Attorney Docket No. 495812001100	:	

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

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

BIRCH, STEWART, KOLASCH & BIRCH
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

COPY MAILED

JAN 31 2005

OFFICE OF PETITIONS

In re Application of	:	
Håkan Bärneman, et. al.	:	
Application No. 10/166,185	:	ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. 1381-0288P	:	

This is a decision on the petition under 37 CFR 1.182, filed August 23, 2004, to change the name of the inventor.

The petition is **GRANTED**.

The name of the inventor will be changed as follows:

1. Håkan Bärneman

The above-identified application is being referred to Technology Center Art Unit 3652, for further processing.

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

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

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARMEN B. PATTI & ASSOCIATES, LLC
ONE NORTH LASALLE STREET
44TH FLOOR
CHICAGO IL 60602

COPY MAILED
MAY 11 2006
OFFICE OF PETITIONS

In re Application of	:	
Clarisse, et al.	:	
Application No.: 10/166,194	:	
Filed: June 10, 2002	:	ON PETITION
Attorney Docket No.: LUC-329/Clarisse 4-2-3	:	
For: CALLER INFORMATION DISPLAY METHODS AND SYSTEMS		

This is a decision on the petition under 37 CFR 1.181, filed February 1, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition under 37 CFR 1.181 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, mailed December 28, 2004. Petitioners filed an amendment after final on February 28, 2005. The amendment after final failed to place the above-identified application in *prima facie* condition for allowance. On June 27, 2005, an Advisory Action was mailed to an incorrect correspondence address. On December 16, 2005, a Notice of Abandonment was mailed to the same incorrect correspondence address.

Petitioners assert that the holding of abandonment should be withdrawn because the PTO directed the Advisory Action to an incorrect correspondence address.

Petitioners are 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 (4) an RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioners' amendment after final failed to place this application in *prima facie* condition for allowance, as stated in the June 27, 2005 Advisory Action.

An Advisory Action does not restart the prosecution of the application. The post-final rejection of amendments does not obligate the Office or examiner to provide an applicant with a new time period or time limit in which to provide a complete response under 37 CFR 1.113.

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).

It is undisputed that the Office mailed the Advisory Action to an incorrect address. Petitioners are reminded that an Advisory Action is mailed as a courtesy and does not start a new period for response. The application became abandoned because petitioners did not submit a proper reply to the final Office action. The fact that the Advisory Action was not received does not absolve petitioners from filing a complete reply to the final Office action.

A registered practitioner is expected to appreciate that proceedings under 37 CFR 1.116 in an application subject to a final Office action will not operate to avoid abandonment in the absence of a timely and proper appeal. See 37 CFR 1.116 and 1.135. Petitioners' failure to appreciate that the filing of a proposed amendment under 37 CFR 1.116 on February 28, 2005 did not relieve petitioners of the burden of timely filing a notice of appeal to avoid abandonment of the above-identified application. The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 USC 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).

The petition under 37 CFR 1.181 is dismissed.

ALTERNATIVE VENUE

Petitioners should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 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 petitioners 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 pertaining to this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARMEN B. PATTI & ASSOCIATES, LLC
ONE NORTH LASALLE STREET
44TH FLOOR
CHICAGO IL 60602

COPY MAILED

JUL 0 5 2006

OFFICE OF PETITIONS

In re Application of :
Clarisse, et al. :
Application No.: 10/166,194 :
Filed: June 10, 2002 : ON PETITION
Attorney Docket No.: LUC-329/Clarisse 4-2-3 :
For: CALLER INFORMATION DISPLAY
METHODS AND SYSTEMS

This is a decision on the petition under 37 CFR 1.137(b), filed June 2, 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, mailed December 28, 2004. Petitioners filed an amendment after final on February 28, 2005. The amendment after final failed to place the above-identified application in *prima facie* condition for allowance. On June 27, 2005, an Advisory Action was mailed to an incorrect correspondence address. On December 16, 2005, a Notice of Abandonment was mailed to the same incorrect correspondence address.

Petitioners have submitted a RCE and required fee and amendment in reply to the December 28, 2004 final Office action, an acceptable statement of the unintentional nature of the delay in responding to the December 28, 2004 final Office action, and the petition fee. Therefore, the petition is granted.

After the mailing of this decision the application will be forwarded to Technology Center AU 2642 for consideration of the RCE filed on June 2, 2006.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-5-09

TO SPE OF : ART UNIT 3625

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/166233 Patent No.: 7076415B

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

FOR IFW FILES: Check Drawing

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

_____
Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

JEFFREY A. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

_____ **SPE**

3625 **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. 9

Rod S. Berman, Esq.
JEFFER, MANGELS, BUTLER & MARMARO LLP
2121 Avenue of the Stars, Tenth Floor
Los Angeles, CA 90067

COPY MAILED

FEB 11 2003

OFFICE OF PETITIONS

In re Application of
Casey et al.
Application No. 10/166,235
Filed: June 3, 2002
Attorney Docket No. 59452-5002

DECISION GRANTING PETITION

This is a decision on the petition filed January 14, 2003, to establish that Figures 4 and 5 were part of the originally filed application.

On June 3, 2002, the application was filed.

On July 17, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of June 3, 2002, and advising applicants that Figures 4 and 5 described in the specification appeared to have been omitted.

In response, the present petition was filed alleging that Figures 4 and 5 were deposited on June 3, 2002. In support, petitioner has submitted a postcard receipt which acknowledges receipt of 11 sheets of drawings on June 3, 2002.[1] Petitioner has also submitted a copy of the missing documentation- sheet four of the drawings containing Figures 4 and 5. The file only contains 10 sheets of drawings and does not contain a copy of sheet four submitted by petitioner.

Upon review of the record, Figures 4 and 5, deposited on June 3, 2002, have not been located. However, the evidence is convincing that the application papers deposited on June 3, 2002, included Figures 4 and 5, and that Figures 4 and 5 were subsequently misplaced in the PTO.

In view of the above, the petition is **granted**.

The petition fee of $130 will be credited to petitioner's deposit account.

The Notice mailed July 17, 2002, was sent in error and is hereby vacated.

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

---

[1] Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self addressed post card properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the post card in the outgoing mail. "A post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." M.P.E.P. § 503.

the petition; however, the Office will mail all future correspondence solely to the address of record.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 3, 2002, using the application papers filed on June 3, 2002, and the copy of sheet 4 of the drawings containing Figures 4 and 5 filed on January 14, 2003.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

cc: Jeffer, Mangels, Butler & Marmaro LLP
Seventh Floor
1900 Avenue of the Stars
Los Angeles, CA 90067

UNITED STATES PATENT AND TRADEMARK OFFICE

7-11-06

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

Patent No. : 6,942,590
Inventor(s) : Shigeki Okuno, et. al.
Issued : September 13, 2005
Title : BELT FABRIC, AND POWER TRANSMISSION BELT AND HIGH LOAD POWER TRANSMISSION V-BELT USING SUCH A BELT FABRIC
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of 37 CFR 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B. After payment of the issue fee, correction of assignment data submitted on the PTOL-85B can only be done by Certificate of Correction under 37 CFR 1.323, with a request under 37 CFR 3.81(b).

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

In view of the foregoing, your request is hereby denied.

Eva James
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or (703) 305-8309

Donald R. Studebaker
Nixon Peabody LLP
401 9th Street, N.W. Suite900
Washington, DC 20004-2128

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIXON PEABODY, LLP
401 9TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20004-2128

COPY MAILED

MAR 07 2007

OFFICE OF PETITIONS

In re Patent No. 6,942,590 :
Issue Date: September 13, 2005 :
Application No. 10/166,249 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. 740819-810 :

This is a decision on the petition filed August 28, 2006, which is being treated as a petition under 37 CFR 3.81(b)[1] to correct assignee's name on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **granted.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3210. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This application is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] See Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

ALCOA INC
ALCOA TECHNICAL CENTER
100 TECHNICAL DRIVE
ALCOA CENTER PA 15069-0001

COPY MAILED

NOV 0 4 2002

OFFICE OF PETITIONS

In re Application of:
Thomas Dwyer, Gerald K. Creswell, Jr., Conley L. McGee, Gaines N. Massey and Kevin T. Monroe
Application No. 10/166,262
Filed: June 11, 2002
Title of Invention: INTERBAY HOUSING ASSEMBLY FOR FIBER OPTIC MANAGEMENT SYSTEMS

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This Decision is in response to a Petition Under 37 C.F.R. 1.47(a), filed October 3, 2002 (Certificate of Mailing dated September 26, 2002), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). A one (1) month extension of time is required and is hereby granted.

The petition is **dismissed**.

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

The above-identified application was filed on June 11, 2002, without a fully executed oath or declaration. Accordingly, on July 5, 2002 a "Notice to File Missing Parts of Nonprovisional Application" (hereinafter "Notice"), was mailed to Petitioner. The Notice required, in relevant part, a fully executed oath or declaration. Applicant was given two-months from the date of the Notice within which to file a fully executed oath or declaration. Extensions of time were available under 37 CFR 1.136(a).

Petitioner responds with the instant petition and Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor Under 37 CFR §1.47. The Statement of Facts avers that on June 10, 2002, and July 3, 2002, the Declaration and Patent Application Assignment form for the above-identified application were sent to inventor Thomas Dwyer for his signature; however, Mr. Dwyer has yet to return the documents. *Statement of Facts* at p.2.

Applicable Law:

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to

sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

As to item (1), the applicant has failed to establish that the nonsigning inventor was ever presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

Petitioner must send a copy of the entire application, including the specification, claims and drawings, along with the oath or declaration to the nonsigning inventor before refusal can be alleged.

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

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

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

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

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

ALCOA INC
ALCOA TECHNICAL CENTER
100 TECHNICAL DRIVE
ALCOA CENTER PA 15069-0001

COPY MAILED

JAN 23 2003

OFFICE OF PETITIONS

In re Application of:
Thomas Dwyer, Gerald K. Creswell, Jr., Conley L. McGee, Gaines N. Massey and Kevin T. Monroe
Application No. 10/166,262
Filed: June 11, 2002
Title of Invention: INTERBAY HOUSING ASSEMBLY FOR FIBER OPTIC MANAGEMENT SYSTEMS

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the Request for Reconsideration of Petition Under 37 C.F.R. 1.47(a), filed October 14, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition is **granted**.

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

Petitioner has shown that the non-signing inventors, Thomas Dwyer, refuses to sign the declaration after being presented with the above-identified application and declaration.

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

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

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas Dwyer
212 Capri Court
Greenville, SC 29609-3085

In re Application of:
Thomas Dwyer, Gerald K. Creswell, Jr., Conley L. McGee, Gaines N. Massey and Kevin T. Monroe
Application No. 10/166,262
Filed: June 11, 2002
Title of Invention: INTERBAY HOUSING ASSEMBLY FOR FIBER OPTIC MANAGEMENT SYSTEMS

COPY MAILED

JAN 23 2003

OFFICE OF PETITIONS

LETTER

Dear Mr. Dwyer:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: ALCOA INC
ALCOA TECHNICAL CENTER
100 TECHNICAL DRIVE
ALCOA CENTER PA 15069-0001

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20061113

DATE : November 13, 2006

TO SPE OF : ART UNIT 1755

SUBJECT : Request for Certificate of Correction on Patent No.: 7,008,559

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

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

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

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

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

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

Comments:

SPE: Jerry Lorengo **Art Unit** 1755

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

June 18, 2002

Paper # 3

Dorsey and Whitney LLP
Suite 4700
370 17th Street
Denver CO 80202-5647

In re Application of:	Murphy, John	:	DECISION GRANTING
Application No.:	60/265582	:	PETITION
Filed:	February 2, 2001	:	
Attorney Docket No.:	12008 (11580.02)	:	

This is a decision on the petition under 37 CFR 1.53(c)(3), received in the Patent and Trademark Office on February 1, 2002, to convert the above identified application to a non-provisional application under 35 U.S.C. 111 (a) and 37 CFR 1.53(c)(3).

The previous decision is reversed and the petition is granted. Upon further review of the petition, the claim required by 37 CFR 1.53(c)(3) was, in fact, included with the petition papers.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application serial number is **10/166,318**. The filing receipt for the non-provisional application will be mailed in due course.

Janice Tippett

Janice Tippett, Program Assistant
Office of Initial Patent Examination
(703) 308-0910

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

MAY 19 2006

OFFICE OF PETITIONS

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

In re Application of John E. Murphy Application No. 10/166,318 Filed: February 1, 2002 Attorney Docket No. 11580.02	: : : : :	DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed November 16, 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 CFR § 1.136(a).

The request was signed by Lee R. Osman, on behalf of all attorneys or agents who are associated with Customer Number 20686.

All attorneys/agents associated with the Customer Number 20686 have been withdrawn.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of an intervening assignee of the entire interest under 37 CFR 3.71. All future communications from the Office will be directed to the sole inventor at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed April 21, 2006 that requires a reply from the applicant.

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

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Denise Pothier

cc: John E. Murphy
340 Yellowroot Lane
Atlanta, GA 30350

Mr. Michael D. Ewing
Predict, Inc.
91 Washington Street
Morristown, NJ 07960

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

July 23, 2002

Paper # 5

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

In re Application of:	Forstner, et. al.	:	DECISION GRANTING
Application No.:	60/382711	:	PETITION
Filed:	May 22, 2002	:	
Attorney Docket No.:	3477.98PR	:	

This is a decision on your petition under 37 CFR 1.53(c)(3), received in the Patent and Trademark Office on July 9, 2002, to convert the above identified application to a non-provisional application under 35 U.S.C. 111 (a) and 37 CFR 1.53(b).

The petition is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application serial number is **10/166,319**. The filing receipt for the non-provisional application will be mailed in due course.

Janice Tippett, Program Assistant
Office of Initial Patent Examination
(703) 308-0910

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO
60/298,768	06/15/2001	Sumita B. Mitra	55554USA89.002

Attention: MarySusan Howard
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

CONFIRMATION NO.
OC000000008948839

Date Mailed: 10/15/2002

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **06/14/2002,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,321.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE L. TIPPETT
Office of Initial Patent Examination
(703) 308-0910

PART 2 - OFFICE COPY

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

ATTN: MARYSUSAN HOWARD
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

COPY MAILED

FEB 10 2003

OFFICE OF PETITIONS

In re Application of	:
Sumita B. Mitra et al	:DECISION DISMISSING
Application No. 10/166,321	:PETITION UNDER 37 CFR
Filed: June 15, 2001	:1.78(a)(3) AND 37 CFR
Attorney Docket No. 55554USA89.005	:1.78(a)(6)

This is a decision on the petition, filed November 12, 2002, which is being treated both as a petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 119(e) and 120 for the benefit of priority to nonprovisional Application No. 09/589,216, filed June 7, 2000, and provisional Application No. 60/138,365, filed June 10, 1999.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. §§ 119(e) and 120 and 37 CFR 1.78(a)(2)(i)and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;[1]

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition lacks item (1) above.

The "Preliminary Amendment," filed concurrently with the instant petition, contains the following language:

Cross Reference to Related Applications

This application **claims the benefit** of U.S. Application No. 09/589,216, filed June 7, 2000, now U.S. Patent No. 6,331,539 B1, which claims the benefit of Provisional Application No. 60/138,365, filed on June 10, 1999 [emphasis supplied].

The claim for benefit of the above-noted prior-filed applications cannot be entered at this time. In this regard, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) **and indicating the relationship of the applications**. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed ---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed ---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each

---

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).

nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. *See* Manual of Patent Examining Procedure (8th ed., August 2001), Section 201.11, Reference to First Application.

If nonprovisional Application No. 09/589,216, filed June 7, 2000, and provisional Application No. 60/138,365, filed June 10, 1999, which are the subject of the instant petition, are merely related applications, a mere cross reference to these related applications should be included in the specification following the title of the invention.

A further review of Office computer database records indicates that there is a lack of common inventorship between the instant nonprovisional application and the nonprovisional and provisional applications noted in the amendment submitted concurrently with the instant petition. The statute requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. § 119(e) or 120 be filed by an inventor or inventors named in the prior-filed nonprovisional or provisional application.

For the above-noted reasons, the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) cannot be granted.

If reconsideration of this decision is desired, and in order to expedite consideration thereof, petitioner may wish to submit the renewed petition by facsimile transmission to the number indicated below and to the attention of the undersigned.

The instant petition was accompanied by an "Associate Power of Attorney." However, since there is no indication in the file record that a principal attorney was ever duly appointed to represent the applicant herein, the Associate Power of Attorney has not been entered.

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

By mail: U.S. Patent and Trademark Office
P.O. Box 2327
Mail Stop DAC
Arlington, VA 22202

OR

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

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

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

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

This application is being forwarded to the Office of Initial Patent Examination for pre-examination processing.

Frances Hicks

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

Conferree: Joni Chang Joni Y. Chang

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

TED K. RINGSRED
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
3M INNOVATIVE PROPERTIES COMPANY
P O BOX 33427
ST. PAUL, MN 55133-3427

COPY MAILED

MAR 2 5 2003

OFFICE OF PETITIONS

In re Application of	:
Stephen L. Crooks et al	:DECISION ON PETITION
Application No. 10/166,321	:UNDER 37 CFR 1.78(a)(3) AND
Filed: Juen 15, 2001	:UNDER 37 CFR. 1.78(a)(6)
Attorney Docket No. 55554US005	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 28, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/589,216, filed June 7, 2000, and on 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 priority to prior-filed provisional Application No. 60/138,365, filed June 10, 1999.

The petition is **GRANTED**.

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;[1]

(2) the surcharge set forth in § 1.17(t); and

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

[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).

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 15, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

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]
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on June 15, 2001. Additionally, prior-filed nonprovisional Application No. 09/589,216, to which the instant nonprovisional application claims priority, was filed within twelve months of the filing date of prior-filed provisional Application No. 60/138,365, which was filed on June 10, 1999, and for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(5)(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 and provisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(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 and 119(e). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 119(e) to the prior-filed applications satisfies the conditions of 37 CFR 1.78(a)(3) and 1.78(a)(6), the petition is granted.

---

[2] Any nonprovisional application claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference (i.e., in an amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed provisional application, identifying it as a provisional application, and including the application number (consisting of the series code and serial number).

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

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

On February 28, 2003, a copy of the previously filed executed declaration, which names as inventors Stephen L. Crooks and Bryon A. Merrill was received, along with a stamped return post card which acknowledges receipt of, *inter alia*, an "Executed Declaration." The file record does not contain the executed declaration acknowledged as having been received in the USPTO on November 12, 2002. However, in view of the evidence submitted, the executed declaration will be accepted as having been received on November 12, 2002.

The Associate Power of Attorney filed on November 12, 2002 has been accepted and will be entered in due course.

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

This application is being forwarded to the Office of Initial Patent Examination for pre-examination processing. Afterwards, the application will be forwarded to Technology Center AU 1614 for examination in due course and and consideration by the Examiner of applicant's claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to prior-filed nonprovisional Application No. 09/589,216, filed June 7, 2000, and for consideration under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (5) for the benefit of prior-filed provisional Application No. 60/138,365, filed June 10, 1999.

Frances Hicks

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

ATTACHMENT: Corrected Filing

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

September 17, 2002

Paper # 3

Buchanan Ingersoll, P.C.
Once Oxford Centre
301 Grant Street, 20th Floor
Pittsburg PA 15219-1410

In re Application of:	Hart, James E.	:	DECISION GRANTING
Application No.:	60/302319	:	PETITION
Filed:	June 29, 2001	:	
Attorney Docket No.:	000574	:	

This is a decision on your petition under 37 CFR 1.53(c)(3), received in the Patent and Trademark Office on June 20, 2002, to convert the above identified application to a non-provisional application under 35 U.S.C. 111 (a) and 37 CFR 1.53(b).

The petition is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application serial number is **10/166,323**. The filing receipt for the non-provisional application will be mailed in due course.

Janice Tippett, Program Assistant
Office of Initial Patent Examination
(703) 308-0910

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 08-00

Paper No. 7

COPY MAILED

JUL 1 4 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

ARNOLD WHITE & DURKEE
P O BOX 4433
HOUSTON , TX 77210

In re Application of :
Yu et al. :
Application No. 60/082,242 :
Filed: 20 May, 1998 :
Attorney Docket No. UTSC:532/PAR :

ON PETITION

This is a decision on the petition under 37 CFR 1.182 filed on 23 February and 26 July, 1999, to convert the above-identified provisional application to a nonprovisional application under 35 U.S.C. § 111(a) and 37 CFR 1.53(b)(1).

Petitioners allege that the present application was intended to be filed as a nonprovisional application under 35 U.S.C. § 111(a) and 37 CFR 1.53(b)(1), but that the transmittal letter included with the application papers filed on 20 March, 1998, inadvertently indicated that a provisional application was being filed. A Notice to File Missing Parts of Provisional Application was mailed on 28 June, 1999, requiring the provisional application cover sheet and a $50.00 surcharge for its late filing. Petitioner filed the Provisional Application Cover Sheet and the required surcharged on 2 August, 1999. The present petition was initially filed on 23 February, 1999.[1]

Petitioners assert that the application papers filed on 20 March, 1998, are complete for filing date purposes under 35 U.S.C. § 111(a) and 37 CFR 1.53(b)(1) and that conversion is necessary in order for petitioners to claim the benefits under 35 U.S.C. § 120 of their previously filed provisional applications.

[1]Effective 29 May, 2000, 37 CFR 1.53(c)(3) provides that a provisional application may be converted to a nonprovisional application must be accompanied by a petition fee of $130.00 and must be filed prior to the earliest of:
(I) Abandonment of the provisional application; or
(ii) Expiration of twelve months after the filing date of the provisional application.
65 Fed. Reg. 14,865, 14,871 (2000) (to be codified at 37 CFR 1.53(b)(3).

A review of the application papers filed on 20 March, 1998, confirms that the papers are complete for filing date purposes under 35 U.S.C. § 111(a) and 37 CFR 1.53(b)(1).

A provisional application is not entitled to claim priority benefits based on any other application under 35 U.S.C. §§ 190, 120, 121, or 365.[2] Therefore, conversion is necessary in this case in order to allow petitions to claim the benefits available under 35 U.S.C. § 120.

The petition is granted.

It is also noted that the application was filed on 20 March, 1998, without an oath or declaration as required by 37 CFR 1.63. An oath or declaration in compliance with 37 CFR 1.63 and the $130.00 surcharge set forth in 37 CFR 1.16(e) are required.

Petitioner's deposit account, No. 01-2508, will be charged the $130.00 petition fee required by law for the present petition.

The application is being returned to the Office of Initial Patent Examination (OIPE) for reprocessing as a **NONPROVISIONAL** application under 35 U.S.C. § 111(a) and 37 CFR 1.53(b)(1) including the assignment of a new nonprovisional application number.[3]

The new nonprovisional application number will be communicated to applicants by OIPE.

After the new nonprovisional application number has been assigned, OIPE will mail the appropriate notice setting a time period for applicants to file the oath or declaration, the $690.00 basic filing fee, and the $130.00 surcharge. Fees paid in the provisional application are not refundable. [4]

---

[2]MPEP 201.04(b); 35 U.S.C. § 111(b)(7).

[3]Petitioner has requested that this application be re-assigned Application No. 09/045,731, which was originally assigned to this application in error. The application number assigned to an application, however, is exclusively within the discretion of the Office. Therefore, an application number will be assigned in accordance with Office rules and procedures.

[4]In accordance with 37 CFR 1.53(c)(3) as amended 29 May, 2000, the conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. 65 Fed. Reg. 14,865, 14,871 (2000) (to be codified at 37 CFR 1.53(b)(3).

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at (703) 308-6918.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO
60/082,242	03/20/1998	YINHUA YU	UTSC:532/PAR

CONFIRMATION NO.

OC000000008948836

ARNOLD WHITE & DURKEE
P O BOX 4433
HOUSTON, TX 77210

Date Mailed: 10/15/2002

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **02/23/1999,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,325.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE L. TIPPETT
Office of Initial Patent Examination
(703) 308-0910

PART 2 - OFFICE COPY

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4/30/07

TO SPE OF : ART UNIT 1616

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/166325 Patent No.: 7183401 B1

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

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

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

Virginia Tolbert

Certificates of Correction Branch

703-308-9390 ext. 113

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

Gary Benzion 1646

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

MILTON ROBERT KESTENBAUM
11011 BERMUDA NE
ALBUQUERQUE, NM 87111

MAILED

MAR 06 2009

OFFICE OF PETITIONS

In re Application of	:	
David R. Shafer, et. al.	:	
Application No. 10/166,332	:	DECISION ON PETITION
Filed: December 10, 2001	:	TO WITHDRAW
Attorney Docket No. (Z) P40557 US	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 22, 2006.

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

A review of the file record indicates that the power of attorney to MILTON ROBERT KESTENBAUM has been revoked by the assignee of the patent application on August 18, 2006. Accordingly, the request to withdraw under 37 CFR 1.36(b) is moot.

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

Telephone inquiries concerning this decision should be directed to Denise Williams at 571-272-8930.

Carl Friedman
Petitions Examiner
Office of Petitions

cc: SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON DC 20037

UNITED STATES
PATENT AND
TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 2023[illegible]
www.uspto.gov

APPLICATION NUMBER	FILING RECEIPT DATE	FIRST NAMED APPLICANT	[illegible]
60/277,448	03/21/2001	Richard Bernstein	0267-1596 (41912.017700)

CONFIRMATION NO.

OC000000009009364

Paul J. Sutton, Esq.
GREENBERG TRAURIG, LLP
21st Floor
885 Third Avenue
New York, NY 10022

Date Mailed: 10/25/2002

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **03/21/2002,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,337.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE L. TIPPETT
Office of Initial Patent Examination
(703) 308-0910

PART 1 - ATTORNEY/APPLICANT COPY

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

NEEDLE & ROSENBERG P C
127 PEACHTREE STREET N E
ATLANTA GA 30303-1811

COPY MAILED

OCT 0 3 2002

OFFICE OF PETITIONS

In re Application of
Chiorini, et al.
Application No. 60/381,180
Filed: May 17, 2002
Attorney Docket No.
14014.0402U1

DECISION GRANTING
PETITION

This is a decision on the petition under 37 CFR 1.53(b)(3) filed August 8, 2002 (certificate of mailing date July 31, 2002), to convert the above-identified provisional application to a nonprovisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The petition is **GRANTED**.

A review of the application papers filed on May 17, 2002, confirms that the papers are complete for filing date purposes under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The Office acknowledges receipt of an executed declaration, filing fees, and a surcharge for the late filing of the declaration.

The application is being returned to the Office of Initial Patent Examination (OIPE) for reprocessing as a **NONPROVISIONAL** application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), <u>including the assignment of a new nonprovisional application number</u>.

The new nonprovisional application number will be communicated to applicants by OIPE.

Any inquiries pertaining to this matter may be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.

Brian Hearn
Special Projects 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

BALLARD SPAHR ANDREWS &
INGERSOLL, LLP
SUITE 1000
999 PEACHTREE STREET
ATLANTA GA 30309-3915

COPY MAILED

JUL 3 1 2008

OFFICE OF PETITIONS

In re Application of	:	
Chiorini et al.	:	DECISION ON APPLICATION
Application No. 10/166,347	:	FOR
Filed: May 17, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No. 14014.0402U1	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(B) and 37 C.F.R. § 1.705," filed December 31, 2007. Applicants request that the patent term adjustment at the time of the mailing of the Notice of Allowance be corrected from three hundred five (305) days to seven hundred sixty (760) days.

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

However, 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 TWO HUNDRED TWENTY-ONE (221) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 25, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term

adjustment (PTA) to date is 305 days. The instant application for patent term adjustment was timely filed.[1]

Applicants assert that a PTA adjustment of 455 days should be given for office delay in failing to issue an Office action or Notice of Allowance within four (4) months of the filing of a response to a non-final Office action on February 27, 2006.

Applicants are incorrect. 37 CFR § 1.702(a)(2) provides that failure to respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four (4) months after the date on which the reply was filed or the appeal was taken is a ground for adjustment of patent term due to examination delay. See also 37 CFR 1.703(a)(2). A review of the record confirms that in response to their response filed February 27, 2006, on May 18, 2006, the Office mailed a notification pursuant to 35 U.S.C. 132. As stated in the final rule, an action issued as a result of the examination conducted pursuant to 35 U.S.C. 131 is a notification under 35 U.S.C. 132. The action issued May 18, 2006, was such an action. As this action was issued within the four (4) month period provided for in 37 CFR 1.702(a)(2), there was no Office delay within the meaning of 37 CFR 1.702(a)(2). Entry of a period of adjustment of 455 days for Office delay is not warranted.

It is noted that upon issuance of the patent, a period of adjustment will be entered for the Office's failure to issue the patent within three (3) years.

A review of the record also reveals a further basis for entry of a period of reduction for applicant delay. 37 CFR 1.704(c)(5) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in 1.703 to the extent that the periods are not overlapping:

> Conversion of a provisional application under 35 U.S.C. 111(b) to a nonprovisional application under 35 U.S.C. 111(a) pursuant to 35 U.S.C. 111(b)(5), in

[1] PALM records show the issue fee payment was also received on December 31, 2007.

> which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date the application was filed under 35 U.S.C. 111(b) and ending on the date a request in compliance with § 1.53(c)(3) to convert the provisional application into a nonprovisional application was filed.

On May 17, 2002, the subject application was filed as a provisional application. On August 8, 2002, eighty-four (84) days after the application was filed, a request to convert the application from a provisional application to a nonprovisional application was filed. Accordingly, the patent term adjustment will be reduced by 84 days for applicant delay.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is TWO HUNDRED TWENTY-ONE (221) days (442 days of PTO delay, reduced by 221 (5+92+40+84) days of Applicant delay).

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

The application is being forwarded to the 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.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of adjusted PAIR calculation

Day : Wednesday

PALM INTRANET

Date: 7/30/2008
Time: 17:22:08

PTA Calculations for Application: 10/166347			
Application Filing Date:	05/17/2002	PTO Delay (PTO):	442
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	137
Post-Issue Petitions:	0	Total PTA (days):	221
PTO Delay Adjustment:	-84		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
67	07/28/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		84	
59	09/25/2007	MAIL NOTICE OF ALLOWANCE			
58	09/25/2007	MAIL EXAMINER'S AMENDMENT			
57	09/24/2007	ISSUE REVISION COMPLETED			
56	09/24/2007	DOCUMENT VERIFICATION			
55	09/24/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
54	09/24/2007	EXAMINER'S AMENDMENT COMMUNICATION			
53	09/17/2007	NOTICE OF ALLOWABILITY			
52	12/26/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
46	12/26/2006	REFERENCE CAPTURE ON IDS			
45.7	12/26/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
45	12/26/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
44	06/08/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
43	05/18/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
42	05/15/2006	MISCELLANEOUS ACTION WITH SSP			
41	03/08/2006	DATE FORWARDED TO EXAMINER			
40	02/27/2006	RESPONSE AFTER NON-FINAL ACTION		40	38
39	02/27/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
38	10/18/2005	MAIL NON-FINAL REJECTION			
37	10/17/2005	NON-FINAL REJECTION			
36	08/09/2005	DATE FORWARDED TO EXAMINER			

35	08/01/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
34	06/28/2005	MAIL RESTRICTION REQUIREMENT			
33	06/27/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
32	04/13/2005	DATE FORWARDED TO EXAMINER			
31	04/08/2005	RESPONSE AFTER NON-FINAL ACTION		92	28
30	03/28/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
29	01/18/2005	DATE FORWARDED TO EXAMINER			
28.1	01/06/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
28	01/06/2005	RESPONSE AFTER NON-FINAL ACTION		5	26
27	01/06/2005	WORKFLOW INCOMING AMENDMENT IFW			
26	10/01/2004	MAIL NON-FINAL REJECTION	442		-1
25	09/30/2004	NON-FINAL REJECTION			
24.7	08/04/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	08/04/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	01/16/2004	CASE DOCKETED TO EXAMINER IN GAU			
22	12/02/2003	TRANSFER INQUIRY TO GAU			
21	11/04/2003	APPLICATION DISPATCHED FROM OIPE			
20	11/04/2003	APPLICATION IS NOW COMPLETE			
19	07/03/2003	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM			
17	07/03/2003	APPLICANT HAS SUBMITTED A NEW SPECIFICATION TO CORRECT CORRECTED PAPERS PROBLEMS			
16	04/29/2003	CORRECTED PAPER			
15	01/30/2003	CLEARED BY L&R (LARS)			
14	01/27/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
13	01/15/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
12	12/12/2002	PRE_EXAM CONVERSION			
11	06/18/2002	PRE-EXAM OFFICE ACTION WITHDRAWN			
10	12/12/2002	APPLICATION RETURN TO OIPE			
9	10/03/2002	MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO FILING DATE			
8	08/25/2002	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS			
7	08/08/2002	PETITION ENTERED			
6	06/19/2002	APPLICATION DISPATCHED FROM OIPE			

5	06/18/2002	APPLICATION IS NOW COMPLETE			
4	06/05/2002	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
3	06/04/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	05/31/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	05/17/2002	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.

Back to OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Frank C. Eymard
ADAMS and REESE LLP
4500 One Shell Square
701 Poydras Street
New Orleans, LA 70139

COPY MAILED
MAR 1 2 2004
OFFICE OF PETITIONS

In re Application of
Robert M. Adams
Application No. 10/166,348
Filed: November 9, 2001
Attorney Docket No. 931-104

ON PETITION

This is a decision on the petitions under 37 CFR 1.137(a) and 37 CFR 1.137(b), filed February 27, 2004, to revive the above-identified application.

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

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

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

The above-identified application became abandoned for failure to reply to the "Notice to File Corrected Application Papers" mailed February 3, 2003, which set a shortened period for reply of two (2) months from its mailing date. No response was received within the allowable period, and the application became abandoned on April 4, 2003.

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

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

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

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

The instant petition lacks item (3).

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

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

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

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

The standard

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

---

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

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

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

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

[7]Id.

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

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner argues that the notice was not received because of a change in the correspondence address of the attorney of record when the notice was mailed and because petitioner also changed the attorney of record around the time the notice was mailed.

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

Petitioner maintains that the previous attorney of record for the subject application was Shawn Sentilles and that, in October of 2002, Mr. Sentilles left the law firm of Adams and Reese, LLP. The facts do not indicate that the power of attorney to Mr. Sentilles was revoked at that time or that the correspondence address for Mr. Sentilles was changed in the records of the Patent and Trademark Office. The facts, as presented by petitioner, further indicate that Frank Eymard filed a communication in the subject application in November of 2002, but the facts do not indicate that Mr. Eymard was given power of attorney at that time, or that the correspondence address of record was changed to that of Mr. Eymard. A review of the application file does reveal that a revocation of the power of attorney to Mr. Sentilles was not filed until February 18, 2003, but that the Notice to File Corrected Application Papers was mailed on February 4, 2003, while Mr. Sentilles was still attorney of record.

Section 601.03 of the *Manual of Patent Examining Procedure* ("MPEP")explains that applicants are required to provide a correspondence address to which all correspondence from the Patent and Trademark Office will be mailed. Implicit in this requirement is an obligation of the applicant to promptly notify the Office when the correspondence address has changed. There is no indication that petitioner made an attempt to promptly notify the Office of Mr. Sentilles new

---

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

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

address when Mr. Sentilles left the Adams and Reese, LLP. Further, petitioner did not promptly seek to revoke the power of attorney to Mr. Sentilles and appoint Mr. Eymard. Section 711.03 of the MPEP explains, in pertinent part, that

> ... where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant . . .)an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement of prompt notification in each concerned application of the change of address (see MPEP 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application . . .

In light of the aforementioned, the delay in responding to the Notice to File Corrected Application Papers cannot be said to be unavoidable as petitioner did not provide prompt notification of the change of address of Mr. Sentilles and did not provide prompt notification of the revocation of Mr. Sentilles' authority in the subject application and the appointment of Mr. Eymard.

TREATMENT UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is granted.

Deposit account 50-2413 will be charged $665.00 for the fee for the petition under 37 CFR 1.137(b) and $55.00 for the petition under 37 CFR 1.137(a).

The replacement drawings filed February 27, 2004, are noted and made of record.

The application file will be forwarded to the Office of Initial Patent Examination for further processing.

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

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
60/378,556	05/07/2002	David A. Lewin	10716/69

CONFIRMATION NO.

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

OC000000009239189

Date Mailed: 12/13/2002

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **11/19/2002,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,349.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE L TIPPETT
Office of Initial Patent Examination
(703) 308-0910

PART 2 - OFFICE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
60/330,076	10/19/2001	Ronald Breaker	044574-5048-P2

CONFIRMATION NO.

OC000000009240990

009629
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date Mailed: 02/28/2003

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **10/11/2002,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,352.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE LITTPETT
Office of Initial Patent Examination
(703) 308-0910

PART 2 - OFFICE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

MAILED

OCT 26 2009

OFFICE OF PETITIONS

In re Application of	:	
Nnochiri N. Ekwuribe, et al.	:	
Application No. 10/166,355	:	DECISION GRANTING PETITION
Filed: November 8, 2002	:	UNDER 37 CFR 1.313(c)(1)
Attorney Docket No. 014811-174.64IP	:	

This is a decision on the petition under 37 CFR 1.313(c)(1), filed October 23, 2009 and supplemented October 26, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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 request for continued examination in compliance with 37 CFR 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

The petition complies with the requirements of 37 CFR 1.313(c)(1). Accordingly, the above-identified application is withdrawn from issue.

Petitioner is advised that the issue fee paid in this application 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. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

The application is being referred to Technology Center AU 1654 for consideration of the amendment submitted with the petition.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
60/404,857	08/21/2002	Ruxandra Draghia-Akli	AVSI-0024 (108328.67)

CONFIRMATION NO.

OC000000009575621

Jackson Walker L.L.P.
Suite 600
2435 N. Central Expressway
Richardson, TX 75080

Date Mailed: 02/28/2003

DECISION GRANTING REQUEST TO CONVERT TO NON-PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(3) received in the U.S. Patent and Trademark Office on **09/11/2002,** to convert the above-identified application to a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

The request is granted.

The application will be processed in the Office of Initial Patent Examination (OIPE) as a non-provisional application under 35 U.S.C. 111(a) and 37 CFR 1.53(b), including the assignment of a new non-provisional application number.

The non-provisional application number is **10/166,356.** The filing receipt for the non-provisional application number will be mailed to the applicant by OIPE in due course.

JANICE A. TIPPETT
Office of Initial Patent Examination
(703) 308-0910

PART 2 - OFFICE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Yukiko Iwata
Shell Oil Company
Legal - Intellectual Property
P. O. Box 2463
Houston TX 77252-2463

COPY MAILED

JAN 06 2005

OFFICE OF PETITIONS

In re Application of :
Doll, et al. :
Application No. 10/166,402 : ON PETITION
Filed: June 10, 2002 :
Attorney Docket No. TH1642 (US) :
For: PROCESS FOR THE ISOMERIZATION OF A VINYLIDENE OLEFIN

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed October 15, 2004 (certificate of mailing date October 11, 2004), to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application, application no. 60/300,043, set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR §1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR §1.76(a)(6), petitioners have submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application.

The instant pending nonprovisional application was filed on June 10, 2002, and was pending at the time of filing of the instant petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter and declaration filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR §1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition

will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim priority under § 37 CFR 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed application in the declaration filed with the application, as shown by its inclusion on the filing receipt dated July 15, 2002.

In view of the above, the $130.00 fee submitted is unnecessary and will be refunded to petitioners' deposit account in due course.

Any questions concerning this decision on petition may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The examiner of Technology Center AU 1764 will take appropriate action on the amendment filed October 15, 2004 (certificate of mailing date October 11, 2004), including consideration of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) of the claim for benefit of the prior-filed application.

Frances Hicks

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

---

[1] *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

VERTEX PHARMACEUTICALS INCORPORATED
130 WAVERLY STREET
CAMBRIDGE, MA 02130-4646

COPY MAILED

DEC 2 1 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Golec et al.	:	
Application No. 10/166,437	:	
Filed: June 10, 2002	:	
Attorney Docket No. VPI/99-113 US	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 26, 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) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 081304

DEC 28 2004

Richard L. Miller
12 Parkside Dr.
Dix Hills, NY 11746-4879

In re Application of:
Anthony P. Campione
Serial No.: 10/166,485
Filed: June 10, 2002
Attorney Docket No.: **CAMA32A**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102(c), filed September 5, 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 birth certificate for the inventor, Anthony P. Campione, showing that he is sixty-five (65) years of age or more.

Accordingly, the petition is GRANTED.

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

Inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

Edward Westin

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEHR LAW FIRM
GOLDENWEST CORPORATE CENTER
SUITE 300
5025 ADAMS AVENUE
OGDEN, UT 84403

COPY MAILED

FEB 1 1 2008

OFFICE OF PETITIONS

In re Application of :
Ralph S. Norman, et al. :
Application No. 10/166,498 : DECISION ON PETITION
Filed: June 10, 2002 :
Attorney Docket No. PNORMR-FDDC :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 10, 2007, to revive 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 November 21, 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 December 22, 2006. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief, (2) the petition fee of $750, and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3683 for appropriate action by the Examiner in the normal course of business on the reply received September 10, 2007.

April M. Wise
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

FEHR LAW FIRM
GOLDENWEST CORPORATE CENTER
SUITE 300
5025 ADAMS AVENUE
OGDEN, UT 84403

COPY MAILED

AUG 1 0 2009

OFFICE OF PETITIONS

In re Application of	:	
Ralph S. Norman, et al.	:	
Application No. 10/166,498	:	DECISION ON PETITION
Filed: June 10, 2002	:	
Attorney Docket No. PNORMR-FDDC	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 5, 2009, to revive the above-identified application.

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 August 15, 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 September 16, 2008. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief and fee, (2) the petition fee of $810, and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries 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.

This application is being referred to Technology Center AU 3683 for appropriate action by the Examiner in the normal course of business on the reply received September 10, 2007.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 01-06

Paper No: __

OSTROLENK FABER
GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

COPY MAILED

JAN 30 2006

OFFICE OF PETITIONS

In re Application of	:	
Labrie	:	
Application No. 10/166,506	:	DECISION
Filing Date: 10 June, 2002	:	
Attorney Docket No. P/1259-688	:	

This is a decision on the renewed petition filed on 19 December, 2005, as a request to withdraw 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 **GRANTED**.

BACKGROUND

The record reflects that:

- it appeared Petitioner failed to reply timely and properly to the non-final Office action mailed on 27 April, 2005, with reply due absent extension of time on or before 27 July, 2005;
- thus, the application went abandoned after midnight 27 July, 2005;
- the Office mailed the Notice of Abandonment on 16 November, 2005;
- notably, the record also reflects that Petitioner filed on 31 October, 2005, *inter alia*, over a 27 October, 2005, certificate of mailing, a reply to the Office action in the form of an amendment and a request and fee for a three- (3-) month extension of time–also of note is

that the Office charged as authorized the extension of time to Deposit Account 15-0700;

- an interview summary of 16 November, 2005, contemporaneous with the Notice of Abandonment suggests that the Examiner was unaware of the 31 October, 2005, filing;

- on 19 December, 2005, Petitioner filed the instant petition, evidencing therewith the facts and documents set forth above, and with a copy of the date-stamped ("OIPE OCT 31 2005") receipt card evidencing Office receipt of the reply timely submitted.

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.

---

[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.

(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]))

As to a Request to Withdraw
the Holding of Abandonment

Petitioner alleges timely reply to the Office action, and supports the allegation with the above-referenced documentation.

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

Petitioner satisfied the showing required under Delgar and thus to be considered under the provisions of 37 C.F.R. §1.181.

CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **granted**, the Abandonment of 16 November, 2005, having been improvidently entered hereby is **withdrawn**.

The instant application is released to Technology Center 1600 for further processing in due course.

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

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

---

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

COPY MAILED
OCT 17 2006
OFFICE OF PETITIONS

In re Application of	:	
R. Raymond May	:	
Application No. 10/166,565	:	DECISION GRANTING PETITION
Filed: June 10, 2002	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 38866/239532	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 7, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to file a proper and timely reply[1] to the non-final Office action mailed October 25, 2004, which set a three month shortened statutory period for reply. A three month extension of time was obtained pursuant to the provisions of 37 CFR 1.136(a). Accordingly, the date of abandonment of this application is April 26, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply (a continuing application), (2) the $1,500 petition fee, and (3) the required statement of unintentional delay have been received. Accordingly, the filing of a proper reply to the non-final Office action of October 25, 2004 is accepted as having been unintentionally delayed.

The petition is not accompanied by a statement of express abandonment in favor of the filing of a continuing application. In order to facilitate action, the petition to revive should include reference to the filing of a continuing application and a letter of express abandonment conditional upon the granting of

[1] The filing of a Request for Continued Application under 37 CFR 1.114 on April 25, 2005 was an improper reply to the non-final Office action of October 25, 2004. Accordingly, the $790 fee submitted therefor will be refunded to petitioner's deposit account in due course.

the petition and of a filing date to the continuing application. Nevertheless, in view of the filing of continuing application papers, this will be construed as a request to expressly abandon this application in favor of the granting of a filing date to the continuing application. Accordingly, this application is revived solely for the purpose of continuity with continuing Application No. 11/541,515. Therefore, as continuity has been established by the revival of this application, this application is again abandoned in favor of the continuing application. If this was not the intent of applicant, the Office should be promptly notified.

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

Paper No. 9

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

COPY MAILED

DEC 0 8 2003

OFFICE OF PETITIONS

In re Application
George William et al
Application No. 10/166,570
Filed: June 10, 2002
Attorney Docket No. 130.053US1

: LETTER

This is in response to the paper filed November 28, 2003, which is being treated as a petition under 37 CFR 1.28(b) requesting that status as a Small Entity be removed.

In accordance with the November 28, 2003 request, status as a Small Entity has been removed.

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
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306.**

This file is being forwarded to Technology Center AU 2663.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(703) 306-5684

UNITED STATES PATENT AND TRADEMARK OFFICE

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

The Halvorson Law Firm
Ste 1
405 W. Southern Ave.
Tempe, AZ 85282

COPY MAILED

SEP 2 9 2008

OFFICE OF PETITIONS

In re Application of
Morris Mann, et.. al.
Application No. 10/166,587
Filed: June 5, 2002
Attorney Docket No. 529-025

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 3, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the Non-Final Rejection mailed, September 19, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136 (a) were obtained. Accordingly, the application became abandoned on December 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).

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

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

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

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

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

As to Period (1):

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

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (2.5 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on December 20, 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 The Halvorson Law Firm was counsel of record at the time of abandonment, they should explain why this application became abandoned while it was under their control and what efforts they made to further reply of itself and with whom this matter was discussed. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), and whoever else was involved with this application at the time of abandonment. Statements are required from any and all person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (2.5 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at The Halvorson Law Firm and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

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

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

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

Any renewed petition may be addressed as follows:

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

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

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

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

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to Denise Williams at (571) 272-8930.

for
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

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

COPY MAILED

SEP 08 2005

OFFICE OF PETITIONS

In re Application of	:	
Ikuta, et al.	:	DECISION ON APPLICATION FOR
Application No. 10/166,594	:	PATENT TERM ADJUSTMENT
Filed: June 12, 2002	:	
Atty. Dkt. No.: 4284.0861	:	

This is a decision on the "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) " filed June 29, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **GRANTED**.

The Office will adjust the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance and Issue Fee Due reflects an adjustment of 17 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicants request that the Determination of Patent Term Adjustment be corrected from zero days as indicated on the Determination of Patent Term Adjustment mailed March 30, 2004 to an adjustment of 17 days.

Applicants argue that the adjustment of 92 days should be reduced 75 days for applicant's failure to engage in reasonable efforts to conclude prosecution.

A review of the application history reveals under 37 CFR 1.702(a)(1), an adjustment of 92 days can be attributed to the Office for failure to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed. In accordance with 37 CFR 1.703(a)(1), the delay began August 13, 2003, the day after the date that is fourteen months after the date on which the application was filed, and ending November 12, 2003, the date a restriction requirement was mailed.

The Office errantly entered January 16, 2003 as the date a reply to the Notice to File Missing Parts (Notice) was filed rather than December 30, 2002, the date a reply was filed.

Thus, at the time of allowance, the adjustment of 92 days is reduced 75 days in accordance with 37 CFR 1.704(b) for applicants' failure to engage in reasonable efforts to conclude prosecution. The reduction began October 17, 2002, the day after the date that is three months after the date the Notice was mailed, and ended December 30, 2002, the date a reply was filed.

Thus, at the time of Allowance, the application was entitled to an adjustment of 17 days as argued by applicants.

Receipt of the required application fee of $200.00 is hereby acknowledged.

The application file is being forwarded to the Publications Division for issuance of a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

Karin A Ferriter
per

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

Enclosure: Copy of Adjustment PAIR Calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

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

POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON VA 20191

COPY MAILED

AUG 23 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Koji Sato et al	:	
Application No. 10/166,605	:	
Filed: June 12, 2002	:	
Attorney Docket No. 12-021	:	

This is a decision on the petition, filed August 22, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on June 7, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2673 will consider the request for continued examination under 37 CFR 1.114.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

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

COPY MAILED

JAN 25 2007

OFFICE OF PETITIONS

Patent No. 7,076,111	:	LETTER REGARDING
Issue Date: July 11, 2006	:	PATENT TERM ADJUSTMENT
Application No. 10/166,621	:	AND
Filed: June 12, 2002	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. 00862.022503	:	CERTIFICATE OF CORRECTION

This is in response to the COMMENTS ON DETERMINATION OF PATENT TERM ADJUSTMENT filed August 28, 2006. Pursuant to patentees' duty of good faith and candor to the Office, patentees disclose that the Patent Term Adjustment noted on the cover page of the patent is potentially greater than that to which the patent may be entitled.

The request for reconsideration of patent term adjustment indicated in the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of seven hundred eighty-three (783) days.

On July 11, 2006, this application matured into U.S. Patent No. 7,076,111, with a revised patent term adjustment of 804 days. Patentees disclose an incorrect Patent Term Adjustment on the basis that the Office treated an Information Disclosure Statement (IDS) filed December 13, 2005 as filed on January 19, 2006.

A review of the record reveals that an IDS was filed on December 13, 2005 and a copy of the IDS with a request to initial the IDS was filed on January 19, 2006. Pursuant to § 1.704(c)(8), a period of reduction of 50 days, not 51 days, should have been entered for applicant delay in filing an IDS on December 13, 2005 after having filed a response to the Office action on October 2005. There should not have been a reduction of 29 days for the filing of a request to initial the IDS as after the mailing of the notice of allowance was patentees' first opportunity to address this matter. The period of reduction associated with the IDS is corrected from 29 days to 50 days.

In view thereof, the patent should have issued with a revised patent term adjustment of seven hundred eighty-three (783) days.

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by SEVEN HUNDRED EIGHTY-THREE (783) days.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,076,111 B2

DATED : July 11, 2006

INVENTOR(S) : Shimbata

DRAFT

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (804) days

Delete the phrase "by 804" and insert – by 783 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 06-06

Paper No: __

OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

COPY MAILED

JUN 12 2006

OFFICE OF PETITIONS

In re Application of	:	
Lu	:	
Application No. 10/166,648	:	ON PETITION
Filed: 12 June, 2002	:	
Attorney Docket No. 224330US	:	

This is a decision on a petition filed on 16 December, 2005, under 37 C.F.R. §1.137(b).

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

BACKGROUND

The record indicates:

- Petitioner failed to reply timely to the final Office action mailed on 7 October, 2004, with reply due absent an extension of time on or before 7 January, 2005;

- Petitioner replied with a Notice of Appeal and fee (with request and fee for extension of time) on 7 March, 2005, and then a request for continued examination (RCE) under 37 C.F.R. §1.114 with fee and a submission in the form of an IDS (with request and fee for extension of time) on 7 October, 2005, however, the RCE was improper because there was no amendment in reply to the final rejection to advance prosecution as required under the rule;

- the application went abandoned by operation of law after midnight 7 October, 2005;

- the Office mailed the Notice of Abandonment on 7 November, 2005;
- Petitioner filed the instant petition on 16 December, 2005, with fee, a submission for the RCE in the form of an amendment, and made the statement of unintentional delay–thus, Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

STATUTES, REGULATIONS AND ANALYSIS

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

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

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

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

---

[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
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and–where appropriate–a terminal disclaimer and fee.

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

CONCLUSION

Because Petitioner appears to have satisfied the regulatory requirements, regulation, the petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to the Examiner in Technology Center 1600 for further processing in due course.

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 01/04/07

TO SPE OF : ART UNIT

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/166657** Patent No.: **7079700**

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

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

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

Angela Green
Certificates of Correction Branch
703.308.9380 ext. 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** 2624

00862.022504 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	)	Examiner: V. Bali
HIROYUKI SHINBATA	)	Group Art Unit: 2624
Appl. No.: 10/166,657	)	Confirmation No. 6562
Filed: June 12, 2002	)	
For: IMAGE FORMING APPARATUS, IMAGE PROCESSING METHOD, STORAGE MEDIUM, AND PROGRAM	)	
U.S. Patent No.: 7,079,700 B2	)	
Issued: July 18, 2006	)	December 28, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF CORRECTION
UNDER RULES 322 AND 323

Sir:

It is respectfully requested that a Certificate of Correction be issued by the Patent and Trademark Office due to errors which appear in the printed patent as a result of Patent and Trademark Office mistakes and mistakes of a clerical, typographical, or minor character, which were not the fault of the Patent and Trademark Office.

Please charge Deposit Account No. 50-3939 the $100.00 fee for the Certificate of Correction.

Patentee's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Lock See Yu-Jahnes/
Lock See Yu-Jahnes
Attorney for Patentee
Registration No.: 38,667

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

NY_MAIN 608917v1

Staple Here Only!

PRINTER'S TRIM LINE

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,079,700 B2

DATED : July 18, 2006

INVENTOR(S) : HIROYUKI SHINBATA

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

[75] INVENTOR

"Hiroyuki Shinbata, Yochigi (JP)" should read --Hiroyuki Shinbata, Tochigi (JP)--.

REFERENCES CITED

Foreign Patent Documents
"JP 9-212623 A 8/1987" should read --JP 9-212623 8/1997--.

COLUMN 3

Line 9, "overshoot," (second occurrence) should read --undershoot,--.

COLUMN 15

Line 58, "x'(2xn)=s'(n)-floor((d'(nx1)+d'(n))/4" should read
--x'(2xn)=s'(n)-floor((d'(n-1)+d'(n))/4--.

COLUMN 16

Line 37, "newlimage" should read --new image--.

COLUMN 21

Line 17, "∂F1(X)/∂X" should read --∂F1(*X*)∂*X*--.

COLUMN 28

Line 23, "To" should be deleted.

MAILING ADDRESS OF SENDER:

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
(212) 218-2100 - Telephone
(212) 218-2200 - Facsimile

PATENT NO. 7,079,700 B2

No. of add'l. copies @ 30¢ per page

⇨ _____

Form PTO 1050 (Rev. 3-82)
(Form#30)

Staple Here Only!

PRINTER'S TRIM LINE

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,079,700 B2

DATED : July 18, 2006

INVENTOR(S) : HIROYUKI SHINBATA

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

COLUMN 34

Line 39, "*fprc*(*x*, *y*)=*f*(*x*, *y*)+*F*0(*f*(*x*, *y*)x*fh*1(*x*, *y*)" should read --*fprc*(*x*, *y*)=*f*(*x*, *y*)+*F*0(*f*(*x*, *y*))x*fh*1(*x*, *y*)--.

COLUMN 37

Line 57, "f((x, y))" should read --f(x, y)--.
Line 62, "has" should read --have--.

COLUMN 40

Line 58, "x'(2xn+1)=d(n)+floor((x'(2xn)+x'(2xn+2))/2)" should read --x'(2xn+1)=d'(n)+floor((x'(2xn)+x'(2xn+2))/2)--.

COLUMN 45

Line 2, "values," should read --value,--.

MAILING ADDRESS OF SENDER:
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
(212) 218-2100 - Telephone
(212) 218-2200 - Facsimile

PATENT NO. 7,079,700 B2

No. of add'l. copies @ 30¢ per page

Form PTO 1050 (Rev. 3-82)
(Form#30)

Staple Here Only!

PRINTER'S TRIM LINE

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,079,700 B2

DATED : July 18, 2006

INVENTOR(S) : HIROYUKI SHINBATA

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

COLUMN 49

Line 8, "processed," should read --processed--.

NY_MAIN 608918v1

MAILING ADDRESS OF SENDER:

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
(212) 218-2100 - Telephone
(212) 218-2200 - Facsimile

PATENT NO. 7,079,700 B2

No. of add'l. copies @ 30¢ per page

Form PTO 1050 (Rev. 3-82)
(Form#30)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 08 2005

OFFICE OF PETITIONS

In re Patent No. 6,738,550	:	
Issued: May 18, 2004	:	
Application No. 10/166,724	:	PATENT TERM ADJUSTMENT
Filed: June 12, 2002	:	
Dkt. No.: 040268-0171	:	

This is a decision on the "PETITION TO CORRECT PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR 1.705," filed June 17, 2004. This matter is being properly addressed under 37 CFR 1.705(d) as an application for patent term adjustment.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(d) is **GRANTED AS INDICATED HEREIN**. The Office will issue a certificate of correction to reflect that the final PTA determination is 91 days.

The above-identified application matured into U.S. Patent No. 6,738,550 on May 18, 2004. The instant request for reconsideration was timely filed June 17, 2004 in accordance with 37 CFR 1.705(d). The Determination of Patent Term Adjustment under 35 USC 154(b) indicated a PTA of 123 days. The patent issued with a PTA of 47 days. The required application fee was submitted herewith.

Applicant requests that the Determination of Patent Term Adjustment be corrected from the 47 days determination indicated on the letters patent to a determination of 61 days.

The Office initially determined a PTA of 123 days. An adjustment of 133 days for Office delays was reduced 10 days at the time of mailing of Notice of Allowance.

The adjustment was errantly reduced an additional 76 days for applicants' failure to engage in reasonable efforts to conclude prosecution in accordance with 37 CFR 1.704(c)(10) for submission of a priority claim on March 4, 2004. The adjustment, however, should have been reduced 42 days for submission of the priority claim. The delay began March 4, 2004, the day the claim was submitted, and ended April 14, 2004, the day the Office mailed the Priority Acknowledgement.

Thus, the adjustment of 133 days for Office delays is reduced a total of 52 days for applicant's failure to engage in reasonable efforts to conclude prosecution under 37 CFR 1.704.

It is noted that applicant herein requests reconsideration of the 10 days reduction relating to applicant's response to the Notice to File Missing Parts of Nonprovisional Application mailed June 28, 2002. Unfortunately, applicant's request is untimely. In accordance with 37 CFR 1.704(d), any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under 37 CFR 1.705(b) shall be dismissed as untimely as to those issues.

In view thereof, at the time of issuance, applicant was entitled to a patent term adjustment of 91 days.

This application file is being forwarded to the Certificate of Corrections branch for issuance of a certificate of correction indicating that subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 91 days. No additional fees are 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.

Karin Ferriter for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 22 2005

OFFICE OF PETITIONS

In re Patent No. 6,738,550	:	
Issued: May 18, 2004	:	
Application No. 10/166,724	:	DECISION REGARDING PTA
Filed: June 12, 2002	:	
Atty. Dkt. No.: 040268-0171	:	

This decision is in response to the "PETITION TO CORRECT PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR 1.705," filed June 17, 2004, requesting that the above-identified patent be accorded a patent term adjustment of 61 days rather than the presently accorded adjustment of 47 days. This request for reconsideration of patent term adjustment will be considered under 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **GRANTED IN PART**.

The Office will sua sponte issue a Certificate of Correction noting that the amount of PTA is 91 days.

The patent issued with a PTA of 47 days[2]. The Office failed to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application in accordance with 37 CFR 1.702(a)(1). Therefore, an adjustment of 133 days was accorded under 37 CFR 1.703(a)(2).

The adjustment of 133 days was reduced ten days for applicant's failure to engage in reasonable efforts to conclude prosecution with respect to a response filed in response to a Notice to File Missing Parts of Nonprovisional Application ("Notice"). Applicant herein contests the ten days reduction on the grounds that applicant's response to the Notice was timely submitted. Applicant is advised that applicant's request for reconsideration of the ten days reduction is untimely within the meaning of 37 CFR 1.705(d). Supra. Such contestation should have been submitted at or prior to submission of the issue fee

[2] An adjustment of 133 days for Office delays was reduced 86 days at the time of issuance of the patent.

payment and therefore will not be addressed herein. See, 37 CFR 1.704(b).

The adjustment of 133 days is further reduced 42 days for applicant's late submission of a priority document on March 4, 2004. Applicant acknowledges that the late submission of the priority document is in fact a failure to engage in reasonable efforts to conclude prosecution within the meaning of 37 CFR 1.704(c)(10). Applicant, however, believes the reduction should be 72 days rather than 76. It must be presumed that applicant has erred in calculating the period of reduction.

Submission of a priority document after a Notice of Allowance has been mailed or given constitutes a failure to engage in reasonable efforts to conclude prosecution. See, 37 CFR 1.705(c)(10), MPEP 2737, and 1247 O.G. 111 (June 26, 2001).

Accordingly, any adjustment under 37 CFR 1.703 shall be reduced by the lesser of (1) the number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (2) four months.

The reduction herein began March 4, 2004, the date the priority document was filed, and ended April 14, 2004, the date the patent issued. Hence, the adjustment of 133 days is further reduced 42 days.

Accordingly, the patent term adjustment is 91 days, rather than the 47 days shown on the letters patent.

Applicant is given one (1) month to request reconsideration of this decision. The period of time for reconsideration is not extendible under 73 CFR 1.136(a) or 37 CFR 1.136(b).

Receipt is acknowledged of the required application fee of $200.00.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3202.

Karin Ferriter

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

OCT 25 2007

OFFICE OF PETITIONS

In re Application of	:	
Shaoxiang Lu et al	:	
Application No. 10/166,760	:	DECISION ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. 224303US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 5, 2007, to revive the above-identified application.

The petition is **GRANTED.**

A request for continued examination was filed in this application on February 26, 2007, after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. As the request filed on February 26, 2007 lacked the submission required by 37 CFR 1.114, the appeal is withdrawn. Since the proceedings as to the rejected claims are considered terminated, and no claim is allowed, the application is considered abandoned as of the date on which the appeal was withdrawn. Accordingly, this application became abandoned on February 26, 2007. *See* MPEP 1215.01.

This application became abandoned as a result of petitioner's failure to file a proper reply following the filing of a Notice of Appeal on October 26, 2006. On February 26, 2007, applicant filed a Request for Continued Examination and fee therefor, along with a two month extension of time. However, as the RCE was not accompanied by a submission, the Appeal was dismissed. Accordingly, the date of abandonment of this application is February 27, 2007. A Notice of Abandonment was mailed on July 12, 2007.

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) a proper statement of unintentional delay.

Accordingly, the failure to file a proper and timely reply is accepted as being unintentionally delayed.

This application is being referred to Technology Center AU 1615 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 received July 5, 2007.

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

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 06-04

Paper No: 5

DR. MARK FRIEDMAN LTD.
C/O BILL POLKINGHORN
DISCOVERY DISPATCH
9003 FLORIN WAY
UPPER MARLBORO MD 20772

COPY MAILED
JUN 1 7 2004
OFFICE OF PETITIONS

In re Application of
Baratz, et al. :
Application No. 10/166,761 :
Filing Date: 12 June, 2002
Attorney Docket No. 1988/4 :

This is a decision on the petition filed on 28 April, 2004, as a request to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.

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

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the Notice to File Corrected Application Papers (the Notice) mailed on 15 July, 2002, with reply due absent extension of time on Monday, 16 September, 2002;
- a result, the application was deemed abandoned after midnight 15 September, 2002;
- Notice of Abandonment was mailed on 22 January, 2004;
- with the instant petition Petitioner Mark Friedman (Reg. No. 33,883) included, *inter alia*: his statement pointing alleging non-receipt of the Notice, with a complete discussion of the international transmittal docketing methodology used by him, and copies of hand and computerized docketing data reflecting non-receipt of the Notice;

- Petitioner did not submit with the petition a reply to the 15 July, 2002, Notice, and does not address the delay between the mailing of the Notice of Abandonment (22 January, 2004) and Petitioner's filing of the instant petition (28 April, 2004).

NOTES: (1) Docketing of a Status Inquiry at six- (6-) month intervals following the filing of papers/replies may be prudent practice to demonstrate diligence when lengthy delays occur in matters such as this.

(2) Petitioner hereby is reminded and will not be reminded further of the two- (2-) month deadline set forth in the regulations at 37 C.F.R.§1.181.

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]

---

[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).

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 evidences that the Notice was not received, and so satisfies the showing as required under 37 C.F.R. §1.181.

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 22 January, 2004, Notice of Abandonment is **vacated**, and the petition fee is waived.

A copy of the 15 July, 2002, Notice is enclosed herewith, and Petitioner has two (2) months within which to file a proper reply. Extensions of time are available under the provisions 37 C.F.R. §1.136.

The file is being returned to OIPE to await Petitioner's timely and proper reply and further processing, before being forwarded for examination in due course.

---

[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).

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

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

Encl: Copy of the15 July, 2002, Notice

IFW

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/166762

Paper No.: _____

DATE : 1-12-04

TO SPE OF : ART UNIT 1615

SUBJECT : Request for Certificate of Correction on Patent No.: 6,958,155

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

Palm location **7580** - Tel. No. 305-8309

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

Check claims

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:

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE

1615

Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

COPY MAILED
OCT 0 2 2006
OFFICE OF PETITIONS

In re Patent No.	:	
6,978,963	:	
Application No. 10/166,765	:	DECISION GRANTING PETITION
Filing Date: June 12, 2002	:	
Issue Date: December 27, 2005	:	
Attorney Docket No. 020776	:	

This is a decision on the petition under 37 CFR 1.182, filed May 17, 2006, requesting issuance of duplicate Letters of Patent for the above-identified patent.

The petition is **granted.**

The file record discloses that the instant application matured into U.S. Patent No. 6,978,963 on December 27, 2005.

In view of the facts set forth in the petition, it is concluded that the patent was never received at the correspondence address of record. The Publishing Division is directed to issue duplicate Letters of Patent.

Any questions concerning this decision may be directed to the undersigned at (571)272-3222. Any questions concerning issuance of the duplicate Letter of Patent should be directed to Krystal Paige at (703) 308-9250, extension 139.

A copy of this decision is being forwarded to the Publishing Division for issuance of a duplicate Letter of Patent.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc: Krystal Paige, P/OPPD/ST 8C32, (Fax 571-273-9756)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JAN 05 2004

OFFICE OF PETITIONS

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

In re Application of
Yutaka Matsunobu, et al.
Application No. 10/166,768
Filed: June 12, 2002
Attorney Docket No. 381AS/49216CO

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 29, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on December 12, 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OLIFF & BERRIDGE PLC
P O BOX 19928
ALEXANDRIA, VA 22320

COPY MAILED

OCT 0 7 2005

OFFICE OF PETITIONS

In re Application of
Eiji Natori et al
Application No. 10/166,781
Filed: June 12, 2002
Attorney Docket No. 113008

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

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

The petition is **GRANTED**.

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

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

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

This matter is being referred to Technology Center AU 1771 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), 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). Additionally, any balance due or the amount due at the time of payment must be submitted to avoid the abandonment of the application.*

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OCT 20 2005

CHARLES E. BAXLEY, ESQ.
90 JOHN STREET
THIRD FLOOR
NEW YORK, NY 10038

Paper No. 6

In re Application of
CHEN, TSAI-CHING
Appl No.: 10/166,788
Filed: June 11, 2002

DECISION GRANTING PETITION
37 CFR 1.181

This application is before the Director of Technology Center 3700 for reconsideration of the Notice of Abandonment mailed October 15, 2004. In view of the statements in the letter of October 29, 2004, the submission is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-identified application. No fee is required.

The petition is granted.

In support of the request, petitioner has submitted a copy of a response and a copy of a PTO stamped post card receipt dated December 11, 2003.

In view of the above, the Notice of Abandonment mailed October 15, 2004 is in error and is hereby vacated. The holding of abandonment is withdrawn. This application is being forwarded to the Technical Support Staff to return the application to an active status and for entry of the amendment. The application will then be forwarded to the examiner for appropriate action.

Summary: Holding of Abandonment Withdrawn.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JAN 29 2007

Technology Center 2100

Jack Friedman
SCHMEISER, OLSEN & WATTS
22 Century Hill Drive
Suite 302
Latham, NY 12110

In re Application of: Michael J. SPISAK
Application No.: 10/166,839
Filed: June 11, 2002
Attorney Docket No.: END920010128US1
For: WEB ACCESSIBILITY ASSISTANT

DECISION ON PETITION *UNDER 37 CFR §1.181*

This is a decision on the petition filed February 22, 2006 under 37 CFR §1.181(a), for withdrawal of the Final Rejection as premature. The delay in responding to the instant petition is regretted.

A review of the file record indicates that a Notice of Allowance was been mailed in the instant application on October 30, 2006.

Accordingly, in view of the above stated reason, the instant petition, filed under 37 CFR §1.181(a) to invoke supervisory authority to withdraw the Final Rejection mailed February 14, 2006, is rendered moot.

Accordingly, the petition is **DISMISSED as MOOT**.

The due date for payment of the issue fee remains as set forth in PTOL-85, notice of allowance and fee(s) due (i.e. January 30, 2007). Telephone inquiries should be directed to the undersigned at 571-272-3595.

Brian L. Johnson
Workgroup Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software, and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

COPY MAILED

JUL 16 2009

OFFICE OF PETITIONS

In re Application of
Pat HAVERKOST, et al.
Application No. 10/166,842
Filed: June 11, 2002
Attorney Docket No. **S63.2B-14391-US01**

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 16, 2009.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to **HOFFMANN & BARON, LLP** has been revoked by the assignee of the patent application on May 5, 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 the undersigned at 571-272- 7253.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **VIDAS, ARRETT & STEINKRAUS, P.A.**
6640 SHADY OAK ROAD, SUITE 400
EDEN PRAIRIE, MN 55344

UNITED STATES 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. 30205

TRAIAN CHERCIU
426 DE WITT AVE.
BELLEVILLE NJ 07109

MAR 3 2005

In re Application of:
Traian Cherciu
Serial No.: 10/166,847
Filed: June 11, 2002
For: **BASIC MAGNETIC RADIATION - METHODS AND MOTOR**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102(c), filed January 21, 2005, 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 III: Applicant's Health, Section IV: Applicant's Age, Section V: Environmental Quality and Section VI: Energy.

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 from Traian Cherciu stating that the he is sixty-five (65) years of age or more. In addition, a copy of driver's license for Traian Cherciu is included as evidence.

Accordingly, the petition is GRANTED.

The petitions to make the application special under Sections III, V and VI are moot in view of the above.

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.

Inquiries regarding this decision should be directed to Clayton LaBalle at (571) 272-1594.

Clayton E. LaBalle, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

R. Kent Roberts
Hodgson Russ LLP
One M&T Plaza, Suite 2000
Buffalo, NY 14203-2391

COPY MAILED

MAR 20 2003

OFFICE OF PETITIONS

In re Application of
Dmitri Korobkov, Randy Howell and Alex Dolgonos
Application No.10/166,872
Filed: June 11, 2002
Attorney Docket Number: 35683.0new

ON RENEWED PETITION

This is in response to the renewed petition under 37 CFR 1.47(a), filed December 16, 2002 (certificate of mailing December 9, 2002) and supplemented with an executed declaration on February 3, 2003.

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

This application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Michael P. Hartmann
Cooper Cameron Corp
P. O. Box 1212
Houston, TX 77251-1212

COPY MAILED

APR 2 9 2005

OFFICE OF PETITIONS

In re Application of :
Timothy J. Allen, et al. :
Application No. 10/166,879 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. OTD-030326-US :

This is a decision on the petition under 37 CFR 1.137(b), filed March 14, 2005, to revive the above-identified application.

The petition is **GRANTED**.

A "Notice of Allowance and Issue Fee Due" was mailed to applicant on November 22, 2005, which set a three-month shortened statutory period for reply. Since the issue fee was not timely paid, the application became abandoned on February 23, 2005.

The Office acknowledges receipt of the issue fee, which was submitted with the instant petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to the Publishing Division to be processed into a patent.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEB 24 2004

#5

THORP, REED & ARMSTRONG, LLP
ONE OXFORD CENTRE
301 GRANT STREET, 14TH FLOOR
PITTSBURGH, PA 15219-1425

In re Application of	:
Pei-Lin Wu et al	:
Serial No.: 10/166,918	: PETITION DECISION
Filed: June 11, 2002	:
Attorney Docket No.: DB001037-000	:

This is in response to the petition under 37 CFR 1.181, filed September 22, 2003, requesting withdrawal of abandonment based on timely filing of a reply. 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 January 14, 2003, setting a one month shortened statutory period for reply. Upon failure to receive a reply the application was held abandoned by Notice of Abandonment mailed September 9, 2003. Applicants state that a reply was submitted on February 12, 2003, and provide an Office date stamped postcard evidencing receipt thereof on February 19, 2003. In view of the evidence presented, the Notice of Abandonment is withdrawn and the application restored to pending status with the mailing of this decision.

The petition is GRANTED.

The application will be forwarded to the examiner for further consideration.

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

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
PO BOX 37428
RALEIGH, NC 27627

COPY MAILED

AUG 3 0 2002

OFFICE OF PETITIONS

In re Application of
John H. Hebrank
Application No. 10/166,919
Filed: June 10, 2002
Attorney Docket No. 5175-148

DECISION ON PETITION

This is a decision on the "Petition under 37 CFR §1.10(e)," filed August 5, 2002, requesting that the above-identified application be accorded a filing date of June 10, 2002, rather than the presently accorded filing date of June 11, 2002.

Petitioner maintains that on June 10, 2002, the application was deposited as "Express Mail" in the U.S. Postal Service. In support thereof, applicant submits the following documents, which they state are true and accurate[1] copies:

- the Cover Sheet for the Application showing the Express Mail signature and date on Page 2;
- the Express Mail Pickup Service Statement dated June 10, 2002; and
- the official United States Postal Service (USPS) Track and Confirm page, confirming deposit with the USPS at 7:06 pm on June 10, 2002.

Paragraph (a) of 37 CFR 1.10 states that:

> Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. <u>The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation</u>. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See §1.6(a).
>
> (Emphasis supplied).

---

[1] The Cover Sheet presented does not appear to be a true and accurate copy of the cover sheet as originally filed with the Office. Specifically, the Cover Sheet submitted on petition includes on page 2 above and to the right of the certificate of express mailing the Express Mail number, as it would be set forth on the peelable portion of an Express Mail mailing label. This is of little consequence inasmuch as the Express Mail number is also set forth in the certificate of mailing.

Paragraph (c) of 37 CFR 1.10 states that:

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

The instant petition was filed promptly within the meaning of §1.10(c)(1). A review of the application papers presently accorded a filing date of June 11, 2002, reveals that "Express Mail" mailing label No. EV015663880US was placed on the papers prior to the original mailing.

Petitioner's arguments and evidence have been considered, but have not been found entirely persuasive. The petition does not include a true copy of the "Express Mail" mailing label showing a "date-in" of June 10, 2002. Although the Express Mail Pickup Service Statement is dated June 10, 2002, this entry date was made by an employee of petitioner and not by the USPS employee. The portion of the Statement that would be prepared by the USPS employee is blank. Further, petitioner has not submitted a copy of the Corporate Account Monthly Statement corresponding to this statement and which the Office has indicated is the type of evidence found corroborating.

Nonetheless, the "Shipment History" submitted states that the package was "ENROUTE, June 10, 2002, 7:06 pm" and thereby, corroborates petitioner's claim of deposit on June 10, 2002. Given this evidence, the requirement for a copy of the Express Mail mailing label is *sua sponte* waived.

In view thereof, the petition is GRANTED.

As the petition fee submitted is not required, it has been refunded to Deposit Account No. 50-0220, as authorized.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for correction of the filing date to June 10, 2002.

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

Nancy Johnson

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7-20-06

TO SPE OF : ART UNIT 2825

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/166924 Patent No.: 7039893

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

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

Please check claims

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

[signature]

Certificates of Correction Branch

703-308-9390 ext. 117

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: The corrections for figure 14 & Col. 7 & 8 of the specification are Approved. The corrections to the claims in Col. 27 & 28 are denied. They are not necessary because claims 5-11 were renumbered & these corrections are trying to undo the renumbering

[signature]

JACK CHIANG

SUPERVISORY PATENT EXAMINER

SPE

2825

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.

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT
(K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

COPY MAILED
SEP 14 2006
OFFICE OF PETITIONS

In re Patent No. 6,982,251	:	
Ghosal et al.	:	LETTER REGARDING
Issue Date: January 3, 2006	:	PATENT TERM ADJUSTMENT
Application No. 10/166,942	:	and
Filed: June 11, 2002	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No. CV01364K1	:	CERTIFICATE OF CORRECTION

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed March 1, 2006. Pursuant to patentees' duty of good faith and candor, patentees disclose that they believe the correct patent term adjustment is eighty-three (83) days, not two hundred five (205) days.

The request for correction of the patent term adjustment indicated in the patent is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one hundred forty-two **(142)** days.

On January 3, 2006, the above-identified application matured into U.S. Patent No. 6,982,251, with a revised Patent Term Adjustment of 205 days. Given the following grounds for reduction, patentees disclose that the revised PTA should be 83 days:

1. Patentees disclose that an Information Disclosure Statement (IDS) was filed on December 1, 2003 after an amendment in response to a non-final Office action was filed on September 29, 2003. Patentees acknowledge that this paper was not expressly requested by the examiner. Accordingly, patentees disclose that a period of reduction of 63 days pursuant to 37 CFR 1.704(c)(8) should have been entered for the filing of this paper.

2. Likewise, patentees disclose that an IDS was filed on April 15, 2004 after an amendment in response to a final Office action was filed on April 8, 2004. Patentees again acknowledge that this paper was not expressly requested by the examiner. Accordingly, patentees disclose that a period of reduction of 7 days pursuant to 37 CFR 1.704(c)(8) should have been entered for the filing of this paper.

3. Finally, patentees disclose that a supplemental amendment was filed on January 22, 2004 after an amendment in response to a non-final Office action was filed on September 29, 2003. Patentees again acknowledge that this paper was not expressly requested by the examiner. Accordingly, patentees disclose that a period of reduction of 115 days pursuant to 37 CFR 1.704(c)(8) should have been entered for the filing of this paper.

As for the reduction of 63 days disclosed by patentees, the application file has been reviewed and it is concluded that patentees are correct with respect to their characterization of the basis for and amount of the reduction. A period of reduction of 63 days has been entered.

However, with respect to the other periods of reduction, patentees are incorrect. It is acknowledged that an IDS was filed on April 15, 2004 after the filing of a response on April 8, 2004 and the IDS was neither expressly requested by the examiner nor filed with a §1.704(d) statement. Nonetheless, a reduction is not warranted for the filing of this paper because it is not a supplemental response within the meaning of §1.704(c)(8). A response in compliance with 1.113(c) was not filed until May 11, 2004 after the filing of the IDS. As such,

the IDS is not a supplemental response. Accordingly, entry of a period of reduction of 7 days is not warranted.

As to the January 22, 2004 supplemental amendment cited by patentees, a careful review of the file history does not reflect the submission of an amendment on January 22, 2004 (nor do the subsequent Office actions state that they are responding to such a filing). Patentees do not supply a copy of this amendment on instant petition. Accordingly, entry of a reduction of 120 days is not warranted. To the extent that patentees have knowledge that such a paper was in fact filed in this application, out of good faith and candor to the Office, patentees should further respond to this letter with such knowledge.

In view thereof, the patent should have issued with a revised patent term adjustment of 142 days.

As this letter was submitted as an advisement to the Office of errors in Patentees' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The fee submitted is being refunded to Deposit Account No. 23-0650, as authorized. The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one hundred forty-two (142) days.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,982,251 B2

DATED : January 3, 2006

INVENTOR(S) : Ghosal et al.

DRAFT

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (205) days

Delete the phrase "by 205" and insert – by 142 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT
(K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

COPY MAILED

MAR 05 2007

OFFICE OF PETITIONS

In re Patent No. 6,982,251	:	
Ghosal et al.	:	LETTER REGARDING
Issue Date: January 3, 2006	:	PATENT TERM ADJUSTMENT
Application No. 10/166,942	:	
Filed: June 11, 2002	:	
Attorney Docket No. CV01364K1	:	

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed October 17, 2006.

By decision mailed September 14, 2006, a prior REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSMENT UNDER 37 C.F.R. § 1.705(d) filed March 1, 2006 was granted in part.

In response to that decision, patentees file the instant paper to clarify the status of a Supplemental Amendment faxed by Applicant on January 22, 2004 to the Examiner.

This request for reconsideration is **GRANTED** to the extent that it requests reconsideration of the prior decision mailed September 14, 2006, and is **DISMISSED** to the extent it requests any revision of the prior decision.

Patentees' comments have been considered. In view thereof, the following comments are made: The image file wrapper of the application is the Official record of the papers filed in the application. Patentees are advised that no "Supplemental Amendment" with a date of receipt of January 22, 2004 is in the record of this application. Thus, no amendment is considered filed in this application on January 22, 2004. The amendment first appears in the prosecution of the application (including

in the contents of the application on April 23, 2004) with a date of receipt of April 23, 2004 and a cover sheet that says PLEASE HAND DELIVER and itemizes the contents of the previously attempted facsimile. There is no confirmation that the facsimile was successfully transmitted on January 22, 2004. Moreover, this is after the entry of an amendment on April 8, 2004. (So if the examiner had had possession of the facsimile it should have been entered before the April 8, 2004 amendment). Given the prosecution history of this case, it is appropriate to treat the amendment as received on April 23, 2004.

Moreover, the scanning of the Supplemental Amendment on April 23, 2004 would not impact the calculation of patent term adjustment. After the mailing of a final Office action on February 24, 2004:

- on April 8, 2004, applicants filed an amendment;
- on April 15, 2004, applicants filed an IDS;
- on April 23, 2004, applicants filed an amendment;
- on May 11, 2004, applicants filed an amendment.

The period for reply to the final Office action continued to run until an amendment in compliance with § 1.113(c), was filed on May 11, 2004. As the May 11, 2004 amendment was filed within the three-month period provided in 1.704(b), no period of reduction was entered.

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

A Certificate of Correction implementing the decision of September 14, 2006 was issued on November 28, 2006.

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. 5

B G COLLEY
6305 SILVER LAKES DR W
LAKELAND, FL 33810

COPY MAILED

DEC 10 2004

OFFICE OF PETITIONS

In re Application of :
Merton Dibble et al :
Application No. 10/166,954 :
Filed: June 11, 2002 :
Attorney Docket No. C-1010 :

ON PETITION

This is a decision on the petition, filed September 20, 2004, which is being treated as a petition 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.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the non-final Office action mailed April 23, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 24, 2003.

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 items (1), (2) and (3).

A petition to revive cannot be granted where there are outstanding requirements. In the instant case, there was no response to the non-final Office action mailed April 23, 2003. Petitioner must respond to the outstanding Office action. As to item 2, petitioner must submit the petition fee. Effective December 8, 2004, the Petition to Revive Unintentionally Abandoned Application Fee is $750 (small entity) or $1500 (large entity). 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. Enclosed is a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.37(b) Form. Accordingly, the petition to revive cannot be granted until such time as the outstanding requirements are received.

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

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

By mail: Mail Stop 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

cc:

B G Colley
2800 Morgan Ct., Apt. 203
Birmingham, AL 35216-3080

Attachments: Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) Form and Correspondence Address Indication Form.

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

ELLEN SEIN AYE
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

COPY MAILED

NOV 0 8 2002

OFFICE OF PETITIONS

In re Application of
Min-Chung Chou
Application No. 10/166,978
Filed: June 11, 2002
Attorney Docket No. 14058-004001/
0356-7417U

DECISION ON PETITION

This is a decision on the "Response to Notice of Omitted Items in a Nonprovisional Application," filed September 16, 2002. This petition is properly treated as a petition under 37 C.F.R. § 1.53(e)(2)[1]. Petitioner requests that the Office accord the above-identified application a filing date of June 11, 2002, with Figures 8, 9 & 10 as a part of the original application disclosure.

Application papers in the above-identified application were filed on June 11, 2002. However, on July 12, 2002, the Office of Initial Patent Examination mailed applicant a "Notice of Omitted Item(s) in a Nonprovisional Application." Applicant was notified that the application papers had been accorded a filing date; however, figures 8, 9 and 10 described in the specification appeared to have been omitted.

In response, applicant timely filed the instant petition (and petition fee)(certificate of mailing September 10, 2002). Applicant maintains that the application was complete as filed on June 11, 2002, including figures 8, 9 and 10. In support thereof, applicant submitted *inter alia* a copy of their return postcard from the USPTO. Petitioner also submitted a copy of figures 8, 9 and 10 as originally filed.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. A review of petitioner's postcard receipt reveals that: 1) it was date stamped as received in the USPTO on June 11, 2002, and the papers submitted therewith were assigned application No. 10/166,978; 2) it specifically identifies the items being filed, including

---

[1] § 1.53(e) Failure to meet filing date requirements .
(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

"Drawings (formal, 9 sheets)" and 3) it lacks any annotation of nonreceipt of any item denoted on the postcard. Thus, petitioner has shown that the items denoted, including 9 sheets of drawings, were filed on June 11, 2002.

The six drawing sheets received in the Office on June 11, 2002, were reviewed along with the missing figures submitted on petition. These papers together constitute the items described on the postcard receipt as "Drawings (formal, 9 sheets)." Petitioner has shown that figures 8, 9 and 10 were among the items present in the application on the date of deposit and should be included in the original application disclosure.

Accordingly, the petition is **GRANTED**.

Given the basis for granting the petition under § 1.53(e)(2), the petition fee is subject to refund. Accordingly, although authorized, the petition fee will not be charged to Deposit Account No. 06-1050.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of June 11, 2002, using the application papers received in the Office and presently accorded that date; and figures 8, 9 and 10 supplied on petition filed September 16, 2002;
- and indication in Office records that 9 sheets of drawings were present in the application on filing.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

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

for D Wood

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

KLARQUIST SPARKMAN, LLP
One World Trade Center
Suite 1600
121 S.W. Salmon Street
Portland OR 97204

COPY MAILED
JAN 07 [illegible]
OFFICE OF PETITIONS

In re Application of
Croteau, et al.
Application No. 10/166,984
Filed: June 10, 2002
Attorney Docket No. 4630-62267
For: TRANSACYLASES OF THE PACLITAXEL BIOSYNTHETIC PATHWAY

ON PETITION

This is a decision on the petition filed September 23, 2002 (certificate of mailing date September 18, 2002), requesting, in effect, partial withdrawal of a Notice mailed July 18, 2002.

The application was filed on June 10, 2002. However, on July 18, 2002, The Office of Initial Patent Examination mailed a "Notice to File Missing Parts of Nonprovisional Application" (Notice) stating, *inter alia*, that the application had been accorded a filing date of June 10, 2002, and advising applicant that figures 8A-8B and 21A-21B appeared to have been omitted.

In response, the present petition was filed. Petitioners argue that the drawings should be included with the papers filed on June 10, 2002, because (1) they are not new matter and (2) they were originally filed in prior application No. 09,866,572, the entire disclosure of which was incorporated by reference at the time of filing.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items 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 items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an 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 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 drawings were actually deposited in the PTO on June 10, 2002 with the other application papers nor request a later filing date.

Instead, applicants seek to add the figures to the present application on the basis that the figures are not new matter. However, no petition is necessary for that purpose. Additional figures may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

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

If applicants desire that figures 8A-8B and 21A-21B be added to the application, the appropriate procedure is by way of amendment requesting the entry of the figures. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the Office.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 10, 2002. Drawing figures 8A-8B and 21A-21B will not be processed at this time.

Thereafter, the application will be forwarded to Technology Center 1600 for examination in due course.

Telephone inquiries specific to this matter 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
www.uspto.gov

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

COPY MAILED

AUG 1 5 2003

OFFICE OF PETITIONS

Applicant: Croteau et al.
Appl. No.: 10/166,984
Filing Date: June 10, 2002
Title: TRANSACYLASES OF THE PACLITAXEL BIOSYNTHETIC PATHWAY
Attorney Docket No.: 4630-62267
Pub. No.: US 2003/0108891 A1
Pub. Date: June 12, 2003

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), which was received via facsimile transmission on July 10, 2003, for the above-identified application.

The request is granted.

The error has been corrected in the Office's system and a Corrected Filing Receipt has been mailed. To avoid this type of problem in the future, applicant's representative should request a corrected filing receipt using the facsimile number (703-746-9195) on the Filing Receipt.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
10/166,986	06/10/2002	Daniel M. Marks	10759-3U2	6489

570 7590 02/25/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER
HARRISON, JESSICA

ART UNIT	PAPER NUMBER
3714	3

DATE MAILED: 02/25/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

In re Application of	:
Daniel M. Marks, et al.	: DECISION ON PETITION
Application No. 10/166,986	:
Filed: June 10, 2002	:
Attorney Docket No. 10759-3U2	

This is a decision on the petition filed on June 10, 2002 by which petitioner requests entry of color drawings for certain drawing figures. The $130.00 petition fee has been received.

The petition is denied.

As discussed at MPEP § 608.02, subsection entitled "Color Drawings or Color Photographs", a petition to permit the use of color drawings or color photographs will be granted only when it is determined that color drawings or color photographs are "the only practical medium by which to disclose in a printed utility patent the subject matter to be patented." While a review of the petition shows that petitioner has described the invention as including display screens which present complex game graphics to a user, and have asserted that no approved drafting symbols exist to graphically illustrate the manner of operation of the games, petitioner has not demonstrated that it is necessary to include color drawings in order to disclose the claimed invention (subject matter to be patented). From a review of the application and the pending claims, it appears that the concepts disclosed, as well as the claimed subject matter, can be described through the use of language, and if it is regarded by petitioner as being necessary pursuant to 37 CFR 1.83, the use of appropriate mechanical drawing convention to indicate the use of color. See MPEP § 608.02, Eighth Ed., Rev. 1 at page 600-95.

As there is no showing that color drawings are necessary as the being the only practical medium by which to disclose the subject matter to be patented, there is no basis for granting the request to include color drawings or photographs. Therefore, this application will be forwarded to the Primary Patent Examiner of record for an action on the merits.

PETITION DENIED.

S. Thomas Hughes
Supervisory Patent Examiner
Technology Center 3700, Art Unit 3714

Akin, Gump, Strauss, Hauer & Feld, L.L.P.
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

AUG 04 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Leonard Weiss
2300 W. Sahara Avenue, Box 34
Las Vegas, NV 89102

Paper No. ~~4~~ 3

In re application of
Laurence W. Dummett
Application No. 10/166,988
Filed: June 11, 2002
For: DUNNAGE PLATFORM

DECISION ON PETITION TO MAKE SPECIAL (INFRINGEMENT)

This is a decision on the petition under 37 C.F.R §1.102(d) to make the above-identified application special that was filed on July 22, 2003 and supplemented on July 28, 2003.

The petition requests that the above-identified application be made special under the procedure set forth in MPEP 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market; (B) that a rigid comparison of the alleged infringing device or product with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The petition filed February 11, 2002 lacks requirement 2(C), above. In view of this deficiency, the petition is **DISMISSED**.

With respect to requirement 2(C) above, Applicant has not provided a copy of the references deemed most closely related to the subject matter encompassed by the claims.

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 for 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/dxn: 7/29/03

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

SEP 23 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

LEONARD WEISS
2300 W. SAHARA AVENUE, BOX 34
LAS VEGAS, NV 89102

In re application of
Laurence W. Dummett
Application No.10/166988
Filed: June 11, 2002
For: DUNNAGE PLATFORM

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(INFRINGEMENT)**

This is a decision on the renewed petition under 37 C.F.R § 1.102(d) filed August 11, 2003 to make the above-identified application special.
The petition requests that the above-identified application be made special under the procedure set forth in M.P.E.P. § 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market; (B) that a rigid comparison of the alleged infringing device or product with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The renewed petition filed August 11, 2003 completes all of the requirements above and, therefore, 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 and appeal, if any, only if petitioner makes a prompt *bona fide* effort, in response to each Office action, to place

the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

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

RAR/ekn 9/22/03

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)
6798892	2004-09-28	10167007	2002-06-10	PRS 301

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/David S. D'Ascenzo/	Date (YYYY-MM-DD)	2010-06-16
Name	David S. D'Ascenzo	Registration Number	39952

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 6798892
Issue Date: September 28,2004
Application No. 10167007
Filed: June 10,2002
Attorney Docket No. 3595-2

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

This is a decision on the electronic petition, filed June 16,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 16,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
OIPE 01-03

Paper No. 3

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

COPY MAILED

JAN 1 5 2003

OFFICE OF PETITIONS

In re Application of	:
Tada et al.	: DECISION GRANTING
Application No. 10/167,011	: PETITION
Filed: 10 June, 2002	:
Attorney Docket No. 16869P-034700US	:

This is a decision on the petition filed under 37 CFR 1.10 on 12 December, 2002, which is treated as a petition under 37 CFR 1.10(c) to accord the above-identified application a filing date of 10 June, 2002, rather than the presently-accorded filing date of 9 June, 2002.

The petition is **GRANTED**.

Petitioners assert the application was filed on 10 June, 2002, by USPS Express Mail Post Office to Addressee mail. In support, on 12 December, 2002, petitioner supplied a copy of Express Mail Label No. EL951598300US (the same Express Mail number found on the itemized application transmittal sheet located in the official file). The "date-in" on the Express Mail Label appears as "6/9/02". The Express Mail label also contains an official USPS postmark, however, dated 10 June, 2002. Additionally, a search of the USPTO's USPS Express Mail Database reveals that the above-identified Express Mail number was accepted by the USPS on 10 June, 2002.

In view of the above, it is concluded that correct date of deposit of the CPA in Express Mail was 10 June, 2002, not 9 June, 2002.

The petition is granted. No petition fee has been paid and none is due.

The application is being forwarded to the Office of Initial Patent Examination for correction of the filing date to 10 June, 2002, and for issuance of a corrected Filing Receipt. Thereafter, the application will be forwarded to Technology Center 2100 for examination in due course.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRADLEY N. RUBEN, PC
463 FIRST ST., SUITE 5A
HOBOKEN NJ 07030

COPY MAILED

JUN 2 0 2005

OFFICE OF PETITIONS

In re Application of :
Sewon Kang et al :
Application No. 10/167,040 : DECISION GRANTING PETITION
Filed: June 6, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 100UM-009D :

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 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 March 25, 2004, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 1616.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

MICHAEL J. DONOHUE, ESQ.
DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

COPY MAILED

JUN 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Nason et al. :
Application No. 10/167,053 :
Filed: June 10, 2002 :
Attorney Docket No. :

ON PETITION

This decision concerns the June 5, 2003 "Response to Dismissal of Petition" which is being treated as a renewed petition under 37 CFR 1.47(a).

The petition is **DISMISSED as moot.**

The previous petition under 37 CFR 1.47(a), filed on October 15, 2002, was dismissed on April 11, 2003 for lacking any showing that a *bona fide* attempt had been made to present to the non-signing inventor, Carson Kaan ("Kaan"), a copy of the entire application (specification including claims; drawings) before concluding that he refused to join in this application.

The instant renewed petition encloses a "Declaration for Utility or Design Application Using an Application Data Sheet" signed by all of the inventors named in this application, including Kaan ("6/5/03 Declaration"), rendering the renewed §1.47(a) petition subject to dismissal as moot.[1]

No petition fee is owed.

The application is now complete.

The 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

---

[1] An Application Data Sheet indicating each named-inventor's residence and citizenship was filed with the application on 6/10/02.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

MICHAEL J. DONOHUE, ESQ.
DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

COPY MAILED

APR 1 1 2003

OFFICE OF PETITIONS

In re Application of :
Nason et al. :
Application No. 10/167,053 :
Filed: June 10, 2002 :
Attorney Docket No. :

ON PETITION

This decision concerns the October 15, 2002 petition under 37 CFR 1.47(a).

The petition is **DISMISSED.**

There are 6 inventors named in this application. The application upon filing lacked, *inter alia*, a properly signed oath or declaration.[1] A Notice to File Missing Parts of Nonprovisional Application was mailed on July 12, 2002 ("7/12/02 Notice of Missing Parts"), giving Applicants an extendable 2-month period within which to submit the missing items. In response, the instant petition was filed along with a request for a 1-month extension of time, the requisite extension-of-time fee, and a declaration signed by all of the joint-inventors except Carson Kaan ("Kaan") ("10/15/02 Declaration").

The petition asserts that Kaan has refused to join in this application, and requests that the 10/15/02 Declaration be accepted such that Assignee may "file this application on behalf of the joint-inventors."[2]

First of all, if all of the inventors either cannot be found/reached after diligent effort, or, refuse to sign the application declaration, 37 CFR 1.47(b) is the mechanism through which Assignee may petition and request to make the application on behalf of, and as agent for, the inventors. But that is not the scenario in the instant case.

Here, 5 of the 6 joint-inventors have signed the application declaration. Therefore, a petition under 37 CFR 1.47(a) is appropriate, wherein the available inventors would request to file the application on behalf of themselves and the non-signing inventor Kaan.

Even if the petition properly stated the request, the available inventors may file this application on behalf of themselves as well as Kaan only if a *bona fide* attempt has been made to present to Kaan, for review and signature, a copy of the **entire application (specification including**

---

[1] 37 CFR 1.51(b)(2); 37 CFR 1.63. Also missing were the application basic filing fee and drawings that comply with the margins requirements of 37 CFR 1.84.

[2] Petition, page 1, 2nd paragraph, last sentence.

claims; drawings);[3] and the latter refuses to join in this application. To show that Kaan has refused to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a **statement of facts** concerning the circumstances of the presentation of the application papers to Kaan at his last known address,[4] and his subsequent refusal.[5]

The instant petition is accompanied by the declarations of Paula Kamshad, an employee of Assignee ("Kamshad") ("Kamshad Declaration"), and Ellen M. Bierman, Assignee's former outside counsel ("Bierman") ("Bierman Declaration"). The Kamshad Declaration essentially states that on August 28, 2002, Kamshad spoke with Kaan by telephone "to request his review and signing of the application papers . . . including a declaration . . ."; and that Kaan indicated in this conversation, and again in an August 29, 2002 e-mail to Kamshad, that he did not want to sign these application papers."[6] The Bierman Declaration merely states conclusively that Kaan refused to join in this application.[7]

However, there is no evidence in the petition, the Kamshad Declaration, or the Bierman Declaration that a copy of the entire application (specification including claims; drawings) had ever been provided to Kaan prior to concluding that he refused to join in the application. Consequently, the Office is unable to conclude that the declarations by Kamshad and Bierman constitute the "statements of facts" required for granting a petition under 37 CFR 1.47(a). Therefore, even if the petition properly stated the request, the 5 signing inventors would not be allowed to make the application on behalf of themselves and Kaan. The petition is thus dismissed. The 10/15/02 Declaration is not accepted.

Options

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

---

[3] MPEP section 409.03(d) (Aug. 2001) REFUSAL TO JOIN (A refusal . . . to sign . . . when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join in the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers.); also citing In re Gray, 115 U.S.P.Q. 80 (Comm'r Pat. 1956) (It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath/declaration is directed.).

[4] 37 CFR 1.47(a); also MPEP section 409.03(e) (Aug. 2001).

[5] See MPEP section 409.03(d) (Aug. 2001).

[6] Kamshad Declaration, page 2, paragraphs 5, 6.

[7] Bierman Declaration, page 1, 2nd paragraph.

[8] Unless proper extension of time under 37 CFR 1.136(a) is obtained. See 37 CFR 1.53(f).

(1) an oath/declaration properly executed by **all** of the inventors, including Kaan;[9]

OR, (2) a renewed petition under 37 CFR 1.47(a) (no fee), that includes appropriate statement(s) of facts, stating that the entire application papers (specification including claims; drawings) were presented to Kaan at his last known address; and of the facts relied upon to conclude that Kaan refuses to join in this application.[10]

The renewed §1.47(a) petition 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

In addition, the Office acknowledges receipt with the instant petition of the $370 basic filing fee (small entity) and a set of drawings in response to the 7/12/02 Notice of Missing Parts. The drawings have been approved by the draftsperson. The application is now complete.

Also enclosed with the petition are: the $130 petition fee; the $65 surcharge for late filing of the basic filing fee; and the $315 extra claims fee.

Finally, as authorized by facsimile on April 10, 2003, the new correspondence address for this application has been entered and made of record.

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

RC Tang
Petitions Attorney
Office of Petitions

---

[9] **Submit directly to OIPE along with a copy of this Decision.** Refer to www.uspto.gov for PTO's new mailing address effective 5/1/03.

[10] The statement(s) of facts must be made and signed by those who presented the application papers to Kaan/concluded that Kaan refused to join in/to whom Kaan's refusal to join in was made. See MPEP section 409.03(d) (Aug. 2001).

EXPRESS MAIL NO. EV261473645US

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

MICHAEL J. DONOHUE, ESQ.
DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

RECEIVED
APR 15 2003
Michael J. Donohue

COPY MAILED
APR 11 2003
OFFICE OF PETITIONS

In re Application of :
Nason et al. :
Application No. 10/167,053 : ON PETITION
Filed: June 10, 2002 :
Attorney Docket No. :

This decision concerns the October 15, 2002 petition under 37 CFR 1.47(a).

The petition is **DISMISSED.**

There are 6 inventors named in this application. The application upon filing lacked, *inter alia*, a properly signed oath or declaration.[1] A Notice to File Missing Parts of Nonprovisional Application was mailed on July 12, 2002 ("7/12/02 Notice of Missing Parts"), giving Applicants an extendable 2-month period within which to submit the missing items. In response, the instant petition was filed along with a request for a 1-month extension of time, the requisite extension-of-time fee, and a declaration signed by all of the joint-inventors except Carson Kaan ("Kaan") ("10/15/02 Declaration").

The petition asserts that Kaan has refused to join in this application, and requests that the 10/15/02 Declaration be accepted such that Assignee may "file this application on behalf of the joint-inventors."[2]

First of all, if all of the inventors either cannot be found/reached after diligent effort, or, refuse to sign the application declaration, 37 CFR 1.47(b) is the mechanism through which Assignee may petition and request to make the application on behalf of, and as agent for, the inventors. But that is not the scenario in the instant case.

Here, 5 of the 6 joint-inventors have signed the application declaration. Therefore, a petition under 37 CFR 1.47(a) is appropriate, wherein the available inventors would request to file the application on behalf of themselves and the non-signing inventor Kaan.

Even if the petition properly stated the request, the available inventors may file this application on behalf of themselves as well as Kaan only if a *bona fide* attempt has been made to present to Kaan, for review and signature, a copy of the **entire application (specification including**

---

[1] 37 CFR 1.51(b)(2); 37 CFR 1.63. Also missing were the application basic filing fee and drawings that comply with the margins requirements of 37 CFR 1.84.

[2] Petition, page 1, 2nd paragraph, last sentence.

ENTERED IN DWT
IP DOCKET
APR 15 2003
By: M. Larian

RECEIVED
JUN 18 2003
OFFICE OF PETITIONS

claims; drawings);[3] and the latter refuses to join in this application. To show that Kaan has refused to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a **statement of facts** concerning the circumstances of the presentation of the application papers to Kaan at his last known address,[4] and his subsequent refusal.[5]

The instant petition is accompanied by the declarations of Paula Kamshad, an employee of Assignee ("Kamshad") ("Kamshad Declaration"), and Ellen M. Bierman, Assignee's former outside counsel ("Bierman") ("Bierman Declaration"). The Kamshad Declaration essentially states that on August 28, 2002, Kamshad spoke with Kaan by telephone "to request his review and signing of the application papers . . . including a declaration . . ."; and that Kaan indicated in this conversation, and again in an August 29, 2002 e-mail to Kamshad, that he did not want to sign these application papers."[6] The Bierman Declaration merely states conclusively that Kaan refused to join in this application.[7]

However, there is no evidence in the petition, the Kamshad Declaration, or the Bierman Declaration that a copy of the entire application (specification including claims; drawings) had ever been provided to Kaan prior to concluding that he refused to join in the application. Consequently, the Office is unable to conclude that the declarations by Kamshad and Bierman constitute the "statements of facts" required for granting a petition under 37 CFR 1.47(a). Therefore, even if the petition properly stated the request, the 5 signing inventors would not be allowed to make the application on behalf of themselves and Kaan. The petition is thus dismissed. The 10/15/02 Declaration is not accepted.

Options

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

---

[3] MPEP section 409.03(d) (Aug. 2001) REFUSAL TO JOIN (A refusal . . . to sign . . . when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join in the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers.); also citing In re Gray, 115 U.S.P.Q. 80 (Comm'r Pat. 1956) (It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath/declaration is directed.).

[4] 37 CFR 1.47(a); also MPEP section 409.03(e) (Aug. 2001).

[5] See MPEP section 409.03(d) (Aug. 2001).

[6] Kamshad Declaration, page 2, paragraphs 5, 6.

[7] Bierman Declaration, page 1, 2nd paragraph.

[8] Unless proper extension of time under 37 CFR 1.136(a) is obtained. See 37 CFR 1.53(f).

(1) an oath/declaration properly executed by **all** of the inventors, including Kaan;[9]

OR, (2) a renewed petition under 37 CFR 1.47(a) (no fee), that includes appropriate statement(s) of facts, stating that the entire application papers (specification including claims; drawings) were presented to Kaan at his last known address; and of the facts relied upon to conclude that Kaan refuses to join in this application.[10]

The renewed §1.47(a) petition 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

In addition, the Office acknowledges receipt with the instant petition of the $370 basic filing fee (small entity) and a set of drawings in response to the 7/12/02 Notice of Missing Parts. The drawings have been approved by the draftsperson. The application is now complete.

Also enclosed with the petition are: the $130 petition fee; the $65 surcharge for late filing of the basic filing fee; and the $315 extra claims fee.

Finally, as authorized by facsimile on April 10, 2003, the new correspondence address for this application has been entered and made of record.

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

RC Tang
Petitions Attorney
Office of Petitions

RECEIVED
JUN 1 8 2003
OFFICE OF PETITIONS

---

[9] **Submit directly to OIPE along with a copy of this Decision.** Refer to www.uspto.gov for PTO's new mailing address effective 5/1/03.

[10] The statement(s) of facts must be made and signed by those who presented the application papers to Kaan/concluded that Kaan refused to join in/to whom Kaan's refusal to join in was made. See MPEP section 409.03(d) (Aug. 2001).

UNITED STATES
PATENT AND
TRADEMARK OFFICE

OIPE
SEP 2 2 2003
PATENT & 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. 12

In re Application of Asada et al.
Serial No. 10/167,069
Filed June 11, 2002
For: **PHOTOPLETHYSMOGRAPH SIGNAL TO NOISE ENHANCEMENT**

DECISION ON PETITION
UNDER *37 CFR 1.48(a)*

This is a decision on the petition filed February 21, 2003 to correct the inventorship under 37 CFR 1.48.

The petition is granted

In view of the papers filed February 21, 2003, 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 the following inventor: **SOKWOO RHEE**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Max F. Hindenburg
Supervisory Patent Examiner
Art Unit 3736
Patent Examining Group 3700

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)
6738544	2004-05-18	10167071	2002-06-11	

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	/Kenneth C. Brooks/	Date (YYYY-MM-DD)	2008-07-09
Name	Kenneth C. Brooks	Registration Number	38393

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. 6738544
Issue Date: May 18,2004
Application No. 10167071
Filed: June 11,2002
Attorney Docket No. MYS-18-01-02

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

This is a decision on the electronic petition, filed July 9,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 9,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date : August 10, 2005

David E. Vaughan
PARK, VAUGHAN & FLEMING, LLP
702 Marshall Street,
Suite 310
Redwood, CA 94063

Patent No: 6826634 B2
Applicant: Raman Viswa Nath
Issued: November 30, 2004
Title: **EXTENDED MESSAGE BLOCK FOR NETWORK DEVICE DRIVERS**

Request for Certificate of Correction:

Consideration had been given to your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.323.

Inspection of the application for the above patent reveals that the alleged error in column 15, line 51 is printed in accordance with the record in the Patent and Trademark Office, and passed to issue by the examiner.

In view of the foregoing, your request in this matter is hereby **denied.**

Virginia Tolbert
For Cecelia Newman, Supervisor
Decisions and Certificate of Correction
(703) 305-8309 or 308-9390 ext. 113

vt

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: MAR 1 8 2004

HYP

Paper No. 11

In re application of Hiroyuki Sugimura Serial No. 10/167,079 Filed: June 12, 2002 For: WATER-REPELLENT FILMS AND METHOD FOR FORMING SUCH FILMS	:	DECISION ON PETITION

This is a decision on the PETITION TO ACCEPT COLOR PHOTOGRAPHS UNDER 37 C.F.R. § 1.84(b)(2), filed June 12, 2002, to permit color photographs since (1) the fee as required by 37 CFR 1.17(h) has been paid, (2) three sets of the color photographs have been filed, (3) the specification includes the language set forth in 37 CFR 1.84(a)(2)(iv), and (4) an explanation is provided stating why color photographs are necessary. The color photographs include Figures 2 and 4.

A review of the application record indicates that all of the requirements for acceptance of color photographs have been met.

The petition is **GRANTED**.

Harold Y. Pyon
Supervisory Patent Examiner
Technology Center 1700

BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. BOX.1404
Alexandria, Virginia 22313-1404

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Blakely, Sokoloff, Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

COPY MAILED

AUG 1 0 2004

OFFICE OF PETITIONS

In re Application of :
Joao Carlos Gomes De Oliveira, et. al. :
Application No. 10/167,089 :
Filed: June 10, 2002 :
Attorney Docket No. 6143.P001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed February 17, 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 November 6, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned after midnight February 6, 2004.

In response, 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.

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

The petition is **GRANTED**.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

June 30, 2004

Sandra B. Weiss
Jones, Day, Reavis & Pogue
77 West Wacker
Chicago IL 60601

In re Application of:	:	
COUZIN, *et al.*	:	DECISION ON REQUEST TO
Application No. 10/167,135	:	WITHDRAW FROM RECORD
Filed: June 11, 2002	:	
For: RETROREFLECTOR WITH CONTROLLED DIVERGENCE MADE BY THE METHOD OF GROOVE UNDULATION	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed July 14, 2003.

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

The request meets all the above requirements. The request was signed Ronald A. Sandler, on behalf of all the attorneys/ agents of record.

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

Inquiries related to this decision should be directed to Lissi Marquis at (571) 272-1596.

Lissi Mojica Marquis
Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Heidi Boehlefeld
Renner, Otto, Boisselle & Sklar
1621 Euclid Avenue
Cleveland OH 44115-2191
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

Cynthia S. Murphy
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue
Cleveland OH 44115-2191

APR 15 2005

In re Application of:	:	
Couzin et al.	:	DECISION ON PETITION
Serial No.: 10/167,135	:	TO WITHDRAW HOLDING
Filed: June 11, 2002	:	OF ABANDONMENT
Attorney Docket No.: **013013026089**	:	

This is a decision on the communication filed January 24, 2005. The communication has been treated as a petition to withdraw the holding of abandonment of the above-identified application under 37 C.F.R. § 1.181. The petition includes a copy of an earlier filed petition and evidence of the early filing on May 6, 2004. No fee is required.

The petition is **GRANTED**.

The application was held abandoned for failure to timely file a response to the Office action mailed on September 25, 2003. A Notice of Abandonment was mailed on April 21, 2004.

Petitioner asserts that on October 24, 2003, a response was mailed by petitioner and received by the PTO on October 28, 2003. To support this assertion, petitioner has submitted a copy of the response and a copy of a return postcard receipt, which acknowledges receipt in the PTO of the response on October 28, 2003.

M.P.E.P. § 503 states, "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the response was timely received in the PTO. Furthermore, a review of the file record reveals that the original response filed on October 28, 2003 has now been matched with the file.

For the above stated reason, the petition is granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status

and is being forwarded to the examiner of record for consideration of the response and prompt appropriate action.

Inquiries regarding this decision should be directed to Clayton E. LaBalle, Special Programs Examiner, at (571) 272-1594.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

ROBIN BLECKER & DALEY
2ND FLOOR
330 MADISON AVENUE
NEW YORK, NY 10017

COPY MAILED

OCT 0 1 2002

OFFICE OF PETITIONS

In re Application of :
Herzer et al. :
Application No. 10/167,156 : DECISION ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. C4-1031 :

This is a decision on the petition filed August 14, 2002, requesting, in effect, that Figures 6 and 7 filed on August 14, 2002, be entered as part of the original disclosure.

The petition is **dismissed**.

Although petitioner has established the Office misplaced Figures 6 and 7, the Figures supplied with the petition cannot be used for examination. The drawing sheet was sent by facsimile transmission on August 14, 2002. As a result, the quality of the drawings suffered. In addition, content was added to the top and bottom of the drawing sheet by the facsimile machine. A copy of the sheet is attached. The Office requests that petitioner mail, or have hand delivered, a copy of the Figures as they were filed on June 11, 2002.

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

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

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

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

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

Attached: Copy of drawing sheet from facsimile transmission

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

ROBIN BLECKER & DALEY
2ND FLOOR
330 MADISON AVENUE
NEW YORK, NY 10017

COPY MAILED

NOV 04 2002

OFFICE OF PETITIONS

In re Application of :
Herzer et al. :
Application No. 10/167,156 : DECISION ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. C4-1031 :

This is a decision on the renewed petition filed October 8, 2002, to establish that Figures 6 and 7 were part of the originally filed application.

On June 11, 2002, the application was filed.

On July 17, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of , and advising applicants that Figures 6 and 7 described in the specification appeared to have been omitted.

Petitioner alleges that Figures 6 and 7 were deposited on June 11, 2002. In support, petitioner has submitted a postcard receipt which acknowledges receipt of "Drawings (Figs. 1-9)" on June 11, 2002.[1] Petitioner has also submitted a copy of the missing documentation- Figures 6 and 7.

Upon review of the record, Figures 6 and 7, deposited on June 11, 2002, have not been located. However, the evidence is convincing that the application papers deposited on June 11, 2002, included Figures 6 and 7, and that the figures were subsequently misplaced in the PTO.

In view of the above, the petition is **granted**. The copy of Figures 6 and 7 submitted with the petition will be used for examination purposes.

No petition fee is required and none has been charged.

The Notice mailed July 17, 2002, was sent in error and is hereby vacated.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 11, 2002, using the application papers filed on June 11, 2002, and the copy of Figures 6 and 7 filed on October 8, 2002.

---

[1] Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self addressed post card properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the post card in the outgoing mail. "A post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." M.P.E.P. § 503.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAY - 7 2004

In re Application of	:	
Solarz, Donald	:	NOTICE OF WITHDRAWAL
Serial No. 10/167,164	:	FROM ISSUE
Filed: June 10, 2002	:	UNDER 37 CFR 1.313(b)
For: WASTE WATER AERATION WITH	:	
PRESSURE DIFFERENTIAL CONTROL	:	

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 Wanda Walker at (571) 272-1151.

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

Waters & Morse, PC
John A. Waters
400 Ledyard Building
125 Ottawa Avenue N W
Grand Rapids, MI 49503

cc: Allowed Files—Pk3-910

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 04-03

John P. Wasack
199 Lynch Road
Middletown, NJ 07748

COPY MAILED

APR 0 4 2003

OFFICE OF PETITIONS

In re Application of
Wasack et al.
Application No. 10/167,174
Filed: 10 June, 2002
For: AUTOMATED PRESENTATION OF A LIVE EVENT

Dear Mr. Wasack:

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

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

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

SCHNECK & SCHNECK
P.O. BOX 2-E
SAN JOSE CA 95109-0005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DW 04-03

Paper No. 8

SCHNECK & SCHNECK
P.O. BOX 2-E
SAN JOSE CA 95109-0005

COPY MAILED

APR 0 4 2003

OFFICE OF PETITIONS

In re Application of	:
Wasack and Greene	:
Application No. 10/167,174	: DECISION ACCORDING STATUS
Filed: 10 June, 2002	: UNDER 37 CFR 1.47(b)
Attorney Docket No. PIN-007	:

This is in response to the petition filed on 18 December, 2002, under 37 CFR 1.47(b).

The petition is **GRANTED**.

Petitioner has shown by the declaration of the putative assignee, Avid Sports (by change of name Brendan Corporation, by change of name Xstream Sports, Inc., and subsequently by change of name Pinnacle Systems, Inc.), that a copy of the application was sent to each non-signing inventor. Petitioners have also shown that joint inventor Greene refused orally to sign the declaration to counsel's employee, Sally Azevedo, while joint inventor Wasak failed to sign and return the declaration naming him as a joint inventor along with Christopher Greene. Additionally, petitioners have shown proprietary interest by providing a copy of the employment agreement between the joint inventors and Avid Sports as well as a memorandum by Melanie Sherk, General Counsel for Pinnacle Systems, Inc. Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and has demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

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

Counsel's deposit account, No. 19-0590, will be charged the $130.00 late oath or declaration surcharge as authorized on the extension of time form filed on 18 December, 2002.

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

Telephone inquiries regarding this communication should be directed to the undersigned at 703.308.6918.

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

Paper No.

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

MAILED

MAR 3 1 2009

OFFICE OF PETITIONS

In re Application of	:	
Yamaguchi et al.	:	
Application No. 10/167182	:	ON APPLICATION FOR
Filed: June 11, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No. APMOL.004DV1	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT filed October 27, 2008. Applicant requests that the determination of patent term adjustment be increased by 762 days to a total of one thousand four hundred twenty-seven (1,427) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

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, 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). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is 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. Applicant 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 reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment 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 pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, 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.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —
>
> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on October 31, 2007.

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 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 Attorney Derek Woods at (571) 272-3232.

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

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

COPY MAILED

DEC 21 2009

OFFICE OF PETITIONS

In re Application of	:	
Yamaguchi et al.	:	ON REQUEST FOR
Patent Number: 7,527,790	:	RECONSIDERATION OF
Issue Date: 05/05/2009	:	PATENT TERM ADJUSTMENT
Application No. 10/167182	:	
Filing or 371(c) Date: 06/11/2002	:	
Attorney Docket Number: APMOL.004DV1:		

This is in response to the REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(d) AND 35 U.S.C. § 154(b)(3)(B)(ii), filed July 2, 2009. Patentee requests that the determination of patent term adjustment be corrected from 709 days to 1374 days. Patentees request this correction solely on the basis that the Office took in excess of three years to issue this patent.

The request for reconsideration patent term adjustment is **DISMISSED**.

On May 5, 2009, the above-identified application matured into U.S. Patent No. 7,527,790, with a patent term adjustment of 709 days. This application for patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment in light of the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees agree with the Office calculation of 986 days of Office delay and the calculation of 277 days of Applicant delay. Patentees assert an entitlement to an additional 872 days of patent term adjustment for the failure of the Office to issue the patent within three years of its application filing date. Patentees provide that this 872 days delay is reduced for 207 overlapping days. Thus, patentees assert an overall entitlement to 1374 days (986 days of adjustment under 37 CFR 1.702(a) *plus* 872 days of adjustment under 37 CFR 1.702(b) *less* 207 overlapping days *less* 277 days of applicant delay.

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.

The Office asserts that as of the filing of the RCE on October 31, 2007, the application was pending three years and 871 days after its filing date (from June 12, 2005 to October 30, 2007). The Office agrees that at the time of filing of the RCE, certain action was not taken within the specified time frame, and thus, the entry of a period of adjustment of 919 days is correct. At issue is whether patentees should accrue 871 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 919 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 871 days of delay in issuing the patent overlap with the 919 of examination delay under 37 CFR 1.702(a). 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]

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

[1] The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

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, June 11, 2002, and ending October 30, 2007, the day before the filing of the RCE on October 31, 2007. Prior to the filing of the RCE, 919 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 871 days Office delay in issuing the patent overlap with the 919 days of Office examination delay. Prior to the filing of the RCE, the issuance of the patent was delayed by 919 days, not 919 days and 871 days. The Office took 14 months and 581 days to issue a first Office action and four months and 338 days to respond to a reply under 35 U.S.C. 132 after the date on which the reply was filed. Otherwise, the Office took all actions set forth in 37 CFR 1.702(a) within the prescribed timeframes. Nonetheless, given the initial 919 days of Office examination delay and the time allowed within the time frames for processing and examination, at the time of filing of the RCE, the application issued three years and 871 days after its filing date. However, the Office did not delay 919 days and also delay an additional 871 days. Accordingly, 919 days of patent term adjustment was properly entered because the period of delay of 871 days attributable to the delay in the issuance of the patent overlaps with the period of adjustment of 919 days attributable to grounds specified in § 1.702(a). Entry of both periods is not warranted.

Accordingly, at issuance, the Office properly entered 709 days of patent term adjustment, having considered the 871 days of Office delay under the three-year pendency provision in conjunction with the 919 days of delay under 37 CFR 1.702(a) that accrued prior to submission of the RCE and the adjustment of 67 days under 37 CFR 1.702(a)(4) that accrued subsequent to the submission of the RCE, reduced 277 days for applicant delay.

In view thereof, no adjustment to the patent term will be made.

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

Telephone inquiries specific to this matter should be directed to 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

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

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

Mail Date: 04/20/2010

Applicant	: Kyoji Yamaguchi	: DECISION ON REQUEST FOR
Patent Number	: 7527790	: RECALCULATION of PATENT
Issue Date	: 05/05/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/167,182	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/11/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1242** 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.

MAY 1 1 2005

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: 4/25/05

5/13

Re application of: 5274A
BEISTLINE, et al.
Serial No.: 10/167,185
Filed: June 11, 2002
For: CARPET CONSTRUCTIONS SYSTEMS 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 January 18, 2005. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ORRICK, HERRINGTON & SUTCLIFFE, LLP
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

COPY MAILED

OCT 1 9 2004

OFFICE OF PETITIONS

In re Application of :
Miriam H. Taimisto, et al. :
Application No. 10/167,223 : ON PETITION
Filed: June 10, 2002 :
Attorney Docket No. 701470.51 :

This is a decision in response to a communication filed April 14, 2004, transmitting a copy of a petition under 37 CFR 1.137(b), filed by September 2, 2003[1], to revive the above-identified application and a petition under 37 CFR 1.181(a) filed March 10, 2004 to withdraw the holding of abandonment. The petitions are being treated under 37 CFR 1.137(b).

The petition is **GRANTED.**

The application became abandoned for failure to timely respond to a Notice to File Missing Parts mailed July 16, 2002. The notice required an oath or declaration under 37 CFR 1.63, the basic filing fee, as well as additional claim fees, and the surcharge under 37 CFR 1.16(e). A Notice of Abandonment was mailed on February 9, 2004.

The application is being returned to the Office of Initial Patent Examination (OIPE) for further processing using the copy of the declaration provided April 14, 2004.

Telephone inquires related to this decision should be directed to the undersigned at (703) 305-9220. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.

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

[1] A copy of the petition was provided on April 14, 2004. The original petition cannot be located; however, the evidence is convincing that the petition, including the requisite declaration, filing fees and surcharge, was filed on September 2, 2003, and subsequently misplaced in the Office.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

Mail Date: 07/06/2010

Applicant	: Robert Poling	: DECISION ON REQUEST FOR
Patent Number	: 7657616	: RECALCULATION of PATENT
Issue Date	: 02/02/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/167,229	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/10/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1573** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

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

COPY MAILED

SEP 0 6 2002

OFFICE OF PETITIONS

In re Application of
Shoemake et al.
Application No. 10/167,273
Filed: June 11, 2002
Attorney Docket No. TI-33770

DECISION GRANTING PETITION

This is a decision on the petition filed August 1, 2002, requesting that Figures 5 and 6 described in the specification be accorded a filing date of June 11, 2002, as part of the original disclosure.

On June 11, 2002, applicants filed the above-identified application. On July 16, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice), stating that the application had been accorded a filing date of June 11, 2002, and advising applicants that Figures 5 and 6 described in the specification appeared to have been omitted.

In response, on August 1, 2002, applicants filed, inter alia, the present petition, an authorization to charge the petition fee, and a copy of one (1) sheet of drawings, containing Figures 5 and 6. Additionally, applicants submitted a copy of applicants' postcard receipt acknowledging receipt of 4 sheets of drawings on June 11, 2002.

In the present petition, applicants request that the application, including Figures 5 and 6, be accorded a filing date of June 11, 2002. Upon review of the record, Figures 5 and 6, deposited on June 11, 2002, have not been located among the application papers. However, the evidence is convincing that the application papers deposited on June 11, 2002, included Figures 5 and 6, which were subsequently misplaced in the United States Patent and Trademark Office. Therefore, the application, including Figures 5 and 6, was complete on filing and will be granted a filing date of June 11, 2002.

Accordingly, the petition is granted.

The Notice of July 16, 2002, was sent in error and is hereby vacated. No petition fee has been charged to the Deposit Account.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of June 11, 2002, using the Figures 1-4 submitted on June 11, 2002, and Figures 5 and 6 submitted on August 1, 2002. The Office records should indicate that 4 sheets of drawings were present on filing.

Any inquiries related to this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WHYTE HIRSCHBOECK DUDEK S.C.
INTELLECTUAL PROPERTY DEPARTMENT
555 EAST WELLS STREET, SUITE 1900
MILWAUKEE, WI 53202

Mail Date: 04/20/2010

Applicant	: Yong Poo Chia	: DECISION ON REQUEST FOR
Patent Number	: 7579681	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/167,284	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/11/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **830** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED
DEC 1 2 2005
OFFICE OF PETITIONS

In re Application of	:	
Michael A. Riepe, et al.	:	
Application No. 10/167,293	:	ON PETITION
Filed: June 10, 2002	:	
Attorney Docket No. 054355/0293259	:	

This is a decision on the petition under 37 CFR 1.182, filed October 5, 2005, to change the order of inventorship in the above-identified application.

The petition is **GRANTED.**

The order of the names of the inventors will be changed as follows:

1. Michael A. Riepe
2. Robert M. Swanson
3. Timothy M. Burks
4. Lukas van Ginneken
5. Karen Vahtra
6. Hamid Savoj

Office records have been corrected to reflect the desired order of inventorship. A corrected filing receipt accompanies 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 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 future correspondence solely to the address of record.

Telephone inquiries concerning this matter may be directed to Retta Williams at (571) 272-3229.

This matter is being referred to Technology Center 2800, Art Unit 2825 for further processing.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions

Attachment to cc: Corrected Filing Receipt

cc: David A. Jakopin
Pillsbury Winthrop Shaw Pittman LLP
2475 Hanover Street
Palo Alto, CA 94304-1114

UNITED STATES 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

ABLEMAN, FRAYNE & SCHWAB
150 EAST 42ND STREET
NEW YORK, NY 10017-5612

COPY MAILED
APR 2 6 2004
OFFICE OF PETITIONS

In re Application of	:	
Al-Ghamdi	:	
Application No.: 10/167,294	:	ON PETITION
Filing Date: June 10, 2002	:	
Attorney Docket No.: 205,248	:	

This decision concerns the March 25, 2004 petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

The application became abandoned on August 25, 2003 for failure to timely respond to the June 24, 2003 Office Action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), which set forth a 2-month shortened statutory reply period.

The instant petition encloses a response to the above Office action and the $1,330 petition fee, and states that the entire delay in submitting the response from the due date until the filing of a grantable §1.137(b) petition was unintentional. The petition is thus granted.

The application file is being returned to Technology Center 2800 for further examination.

Telephone inquiries on this decision 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 15

ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NY 10017-5621

COPY MAILED
JAN 13 2006
OFFICE OF PETITIONS

In re Application of
Abdulla H. Al-Ghamdi
Application No. 10/167,294
Filed: June 10, 2002
Attorney Docket No. 205,248

ON PETITION

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 17, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 18, 2004.

The Change of Correspondence Address has been accepted and recorded.

The petition satisfies the requirement of 37 CFR 1.137 (b) in that petitioner has supplied (1) the reply in the form of an Amendment; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the petition filed November 1, 2005 is accepted as having been unintentionally delayed.

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

The application file is being forwarded to Technology Center 2800, Art Unit 2856 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARRIER BLACKMAN AND ASSOCIATES
24101 NOVI ROAD
SUITE 100
NOVI MI 48375

COPY MAILED

JUL 1 8 2007

OFFICE OF PETITIONS

In re Application of	:	
Yasuhara et al.	:	
Application No. 10/167298	:	DECISION ON PETITION
Filing or 371(c) Date: 06/11/2002	:	
Attorney Docket No. OCA-157-A	:	

This is a decision on the petition under 37 CFR 1.182, filed, June 3, 2005, to change the order of the named inventors in the above-identified application. The delay in treating this petition is regretted.

The petition is **DISMISSED**.

The issue fee in this application was paid on February 23, 2004. Effective May 29, 2000, the Office changed the practice by clarifying that an amendment under 37 CFR 1.312 (after allowance) must be filed prior to or with payment of the issue fee, and eliminated 37 CFR 1.312(b). Since a change to the order of the inventors' names is an amendment to the application, and amendments are not permitted after the payment of the issue fee, a petition under 37 CFR 1.182 to change the order of the inventors' names cannot be granted.

Additionally, once the patent issues, there is no basis for the USPTO to change the order of the named inventors. *See* Fina Technology v. Ewen, 60 USPQ2D 1314 (Fed. Cir. 2001) (the order of the named inventors is not a clerical error contemplated by § 255; it likewise cannot be corrected in a judicial proceeding under that provision).

In view of the above, the petition under § 1.182 to amend the order of inventors cannot be granted.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

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

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

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

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

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARRIER BLACKMAN AND ASSOCIATES
24101 NOVI ROAD
SUITE 100
NOVI MI 48375

COPY MAILED
JUL 30 2007
OFFICE OF PETITIONS

In re Application of	:	
Yasuhara et al.	:	CORRECTED
Application No. 10/167298	:	DECISION ON PETITION
Filing or 371(c) Date: 06/11/2002	:	
Attorney Docket No. OCA-157-A	:	

This is a decision on the petition under 37 CFR 1.182, filed, June 3, 2005, to change the name of an inventor[1] in the above-identified application. The delay in treating this petition is regretted.

The petition is **DISMISSED**.

> The issue fee in this application was paid on February 23, 2004. In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. Applicants are also strongly encouraged to submit an application data sheet (37 CFR 1.76) showing the new name. The petition should be directed to the attention of the Office of Petitions. The petition must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order.
>
> Since amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the name of the inventor cannot be granted if filed after the payment of the issue fee.

In view of the above, the petition under § 1.182 to amend the order of inventors cannot be granted.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

[1] The Decision mailed July 18, 2007 idenified the petition as a request to change the order of the names of the inventors. .

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

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

Any questions concerning this matter may be directed to 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. 7

PAUL D. GREELEY, ESQ.
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
ONE LANDMARK SQUARE, 10th FLOOR
STAMFORD CT 06901-2682

COPY MAILED

DEC 13 2002

OFFICE OF PETITIONS

In re Application of
Jones, et al.
Application No. 10/167,335
Filed: June 11, 2002
Attorney Docket No. 253.6587USQ
For: HIGH SPEED COOKING DEVICE AND METHOD

DECISION GRANTING PETITION

This is a decision on the petition entitled, "PETITION IN RESPONSE TO NOTICE TO FILE MISSING PARTS REGARDING DRAWINGS DUE TO USPTO ERROR", filed October 8, 2002 (certificate of mailing date October 4, 2002), requesting, in effect, partial withdrawal of the Notice to File Missing Parts of Nonprovisional Application (Notice) . The petition will be treated under 37 CFR 1.53(e).

The application was deposited on June 11, 2002. On August 8, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners, *inter alia*, that drawing figure 11 described in the specification appeared to have been omitted.

In response to the Notice, petitioners timely filed the present petition. Petitioners request that drawing figure 11 be accorded a filing date of June 11, 2002 on the basis that 19 sheets of drawing figures, including drawing figure 11, were received in the Patent and Trademark Office (PTO) on June 11, 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 June 11, 2002 as the date of receipt. The postcard lists, *inter alia*, that the filing included 19 sheets of drawings.

The return postcard constitutes *prima facie* evidence that 19 sheets of drawing figures, including drawing figure 11, were filed on June 11, 2002. MPEP 503. Accordingly, the request is granted.

No petition fee has been or will be charged in connection with this matter.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of June 11, 2002, using substitute drawing figures, including drawing figure 11 submitted with the instant petition. Office records will be corrected to show that 19 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
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

CROMPTON, SEAGER & TUFTE, LLC
1221 NICOLLET AVENUE
SUITE 800
MINNEAPOLIS MN 55403-2420

COPY MAILED

JUL 24 2007

OFFICE OF PETITIONS

In re Application of	:	
Houde et al.	:	
Application No. 10/167,341	:	DECISION ON PETITION
Filed: 06/11/2002	:	
Attorney Docket No. 1001.1487101	:	

This is a decision on the petition under 37 CFR 1.181, filed July 18, 2007, to withdraw the holding of abandonment for the above-identified application.

On May 18, 2007, the Office mailed a Notice of Panel Decision from Pre-Appeal Brief Review ("Decision") in response to the Pre-Appeal Brief Request for Review filed August 10, 2006. The Decision stated that the time period for filing an appeal brief would be reset to be one month from mailing the decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever was greater. The Decision further indicated that the time period for filing of the appeal brief was extendible under 37 CFR 1.136 based upon the mail date of the decision or the receipt date of the notice of appeal, as applicable. On June 26, 2007, the Office mailed a Notice of Abandonment, stating that the appeal was dismissed because a brief was not timely filed and the period for obtaining an extension of time to file a brief under 37 CFR 1.136(a) had expired, and therefore, the application was abandoned because there were no allowed claims.

In the present petition, applicants asserted that the application was not abandoned because the period to reply from the Decision with extensions of time had not expired. Accordingly, applicants requested that the Office withdraw the holding of abandonment.

On July 18, 2007, applicants submitted a Request for Continued Examination, a request for an extension of time for response within the first month, and an authorization to charge the necessary fee to the Deposit Account.

The Office finds that applicants' assertion is correct. As previously stated, the Decision reset a one-month extendable period from May 18, 2007 (the mailing the decision), for applicants to submit an appeal brief. Therefore, applicants' reply of July 18, 2007, was timely filed within the extendable period set in the Decision. Accordingly, the petition under 37 CFR 1.181 is **granted**. The Notice of Abandonment was mailed in error and is hereby withdrawn.

This matter is being referred to the Technology Center Art Unit 3731 for processing the RCE filed on July 18, 2007.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
APR 24 2006
OFFICE OF PETITIONS

LAINIE E. PARKER
AKZO NOBEL INC.
7 LIVINGSTONE AVENUE
DOBBS FERRY NY 10522-3408

In re Application of	:	
Duncan Carr et al	:	
Application No. 10/167,355	:	ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. ANO 6212 US/3162	:	

This is a decision on the petition, filed April 21, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on February 20, 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 1714 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Karen Creasy
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. _____

Date : April 24, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner for Patent Examination Policy

COPY MAILED
APR 24 2006
OFFICE OF PETITIONS

SUBJECT : Withdrawal from Issue of

Applicant(s) :Duncan Carr et al
Application No. :10/167,355
Filed :June 11, 2002

The above-identified application has been assigned Patent No. 7,037,971 and an issue date of May 2, 2006.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of May 2, 2006:

"All reference to Patent No. 7,037,971 to Duncan Carr et al of Wisconsin for AQUEOUS COMPOSITION appearing in the Official Gazette of May 2, 2006 should be deleted since no patent was granted."

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAINIE E. PARKER
AKZO NOBEL INC.
7 LIVINGSTONE AVENUE
DOBBS FERRY, NY 10522-3408

COPY MAILED

NOV 15 2006

OFFICE OF PETITIONS

In re Application of :
Duncan Carr et al :
Application No. 10/167,355 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. ANO 6212 US/3162

This is a decision on the petition filed, November 7, 2006 which is being treated as a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 1, 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 Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1714 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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 2, 2009

TO SPE OF : ART UNIT 1795 - SPE Mark F. Huff Dah-Wei Yuan

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/167,356 Patent No.: 7,122,257 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

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

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

Comments: _____

11/24/09

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper 8

REFLECTIVITY, INC.
350 POTRERO AVENUE
SUNNYVALE, CA 94085

COPY MAILED

MAR 29 2004

OFFICE OF PETITIONS

In re Application of
Patel et al.
Application No.10/167,361
Filed: June 11, 2002
Attorney Docket No. P81-US

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b) filed January 20, 2004 to revive the above-identified application.

This petition is hereby **Dismissed.**

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

This above-identified application became abandoned for failure to file a response to a Notice to file Missing Parts of a Nonprovisional Application which was mailed on July 29, 2002. The Notice to File Missing Parts set a two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on September 30, 2002. A Notice of Abandonment was mailed on January 5, 2004.

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

The instant petition lacks item (1). Although petitioner has provided an executed declaration, petitioner has failed to provide an abstract pursuant to 37 CFR 1.72(b).

It should also be noted the failure to respond to the Notice of Missing Parts was treated as constructive acceptance of the application as it was deposited on June 11, 2002.

A copy of the Missing Parts is being provided for Applicants' 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:	(703) 872-9306
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

enclosure

UNITED STATES 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 8

REFLECTIVITY, INC.
350 POTRERO AVENUE
SUNNYVALE, CA 94085

COPY MAILED

JUL 1 3 2004

OFFICE OF PETITIONS

In re Application of
Patel et al.
Application No.10/167,361
Filed: June 11, 2002
Attorney Docket No. P81-US

DECISION ON PETITIONS

This is a decision on the renewed petition under 37 CFR §1.137(b) filed May 3, 2004 to revive the above-identified application. Petitioner has also submitted a request to withdraw the Notice to File Missing Parts.

The petition to withdraw the Notice to File Missing Parts which is being treated under 37 CFR 1.53 is **Granted -In- Part**.
The renewed petition to revive the application under 37 CFR 1.137(b) is **Granted**.

This above-identified application became abandoned for failure to file a response to a Notice to file Missing Parts of a Nonprovisional Application which was mailed on July 29, 2002. The Notice to File Missing Parts set a two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on September 30, 2002. A Notice of Abandonment was mailed on January 5, 2004. A petition was dismissed on March 29, 2004.

The request to withdraw the Notice of Missing Parts is **Granted -in Part**. On renewed petition, applicant has provided a stamped postcard receipt which serves as prima facie evidence 46 pages of specification, including pages 29-46 (including the abstract) were submitted on June 11, 2002. However, the Notice of Missing Parts was correct to the extent the oath or declaration was missing and it appeared that figures 9F and 9G were omitted.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

Since the original pages 29-46 of the specification cannot be located in the Office, pages 29 and 46 of the specification supplied on May 3, 2004, will be used for processing and examination purposes.

The application will be returned to the Office of Initial Patent Examination for further processing with a **filing date of June 11, 2002**, using the substitute pages 29-46 of the

specification supplied on May 3, 2004.

This application is being forwarded to the Office of Initial Patent Examination for further processing of the application

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Brown

Charlema R. Brown
Petition 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

GERALD F. SWISS
BURNS, DOANE, SWECKER & MATHIS , L.L.P.
P. O. BOX 1404
ALEXANDRIA VA 22313-1404

COPY MAILED
JAN 3 0 2004
OFFICE OF PETITIONS

In re Application of	:	
Gallop et al.	:	
Application No. 10/167,381	:	DECISION DISMISSING
Filed: 12 June, 2002	:	PETITION
Attorney Docket No. 033053-037	:	

This is a decision on the petition filed on 17 November, 2003, requesting that the above-identified application be accorded a filing date of 11 June, 2002, instead of the presently accorded filing date of 12 June, 2002.

Petitioners request the earlier filing date on the basis that the application was purportedly deposited in Express Mail service on 11 June, 2002, pursuant to the requirements of 37 CFR 1.10. In support, petitioners have provided a copy of a mail log purporting to show that, counsel's employee, Sandra Paye, placed the application papers in Express Mail Post Office to Addressee envelope No. EL766105181US (the same Express Mail number found on the itemized Utility Patent Application Transmittal located in the official file) and then placed the Express Mail envelope in "the designated outgoing mail bin to be picked up by our daily mail courier service . . . at 4:00 p.m."

Petitioners have not provided a copy of the Express Mail customer label, but have provided delivery record received from the USPS, showing that the above-referenced Express Mail shipment was delivered on 12 June, 2002, to Washington, DC 20231.

Paragraph (a) of 37 CFR 1.10 states that:

> Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing

> label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.[1] (emphasis added)

At the outset, petitioners are reminded that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked.[2] In this case, it is unclear from the facts presented whether the individual who deposited the application in Express Mail did so at a USPS customer service window or via a drop box. In any event, petitioners could have avoided the predicament that has now occurred by obtaining a copy of the Express Mail mailing label with the "date-in" completed before leaving the USPS customer service window. The Express Mail mailing label provides a means to verify the date that the application papers were deposited in Express Mail Post Office to Addressee Service.

Paragraph (d) of 37 CFR 1.10 states that:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
> (3) The petition includes a showing which establishes, to

---

[1] See 37 CFR 1.6(a).

[2] 37 CFR 1.10(b).

> the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

The petition lacks the showing required by item (3) above. The instant petition is not supported by corroborating evidence showing that the correspondence was deposited as Express Mail prior to the last scheduled pickup on the requested filing date. Petitioners have provided no evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in "Express Mail Post Office to Addressee" service of the USPS. The mail log signed by Ms. Paye states only that she placed the Express Mail envelope in an outgoing mail receptacle to be picked up by a courier, not with the USPS. As such, no statement has been provided from the person (*i.e.*, the courier) who actually deposited the application with the USPS. Any renewed petition would need to be accompanied by evidence that came into being after deposit and within one business day of the deposit of the correspondence which was created by the person who actually deposited the application with the USPS. Alternatively, petitioners should provide evidence from the USPS (*e.g.*, Express Mail Corporate account Mailing Statement or an official letter) showing that the application was accepted by the USPS on 11 June, 2002.

In this regard, the USPS delivery confirmation facsimile showing that the application was delivered on 12 June, 2002 is not persuasive evidence that the application is entitled to a filing date of 11 June, 2002, because the USPS confirmation facsimile does not show the date that the application was accepted by the USPS. As such, it is not possible to verify that the application was in fact deposited with the USPS on 11 June, 2002.

In summary, the showing of record indicates that petitioners intended to deposit the application in Express Mail on 11 June, 2002, however there is no showing that the application was actually deposited in Express Mail Post Office to Addressee service on that date. Petitioners should also note that there is

no provision in the rules for a certificate of mailing by "Express Mail".[3] In accordance with 37 CFR 1.10(d)(3), the Express Mail certificate of mailing may not serve as evidence of timely mailing because it was created prior to the deposit of the application in Express Mail.

Accordingly, the petition is dismissed.

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

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

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

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

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

Telephone inquiries may be directed to the undersigned at 703-308-6918.

D Wood

Douglas Wood
Senior Petitions Attorney
Office of Petitions

[3]The requirement of 37 CFR 1.10(d) for a certificate of mailing by "Express Mail" has been waived by the Commissioner. See 1174 O.G. Pat. Of. 92 (May 16, 1995).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

APR 27 2006

OFFICE OF PETITIONS

In re Application of	:	
Fallon, et. al.	:	
Application No. 10/167,384	:	DECISION ON PETITION
Filed: June 10, 2002	:	TO WITHDRAW
Attorney Docket No. UCAL-263CIP2	:	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 by facsimile transmission on February 3, 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 Karl Bozicevic on behalf of all attorneys and agents of record, who are associated with Customer No. 24353.

All attorneys/agents associated with the Customer Number 24353 have been withdrawn.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

This application file is being referred to Technology Center Art Unit 1649, to await the filing of the Appeal Brief and fee, which should be submitted within two months of the Notice of Appeal filed January 20, 2006[1].

Telephone inquiries concerning this decision should be directed to Andrea Smith at 571-272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

cc: Robert Cogan
Nath & Associates, LLP
12264 El Camino Real, Ste. 400
San Diego, CA 92130

[1] The time period for filing the Appeal Brief and fee can be extended, pursuant to 37 CFR 1.136.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NATH & ASSOCIATES PLLC
112 SOUTH WEST STREET
ALEXANDRIA, VA 22314

COPY MAILED

MAR 3 1 2008

In re Application of	:	
FALLON, et al.	:	
Application No. 10/167,384	:	DECISION ON PETITION
Filed: June 10, 2002	:	TO WITHDRAW
Attorney Docket No. **90417X2**	:	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 28, 2007.

The request is **NOT APPROVED.**

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

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

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **ERIK FLOM, PH. D., ESQ.**
WELSH & KATZ
120 S. RIVERSIDE PLAZA
CHICAGO, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DR. MARK FRIEDMAN LTD.
c/o ANTHONY CASTORINA
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

COPY MAILED

SEP 13 2006

OFFICE OF PETITIONS

In re Application of
Adam Rom et al.
Application No. 10/167,401
Filed: June 13, 2002
Attorney Docket No. 1740/4

ON PETITION

This is a decision on the petition filed June 26, 2006, to withdraw the holding of abandonment under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition under 37 CFR 1.181(b) is **DISMISSED.**

This application became abandoned November 28, 2005 for failure to timely reply to the non-Final Office Action mailed August 25, 2005, which set a three month period for reply. Accordingly, a Notice of Abandonment was mailed May 25, 2006.

The file record discloses that the non-Final Office Action was mailed to what was believed to be the address of record. However, petitioner contends that it was not received. In support of this contention, petitioner indicates that mail from the USPTO is delivered to the address of record and from there forwarded to his address in Tel Aviv and that a review of the docketing system for mail received in Tel Aviv, reveals that there was no indication the non-Final Office Action had been received.

Unfortunately, the requirement under 37 CFR 1.181, that copies of the actual docket records or file jacket be provided, has not been met. In a petition under 37 CFR 1.181 the petitioner must show, as in this instance where non-receipt is claimed that petitioner is without fault in not receiving the communication. In the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received at the address of record. Although the petitioner has provided docket records for the Tel Aviv address, petitioner has not provided any docket records for the address of record which is in the United States.

The docket records for an address that is not the address of record does not substantiate the claim of non-receipt and since no other corroborating evidence to prove non-receipt has been presented, the holding of abandonment cannot be withdrawn.

ALTERNATIVE VENUES

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(a)[1] or 37 CFR 1.137(b),[2] which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

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

---

[1]A grantable petition under 37 CFR 1.137(a) must be accompanied by:

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

(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)).

[2]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)).

statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

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

By FAX: (571) 273-8300

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DR. MARK M. FRIEDMAN
C/O BILL POLKINGHORN - DISCOVERY DISPATCH
9003 FLORIN WAY
UPPER MARLBORO MD 20772

COPY MAILED

DEC 1 2 2008

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Adam Rom et al. :
Application No. 10/167,401 :
Filed: June 13, 2002 :
Attorney Docket No. 1740/4

This is a decision on the petition filed May 13, 2008 under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned November 28, 2005 for failure to timely reply to the non-Final Office Action mailed August 25, 2005, which set a three month period for reply. Accordingly, a Notice of Abandonment was mailed May 25, 2006. A petition filed June 26, 2006 under 37 CFR 1.181 was dismissed in a decision mailed September 13, 2006 because no corroborating evidence to prove non-receipt was presented.

Comes now petitioner with the instant petition to revive.

This matter is being referred to Technology Center 2152 for appropriate treatment of the amendment filed May 13, 2008.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

CONNOLLY BOVE LODGE & HUTZ LLP
SUITE 800
1990 M STREET NW
WASHINGTON DC 20036-3425

COPY MAILED

SEP 2 4 2002

OFFICE OF PETITIONS

In re Application of
Moribatake, et al.
Application No. 10/167,441
Filed: August 9, 2002
Attorney Docket No.: 20162/0590

DECISION GRANTING PETITION

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 page 68 of the specification.

The application was deposited on June 13, 2002. On July 2, 2002, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application (Notice) informing petitioners that page 68 of the specification appeared to have been omitted.

In response to the Notice, a petition under 37 CFR 1.182, including page 68 and a declaration executed on December 11, 1998, was filed on August 9, 2002, requesting that the above-identified application be accorded a filing date as of the date of deposit of the item noted as omitted in the Notice mailed July 2, 2002.

The above-identified application should be accorded a filing date of August 9, 2002, which is the date that page 68 was received in the Office.

The petition is granted.

However, petitioners must submit a clean copy of the declaration executed by both inventors on December 11, 1998. It appears that applicants have modified the original declaration by typing "See attached sheet." Petitioners must submit a clean copy of the December 11, 1998 declaration within **2 MONTHS** of the mail date of this decision.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of **August 9, 2002**, using page 68 filed with the instant petition. The Office of Initial Patent Examination will mail a filing receipt in due course.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
OCT 13 2005
OFFICE OF PETITIONS

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-3801

In re Application of	:
Noriyuki Kaifu et al	:
Application No. 10/167,451	: DECISION GRANTING PETITION
Filed: June 13, 2002	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 03500.010380.36	:

This is a decision on the petition, filed October 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 March 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 2815 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

---

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

UNITED STATES 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

E. I. Du Pont De Nemours & Co.
Legal Patent Records Center
Barley Mill Plaza 25/1128
4417 Lancaster Pike
Wilmington, DE 19805

COPY MAILED
MAR 2 9 2004
OFFICE OF PETITIONS

In re Application of :
Armin Goebel et al. :
Application No. 10/167,527 : ON PETITION
Filed: June 12, 2002 :
Attorney Docket No. FA0901USNA :

This is a decision on the petition under 37 CFR 1.137(b), filed March 18, 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 Non-provisional Application mailed July 12, 2002, which set a shortened statutory period for reply of Two (2) Months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on September 13, 2002.

The Application Data Sheet submitted with the instant application in combination with the declaration submitted with the instant petition will be accepted as complying with 37 CFR 1.63 and 37 CFR 1.76.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

Mail Date: 04/21/2010

Applicant	: Ingrid Birgitta Carlbom	: DECISION ON REQUEST FOR
Patent Number	: 7580912	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/167,533	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/12/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1050** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAN -6 2005

In re Application of Young-Hee Yu Serial No. 10/167,576 Filed: June 13, 2002 For: MULTI-POSITION CONTROL CYLINDER FOR HOT RUNNERS OF INJECTION MOLDING MACHINES AND METHOD OF MANUFACTURING SUCH CYLINDER	DECISION ON PETITION TO WITHDRAW AS ATTORNEY

By papers filed on September 20, 2004, counsel has petitioned to withdraw as attorney of record in this application.

The petition is GRANTED.

Applicant is advised that the current correspondence address for this application is:

Kim and Chung Patent and Law Office
Suite 201 Yuyang Building
823-11 Yoksam-Dong
Gangnam-Ku
Seoul, 135-080 Korea

Richard A. Bertsch, Director
Technology Center 3700

Daniel Bucca
McDermott Will & Emery, LLP
600 13th Street, NW
Washington, DC 20005-3096

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Joseph W. Berenato, III
Liniak, Berenato, Longacre & White, LLC
Ste. 240
6550 Rock Spring Drive
Bethesda, MD 20817

COPY MAILED

NOV 0 8 2002

OFFICE OF PETITIONS

In re Application of Hur, et al. Application No. 10/167,591 Filed: June 13, 2002 Attorney Docket No. 6345.130	DECISION GRANTING PETITION

This is a decision on the "Petition to Reconsider Items Deemed Omitted," filed September 19, 2002. Petitioner requests that the Office accord the above-identified application a filing date of June 13, 2002, with figures 3, 4 and 5 considered a part of the original application disclosure. This petition is properly treated under § 1.53(e)(2)[1].

Application papers in the above-identified application were filed on June 13, 2002. However, on July 19, 2002, the Office of Initial Patent Examination mailed applicants a "Notice to File Corrected Application Papers." Applicants were notified that the application papers had been accorded a filing date; however, figures 3, 4 and 5 described in the specification appeared to have been omitted from the application. In addition, applicants were required to submit substitute drawings in compliance with § 1.84.

In response, applicants timely filed the instant petition. Petitioner asserts that the figures deemed omitted were present in the application on the initial filing date. Petitioner states that by hand courier the instant application including Figures 1-5 was filed in the Office on June 13, 2002. In support thereof, petitioner submits a copy of the acknowledgment postcard returned by the courier and a copy of the return postcard returned by mail by the Office.

Petitioner's evidence is persuasive that the 5 sheets of drawings were present in the application on filing.[2] Nonetheless,

---

[1] §1.53(e) Failure to meet filing date requirements.
... (2) Any request for review of ... a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in §1.17(h). In the absence of a timely (§1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

[2] A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. A review of petitioner's postcard receipts reveals that: 1) they

consideration of this evidence is not necessary. A review of the PACRview image, the scanned image of this application on filing, reveals that as filed the application contained 5 sheets of drawings including figures 3, 4 and 5. Except with regard to compliance with § 1.84, these scanned drawings are the same as the drawings submitted on petition filed September 19, 2002. Furthermore, a review of the application file reveals that the 2 sheets of drawings physically present in the application were filed in another application. (Those drawings have been removed and forwarded for inclusion in the proper application). This evidence supports a conclusion that the drawing sheets as originally filed were misplaced by the Office. Thus, it is concluded that the 5 sheets of drawings including figures 3, 4 and 5 were among the items present in the application on the date of deposit and should be included in the original application papers.

Accordingly, the petition is **GRANTED**.

Given the basis for granting the petition, the petition fee has been refunded to Deposit Account No. 50-0548.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of June 13, 2002, using the application papers received in the Office on that date and the five (5) sheets of substitute drawings supplied on petition filed September 19, 2002.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

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

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

---

both are date stamped as received in the Office of Initial Patent Examination (OIPE) on June 13, 2002; 2) they specifically identify the items being filed, including "Drawings (5 sheets)" and 3) they lack any annotation of nonreceipt of any item denoted on the postcard. The mailed return postcard further identifies this application by assignment of application No. 10/167,591 Thus, petitioner's evidence also shows that the items denoted, including the 5 sheets of drawings, were filed on June 13, 2002.

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND

1 Date of Request: 10/28/02

2 Serial/Patent # 10/167,591

	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	9/19/02	$ 130.00
	Issue			$
	Cert of Correction/Terminal Disc.			$
	Maintenance			$
	Assignment			$
	Other			$

7 TOTAL AMOUNT OF REFUND $ 130.00

8 TO BE REFUNDED BY:

	Treasury Check
X	Credit Deposit A/C #:

9 50--0548

10 REASON:

	Overpayment
	Duplicate Payment
X	No Fee Due (Explanation):

Filing Date Grant under 1.53(e)(2).

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: NANCY JOHNSON TITLE: Petitions Attorney

SIGNATURE: Nancy Johnson PHONE: 703-305-0309

OFFICE: Petitions, 4700

****

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: Alicia Kelly DATE: 11/8/02

Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:

Office of Finance
Refund Branch
Crystal Park One, Room 802B

FORM PTO 1577
(01/90)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

B-MOSS USA, INC.
C/O DIMITRI PRESSMAN
379 FIFTH AVENUE
4TH FLOOR
NEW YORK NY 10016

COPY MAILED

FEB 0 2 2007

OFFICE OF PETITIONS

In re Application of	:	
Mordeckai Mouyal	:	
Application No. 10/167,599	:	DECISION ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No.	:	

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

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed March 16, 2005, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 17, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election, (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

The power of attorney received with petition on September 11, 2006 is not accepted. 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 11, 2006 does not include one of the above two options.

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

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

This application is being referred to Technology Center AU 3611 for appropriate action by the Examiner in the normal course of business on the reply received.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WELLSTAT MANAGEMENT COMPLAY LLC
LEGAL DEPARTMENT
930 CLOPPER ROAD
GAITHERSBURG, MD 20878

COPY MAILED

DEC 23 2009

OFFICE OF PETITIONS

In re Application of	:	
Michael S. Roberts, et al.	:	
Application No. 10/167,652	:	DECISION GRANTING PETITION
Filed: June 13, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 18004-CP2C1	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 18, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on October 23, 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 regarding 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.

This application is being referred to Technology Center AU 1632 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Wellstat Management Company.
LLC
LEGAL DEPARTMENT
930 CLOPPER ROAD
GAITHERSBURG MD 20878

COPY MAILED
JAN 27 2010

In re Application of	:	
Roberts, et al.	:	
Application No. 10/167,652	:	ON APPLICATION FOR
Filed: June 13, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No.18004-CP2C1	:	

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed October 23, 2009, which is properly treated under 37 CFR 1.705(b). Applicants submit that the patent term adjustment to be indicated on the patent is a minimum of five hundred twenty (520) days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction 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

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].

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

---

[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.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on October 23, 2007.

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 Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9-6-06

TO SPE OF : ART UNIT 2828

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/1676664 Patent No.: 6995516

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.

Check Drawings

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

Certificates of Correction Branch

703-308-9390 ext. 117

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: page 3 of 4, column 23, line 33 should have been line 34

DOUGLAS W. OWENS
PRIMARY EXAMINER SPE

2821
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

COPY MAILED
SEP 1 1 2006
OFFICE OF PETITIONS

In re Application of	:	
Rogerio Costa	:	
Application No. 10/167,672	:	DECISION ON PETITION
Filing Date: June 11, 2002	:	UNDER 37 C.F.R. § 1.137(B)
Attorney Docket Number: PPC-803	:	
Title: ABSORBENT TAMPON HAVING	:	
OUTER PETALS	:	

This is a decision on the petition under 37 CFR §1.137(b)[1], filed June 13, 2006, to revive the above-identified application.

The above-identified application became abandoned for failure to file a proper response to the Restriction Requirement, mailed June 29, 2004, which set a shortened statutory period to reply for one month. A response was received on August 2, 2004 which contained a certificate of mailing dated July 29, 2004. A communication was mailed on November 1, 2004, which indicated that the submission was not fully responsive and set a period for response of one month. No further submissions, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were received. Accordingly, the above-identified application became abandoned on December 2, 2004. A Notice of abandonment was mailed on September 14, 2005.

---

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.

37 C.F.R. §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 C.F.R. §1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §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.

With the present petition, Petitioner has submitted the petition fee, a response, and a statement which is being construed as the proper statement of unintentional delay. A terminal disclaimer is not required.

Petitioner has met all requirements for a grantable petition under 37 C.F.R. §1.137(b).

As such, the petition is **GRANTED**.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the submission which was received with the present petition can be processed.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[2]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

COPY MAILED

FEB 19 2004

OFFICE OF PETITIONS

MARK W. CROLL
ILLINOIS TOOL WORKS INC.
3600 WEST LAKE AVENUE
GLENVIEW IL 60025

In re Application of
Craig W. Arends et al.
Application No. 10/167,680
Filed: June 12, 2002
Attorney Docket Number: 12999

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b),[1] filed February 9, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned September 19, 2002, for failure to timely reply to the Notice to File Corrected Application Papers mailed on July 18, 2002, which set a two (2) month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed January 27, 2004.

Receipt of the substitute drawings submitted to comply with 37 CFR 1.84 is acknowledged.

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WISCONSIN ALUMNI RESEARCH FOUNDATION
C/O BOYLE FREDRICKSON S.C.
840 North Plankinton Avenue
Milwaukee, WI 53203

COPY MAILED

MAR 25 2008

OFFICE OF PETITIONS

In re Application of	:	
FRED T. LEE ET AL	:	
Application No. 10/167,681	:	ON PETITION
Filed: June 10, 2002	:	
Attorney Docket No. 1512.001_1	:	

This is a decision on the petition under 37 CFR 1.127, which was filed November 7, 2007. The petition is being considered under 37 CFR 1.181, as a petition to invoke the supervisory authority of the Director.

The petition is **DISMISSED**.

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

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 11, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, by operation of law, the above-identified application became statutorily abandoned on July 12, 2007.

Petitioner states that a timely response was electronically filed on June 28, 2007, and that the filed papers correctly identified, on their face, the proper serial number, title, filing date, art unit, and the examiner handling the case.

The required reply must be signed and identified as being submitted for the application in issue. A review of the petition indicates that the signature page of the petition (page 2) contains a different serial number and identifies a different inventor. Hence it is unclear as to the intent of the signing party regarding which particular application the page should be placed.

For the above reasons the petition is **dismissed.**

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

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

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

Telephone inquiries concerning this decision should be directed to Thurman K. Page at (571) 272-0602.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WISCONSIN ALUMNI RESEARCH FOUNDATION
C/O BOYLE FREDRICKSON S.C
840 North Plankinton Avenue
Milwaukee WI 53203

In re Application of	:
Lee, Fred T. et al	:
Appl. No.: 10/167,681	: DECISION ON PETITION
Filed: Jun. 10, 2002	:
For: RADIO-FREQUENCY ABLATION	:
SYSTEM USING MULTIPLE	:
ELECTRODES	:

This is a decision on the petitions filed on Nov. 7, 2007 and Mar. 4, 2008. In the petition of Nov. 7, 2007, petitioner requests acceptance of amendment filed by facsimile on Jun. 28, 2007. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition filed on Nov. 7, 2007 is granted.
The petition to suspend action filed on Mar. 4, 2008 is dismissed as moot.

In the petition, petitioner asserts that on Jun. 28, 2007, an amendment was electronically transmitted to USPTO. With unexplained reason, a wrong serial number 11/770,218 was shown on the auto-generated filing receipt. Subsequently, the amendment for this application failed to reach to the examiner. Petitioner has submitted an evidentiary copy of the Jun. 28, 2007 amendment along with a copy of a filing receipt. Based upon this evidence, the duplicate amendment filed with the petition is accepted. A review of the record also shows the original amendment was in fact received by the USPTO and matched with the current application.

The application is being forwarded to the examiner of record in Art Unit 3735 for consideration of the amendment filed on Jun. 28, 2007. The inconvenience caused is regretted. The petition to suspend office action pending the outcome of the earlier petition of Nov. 7, 2007 is unnecessary. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED

Karen M. Young

Karen M. Young, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WISCONSIN ALUMNI RESEARCH FOUNDATION
C/O BOYLE FREDRICKSON S.C
840 North Plankinton Avenue
Milwaukee WI 53203

COPY MAILED

MAY 1 4 2008

OFFICE OF PETITIONS

In re Application of	:	
Fred T. LEE et al.	:	
Application No. 10/167,681	:	ON PETITION
Filed: June 10, 2002	:	
Attorney Docket No. 1512.001_1	:	

This is a decision on the renewed petition under 37 CFR 1.181, filed April 24, 2008, requesting entry of the amendment filed June 28, 2007.

The petition is **GRANTED**.

Petitioner asserts that on June 28, 2007, an amendment was electronically transmitted to the USPTO. With unexplained reason, a wrong serial number was shown on the auto-generated filing receipt. Subsequently, the amendment for this application failed to reach the examiner. Petitioner has submitted an evidentiary copy of the June 28, 2007 amendment along with a copy of the filing receipt. Based upon this evidence, the duplicate amendment filed with the petition is accepted. A review of the record also show the original amendment was in fact received by the USPTO and matched with the current application.

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

The application file is being referred to Technology Center AU 3735 for appropriate action on the amendment filed July 13, 2005.

David Bucci
Petitions Examiner
Office of Petitions

OIPE JC176
MAY 1 2 2003
PATENT & TRADEMARK OFFICE

RECEIVED
FEB 2 2 2001
NELSON MULLINS
COLUMBIA

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

Paper No. 4

COPY MAILED

FEB 1 6 2001

OFFICE OF PETITIONS
A/C PATENTS

NELSON MULLINS RILEY & SCARBOROUGH
1330 LADY STREET
COLUMBIA, SC 29201

RECEIVED
MAY 2 1 2003
TECHNOLOGY CENTER R3700

In re Application of
Stephen W. Steadings et al.
Application No. 09/736,762
Filed: December 12, 2000
Attorney Docket No. 03752/9071CO2
JCM-215-CON2

: DECISION GRANTING
: PETITION

This is a decision on the petition under 37 CFR 1.10(c) filed January 29, 2001, requesting that the above-identified application be accorded a filing date of December 12, 2000, instead of the presently accorded date of December 13, 2000.

Petitioner alleges that the application was deposited in "Express Mail" service with the U.S. Postal Service, on December 12, 2000. In support, petitioners provided a copy of the Express Mail label, receipt no. EL515962012US, showing a Date-In of December 12, 2000. The same Express Mail receipt number was referred to in the copy of the original Application Transmittal Letter submitted with the instant petition. Petitioner requests that the application be accorded a filing date of December 12, 2000.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on December 12, 2000.

MD ✓

The petition is granted.

NOTE

The application is being returned to Initial Patent Examination Division for correction of the filing date to December 12, 2000.

dwh
8-4-04

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202

COPY MAILED

FEB 1 7 2005

OFFICE OF PETITIONS

In re Application of

Lin and Gomm

Application No. 10/167,709

Filed: June 12, 2002

Attorney Docket No.
37829.1000/Mic.01-101701

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 31, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure timely file an Appeal brief subsequent to the filing of the Notice of Appeal on April 9, 2004. The application became abandoned on June 10, 2004. A Notice of Abandonment was mailed on November 30, 2004.

The petition fee of $1,500.00 and the Request for Continued Examination fee of $790.00 will be charged to deposit account 19-2814.

The Request for Continued Examination and amendment filed January 31, 2005, are noted.

The application is being forwarded to Technology Center 2800, GAU 2816 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
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 03-03

Paper No. 10

JOHN F. LETCHFORD
KLEHR, HARRISON, HARVEY, BRANZBURG, & ELLERS
260 SOUTH BROAD STREET
PHILADELPHIA PA 19102

BEST AVAILABLE COPY

COPY MAILED
MAR 2 8 2003
OFFICE OF PETITIONS

In re Application of	:
Robins et al.	:
Application No. 10/167,711	: DECISION GRANTING
Filed: 11 June, 2002	: PETITION
Attorney Docket No. 11241-0024	:

This is a decision on the renewed petition filed on 17 March, 2003 (certificate of mailing date 10 March, 2003), requesting that the above-identified application be accorded a filing date of 11 June, 2002, instead of the presently accorded filing date of 13 June, 2002.

The petition is **granted**.

Petitioners request the earlier filing date on the basis that the application was purportedly deposited in Express Mail service on 11 June, 2002, pursuant to the requirements of 37 CFR 1.10. In support, petitioners have provided a statement by Howard Sharp, Supervisor, Customer Service for the USPS Land Title Station, Philadelphia, PA, stating that, based on the circumstances of this situation, an Express Mail package bearing Customer Number ET698465373US (the same Express Mail number found on the itemized Utility Patent Application Transmittal located in the official file) was accepted by the USPS on 11 June, 2002.

In view of the evidence present in the file, it is concluded that the correct date of deposit in Express Mail service is 11 June, 2002.

In view of the above, the application is entitled to a filing date of 11 June, 2002.

The petition is granted. The petition fee of $130.00 will be credited to counsel's deposit account, No. 50-1555.

The application is being returned to Office of Initial Patent Examination for reprocessing with a filing date of 11 June, 2002, not 13 June, 2002, and for issuance of a corrected Filing Receipt.

Telephone inquiries may be directed to the undersigned at 703-308-6918.

D Wood

Douglas Wood
Senior Petitions Attorney
Office of Petitions

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 11-02

Paper No. 8

JOHN F. LETCHFORD
KLEHR, HARRISON, HARVEY, BRANZBURG, & ELLERS
260 SOUTH BROAD STREET
PHILADELPHIA PA 19102

COPY MAILED

NOV 1 4 2002

OFFICE OF PETITIONS

In re Application of	:
Robins et al.	:
Application No. 10/167,711	: DECISION DISMISSING
Filed: 13 June, 2002	: PETITION
Attorney Docket No. 11241-0024	:

This is a decision on the petition filed on 15 October, 2002, requesting that the above-identified application be accorded a filing date of 11 June, 2002, instead of the presently accorded filing date of 13 June, 2002.

Petitioners request the earlier filing date on the basis that the application was purportedly deposited in Express Mail service on 11 June, 2002, pursuant to the requirements of 37 CFR 1.10. In her declaration, counsel's paralegal, Vanessa G. Hilton, states that she placed the application papers in Express Mail Post Office to Addressee envelope No. ET698465373US (the same Express Mail number found on the itemized Utility Patent Application Transmittal located in the official file) and then placed the Express Mail envelope in counsel's Messenger Department, which was "to deliver all outgoing mail to the USPS and other courier services on the date that they [*sic*] are received by the Messenger Department."

Petitioners further state that no copy of the Express Mail customer label was ever received from the USPS, and that counsel's secretary was informed by the USPS that the customer

label had become lost. Petitioners have provided, however, a letter from the USPS showing that the above-referenced Express Mail shipment was delivered on 12 June, 2002, to the Washington, DC 20231 ZIP code. Petitioners assert that since the application was delivered on 12 June, 2002, it must have been deposited with the USPS on 11 June, 2002.

Paragraph (a) of 37 CFR 1.10 states that:

> Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.[1] (emphasis added)

At the outset, petitioners are reminded that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked.[2] In this case, it is unclear from the facts presented whether the individual who deposited the application in Express Mail did so at a USPS customer service window or via a drop box. In any event, petitioners could have avoided the predicament that has now occurred by obtaining a copy of the Express Mail mailing label with the "date-in" completed before leaving the USPS customer service window. The Express Mail mailing label provides a means to verify the date that the application papers were deposited in Express Mail Post Office to Addressee Service.

Paragraph (d) of 37 CFR 1.10 states that:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail

---

[1] See 37 CFR 1.6(a).

[2] 37 CFR 1.10(b).

> Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

The petition lacks the showing required by item (3) above. The instant petition is not supported by corroborating evidence showing that the correspondence was deposited as Express Mail prior to the last scheduled pickup on the requested filing date. Petitioners have provided no evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in "Express Mail Post Office to Addressee" service of the USPS. The declaration of Ms. Hilton was not made within one business day of deposit and shows only that she deposited in the application in counsel's mail room, not with the USPS. Any renewed petition would need to be accompanied by evidence that came into being after deposit and within one business day of the deposit of the correspondence which was created by the person who actually deposited the application with the USPS. Alternatively, petitioners should provide evidence from the USPS (e.g. Express Mail Corporate account Mailing Statement or an official letter) showing the date the application was accepted by the USPS.

In this regard, the USPS delivery confirmation facsimile showing that the application was delivered on 12 June, 2002 is not persuasive evidence that the application is entitled to a filing date of 11 June, 2002, because the USPS confirmation facsimile does not show the date that the application was accepted by the USPS. As such, it is not possible to verify that the application was in fact deposited with the USPS on 11 June, 2002.

In summary, the showing of record indicates that petitioners intended to deposit the application in Express Mail on 11 June, 2002, however there is no showing that the application was actually deposited in Express Mail Post Office to Addressee service on that date. Petitioners should also note that there is no provision in the rules for a certificate of mailing by "Express Mail".[3] In accordance with 37 CFR 1.10(d)(3), the Express Mail certificate of mailing may not serve as evidence of timely mailing because it was created prior to the deposit of the application in Express Mail.

Accordingly, the petition is dismissed.

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

Telephone inquiries may be directed to the undersigned at 703-308-6918.

D Wood

Douglas Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[3]The requirement of 37 CFR 1.10(d) for a certificate of mailing by "Express Mail" has been waived by the Commissioner. See 1174 O.G. Pat. Of. 92 (May 16, 1995).

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 01 2004

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

Paper No. 5

Thompson & Thompson, P.A.
310 4th Street
P.O. Box 66
Scandia, KS 66966

In re Application of	:	
Matt D. Pursley et al	:	*SUA SPONTE*
Serial No. : 10/167,718	:	RESCISSION OF
Filed : June 11, 2002	:	NOTICE OF
For : Method and Apparatus for Curving Catheter with Soft Distal End	:	ABANDONMENT

A review of the application reveals that an Office action was mailed to applicants on December 17, 2003. On June 22, 2004, a Notice of Abandonment was mailed indicating that the application was being abandoned for failure to file a response to the Office action mailed December 17, 2003. The abandonment of the application was premature given the fact that applicant had filed a response on June 17, 2004. The response included a three-month extension of time request.

In view of these facts, the abandonment was clearly premature and is hereby rescinded. The application will be forwarded to the Examiner via the Legal Instruments Examiner for entry and consideration of the response filed June 17, 2004.

Summary: Holding of Abandonment Rescinded.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873

ak/08/25/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WINSTON & STRAWN LLP
1700 K STREET, N.W.
WASHINGTON DC 20006

COPY MAILED
OCT 26 2005
OFFICE OF PETITIONS

In re Application of	:	
Gilon et al.	:	
Application No. 10/167,723	:	DECISION DISMISSING PETITION
Filed: 11 June, 2002	:	
Atty Docket No. 87534-2699	:	

This is a decision in reference to the "Petition for Filing Date" filed on 16 September, 2002, which is treated as a petition, requesting that the above-identified application be accorded a filing date of 11 June, 2002, with Pages 7, 12, 22, 27, 102, and 107 of the specification as a part of the original disclosure.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is dismissed.

On 11 June, 2002, the application was filed.

Accordingly, on 15 July, 2002, Initial Patent Examination Division mailed a "Notice to Comply" stating, *inter alia*, that the application had been accorded a filing date of 11 June, 2002, but that Pages 7, 12, 22, 27, 102, and 107 of the specification (description and claims) appeared to have been omitted. In response, on 16 September, 2002, the present petition and a copy of Pages 7, 12, 22, 27, 102, and 107 of the specification were filed.

Petitioners concede that Pages 7, 12, 22, 27, 102, and 107 were inadvertently omitted from the application, but state that the omitted Pages are contained in the disclosure of Application No. 09/580,905, the disclosure of which is incorporated by reference in the present application.

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, however, petitioners neither assert that the missing pages of specification were deposited on 11 June, 2002, nor request the 16 September, 2002 (the date the missing pages of specification were supplied), filing date.

As Pages 7, 12, 22, 27, 102, and 107 were not present on 11 June, 2002, the application cannot be accorded a filing date of 11 June, 2002, with Pages 7, 12, 22, 27, 102, and 107 as a part of the original disclosure. Still further, the question of new matter is not an issue here. Pages 7, 12, 22, 27, 102, and 107 simply were not filed in the USPTO on 11 June, 2002.

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 7, 12, 22, 27, 102, and 107 of the

specification are not new matter if they were a part of the disclosure of the prior application.

Petitioner should file Pages 7, 12, 22, 27, 102, and 107 as a preliminary amendment. If Pages 7, 12, 22, 27, 102, and 107 are filed as a preliminary amendment, it will be reviewed by the examiner for new matter.

The application will be processed using only the application papers present on filing. The copy of Pages 7, 12, 22, 27, 102, and 107 filed with the present petition will not be processed for examination, but will be retained in the application file.

As this petition was necessitated by applicants' filing error rather than an error on the part of the Office, a petition fee of $130.00, the fee applicable at the time petition was filed, is due. The fee will be charged to counsel's deposit account, No. 50-1814, as authorized in the preliminary amendment filed on 11 June, 2002.

The application is being returned to the Office of Publications for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW Nov-05

WINSTON & STRAWN LLP
1700 K STREET, N.W.
WASHINGTON DC 20006

COPY MAILED

NOV 17 2005

OFFICE OF PETITIONS

In re Application of	:	
Gilon et al.	:	
Application No. 10/167,723	:	DECISION ON PETITION
Filed: 11 June, 2002	:	
Atty Docket No. 87534-2699	:	

This is a decision in reference to the "Request for Reconsideration of Decision on Petition" filed on 1 November, 2005, which is treated as a petition requesting that the application be accorded a filing date 11 June, 2002.

The petition is granted to the extent indicated.

On 11 June, 2002, the application was filed.

On 15 July, 2002, Initial Patent Examination Division mailed a "Notice to Comply" stating, *inter alia*, that the application had been accorded a filing date of 11 June, 2002, but that Pages 7, 12, 22, 27, 102, and 107 of the specification (description and claims) appeared to have been omitted.

In response, on 12 September, 2002, a copy of Pages 7, 12, 22, 27, 102, and 107 of the specification were filed. On 16 September, 2002, a petition was also filed requesting that that the copy of Pages 7, 12, 22, 27, 102, and 107 be considered part of the original disclosure. On 26 October, 2005, the petition was dismissed.

On 1 November, 2005, the present request for reconsideration was filed. Petitioners note that the application has been assigned a filing date of 12 September, 2002. Petitioners request that the application be accorded a filing date of 11 June, 2002, and that Pages 7, 12, 22, 27, 102, and 107 of the specification be considered part of the original disclosure.

As the original application papers deposited on 11 June, 2002, constituted a complete application for filing date purposes, the application, including the specification, claims, and drawings filed on 11 June, 2002, is entitled to a filing date of 11 June, 2002.

As stated in the decision mailed on 26 October, 2005, in the absence of evidence that Pages 7, 12, 22, 27, 102, and 107 were among the application papers deposited on 11 June, 2002, the application cannot be accorded a filing date of 11 June, 2002, including Pages 7, 12, 22, 27, 102, and 107. Rather, an amendment should be filed if petitioners desire to file these pages. Any amendment will be reviewed by the examiner for new matter.

The application will be processed with a filing date of 11 June, 2002, using only the application papers present on filing. The pages supplied on 16 September, 2002, will not be considered part of the original disclosure, but will be retained in the record.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 11 June, 2002, and issuance of a corrected filing receipt.

The application will be processed using only the application papers present on filing. The copy of Pages 7, 12, 22, 27, 102, and 107 filed with the present petition will not be processed for examination, but will be retained in the application file.

As the filing date was changed as a result of Office error, no further petition fee is due and none has been charged.

The application is being returned to the Office of Initial Patent Examination for correction of the filing date to 11 June, 2002, and issuance of a corrected filing receipt.

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

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/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/167,759	06/12/2002	Craig Newswanger	ZEB0039US

CONFIRMATION NO. 4614

OC000000011030012

CAMPBELL STEHENSON ASCOLESE LLP
Building 4, Suite 201
4807 Spicewood Springs Road
Austin, TX 78759

Date Mailed: 10/14/2003

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 01/22/2004.

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 (703) 305-9282. 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".

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

CAMPBELL STEHENSON ASCOLESE LLP
Building 4, Suite 201
4807 Spicewood Springs Road
Austin TX 78759

COPY MAILED
OCT 1 4 2003
OFFICE OF PETITIONS

In re Application of
Craig Newswanger et al.
Application No. 10/167,759
Filed: June 12, 2002
Attorney Docket No. ZEB0039US
Title: PULSED-LASER SYSTEMS AND METHODS FOR PRODUCING HOLOGRAPHIC STEREOGRAMS

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(f)

This is a decision on the petition filed on July 24, 2003, pursuant to 37 C.F.R. §1.137(f), to revive the above-identified application.

A grantable petition pursuant to 37 CFR 1.137(f) must be accompanied by:

(1) Notification of the filing of an application in a foreign country or under a multinational treaty that requires 18 month publication[1];
(2) The petition fee as set forth in 37 C.F.R. § 1.17(m), and;
(3) A statement that the entire delay in filing the notice from the date that the notice was due under 35 U.S.C. §122(b)(2)(B)(iii) until the date the notice was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner states that the instant nonprovisional application is the subject of an application filed in either a foreign or an international application on November 26, 2002. However, the United States Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

On January 7, 2003, a Notice of Rescission of Nonpublication Request was filed with the Office. Unfortunately, notification of the filing of the international application did not accompany this filing.

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.

BEST AVAILABLE COPY

In view of the above, this application became abandoned pursuant to 35 U.S.C. §1.22(b)(2)(B)(iii) and 37 C.F.R. §1.213(c) for failure to timely notify the Office of the filing of either a foreign application or an application under a multilateral international agreement that requires publication of applications 18 months after filing.

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

Petitioner has submitted the notification of either a foreign or an international filing, paid the petition fee, and has made 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 January 22, 2004 accompanies this decision on petition.

After this decision is mailed, the application will be forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning *this decision* should be directed to Attorney Paul Shanoski at (703) 305-0011.

Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Nokia
c/o DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
NEW YORK NY 10008-0770

MAILED

MAY 19 2010

OFFICE OF PETITIONS

In re Application of
Jussi Ruutu, et al.
Application No. 10/167,769
Filed: June 11, 2002
Attorney Docket No. **28212/000S059-US0/NC19451**

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney of record under 37 CFR § 1.36, filed March 16, 2010.

The request is **NOT APPROVED**.

The request cannot be approved because it lacks a forwarding correspondence address of the first named inventor or a properly intervening assignee.

If the forwarding correspondence address is to the assignee, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *that properly became of record under 37 CFR 3.71.* 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **NOKIA, INC.**
6021 CONNECTION DRIVE
MS 2-5-520
IRVING, TX 75039

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

AUG 13 2007

OFFICE OF PETITIONS

In re Application of	:	
Estevez, et al.	:	
Application No. 10/167,790	:	DECISION ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. TI-33158	:	

This is a decision on the petition under 37 CFR 1.182, filed, May 26, 2006, to change the name of inventor "Mary A. DuVal" to – "Mary A. Metelko --.

The petition is **GRANTED**.

Office records have been updated to reflect the inventor's change of name. A corrected Filing Receipt, which reflects the inventor's change of name, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230. Any questions concerning the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2623 for consideration of the amendment filed on June 12, 2007.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
10/167,790	06/12/2002	2623	954	TI-33158	18	4

CONFIRMATION NO. 9428

CORRECTED FILING RECEIPT

OC000000025287675

23494
TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Date Mailed: 08/09/2007

Receipt is acknowledged of this nonprovisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Leonardo W. Estevez, Rowlett, TX;
Frank J. Moizio, Dallas, TX;
Mary A. Metelko, Farmers Branch, TX;
William M. Bommersbach, Richardson, TX;

Power of Attorney: The patent practitioners associated with Customer Number **23494**.

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/297,565 06/12/2001

Foreign Applications

If Required, Foreign Filing License Granted: 07/17/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/167,790

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Wireless display

Preliminary Class

725

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

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

GRANTED

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

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

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Wells St. John Roberts Gregory & Matkin P.S.
601 W. First Avenue
Suite 1300
Spokane, WA 99201-3828

MAILED
SEP 8 2003
OFFICE OF DIRECTOR
GROUP 35

In re Application of	)	
McKenna et al.	)	
Application No. 10/167,808	)	
Filed: June 10, 2002	)	DECISION ON PETITION
For: Method of Forming Magnetic Eyeglass	)	
Appliance	)	

This is a decision on the petition, filed August 12, 2003, to withdraw the holding of abandonment of the above-identified application.

The petition is GRANTED.

This application was held abandoned for failure to timely pay the issue fee in response to the Notice of Allowance and Issue Fee Due mailed March 18, 2003. A Notice of Abandonment was mailed on July 24, 2003.

Petitioner states that a Request for Continued Examination (RCE) was in fact timely filed, however, due to a clerical error the serial number given on the documents identified the parent application which had issued a year earlier. Otherwise, the attorney docket number, the examiner, the inventor, the assignee and the title of the application were correctly identified on the documents filed. To support this assertion, petitioner has submitted a copy of the certificate of hand delivery and a return postcard receipt which acknowledges receipt of an RCE, the transmittal letter and the required submission in the form of an Information Disclosure Statement (IDS) in the USPTO on June 18, 2003. A copy of the response was submitted with the petition.

A review of the parent application, US Patent 6,412,942, reveals that the IDS was entered into the patented file and the RCE and transmittal letter was attached thereto.

M.P.E.P. § 502 states 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 transposed numbers, typographical errors and listing the parent application number."

The RCE, transmittal letter and the IDS submitted on June 18, 2003 has been removed from the patented file. The patent application serial number given on the RCE, transmittal letter and the IDS has been corrected to properly identify this application and matched with this file.

M.P.E.P. § 503 states that "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the RCE was timely received in the PTO.

In view of the above stated reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The application file is being forwarded to the Technical Support staff for processing the RCE. From there, the application file will be returned to the examiner for further examination..

José G. Dees, Special Program Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components
(703) 308-4628

UNITED STATES PATENT AND TRADEMARK OFFICE

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

dss

Mailed: 11-30-05

In re application of :
Alice Mary O'Donnell Kiely
Serial No. 10/167,812 :
Filed: June 12, 2002 :
For: NUTRITIOUS SUPPORTS FOR
COMESTIBLES WITH OPTIONAL, EDIBLE MESS GUARDS
AND DRIP GUARDS :

DECISION ON
PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT under 37 CFR 1.181 filed April 19, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of April 04, 2005, for failure to timely file a proper reply to the Office letter of August 26, 2004, be withdrawn since the applicants did timely file a response thereto on September 27, 2004. (A copy of the response filed September 27, 2004 is attached to the instant request.)

DECISION

The instant request has been accepted as a timely 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 filed with the USPTO on September 27, 2004 as evidenced by the date stamped return receipt postcard indicating receipt of the response at the USPTO on September 27, 2004. A further review of the each of the originally filed papers indicates that applicant's response of September 17, 2004 contained incorrect Serial No. 10/347,018 thereon but the response contained thereon the correct inventors, title, art unit, and examiner. Further, review of the response of September 17, 2004 clearly indicates it is directed to the election/restriction requirement of the Office letter of August 26, 2004.

Therefore upon consideration of the entirety of the evidence presented it is considered that applicant's response filed September 27, 2004 was intended to be filed in serial number 10/167,812 rather than the incorrect serial number of 10/347,018 listed on the response, thus, the application was never in-fact abandoned and any holding of abandonment for failure to timely file a proper response to the Office letter mailed on August 26, 2004 is hereby vacated, and the application is returned to pending status. The application shall be forwarded to the examiner for processing and consideration of the papers originally filed September 27, 2004.

The Petition is **GRANTED**.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Alice O. Kiely
71 Stonewall Court
Yorktown Heights, NY 10598

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Daniel R. Pote, Esq.
SNELL & WILMER LLP
One Arizona Center
400 Easten Van Buren
Phoenix AZ 85004-2202

COPY MAILED

SEP 08 2005

OFFICE OF PETITIONS

In re Application of	:	
Basab DATTARAY et al.	:	
Application No. 10/167,818	:	ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. 39597.0100	:	

This is a decision on the petition under 37 CFR 1.137(b), filed August 25, 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 November 22, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on February 23, 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 a Request for Continued Examination; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of November 22, 2004 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099 or in his absence, the undersigned at (571) 272-3217.

The application file is being referred to Technology Center AU 3714 for appropriate action on the concurrently filed amendment.

Brian Hearn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

AUG - 9 2004

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

MAILED

AUG 9 2004

OFFICE OF THE DIRECTOR
TC 3600

Philip J. Lee
Suite 525
10050 Regency Circle
Omaha, NE 68114

In re Application of	:	
Thomas G. Hechimovich et al.	:	
Serial No. 10/167,828	:	WITHDRAWAL FROM ISSUE
Filed June 12, 2002	:	
For: RELEASABLE SNAP HOOK CLASP	:	

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.

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee 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.

Robert J. Oberleitner, Director
Technology Center 3600
Phone: (703) 308-1134
Fax: (703) 308-2177

cc: Office of Publications (2 copies)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JAN 24 2007

OFFICE OF PETITIONS

Lewis Kreisler
930 Clopper Road
Gaithersburg, MD 20878

In re Application of:
Sharma
Application No. 10/167,839
Patent No. 7,101,910
Filing Date: June 12, 2002

: Decision Dismissing Petition

This decision is in response to Applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)" timely[1] filed on September 8, 2006. Applicants' request that the PTA be adjusted to reflect a determination of either420 days at the time of the issuance of the application.

Applicants' petition for PTA adjustment is **DISMISSED.** Applicants are given thirty days to respond to such decision. No extensions of time are granted under 37 CFR 1.136.

Applicants argue that the Office erred in assessing a reduction of 120 days for the submission of a refund request on May 25, 2005. Applicants do not dispute a reduction pursuant to 37 CFR 1.704(c)(10) but believe that the should be limited to 40 days. Applicants assert that the forty day reduction should stop on the date September 17, 2004 date that the money was deposited to the account.

Applicants arguments are not deemed persuasive. The Office notes that the reduction was not due to a refund request on August 2, 2005. Rather, the reduction pursuant to 37 CFR 1.704(c)(10) is due to a status inquiry submitted on May 25, 2005. Accordingly, the one hundred and twenty (120) reduction is deemed proper. See Clarification of 37 CFR 1.704(c)(10)-Reduction of Patent Term Adjustment for Certain Types of Papers After a Notice of Allowance Has Been Mailed 1247 OG 111 (June 26,2001).

After the mailing of the decision, the filed will be returned to the file repository for proper handling.

The Office has assessed the $200.00 fee for this submission of this petition. No additional fees are required by the Office.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

---

[1]Patent issued on September 5, 2006.

Kery Fries

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

FEB 07 2007

OFFICE OF PETITIONS

Lewis Kreisler
930 Clopper Road
Gaithersburg, MD 20878

In re Application of:
Sharma
Application No. 10/167,839
Patent No. 7,101,910
Filing Date: June 12, 2002

: Supplemental Decision granting petition

This decision is in response to Applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)" timely[1] filed on September 8, 2006. Applicants' request that the PTA be adjusted to reflect a determination of either 407 or 420 days at the time of the issuance of the application. The Office had previously determined that the petition was dismissed, however, the decision addressed only the submission on May 25, 2005 and not the submission on August 9, 2004.

Applicants' petition for PTA adjustment is **GRANTED TO THE EXTENT HEREIN INDICATED.** The Office will adjust the PAIR calculation to reflect a determination of **407** days at the time of issuance. In addition, the Office will *sua sponte* issue a certificate of correction reflecting this decision.

Applicants argue that the Office erred in assessing a reduction of 120 days for the submission of a refund request on August 9, 2004. Applicants do not dispute a reduction for refund request pursuant to 37 CFR 1.704(c)(10) but believe that the reduction should be limited to 40 days or alternatively 53 days if the response occurred on September 30, 2006. Applicants assert that the forty day reduction should stop on the date September 17, 2004 date that the money was deposited to the account. Alternatively, the applicants assert that the reduction under 37 CFR 1.704(c)(10) should have stopped on the date of September 3, 2006, (53 days) which is the date that the Office mailed applicants a deposit statement reflecting the refund.

Applicants arguments are deemed persuasive. The Office notes that the August 9, 2004 reduction was due to a refund request. However, applicants have submitted proof that the Office did mail a reply in the form a deposit account statement on September 30, 2006. Accordingly, the applicant should have only received a delay of 53 days not 120 as assessed. As for the date of September 17, 2006, the Office notes that the Office did not mail a letter to applicant on such date. Accordingly, the date of September 17, 2006 is not effective in stopping the reduction pursuant to 37 CFR 1.704(c)(10).

After the mailing of the decision, the patented file will be forwarded to the Certificate of correction branch for a prompt issuance of the certificate of correction.

---

[1]Patent issued on September 5, 2006.

The Office has previously assessed the $200.00 fee. No additional fees are required by the Office.

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: ADJUSTED PAIR
Draft Cert of correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	7,101,910 B2
DATED	:	Sep. 5, 2006
INVENTOR(S)	:	Sharma 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 (340) days

Delete the phrase "by 340 days" and insert – by 407 days--

PALM INTRANET

Day : Monday
Date: 2/5/2007
Time: 13:49:47

PTA Calculations for Application: 10/167839			
Application Filing Date:	06/12/2002	PTO Delay (PTO):	691
Issue Date of Patent:	09/05/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	351
Post-Issue Petitions:	0	Total PTA (days):	407
PTO Delay Adjustment:	67		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
72	02/05/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		53	
71	02/05/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	120		
66.5	08/16/2006	PTA 36 MONTHS			
66	09/05/2006	PATENT ISSUE DATE USED IN PTA CALCULATION	642		62
65	07/26/2006	RECEIPT INTO PUBS			
64	07/25/2006	DISPATCH TO FDC			
63	07/25/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
62	08/02/2004	ISSUE FEE PAYMENT VERIFIED			
61	04/04/2005	RECORD PETITION DECISION OF GRANTED RELATED TO INVENTOR IN APPLICATION			
60	07/14/2006	DISPATCH TO PUBLICATIONS			
59	04/21/2006	PUBS CASE REMAND TO TC			
58	05/25/2005	MISCELLANEOUS INCOMING LETTER		120	
57	08/02/2004	RESPONSE TO REASONS FOR ALLOWANCE			
56	02/03/2006	RECEIPT INTO PUBS			
55	12/29/2005	WORKFLOW - QUERY REQUEST - FINISH			
54	09/14/2005	WORKFLOW - QUERY REQUEST - BEGIN			
53	09/09/2005	WORKFLOW - QUERY REQUEST - BEGIN			
52	09/09/2005	WORKFLOW - QUERY REQUEST - BEGIN			
51	08/22/2005	WORKFLOW - QUERY REQUEST - FINISH			
50	05/25/2005	MISCELLANEOUS INCOMING LETTER		0	
46	04/04/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
45	03/01/2005	WORKFLOW - QUERY REQUEST - BEGIN			
44	11/08/2004	WORKFLOW - QUERY REQUEST - BEGIN			
43	07/26/2004	PETITION ENTERED			

42	09/29/2004	WORKFLOW - QUERY REQUEST - BEGIN			
41	08/09/2004	REQUEST FOR REFUND		120	
40	08/09/2004	RECEIPT INTO PUBS			
39	08/02/2004	ISSUE FEE PAYMENT RECEIVED			
38	08/02/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
37	07/20/2004	MAIL NOTICE OF ALLOWANCE			
36	07/19/2004	ISSUE REVISION COMPLETED			
35	07/19/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
34	07/19/2004	CASE DOCKETED TO EXAMINER IN GAU			
33	07/19/2004	NOTICE OF ALLOWABILITY			
32	06/10/2004	MISCELLANEOUS INCOMING LETTER			
31	06/28/2004	DATE FORWARDED TO EXAMINER			
30	06/07/2004	RESPONSE AFTER NON-FINAL ACTION		95	26
29	06/07/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
28	06/10/2004	MISCELLANEOUS INCOMING LETTER			
27	06/07/2004	WORKFLOW INCOMING AMENDMENT IFW			
26	12/04/2003	MAIL NON-FINAL REJECTION			
25	12/03/2003	NON-FINAL REJECTION			
24	11/06/2003	DATE FORWARDED TO EXAMINER			
23	10/31/2003	SUPPLEMENTAL RESPONSE		16	21
22	10/21/2003	DATE FORWARDED TO EXAMINER			
21	10/15/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
20	09/30/2003	MAIL RESTRICTION REQUIREMENT	49		-1
19	09/29/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
18	07/30/2003	PRELIMINARY AMENDMENT			
17	06/12/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	01/23/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	12/10/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	02/27/2003	MISCELLANEOUS INCOMING LETTER			
13	03/08/2003	CASE DOCKETED TO EXAMINER IN GAU			
12	06/12/2002	PRELIMINARY AMENDMENT			
11	08/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	09/12/2002	APPLICATION DISPATCHED FROM OIPE			

9	09/11/2002	APPLICATION IS NOW COMPLETE			
7	08/19/2002	ADDITIONAL APPLICATION FILING FEES			
6	08/19/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	07/18/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	07/14/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	07/13/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	06/12/2002	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FAY SHARPE, LLP
1228 EUCKUD AVENUE, 5TH FLOOR
THE HALLE BUILDING
CLEVELAND, OH 44115

MAILED

FEB 23 2010

OFFICE OF PETITIONS

In re Patent No. 6,953,525 :
Issue Date: October 11, 2005 :
Application No. 10/167,874 : ON PETITION
Filed: June 12, 2002 :
Attorney Docket No. PNZ 2 0045 :

This is a decision on the petition under 37 CFR 1.378(b), filed October 15, 2009, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The patent issued on October 11, 2005. The 3 ½ year maintenance fee was due by October 11, 2009. The said fee could have been paid from October 11, 2008 through April 11, 2009 or with a surcharge during the period of April 14, 2009 through October 11, 2009. Accordingly, the patent expired at midnight October 11, 2009 for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

Petitioner state that the delay was unavoidable because the client's response to an e-mail sent October 12, 2009 was delayed.

Petitioner has failed to meet his burden of proof in showing to the satisfaction of the Director that the delay in payment of the maintenance fee unavoidable within the meaning of 35 USC § 41(c) and 37 CFR 1.378(b)(3).

The issue of whether or not the delay in payment of the maintenance fee due is not whether or not petitioner's client's response to the October 12, 2009 e-mail was delayed, rather, it is why

petitioner's client failed to respond to petitioner's communication of April 2009 to his client regarding payment of the maintenance fee. Petitioner must show why it was unavoidable for petitioner's client to respond in a timely manner to his April 2009 communication. Furthermore, petitioner must show, knowing that the maintenance fee was due and the client had not responded to the April 2009 communication, why it was unavoidable for petitioner to not have contacted the client with regard to this matter prior to October 12, 2009 in order to ensure timely payment of the maintenance fee due.

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts, as they know them. Petitioner must supply a thorough explanation of the docketing and call up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies mail ledger, docket sheets, file wrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. Petitioner must also supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

37 CFR 1.378(b)(3) states that nay petition to accept delayed payment of a maintenance fee must include:

> "A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to filed the petition promptly."

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd dub nom*. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather,

such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

ALTERNATIVE VENUE

Petitioner should also note that since the maintenance fee was proffered within 24 months of the date of expiration date of the patent, he has an alternate remedy under the unintentional provisions of 37 CFR 1.378(c) which does not require a showing of the delay in timely paying the maintenance fee in order to reinstate the patent. The $700 already submitted would be applied to the $1,640 fee owed under 37 CFR 1.378(c), leaving a balance due of $940.

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 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f)**. The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted above, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

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 regarding this decision should be directed to April M. Wise at (571) 272-1642.

/dab/
David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FAY SHARPE LLP
1228 EUCLID AVENUE, 5TH FLOOR
THE HALLE BUILDING
CLEVELAND OH 44115

MAILED

JUN 04 2010

OFFICE OF PETITIONS

Patent No. 6,953,525	:	
Application No. 10/167,874	:	
Filed: June 12, 2002	:	ON PETITION
Issued: October 11, 2005	:	
Attorney Docket No. PZNZ 2 00045	:	

This is a decision on the petition under 37 CFR 1.378(c), filed April 20, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The patent issued October 11, 2005. The last day of the grace period for paying the 3.5-year maintenance fee was October 11, 2009. Therefore, since this petition was filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), this 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 previous payment of $700.00 will be applied towards the $1640.00 unintentional surcharge, as requested.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

The patent file is being forwarded to Files Repository.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Karen B. Tripp
Attorney at Law
P. O. Box 1301
Houston, TX 77251-1301

COPY MAILED

FEB 07 2005

OFFICE OF PETITIONS

In re Application of	:	
James V. Fisk, Jr., et al.	:	
Application No. 10/167,882	:	ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. HALB:034	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 5, 2004 and supplemented on December 6, 2004, to revive the above-identified application.

The petition is **GRANTED**.

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. Since the $1530 extension of time fee submitted with the present petition was subsequent to the six-month statutory period for reply, this fee is unnecessary. Petitioner may request a refund of this fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany such a request.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 1700.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

C. ROBERT VON HELLENS
CAHILL SUTTON & THOMAS
SUITE 155
2141 EAST HIGHLAND
PHOENIX, AZ 85016

COPY MAILED

NOV 09 2005

OFFICE OF PETITIONS

In re Application of	:	
Roy L. Weekly	:	
Application No. 10/167,883	:	DECISION ON PETITION
Filed: June 12, 2002	:	TO MAKE SPECIAL UNDER
Attorney Docket No. 6453-A-4	:	37 CFR 1.102(c)(2)
	:	

This is a decision on the petition under 37 CFR 1.102(c)(2)(iii), filed June 12, 2002,[1] to make the above-identified application special based on the invention materially contributing to countering terrorism as set forth in M.P.E.P. § 708.02, Section XI.

The petition is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(2)(iii) and MPEP § 708.02, Section XI: Inventions for Countering Terrorism, should state that special status is sought because the invention materially contributes to countering terrorism. International terrorism as defined in 18 U.S.C. 2331 includes:

> activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (i) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping...

If the disclosure it not clear on its face that the clamed invention is materially directed to countering terrorism, the petition must be accompanied by a statement by the applicant, assignee or a registered attorney/agent explaining how the materiality standard is met. The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.

The instant petition fails to meet the criteria set out with respect to countering terrorism in MPEP § 708.02 (XI). The specification and claims as originally filed provide no indication of an intention to counter terrorism by providing a tray to shielded body parts. The disclosure fails to indicate countering terrorism. Further steps would be required to actually offset or nullify terrorism, yet no suggestion of "countering terrorism" is found in the disclosure. As a result, no advancement in the technology of countering terrorism has been persuasively shown.

---

[1] The instant petition was only recently brought to the attention of the deciding official. The Office sincerely apologizes for the delay in replying to the instant petition and inconvenience caused petitioner by this delay.

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

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

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

By FAX: (571) 273-8300

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

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

This matter is being referred to Technology Center Art Unit 3641 to await applicant's reply to the final Office action mailed October 14, 2005.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 05 2007

OFFICE OF PETITIONS

In re Application of	:	
Tomonori Nishida, et al.	:	
Application No. 10/167,897	:	DECISION ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. TJK/239	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 13, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, January 27, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 28, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

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

This application is being referred to Technology Center AU 1714 for appropriate action by the Examiner in the normal course of business on the reply received.

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. 4

TOWNSEND & TOWNSEND & CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SA FRANCISCO, CA 94111-3834

COPY MAILED
OCT 15 2002
OFFICE OF PETITIONS

In re Application of :
Ronald Chang et al :
Application No. 10/167,898 : NOTICE
Filed: June 11, 2002 :
Attorney Docket No. 020048-002730US :

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 1743.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Spencer C. Patterson, Esq.
Jenkens and Gilchrist, P.C.
3200 Fountain Place
1445 Ross Ave.
Dallas, TX 75202

COPY MAILED

FEB 07 2003

OFFICE OF PETITIONS

In re Application of
Bernd LinB and Martin Bergstrom
Application No. 10/167,918
Filed: June 12, 2002
Attorney Docket Number: 53806-00014USPX

DECISION ACCEPTING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed October 15, 2002.

The petition is GRANTED.

Petitioner has shown that the non-signing inventor can not be reached or located and diligent effort has been used to locate the inventor. Specifically, the petition indicates the application papers were sent to the last known address of Martin Bergstrom. The envelope was returned as being undeliverable. Petitioner conducted unsuccessful electronic searches. Petitioner also used the assistance of a detective consultant who was unable to locate inventor Bergstrom. The last known address of inventor Bergstrom is assumed to be the address provided in the declaration.

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

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

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

Charlema R. Grant
Petitions Attorney
Office of Petitions

#7
12-19-02

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 19 2002

Paper No. 7

Joseph A. Sawyer, Jr.
Sawyer Law Group LLP
P.O. Box 51418
Palo Alto, California 94303

In re Application of: Larry L. Jones et al. Application No. 10/167,925 Filed: June 11, 2002 For: FLASHTOASTER FOR READING SEVERAL TYPES OF FLASH-MEMORY CARDS WITH OR WITHOUT A PC	)))))))	**DECISION ON PETITION UNDER M.P.E.P. §708.02(II): INFRINGEMENT**

This is a decision on the petition, filed 7 October 2002, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

A grantable petition under 37 C.F.R. §1.102(c), and M.P.E.P. §708.02, Section II, must be accompanied by payment of the fee under 37 C.F.R.§1.117(h) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed: and (C) he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the prior art. A fee under 37 C.F.R. for such a petition is required .

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GREENBERG TRAURIG, LLP
1900 UNIVERSITY AVENUE
FIFTH FLOOR
EAST PALO ALTO, CA 94303

COPY MAILED
APR 0 5 2006
OFFICE OF PETITIONS

In re Application of	:	
Larry L. Jones, et al.	:	
Application No. 10/167,925	:	ON PETITION
Filed: June 11, 2002	:	
Attorney Docket No. 76706-201001/US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed December 23, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply to a final Office action mailed May 17, 2005. A Notice of Abandonment was mailed December 14, 2005.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

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

The application file is being forwarded to Technology Center AU 2112 for further processing of the request for continued examination under 37 CFR 1.114 filed December 23, 2005.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATTERSON THUENTE SKAAR & CHRISTENSEN PA
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

COPY MAILED
AUG 1 6 2004
OFFICE OF PETITIONS

In re Application of :
Jiayi Zhu et al :
Application No. 10/167,932 : DECISION GRANTING PETITION
Filed: June 10, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 3216.41US01 :

This is a decision on the petition, filed August 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 February 20, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1756 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

MAILED

NOV 30 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Saliwanchik Lloyd & Saliwanchik
A Professional Association
P.O. Box 142950
Gainesville, FL 32614-2950

In re application of Morris Notelovitz Application No. 10/167,941 Filed: June 10, 2002 For: NOVEL METHODS FOR PROVIDING SERVICES AND INFORMATION RELATING TO THE HEALTH AND WELL-BEING OF ADULT WOMEN	: : : :	**DECISION ON PETITION TO MAKE SPECIAL (APPLICANT'S AGE)**

This is a decision on the petition submitted on August 3, 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 IV: Applicant's Age.

The petition is **GRANTED**.

An application may be accorded special status upon the filing of a petition providing evidence showing that the applicant is at least 65 years old. Such a showing may be provided by evidence such as a birth certificate or a statement from the applicant.

The evidence submitted with the petition is a birth certificate for Morris Notelovitz indicating that he is at least 65 years of age.

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

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

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

Randolph A. Reese

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

RAR/dcg: 11/20/04

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/31/06

TO SPE OF : ART UNIT 1724

SUBJECT : Request for Certificate of Correction on Patent No.: 6749748

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

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

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

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

Comments:

OK

DUANE SMITH
SUPERVISORY PATENT EXAMINER

SPE

1724
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

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

COPY MAILED

APR 0 7 2005

OFFICE OF PETITIONS

In re Application of :
William E. McKinzie III et al :
Application No. 10/167,954 : ON PETITION
Filed: June 12, 2002 :
Attorney Docket No. 10599-66 :

This is a decision on the petition filed October 25, 2004, under 37 CFR § 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR § 1.76(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application.

The instant pending nonprovisional application was filed on June 7, 2004, and was pending at the time of filing of the instant petition. While a reference to the prior-filed applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application set forth in the oath or declaration or transmittal letter submitted with the application,

a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed application in the declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the $1370 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Irvin Dingle at (571) 272-3210. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being forwarded to the Examiner of Technology Center AU 2821 for appropriate action on the amendment filed October 25, 2004.

Frances Hicks

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

[1] *Note* MPEP 201.11 (III)(D) , pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
DEC 20 2005
OFFICE OF PETITIONS

BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610

In re Patent No. 6,906,674 :
Issued: June 14, 2005 : LETTER REGARDING PTA
Application No. 10/167,954 :
Filed: June 12, 2002 :
Atty. Dkt. No.: 10599-66 :

This letter is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT" filed June 20, 2005. The Office thanks patentees for their good faith and candor in bringing this to our attention.

The instant application matured into U.S. Pat. No. 6,906,674 on June 14, 2005. The patent issued with a patent term adjustment (PTA) of 337 days. Patentees indicate that the PTA indicated on the front of the patent may extend the term of the patent by too many days.

Applicants are given 30 days to respond to this decision. No extensions of time are available under 37 CFR 1.136.

A review of the application history reveals that the correct PTA at the time of the issuance is 217 days.

In accordance with 37 CFR 1.702(a)(1), an adjustment of 161 days can be attributed to the Office. The adjustment began August 13, 2003, the day after the date that is 14 months from the date that the application was filed, and ended January 20, 2004, the date the non-final Office action was mailed. *See*, 37 CFR 1.703(a)(1).

A further adjustment of 67 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(2). The adjustment began July 19, 2004, the day after the date that is four months after the date that a reply to the non-final Office action was filed, and ended September 23, 2004, the date the Notice of Allowance was mailed. *See*, 37 CFR 1.703(a)(2).

A further adjustment of 109 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(4). The adjustment began February 26, 2005, the day after the date that is four months from the date that the issue fee payment was received, and ended May 25, 2005, the date the patent issued. *See*, 37 CFR 1.703(a)(6).

The adjustment of 337 days, however, is reduced 120 days, the maximum period allowed by a law, in accordance with 37 CFR 1.704(c)(10) in connection with the petition for delayed claim for priority under 1.119(c) filed April 7, 2005.

Accordingly, at the time of issuance, the patent was entitled to an adjustment of 337 days under 37 CFR 1.702. The adjustment of 337 days is reduced 120 days for applicants' failure to engage in reasonable efforts to conclude prosecution under 37 CFR 1.704(c)(10), yielding an overall PTA of 217 days.

As applicant is advising us of an error in providing too much patent term adjustment in this application, no fee is due in connection to this matter.

This application is being forwarded to the Certificate of Correction Branch for issuance of a certificate of correction indicating that the above-identified patent has received 217 days of patent adjustment.

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

Kery Fries

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

Enclosure: Draft Certificate of Correction

SPE Wael Fahmy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/162,959

Paper No.: _____

DATE : 5/12/05

TO SPE OF : ART UNIT 2814

SUBJECT : Request for Certificate of Correction on Patent No.: 6780713

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.

Lamonte Newsome

Thank You For Your Assistance

Certificates of Correction Branch

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

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

Comments:

Please enter the certificate of correction.
Exr. Trinh

Wael Fahmy
SPE

2814
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 6

Kent B Chambers
Hamilton & Terrile LLP
P O Box 203518
Austin, TX 78720

COPY MAILED

JUN 2 0 2003

OFFICE OF PETITIONS

In re Application of
Gupta et al.
Application No.10/167,989
Filed: June 11, 2002
Attorney Docket No. 85160.915CCPA

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), filed June 12, 2003, to revive the above-identified application.

This above-identified application became abandoned for failure to file a response to a Notice to file Missing Parts of a Nonprovisional Application which was mailed on July 23, 2002. The Notice to File Missing Parts set an extendable two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on September 24, 2002. A Notice of Abandonment was mailed on June 4, 2003.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The Office acknowledges receipt of the filing fee in the amount of $750.00 and the late filing fee surcharge of $130.00.

This application is being forwarded to the Office of Initial Patent Examination for further processing of the application.

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

29 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Sughrue Mion
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

In re Application of BILLIOTTE et al. Serial No.: 10/168,013 PCT No.: PCT/FR00/02055 Int. Filing Date: 17 July 2000 Priority Date: 11 May 2000 Attorney's Docket No.: Q69987 For: CENTRALISED STOCHASTIC SIMULATION METHOD	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 18 June 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statements that the "the abandonment was unintentional" and "that the delay in prosecution was unintentional" have been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

A review of the application file reveals that the basic national fee of $445 has been paid. The required petition fee of $640 has also been paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for issuance of a Notification of Missing Requirements indicating the oath or declaration executed by the inventors and the $65 surcharge for filing the oath or declaration after the twenty month period.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

OIPE JC11 FEB 17 2005 PATENT & TRADEMARK OFFICE

PTO/SB/83 (05-03)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

Application Number	10/168,018
Filing Date	June 18, 2002
First Named Inventor	Irene KUNZE
Art Unit	1638
Examiner Name	HELMER, Georgia
Attorney Docket Number	532622001400

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby apply to withdraw as attorney or agent for the above identified patent application.

The reasons for this request are:
Application is being transferred to another attorney.

This request is being made at the request of the assignee, **SunGene GmbH & Co. KGaA**

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☐ Change the correspondence address and direct all future correspondence to:

CORRESPONDENCE ADDRESS

☐ Customer Number [ ] → [ ]

OR

☒ Firm or Individual Name	James Remenick (Powell Goldstein LLP)				
Address	901 New York Avenue, NW Third Floor				
City	Washington	State	DC	Zip	20001-4413
Country	USA				
Telephone	(202)347-0068			Fax	(202) 624-7222

☒ This request is made on behalf of myself and
- ☐ all the attorneys/agents of record,
- ☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- ☒ the attorneys/agents associated with Customer Number 25227

This request is enclosed in triplicate (including any attachments).

Name	Wayne C. Jaeschke, Jr. Registration No. 38,503
Signature	
Date	February 17, 2005

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

APPROVED 3-7-05

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 17, 2005 Signature: _____ (Chimin Taylor)

va-93934

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

COPY MAILED

MAR 0 5 2007

OFFICE OF PETITIONS

NOTICE

In re Patent No. 6,924,374 :
Issue Date: August 2, 2005 :
Application No. 10/168, 019 :
Filed: June 18, 2003 :
Attorney Docket No. 003300-963 :

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

09 SEP 200

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Kenyon & Kenyon
One Broadway
New York, New York 10004

In re Application of	:	
KAISER et al.	:	
Application No.: 10/168,039	:	
PCT No.: PCT/DE00/04474	:	DECISION ON PETITION
Int. Filing Date: 15 December 2000	:	
Priority Date: 18 December 1999	:	
Attorney Docket No.: 10191/2500	:	
For: METHOD AND DEVICE FOR CONTROLLING THE DRIVE UNIT OF A VEHICLE		

This is a decision on applicants' "Petition under 37 CFR 1.182" filed in the Patent and Trademark Office (PTO) on 06 June 2003. Applicants are requesting to change the name of the first named inventor from Lilian Kaiser to Lilian Matischok due to marriage. The petition was accompanied by an affidavit signed by Lilian Matischok using both her former name and present name. The $130 petition fee will be charged to Deposit Account no. 11-0600.

DISCUSSION

The Manual of Patent Examining Procedure at §605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order. As noted above, the $130 petition fee will be charged to Deposit Account no. 11-0600.

The petition has been reviewed and is approved. The declaration submitted on 19 February 2003 is accepted.

CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Lilian Kaiser to Lilian Matischok is **GRANTED**.

The application has an international filing date of 15 December 2000 under 35 U.S.C. 363 and a date of **19 February 2003** under 35 U.S.C. 371(c).

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: (703) 308-6314
Fax: (703) 308-6459

12 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Kenyon & Kenyon
One Broadway
New York, New York 10004

In re Application of	:	
KERI et al.	:	
Application No.: 10/168,042	:	DECISION ON PETITION
PCT No.: PCT/US00/32574	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 30 November 2000	:	
Priority Date: 01 December 1999	:	
Attorney Docket No.: 2664/46901	:	
For: A MULTISTAGE PROCESS FOR THE PREPARATION OF HIGHLY PURE DEFEROXAMINE MESYLATE SALT		

The petition to revive under 37 CFR 1.137(b) filed 18 June 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay caused by the abandonment of the national phase application was unintentional" has been construed as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, Petitioner must immediately notify the PCT Legal Office of such error.

A review of the application file reveals that applicant has submitted the basic national fee of $100 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

Deposit Account No. 11-0600 has been charged a $130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON MA 02205

COPY MAILED

MAR 30 2007

OFFICE OF PETITIONS

RECEIVED
CANCELED
MAR 30 2007
OFFICE OF PETITIONS

In re Patent No. 7,064,106
Issued: June 20, 2006
Application No. 10/168,067
Filed: June 14, 2002
Attorney Docket Number: 57788 (46342)

ON PETITION

This is a decision on the petition under 37 CFR 1.183 and for a certificate of correction under 37 CFR 1.323, filed January 23, 2007, to correct the assignees' names on the front of the Patent. The request is being treated as a request under 37 CFR 3.81(b)[1].

The petition is **DISMISSED**.

Petitioner argues that although the Issue Fee Transmittal (PTOL-85B) filed February 10, 2006 identified the assignee as Takeda Chemical Industries, Ltd., the former name of the assignee, it should have listed the assignee as Takeda Pharmaceutical Company, Ltd. Further, petitioner argues that the name of the assignee was recorded, provides the reel and frame number and that a certificate of correction be issued to correctly identify the assignee.

Pursuant to the Reel/Frame No. (014720/0385) information provided in the petition, the assignee is Takeda Chemical Industries, Ltd. and not Takeda Pharmaceutical Company, Ltd. A review of the file however reveals that an assignment from Takeda Chemical Industies, Ltd., to Takeda Pharmeceutical Company, Ltd. was not recorded until March 14, 2007 which was after the patent issued on June 20, 2006.

What is printed on the face of the patent is the information printed on the PTOL-85(b). A certificate of correction would be in order if the information provided on the PTOL-85(b) was different from that included in the Office assignment records and it could be proven that the correct assignment information was recorded prior to the payment of the issue fee.

37 CFR 3.81(b), effective June 25, 2004, reads:

---

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

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

Since petitioners have not provided any evidence that the assignment from Takeda Chemical Industies, Ltd., to Takeda Pharmeceutical Company, Ltd. was submitted for recordation before issuance of this patent, issuance of a certificate of correction would not be proper.[2]

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

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

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

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[2]See also MPEP 307.

23 JAN 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

Hale and Dorr LLP
300 Park Avenue
New York, NY 10022

In re Application of RUSSELL et al	:	
U.S. Application No.: 10/168,069	:	
PCT Application No.: PCT/AU00/01547	:	DECISION
Int. Filing Date: 15 December 2000	:	
Priority Date Claimed: 16 December 1999	:	
Attorney Docket No.: 111590.126	:	
For: FIBRE PROCESSING	:	

This is in response to applicant's "Petition Pursuant to 37 C.F.R. § 1.10(e)" filed 08 September 2003, which is being treated under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 15 December 2000, applicant filed international application PCT/AU00/01547, which claimed priority of an earlier Australia application filed 16 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 21 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 16 June 2002.

On 14 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 14 November 2002, applicant purportedly filed an executed declaration.

On 21 January 2003, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated 13 November 2002 as the date of receipt of the 35 U.S.C. 371 requirements.

On 20 August 2003, applicant filed a request for corrected patent application publication.

On 08 September 2003, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

The evidence of record is sufficient to establish that the declaration was originally filed on 14 November 2002. Specifically, the copy of the return postcard, which includes the declaration in its itemized contents and which bears a USPTO date stamp of 14 November 2002, serves as *prima facie* evidence that the declaration was received by the USPTO on 14 November 2002.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 21 January 2003 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 15 December 2000, and a date under 35 U.S.C. 371(c) of 14 November 2002.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision including: (1) preparation and mailing of a new Notice of Acceptance of Application Under 35 U.S.C. 371 indicating the proper date of receipt of the 35 U.S.C. 371 requirements and (2) thereafter forwarding the application to the Office of Patent Legal Administration for consideration of applicant's request for corrected patent application publication.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HALE AND DORR LLP
300 PARK AVENUE
NEW YORK NY 10022

COPY MAILED
MAR 3 1 2004
OFFICE OF PETITIONS

In re Application of
Russell et al.
Application No. 10/168,069
International
Filing Date: December 15, 2000
For: FIBRE PROCESSING
Attorney Docket No: 111590-126
Pub. No.: US 2003/0115720 A1
Pub. Date: June 26, 2003

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on August 20, 2003 for the above-identified application.

The request is granted.

The corrected patent application publication will be published 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL Paper No. 6

MAR 1 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of
Ali et al.
Application No. 10/168, 070
Filed: June 14, 2002
For: **INTELLIGENT SYSTEM AND METHODS OF RECOMMENDING MEDIA CONTENT ITEMS BASED ON USER PREFENCES**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as agent of record filed on January 13, 2004.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Attorneys/agents listed in the Request to withdraw are withdrawn.

It is noted that the Attorney of Record did not check either box within the Request indicating a change of address. However, based upon the fact a new address was incorporated within the Request and also indicated within the letter attached to the Request, the combination of the aforementioned will be construed as a request to change the correspondence address. All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

The file is being returned to TC 2600 Central Files to await examination in appropriate turn.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

Cc: Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, CA 95125-5106

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
SUITE 702
UNIONDALE NY 11553

COPY MAILED

NOV 15 2007

OFFICE OF PETITIONS

In re Application of
DEPICKER et al.
Application No. 10/168,072
371(c) Date: October 29, 2002
Attorney Docket No. 1187-42

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petitions under 37 CFR § 1.78(a)(6), filed June 8, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed application set forth in the currently-filed amendment.

The petition is **GRANTED.**

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR § 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(6) must be accompanied by:

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

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application. All the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. § 119(e) 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)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date 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. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

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

Any questions concerning this matter may be directed to Denise Pothier at (571) 272-4787. 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 Group Art Unit 1636 for consideration by the examiner of the claim under 35 U.S.C. § 119(e) of the prior-filed provisional application.

Frances Hicks
Lead Paralegal
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
10/168,072	10/29/2002	1636	1199	1187-42	29	1

CONFIRMATION NO. 6058

CORRECTED FILING RECEIPT

28249
DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
SUITE 702
UNIONDALE, NY 11553

OC000000026765048

Date Mailed: 11/15/2007

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)

Anna Depicker, Merelbeke, BELGIUM;
Vladimir Mironov, Gent, BELGIUM;
Franky Terras, Gent, BELGIUM;
Willem Broekaert, Dilbeek, BELGIUM;
Sylvie De Buck, Knokke-Heist, BELGIUM;
Chris De Wilde, Herdersem-Aalst, BELGIUM;

Power of Attorney:

Rocco Barrese--25253
Peter Dilworth--26450
George Kaplan--28375
Adrian Calderone--31746
Cindy Zelson--33467
Paul Farrell--33494Yuri Kateshov--34466Ann Pokalsky--34697Michael Musella--39310Michael Brew--43513

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/EP00/12683 12/13/2000
which claims benefit of 60/195,758 04/10/2000

Foreign Applications

If Required, Foreign Filing License Granted: 05/10/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/168,072**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
**** SMALL ENTITY ****
Title

Optimized t-dna transfer and vectors therefor

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

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

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

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: 5/16/05

Paper No.
WAK

In re Application of
Ulrike Licht et al.
Serial No. 10/168,084
Filed: June 17, 2002
For: CARBODIIMIDES IN EMULSION POLYMERS

DECISION
ON
PETITION

This is a decision on the petition filed October 4, 2004, requesting the withdrawal of the finality of the Office action mailed August 26, 2004. The petition is considered a timely submission under 37 CFR 1.181.

Issues:

Applicants filed an amendment on June 4, 2004, in response to the first Office Action; the Examiner issued a second, final Office Action dated August 26, 2004. This Office Action contained a first rejection of the claims based on 35 USC 102(a) and 35 USC 103 over JP-2000-119539 reference which was newly cited into the record. Applicants assert that the amendments made were a matter of improving syntax of the amended claims and did not involve amendments, which changed the scope of the claims. Applicants further assert that the amendment made to claim 1 did not necessitate the search and citation of the reference, which has been cited. Specifically, applicants have amended claim 1 to recite, in part, that the carboiimide group-containing compound has a water solubility of less than 50 g per liter of water. The reference does not mention the degree of water solubility and as such the amendment made to the claim did not necessitate the search and citation of the reference, which has been cited.

Decision:

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). A second or any subsequent action on the merits in an application should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations, which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.*

Applicants' amendment of June 4, 2004, canceled claims 2 and 16-18 and added new claims 25 and 26. Claim 1 was amended to incorporating the limitation of cancelled claim 2. While applicant's arguments addressed claim 1, it is noted that newly added claims 25 and 26 were also included the

examiner's rejection citing JP 2000-119539. Dependent claims 25 and 26 contained limitations that were not previously considered. Accordingly, the Finality of the Office Action of August 26, 2004 was proper. As the Office has received no response to the Office Action of August 26, 2004, the application is abandoned

The petition is **DENIED.**

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

Frederick D. Vastine, Ph.D.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexander, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

COPY MAILED

JAN 09 2006

OFFICE OF PETITIONS

In re Application of	:	
Perry	:	DECISION ON PETITION
Application No. 10/168,103	:	
Filed: June 12, 2002	:	
Atty. Dkt. No.: CUL-0003	:	

This decision is in response to the petition filed December 22, 2005 under 37 CFR 1.181, to withdraw the holding of abandonment for the above-identified application.

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

This application was held abandoned August 4, 2005, for failure to timely file a proper response to the non-final Office action mailed May 3, 2005. The Notice set a three month shortened statutory period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely obtained. Notice of Abandonment was mailed November 30, 2005.

Petitioner argues that a response to the non-final Office action was timely submitted August 3, 2005 in accordance with the Certificate of Facsimile procedures outlined at 37 CFR 1.8. Petitioner has included a copy of the response to the non-final Office action.

A review of the application file does not indicate receipt of the response purportedly submitted August 3, 2005, however, the response will be considered timely as it complies with the requirements of 37 CFR 1.8(b) in that (1) the Office was promptly informed of the previous timely mailing, (2) a copy of the previously submitted correspondence with certificate of facsimile thereon has been supplied, and (3) statements attesting to the previous timely mailing have been submitted.

In view of the above, the Notice of Abandonment is hereby VACATED and the Notice of Abandonment is WITHDRAWN.

This application is being forwarded to Technology Center 3700 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WILLIAM A. DRUCKER
UNIT 208
610 N. WEST STREET
ALEXANDRIA, VA 22314

COPY MAILED

MAY 10 2007

OFFICE OF PETITIONS

In re Application of	:	
Michel Bernard, et al.	:	
Application No. 10/168,128	:	ON PETITION
Filed: September 11, 2002	:	
Attorney Docket No. 71269-0023	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 12, 2007, to revive the above-identified application.

The petition is **GRANTED**.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Sheridan Neimark appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. A courtesy copy of this decision is being mailed to petitioner. However, if Mr. Neimark desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. Until otherwise instructed, all future correspondence regarding this application will be directed solely to the address of record.

This application became abandoned for failure to timely reply to the final Office action mailed July 27, 2005. A Notice of Abandonment was mailed March 8, 2006. In response, on January 12, 2007 the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including the fee of $395; (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) 272-3204.

The application file is being forwarded to Technology Center AU 1753, for further processing of the request for continued examination under 37 CFR 1.114 filed January 12, 2007.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: SHERIDAN NEIMARK
BROWDY AND NEIMARK
624 NINTH ST NW STE 300
WASHINGTON, DC 20001

16 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Werner H Stemer
Lerner and Greenberg
PO Box 2480
Hollywood, FL 33020-2480

In re Application of KUTSCHBACH, et al. Application No.: 10/168,147 PCT No.: PCT/DE00/04395 Int. Filing Date: 11 December 2000 Priority Date: 13 December 1999 Attorney Docket No.: RWS-D6-1186 For: METHOD AND SYSTEM FOR DETERMINING THE TOPOGRAPHY FOR REACTION SIGNALS OF AN EYE	DECISION ON REQUEST UNDER 37 CFR 1.42 AND PETITION UNDER 37 CFR 1.181

This is a decision on the papers filed in United States Patent and Trademark Office (USPTO) on 29 October 2002, which are being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 11 December 2000, applicant filed international application PCT/DE00/04395, which claimed a priority date of 13 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 June 2001. A Demand for international preliminary examination in which the United States was elected was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 June 2002.

On 13 June 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee; a translation of the International Application into English and a First Preliminary Amendment. An executed oath or declaration of the inventors was not included.

On 18 September 2002, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date and providing a surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 29 October 2002, applicant filed the current papers which included a combined declaration and power of attorney executed by joint inventor Jens GRUNEWALD and by Johanna Jutta KUTSCHBACH as heir of the deceased joint inventor Ernst KUTSCHBACH. In addition, the papers contained a statement that the declaration was originally forwarded to the USPTO along with payment of the surcharge on 11 July 2002.

On 28 May 2003, applicant filed a copy of a date stamped postcard for the combined declaration and power of attorney in question.

DISCUSSION

I. Petition Under 37 CFR 1.181

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped postcard receipt. The postcard identifies the application by serial number and docket number. Among the items listed on the receipt is "Declaration". The receipt is stamped "OIPE JUL 16 2002" across its face. Thus, it is clear that applicant filed an executed combined declaration and power of attorney on 16 July 2002. In addition, the postcard lists "Credit Card $130." As such, it is proper to grant applicant's petition at this time and accept the copy of the combined declaration and power of attorney filed 29 October 2002 as a substitute for the combined declaration and power of attorney originally filed 16 July 2002.

II. Request Under 37 CFR 1.42

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 29 October 2002 is executed by Johanna Jutta KUTSCHBACH as heir of the deceased joint inventor, Ernst KUTSCHBACH. However, neither the declaration nor the transmittal letter declares that Ms. KUTSCHBACH is the **sole** heir of the deceased. Thus, there may be other heirs who are required to sign the declaration. Therefore, the declaration can not be accepted at this time. Applicant is required to file a statement either from the heir herself or applicant's counsel setting forth that the individual listed above represents all of the heirs of the deceased inventor, Ernst KUTSCHBACH. In addition, said statement should set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

The "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) mailed 18 September 2002 is hereby **VACATED**.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct future correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
Legal Examiner
Office of PCT Legal Administration

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

24 JUN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Trevor D. Arnold
Burns & Levinson LLP
1030 Fifteenth St., NW
Suite 300
Washington, DC 20005-1501

In re Application of DUKACH et al. Application No.: 10/168,149 PCT No.: PCT/US00/34549 Int. Filing Date: 15 December 2000 Priority Date: 15 December 1999 Attorney Docket No.: VERT99-1US For: APPARATUSES, METHODS, AND COMPUTER PROGRAMS FOR DISPLAYING INFORMATION ON SIGNS	DECISION ON REQUEST UNDER 37 CFR 1.497(d)

This decision is in response to the "PETITION TO AMEND INVENTORSHIP UNDER 37 CFR 1.497(d)" filed 09 January 2003.

BACKGROUND

On 15 December 2000, applicant filed international application PCT/US00/34549, which designated the United States and claimed a priority date of 15 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 21 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 July 2001, which was within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2002 (15 June 2002 being a Saturday).

On 14 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee, the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the earliest claimed priority date, and an assertion of small entity status.

On 25 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a TWO (2) MONTH extendable period for response.

On 09 October 2002, applicants filed a submission including, *inter alia*, a declaration of the inventors.

On 09 December 2002, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration of inventors submitted 09 October 2002 did not comply with 37 CFR 1.497(a)-(b) because an inventor was added. This NOTIFICATION set a ONE (1) MONTH period for response.

On 09 January 2003, applicants submitted the instant "PETITION TO AMEND INVENTORSHIP UNDER 37 CFR 1.497(d)", which was accompanied by, *inter alia*, a statement by the added inventor and a statement by the assignee.

On 14 April 2003, the assignee of record of the entire interest submitted a new power of attorney.

DISCUSSION

Petition Under 37 CFR 1.497(d)

37 CFR 1.497(d), provides:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in Sec. 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Applicants have satisfied items (1), (2) and (3) with the submission of 09 January 2003. As to item (4), a new declaration is not required by 37 CFR 1.497(f) here.

Power Of Attorney

A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 CFR 3.73(b). MPEP § 402.07. The assignee has established the right to take action in the papers filed 09 January 2003.

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** for the reasons set forth above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision, that is (1) for entry of the Power of Attorney filed 14 April 2003, and (2) for processing the application in the name of Semyon DUKACH, Matt W. D. MANKINS, Leonid FRIDMAN, Salvatore A. D'AGOSTINO, Brad HARKAVY, Edwin J. SELKER, and Edward W. PORTER as joint inventors and for according the application a 35 U.S.C. 371(c) date of **09 October 2002**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

24 SEP 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

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

BURNS DOANE SWECKER & MATHIS LLP
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

In re Application of	:	
BENGT ANDERSON (DECEASED)	:	
Serial No.: 10/168,173	:	DECISION ON
PCT No.: PCT/SE00/02674	:	PETITION
Int. Filing Date: 22 December 2000	:	UNDER 37 CFR 1.42
Priority Date: 25 December 1999	:	
Attorney Docket No.: 003300-964	:	
For: NEW MODULATORS OF DOPAMINE NEUROTRANSMISSION	:	

This is a decision on applicant's submission under 35 U.S.C. 371, including an executed declaration, in effect requesting status under 37 CFR 1.42, filed 19 June 2002 in the United States Patent and Trademark Office (USPTO) in the above-captioned application.

BACKGROUND

On 19 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee and an executed declaration and Information Data Sheet. The submission is treated as a request for status under 37 CFR 1.42.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The four page declaration submitted on 19 June 2002 identified Bengt Anderson as the deceased inventor and provided his country of citizenship, former residency and mailing address, as required for compliance with 37 CFR 1.497(a)(3). The declaration is signed by Ingela Marianne Svan, Liselott Lilja Ronnqvist as mother on behalf of underage son Anders Kristoffer

Lilja (a minor) and Jenny Maria Carlberg and identified as "all the heirs of Bengt Anderson (deceased) serving as Legal Representative". However, the declaration itself does not identify the respective citizenship of the heirs.

While applicant has provided an Information Data Sheet providing the residence, post office address and country of citizenship of the heirs, the respective citizenship of the heirs does not appear on the declaration itself. The information must be provided for both the deceased joint inventor, Bengt Anderson and his surviving heirs. Absent this information it is not possible to grant applicant's request for status under 37 CFR 1.42 at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard E. Smith
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/LES:cmk

Tel: 703-306-5467
Facsimile: 703-308-6459

24 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BURNS DOANE SWECKER & MATHIS LLP
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

In re Application of	:	
BENGT ANDERSON (DECEASED)	:	
Serial No.: 10/168,173	:	DECISION ON
PCT No.: PCT/SE00/02674	:	RENEWED PETITION
Int. Filing Date: 22 December 2000	:	UNDER 37 CFR 1.42
Priority Date: 25 December 1999	:	
Attorney Docket No.: 003300-964	:	
For: NEW MODULATORS OF DOPAMINE NEUROTRANSMISSION	:	

This is a decision on applicant's renewed petition under 37 CFR 1.42 including an executed declaration, filed 21 November 2002 in the United States Patent and Trademark Office (USPTO) in the above-captioned application.

BACKGROUND

On 19 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee and an executed declaration and Information Data Sheet. The submission was treated as a request for status under 37 CFR 1.42.

On 24 September 2002, a decision was mailed to applicant indicating that the declaration did not identify the respective citizenship of the heirs. On 21 November 2002, applicant filed the instant renewed petition along with a newly executed declaration.

DISCUSSION

The four page declaration submitted on 19 June 2002 identified Bengt Anderson as the deceased inventor and provided his country of citizenship, former residency and mailing address, as required for compliance with 37 CFR 1.497(a)(3). The declaration was signed by Ingela Marianne Svan, Liselott Lilja Ronnqvist as mother on behalf of underage son Anders Kristoffer Lilja (a minor) and Jenny Maria Carlberg and identified as "all the heirs of Bengt Anderson (deceased) serving as Legal Representative" but did not identify the respective citizenship of the

heirs.

Applicant have now submitted a newly executed declaration identifying the citizenship, residency and mailing address of all the heirs of the deceased inventor, as required for compliance with 37 CFR 1.497(a)(3). Thus, applicant's request for status under 37 CFR 1.42 is granted.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **GRANTED.**

The application will be forwarded to the United States Designate/Elected Office for further processing. The 35 U.S.C. 371 date is **21 November 2002.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Tel: 703-306-5467
Facsimile: 703-308-6459

CMK:cmk

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

COPY MAILED

FEB 06 2007

OFFICE OF PETITIONS

In re Patent No. 6,903,120 :
Issue Date: 06-07-2005 : NOTICE
Application No. 10/168,173 :
Filed: 11-21-2002 :
Attorney Docket No. 003300-964 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28(c), filed September 7, 2006.

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. This Notice is not intended to imply that the USPTO conducted any investigation of this matter.

The application file is being forwarded to Files Repository.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Office

COPY MAILED

JUL 2 4 2006

Director's Office
Office of Patent Publication

JEFFREY M. GREENMAN
VICE PRESIDENT, PATENTS AND LICENSING
BAYER CORPORATION
400 MORGAN LANE
WEST HAVEN, CT 06516

In re Application of
FISCHER, RUDIGER, et al.
Application No. 10/168,197
Filed: November 12, 2002
Attorney Docket No. LE A 34 082

DECISION ON PETITION

This is a decision on the Petition Under (37 CFR 1.181(a)) Requesting Withdrawal Of The Holding Of Abandonment, received in the United States Patent and Trademark Office (USPTO) on April 1, 2005. The undersigned became aware of the petition on July 19, 2006. The Office apologizes for the delay in processing the petition.

The petition is **GRANTED**.

The application was held abandoned for failure to timely pay the issue fee as required in the Notice of Allowance and Fee(s) Due mailed July 9, 2004, which set a three (3) month statutory period for reply. Accordingly, a Notice of Abandonment was mailed on February 2, 2005.

Petitioner has submitted a copy of Part B – Fee(s) Transmittal, and a copy of the USPTO Auto-Reply Facsimile Transmission, which acknowledges receipt of the afore-mentioned documents on October 12, 2004. The Fee(s) Transmittal contains a proper executed Certificate of Facsimile Transmission, signed and dated on same day.

Petitioner has demonstrated that the Fee(s) Transmittal, with authorization to charge the issue fee to the Deposit Account, was timely submitted via certificate of mailing or transmission on October 12, 2004 in compliance with 37 CFR § 1.8.

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

As authorized, the issue fee in the amount of $1,330 and $300 for the publication fee were charged to the Deposit Account No. 13-3372.

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

Telephone inquires relating to this matter may be directed to the undersigned in the Office of Patent Publication at 703-308-9250 Ext. 137.

Thomas E Hawkins

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: NOV - 7 2003

VJ
Paper Number 11

In re Application of		:	DECISION
Suhm et al.		:	ON PETITION
Serial No.:	10/168,215	:	
Filed:	June 19, 2002	:	
For:	Partly crystalline propylene polymerisate composition for production of biaxial-stretched polypropylene films	:	

This is a decision on a petition under 37 CFR 1.144 filed September 5, 2003 requesting a review of a restriction requirement, or more properly, lack of unity of invention set forth in the Office action mailed March 19, 2003 and made final in the Office action mailed May 20, 2003.

According to the examiner, there is a lack of unity of invention between Group I, claims 1-5 and 8-10, drawn to a polymer composition (drafted in product-by-process format) as well as articles made from the composition and Group II, claims 6 and 7, drawn to a process for making the composition. In a response filed April 17, 2003, applicants elected Group I with traverse.

It is noted that along with the present petition, an amendment was filed to amend some of the original claims and to add claim 11. That amendment, which principally involves changing a melting point temperature range, has been taken into account in the present decision. With respect to claim 11, since it is drawn to a polymer composition, for the purposes of the present response, this claim has been taken as belonging to the elected invention and has likewise been taken into account in this decision.

The examiner's position, set forth in the action mailed March 19, 2003, is that the polymer composition, which is common to both groups of inventions, does not constitute a special technical feature because it does not define a contribution over prior art such as US 5,543,373. In response to applicants' traverse, the examiner indicated that the process limitation in the elected polymer composition claims, which are recited in product-by-process format, is not a special technical feature since in that type of claim "the product is not limited to the process." See the action mailed May 20, 2003.

The applicants' main argument, as set forth, e.g., on page 4 of the petition, is that the examiner has not followed "the course required by PCT Rule 13" both in interpreting the process limitation in a product-by-process claim and in the overall analysis regarding the special technical feature. The applicants have pointed out that no rejection was made over US 5,543,373 cited by the examiner in making a determination of lack of unity.

As noted by applicants, given that the present application was filed under the provisions of 35 USC 371, in accordance with PCT Rule 13.2, unity of invention exists only "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features."

It is emphasized that the expression "special technical features" refers to those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In response to applicants' arguments regarding the examiner's treatment of claims in product-by-process format, it is observed that there is nothing in PCT Rule 13.2 to indicate that process limitations are to be given special consideration in a product-by-process claim. On the contrary, applicants are reminded that, according to MPEP 806.05(f), "a product defined by the process by which it can be made is still a product claim (In re Bridgeford, 357 F.2d 679, 149 USPQ 55 (CCPA 1966))" and, further, that "defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention." In view of that, the applicants' argument that the examiner did not follow PCT Rule 13 in interpreting the process limitation in a product-by-process claim is inapposite and unpersuasive.

In response to applicants' statement that no rejection was made over US 5,543,373 cited by the examiner in showing lack of unity, it appears that applicants are casting doubt on the evidence relied upon by the examiner to show lack of unity of invention because that reference was not also used in a rejection. However, there is no requirement that the reference relied upon by the examiner in establishing a prima facie case of lack of unity of invention must necessarily also be utilized in a rejection.

Even if, arguendo, the applicants are granted the benefit of the doubt, it is contended that EP 0,887,357 to Hüffer et al. used in the rejection given in paragraph 9 on page 4 of the action mailed May 20, 2003 provides evidence that the claimed polymer composition does not constitute a special technical feature that defines a contribution over prior art. Since the EP reference is in German, use is made of the English language equivalent US document 2001/0012874 (hereafter, US '874) also to the same inventive entity of Hüffer et al..

The polymer composition in the present claims (see, e.g., claim 1) is a semicrystalline propylene polymer composition made by a process involving metallocene catalysts and where the composition possesses certain characteristics with respect to melting point, TREF fractions, molar masses and melt flow rate (this last property is recited in newly added claim 11).

Particular attention is drawn to paragraphs [0013] and [0068] as well as Table 2 (this Table was cited in the rejection over EP) at pages 1, 5 and 8, respectively, of US '874. These cited portions show that US '874 discloses a propylene polymer with a semicrystalline matrix phase which is characterized by:

- A melting point of, e.g., 167.7°C compared with 135° to 165°C in the present claims, as amended. Although the overlap at the upper limit of the claimed range is not mathematically exact, it is sufficiently close given the general accuracy in measuring temperature values. It is noted that prior to amendment the present claims recited a melting point range of 65°to 170°C which would clearly have been met by US '874's melting point.
- A melt flow rate of, e.g., 1.8, 3.5 or 5.1g/10min which reads on values in the range of 1 to 12 g/10min in present claim 11. Both sets of rates are measured under identical test conditions as is evident from paragraphs [0076] and [0077] on page 6 of US '874.
- A weight-average molar mass of 1,000 to 1,000,000 compared with a number-average molar mass of at least 120,000 in the present claims. Given that the weight average molar mass is greater than or equal to the number average molar mass, the reference molar mass value meets the value in the claims.

It is apparent that due to the overlap between the characteristics of the claimed polymer and the polymer disclosed by US '874 (or, equivalently, EP), the two polymers are indistinguishable and the burden shifts to the applicants to show otherwise.

With respect to the TREF fraction characteristics in the present claims, while US '874 discloses TREF fractions at $\leq$ 80°C and at a series of temperatures above that just as done in the present claims which recite such fractions at $(T_M/2)$ + 7.5°C, i.e. 75°-90°C, and at some of the same temperature values above that as the ones disclosed in Table 2 of US '874, a side-by-side comparison of the fractions is thwarted by the fact that US '874 shows fractions separately based on an elastomer phase and a matrix phase in contrast to their depiction in the present claims. Nevertheless, in view of the similarities in chemical composition and due to the overlap in several other claimed properties as discussed above, no difference is seen between the claimed composition and the one disclosed by US '874.

With respect to the process limitations, US '874 uses a Ziegler-Natta catalyst system in contrast to the metallocene catalysts in the present claims. However, in accordance with the previous discussion of patent law regarding the lack of significance of process limitations in product-by-process claims, the specific catalyst system used is irrelevant to demonstrating whether or not the present claims define a contribution over EP or equivalently US '874. All that is required is to show that the claimed polymer composition per se is disclosed by prior art. US '874 provides evidence that this is indeed the case.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the claims lack unity of invention.

Applicants are advised that, in the event that the elected product claims become allowable, then, provided that the non-elected process claims are amended so as to depend from or otherwise include all the limitations of the allowable product claim, then such process claims will be rejoined with the allowable product claims consistent with the requirement for rejoinder set forth in MPEP 821.04.

The petition is DENIED.

JMStone

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

Keil & Weinkauf
1101 Connecticut Avenue NW
Washington DC 20036

UNITED STATES PATENT AND TRADEMARK OFFICE

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

rld

Mailed: 1-18-06

Paper Number _____

In re application of Suhm et al. Serial No. 10/168,215 Filed: June 19, 2002 For: PARTLY CRYSTALLINE PROPYLENE POLYMERISATE COMPOSITION FOR PRODUCTION OF BIAXIAL STRETCHED POLYPROPYLENE FILMS	:	DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed October 7, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment mailed June 15, 2004, be withdrawn since the applicant did not receive the Office letter mailed November 13, 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). The evidence presented by the petitioner fails to comply with the requirements as set forth in MPEP 711.03(c) II. The evidence fails to provide 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.

A review of the USPTO application file reveals that a Final Rejection was mailed on November 13, 2003, but contained an incorrect mailing address. It is noted that a CHANGE OF CORRESPONDENCE ADDRESS was filed on March 4, 2003, but had not been changed in PALM prior to mailing of the Office letter.

Therefore, even though the petitioner has failed to provide a copy of the docket record where the non-received Office communication would have been entered, such requirement is waived in view of the fact that the application file record reveals that the Office letters mailed on November 13, 2003 was mailed to the incorrect address.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the examiner for prompt re-mailing of the Office letter originally mailed November 13, 2003 and restarting of the period of response from the re-mail date thereof.

The Petition is **GRANTED**.

Serial No. 10/168,215

The PETITION TO THE COMMISSION UNDER 37 CFR § 1.144 filed September 5, 2003 is acknowledged. A copy of the decision to this petition originally mailed on November 7, 2003 has been provided with this communication.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

NOVAK DRUCE DELUCA & QUIGG, LLP
1300 Eye Street N.W.
Suite 400 East
WASHINGTON, D.C. 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: NOV - 7 2003

VJ
Paper Number 11

In re Application of		:	DECISION
Suhm et al.		:	ON PETITION
Serial No.:	10/168,215	:	
Filed:	June 19, 2002	:	
For:	Partly crystalline propylene polymerisate composition for production of biaxial-stretched polypropylene films	:	

This is a decision on a petition under 37 CFR 1.144 filed September 5, 2003 requesting a review of a restriction requirement, or more properly, lack of unity of invention set forth in the Office action mailed March 19, 2003 and made final in the Office action mailed May 20, 2003.

According to the examiner, there is a lack of unity of invention between Group I, claims 1-5 and 8-10, drawn to a polymer composition (drafted in product-by-process format) as well as articles made from the composition and Group II, claims 6 and 7, drawn to a process for making the composition. In a response filed April 17, 2003, applicants elected Group I with traverse.

It is noted that along with the present petition, an amendment was filed to amend some of the original claims and to add claim 11. That amendment, which principally involves changing a melting point temperature range, has been taken into account in the present decision. With respect to claim 11, since it is drawn to a polymer composition, for the purposes of the present response, this claim has been taken as belonging to the elected invention and has likewise been taken into account in this decision.

The examiner's position, set forth in the action mailed March 19, 2003, is that the polymer composition, which is common to both groups of inventions, does not constitute a special technical feature because it does not define a contribution over prior art such as US 5,543,373. In response to applicants' traverse, the examiner indicated that the process limitation in the elected polymer composition claims, which are recited in product-by-process format, is not a special technical feature since in that type of claim "the product is not limited to the process." See the action mailed May 20, 2003.

The applicants' main argument, as set forth, e.g., on page 4 of the petition, is that the examiner has not followed "the course required by PCT Rule 13" both in interpreting the process limitation in a product-by-process claim and in the overall analysis regarding the special technical feature. The applicants have pointed out that no rejection was made over US 5,543,373 cited by the examiner in making a determination of lack of unity.

As noted by applicants, given that the present application was filed under the provisions of 35 USC 371, in accordance with PCT Rule 13.2, unity of invention exists only "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features."

It is emphasized that the expression "special technical features" refers to those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In response to applicants' arguments regarding the examiner's treatment of claims in product-by-process format, it is observed that there is nothing in PCT Rule 13.2 to indicate that process limitations are to be given special consideration in a product-by-process claim. On the contrary, applicants are reminded that, according to MPEP 806.05(f), "a product defined by the process by which it can be made is still a product claim (In re Bridgeford, 357 F.2d 679, 149 USPQ 55 (CCPA 1966))" and, further, that "defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention." In view of that, the applicants' argument that the examiner did not follow PCT Rule 13 in interpreting the process limitation in a product-by-process claim is inapposite and unpersuasive.

In response to applicants' statement that no rejection was made over US 5,543,373 cited by the examiner in showing lack of unity, it appears that applicants are casting doubt on the evidence relied upon by the examiner to show lack of unity of invention because that reference was not also used in a rejection. However, there is no requirement that the reference relied upon by the examiner in establishing a prima facie case of lack of unity of invention must necessarily also be utilized in a rejection.

Even if, arguendo, the applicants are granted the benefit of the doubt, it is contended that EP 0,887,357 to Hüffer et al. used in the rejection given in paragraph 9 on page 4 of the action mailed May 20, 2003 provides evidence that the claimed polymer composition does not constitute a special technical feature that defines a contribution over prior art. Since the EP reference is in German, use is made of the English language equivalent US document 2001/0012874 (hereafter, US '874) also to the same inventive entity of Hüffer et al..

The polymer composition in the present claims (see, e.g., claim 1) is a semicrystalline propylene polymer composition made by a process involving metallocene catalysts and where the composition possesses certain characteristics with respect to melting point, TREF fractions, molar masses and melt flow rate (this last property is recited in newly added claim 11).

Particular attention is drawn to paragraphs [0013] and [0068] as well as Table 2 (this Table was cited in the rejection over EP) at pages 1, 5 and 8, respectively, of US '874. These cited portions show that US '874 discloses a propylene polymer with a semicrystalline matrix phase which is characterized by:

- A melting point of, e.g., 167.7°C compared with 135° to 165°C in the present claims, as amended. Although the overlap at the upper limit of the claimed range is not mathematically exact, it is sufficiently close given the general accuracy in measuring temperature values. It is noted that prior to amendment the present claims recited a melting point range of 65°to 170°C which would clearly have been met by US '874's melting point.
- A melt flow rate of, e.g., 1.8, 3.5 or 5.1g/10min which reads on values in the range of 1 to 12 g/10min in present claim 11. Both sets of rates are measured under identical test conditions as is evident from paragraphs [0076] and [0077] on page 6 of US '874.
- A weight-average molar mass of 1,000 to 1,000,000 compared with a number-average molar mass of at least 120,000 in the present claims. Given that the weight average molar mass is greater than or equal to the number average molar mass, the reference molar mass value meets the value in the claims.

It is apparent that due to the overlap between the characteristics of the claimed polymer and the polymer disclosed by US '874 (or, equivalently, EP), the two polymers are indistinguishable and the burden shifts to the applicants to show otherwise.

With respect to the TREF fraction characteristics in the present claims, while US '874 discloses TREF fractions at ≤ 80°C and at a series of temperatures above that just as done in the present claims which recite such fractions at $(T_M/2) + 7.5$°C, i.e. 75°-90°C, and at some of the same temperature values above that as the ones disclosed in Table 2 of US '874, a side-by-side comparison of the fractions is thwarted by the fact that US '874 shows fractions separately based on an elastomer phase and a matrix phase in contrast to their depiction in the present claims. Nevertheless, in view of the similarities in chemical composition and due to the overlap in several other claimed properties as discussed above, no difference is seen between the claimed composition and the one disclosed by US '874.

With respect to the process limitations, US '874 uses a Ziegler-Natta catalyst system in contrast to the metallocene catalysts in the present claims. However, in accordance with the previous discussion of patent law regarding the lack of significance of process limitations in product-by-process claims, the specific catalyst system used is irrelevant to demonstrating whether or not the present claims define a contribution over EP or equivalently US '874. All that is required is to show that the claimed polymer composition per se is disclosed by prior art. US '874 provides evidence that this is indeed the case.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the claims lack unity of invention.

Applicants are advised that, in the event that the elected product claims become allowable, then, provided that the non-elected process claims are amended so as to depend from or otherwise include all the limitations of the allowable product claim, then such process claims will be rejoined with the allowable product claims consistent with the requirement for rejoinder set forth in MPEP 821.04.

The petition is DENIED.

JMStone

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

Keil & Weinkauf
1101 Connecticut Avenue NW
Washington DC 20036

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 13 2005

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

In re Application of	:
Ernst Baumann et al	:
Serial No.: 10/168,216	: PETITION DECISION
Filed: June 19, 2002	:
Attorney Docket No.: 51038	:

This is in response to the petition under 37 CFR 1.144, filed March 24, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on June 19, 2002, and contained, as filed, claims 1-17, which were amended by preliminary amendment In a first Office action, mailed September 24, 2003, the examiner set forth a Lack of Unity, as follows:

Group I, claims 1-8 and 14, drawn to a products of formula I;
Group II, claim 9, drawn to processes for preparation of products of formula I;
Group III, claims 10-11, drawn to products of formula III;
Group IV, claim 12, drawn to the product of formula VI;
Group V, claim 13, drawn to products of formula VII;
Group VI, claim 15, drawn to a process for preparation of products of formula I and
Group VII, claims 16-17, drawn to methods of use of the products of formula I.

The examiner reasoned that the groups lacked a significant structural element qualifying as a special technical feature which defines a contribution over the prior art. The examiner identified the common structural element as 5-phenyl-4,5-dihydroisoxazole which is taught by a cited reference.

Applicants replied on July 29, 2004, canceling claim 17 and electing Group I with traverse. Applicants argued that the significant structural element claimed was different from that of the reference because of specific orientations of the attached radical groups. Applicants also argued that PCT Rules required examination together of product claims coupled with methods of making the product claims and methods of using the products.

The examiner mailed a new Office action to applicants on September 21, 2004, acknowledging applicants election and maintaining the requirement for the same reasons as before – that there is no significant structural element which qualifies as a special technical feature. The examiner rejected claims 1-3, 7-8 and 14 under 35 U.S.C. 103(a) as unpatentable over WO 98/31682

Applicants replied on March 24, 2005 with an amendment and this petition. The reply cancels claims 11-12 and replies to the outstanding rejection of record.

DISCUSSION

It is noted initially that the Lack of Unity requirement has not been made Final, however it is an action that has been repeated by the examiner and thus ripe for petition.

Applicants argue in their petition that PCT Rule 13 permits inclusion in an application claims to a product, a process for making that product and a process for using that product and that claims so grouped would have Unity of Invention. It is noted that with the cancellation of claims 12 and 13, the traversal with respect to Groups IV and V is rendered moot, as acknowledged by applicants. Of the remaining claims, claims 1-8 and 14 are directed to the dihydroisoxazole benzoylpyrazole compound or composition (Group I), claim 9 is to a method of making the compound from a precursor (Group II), claims 10-11 are to a precursor (Group III) and claim 16 is to a method of using the compound/composition. Claim 15 is found to be dependent on a canceled claim and is not addressed here.

The examiner has identified the dihydroisoxazole benzene structure as a significant structural element but has found the same structure in a reference (Löher et al) thus showing it to be old and to not make a contribution over the prior art. Applicants, however, point out that the attachment of other moieties to the benzene is part of the significant structure and has been overlooked by the examiner. Applicants point out that the carbonyl group (with a pyrazole terminus) has a specific orientation to the location of the dihydroisoxazole group which is not shown by the prior art. Thus the element identified does define over the prior art. However, in a subsequent action the examiner applied a different reference (von Deyn et al) which appears to more closely show applicants' compounds. This leads to the conclusion that the significant structural element which is relied on for establishing Unity does not make a contribution over the prior art and Unity among the categories of invention is lacking.

However, should product claims eventually be deemed allowable over the prior art and all other applicable statutes, under PCT Rules as well as under *In re Ochiai* doctrine, rejoinder of method of making and method of using claims having the same scope as the allowed product claims would be effected and the claims examined to determine their patentability with respect to all aspects of the statute.

DECISION

The petition is **DENIED.**

The application will be forwarded to the examiner for consideration of the amendment filed March 24, 2005, and further prosecution not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 13 2005

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

In re Application of	:
Ernst Baumann et al	:
Serial No.: 10/168,216	: PETITION DECISION
Filed: June 19, 2002	:
Attorney Docket No.: 51038	:

This is in response to the petition under 37 CFR 1.144, filed March 24, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on June 19, 2002, and contained, as filed, claims 1-17, which were amended by preliminary amendment In a first Office action, mailed September 24, 2003, the examiner set forth a Lack of Unity, as follows:

Group I, claims 1-8 and 14, drawn to a products of formula I;
Group II, claim 9, drawn to processes for preparation of products of formula I;
Group III, claims 10-11, drawn to products of formula III;
Group IV, claim 12, drawn to the product of formula VI;
Group V, claim 13, drawn to products of formula VII;
Group VI, claim 15, drawn to a process for preparation of products of formula I and
Group VII, claims 16-17, drawn to methods of use of the products of formula I.

The examiner reasoned that the groups lacked a significant structural element qualifying as a special technical feature which defines a contribution over the prior art. The examiner identified the common structural element as 5-phenyl-4,5-dihydroisoxazole which is taught by a cited reference.

Applicants replied on July 29, 2004, canceling claim 17 and electing Group I with traverse. Applicants argued that the significant structural element claimed was different from that of the reference because of specific orientations of the attached radical groups. Applicants also argued that PCT Rules required examination together of product claims coupled with methods of making the product claims and methods of using the products.

The examiner mailed a new Office action to applicants on September 21, 2004, acknowledging applicants election and maintaining the requirement for the same reasons as before – that there is no significant structural element which qualifies as a special technical feature. The examiner rejected claims 1-3, 7-8 and 14 under 35 U.S.C. 103(a) as unpatentable over WO 98/31682

Applicants replied on March 24, 2005 with an amendment and this petition. The reply cancels claims 11-12 and replies to the outstanding rejection of record.

DISCUSSION

It is noted initially that the Lack of Unity requirement has not been made Final, however it is an action that has been repeated by the examiner and thus ripe for petition.

Applicants argue in their petition that PCT Rule 13 permits inclusion in an application claims to a product, a process for making that product and a process for using that product and that claims so grouped would have Unity of Invention. It is noted that with the cancellation of claims 12 and 13, the traversal with respect to Groups IV and V is rendered moot, as acknowledged by applicants. Of the remaining claims, claims 1-8 and 14 are directed to the dihydroisoxazole benzoylpyrazole compound or composition (Group I), claim 9 is to a method of making the compound from a precursor (Group II), claims 10-11 are to a precursor (Group III) and claim 16 is to a method of using the compound/composition. Claim 15 is found to be dependent on a canceled claim and is not addressed here.

The examiner has identified the dihydroisoxazole benzene structure as a significant structural element but has found the same structure in a reference (Löher et al) thus showing it to be old and to not make a contribution over the prior art. Applicants, however, point out that the attachment of other moieties to the benzene is part of the significant structure and has been overlooked by the examiner. Applicants point out that the carbonyl group (with a pyrazole terminus) has a specific orientation to the location of the dihydroisoxazole group which is not shown by the prior art. Thus the element identified does define over the prior art. However, in a subsequent action the examiner applied a different reference (von Deyn et al) which appears to more closely show applicants' compounds. This leads to the conclusion that the significant structural element which is relied on for establishing Unity does not make a contribution over the prior art and Unity among the categories of invention is lacking.

However, should product claims eventually be deemed allowable over the prior art and all other applicable statutes, under PCT Rules as well as under *In re Ochiai* doctrine, rejoinder of method of making and method of using claims having the same scope as the allowed product claims would be effected and the claims examined to determine their patentability with respect to all aspects of the statute.

DECISION

The petition is **DENIED.**

The application will be forwarded to the examiner for consideration of the amendment filed March 24, 2005, and further prosecution not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

09 MAY 2003

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ashley I. Pezzner
Connolly Bove Lodge & Hutz LLP
1220 Market Street
P.O. Box 2207
Wilmington, DE 19899

In re Application of SÜLING	:	
U.S. Application No.: 10/168,268	:	
Int. Application No.: PCT/EP00/12510	:	DECISION
Int. Filing Date: 11 December 2000	:	
Priority Date: 21 December 1999	:	
Attorney Docket No.: DT00/0024	:	
For: METHOD FOR PRODUCTION OF A SOLID	:	
CATALYST FOR OLEFIN POLYMERISATION	:	

This is in response to applicant's "Petition Under 37 CFR 1.182" filed 28 April 2003.

BACKGROUND

On 11 December 2000, applicant filed international application PCT/EP00/12510, which claimed priority of an earlier Germany application filed 21 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 28 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 June 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2002.

On 18 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 October 2002, applicant filed a newly executed declaration.

On 25 March 2003, this Office mailed a communication which indicated that a petition under 37 CFR 1.182 is necessary to effect a change in an inventor's name.

On 28 April 2003, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

The third inventor's name in international application PCT/EP00/12510 is listed as "Nicola Hüsgen", whereas the third inventor's name on the declaration is listed as "NIcola Paczkowski".

MPEP 605.04(c) states in relevant part,

> In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant has filed a petition under 37 CFR 1.182 along with the required fee. However, the affidavit accompanying the petition is not signed with both names as required by MPEP 605.04(c).

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182". No additional petition fee is due. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

15 OCT 2003

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ashley I. Pezzner
Connolly Bove Lodge & Hutz LLP
1220 Market Street
P.O. Box 2207
Wilmington, DE 19899

In re Application of SÜLING
U.S. Application No.: 10/168,268
Int. Application No.: PCT/EP00/12510
Int. Filing Date: 11 December 2000
Priority Date: 21 December 1999
Attorney Docket No.: DT00/0024
For: METHOD FOR PRODUCTION OF A SOLID CATALYST FOR OLEFIN POLYMERISATION

DECISION

This is in response to applicant's "Petition Under 37 CFR 1.182" filed 22 May 2003.

BACKGROUND

On 11 December 2000, applicant filed international application PCT/EP00/12510, which claimed priority of an earlier Germany application filed 21 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 28 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 June 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2002.

On 18 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 October 2002, applicant filed a newly executed declaration.

On 25 March 2003, this Office mailed a communication which indicated that a petition under 37 CFR 1.182 is necessary to effect a change in an inventor's name.

On 28 April 2003, applicant filed a petition under 37 CFR 1.182.

On 09 May 2003, this Office mailed a decision dismissing the 28 April 2003 petition.

On 22 May 2003, applicant filed the present renewed petition under 37 CFR 1.182.

DISCUSSION

The third inventor's name in international application PCT/EP00/12510 is listed as "Nicola Hüsgen", whereas the third inventor's name on the declaration is listed as "Nicola Paczkowski".

MPEP 605.04(c) states in relevant part,

> In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant has filed a petition under 37 CFR 1.182 along with an affidavit signed with both names and setting forth the procedure whereby the change of name was effected.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date of 11 December 2000 and a date under 35 U.S.C. 371(c) of 22 October 2002.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KATE H. MURASHIGE
MORRISON & FOERSTER
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

COPY MAILED

JAN 04 2007

OFFICE OF PETITIONS

In re Application of
Ben R. De Haan
Application No. 10/168,270
Filed: June 17, 2002
Attorney Docket No. 246152017200

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed October 3, 2006 and October 5, 2006.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Morrison & Foerster has been revoked by the assignee of the patent application on October 17, 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: MR. BRYAN H. DAVIDSON
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203

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
10/168,270	06/17/2002	Ben Rudolf De Haan	246152017200

CONFIRMATION NO. 6291

OC000000021801196

OC000000021801196

Kate H Murashige
Morrison & Foerster
Suite 500
3811 Valley Centre Drive
San Diego, CA 92130-2332

Date Mailed: 01/03/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/08/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

April M Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

Mail Date: 04/21/2010

Applicant	: Ludwig Baumgartner	: DECISION ON REQUEST FOR
Patent Number	: 7655615	: RECALCULATION of PATENT
Issue Date	: 02/02/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/168,294	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 10/22/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2119** 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.

20 SEP 2002

URGENT

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CW 9/25

Awapatent
003300-965
DSO

Benton S. Duffett, Jr.
Burns, Doane, Swecker & Mathis, L.L.P.
P.O. Box 1404
Alexandria, Virginia 22313-1404

9-24-0200

In re Application of	:	
SONESSON, et al.	:	
Application No.: 10/168,297	:	DECISION ON PAPERS
PUT No.: PCT/SE00/02673	:	
Int. Filing Date: 22 December 2000	:	UNDER 37 CFR 1.42
Priority Date: 22 December 1999	:	
Attorney Docket No.: 003300-965	:	Substitute Declaration
For: NEW MODULATORS OF DOPAMINE	:	Due 11/20/02
NEUROTRANSMISSION	:	

This is a decision on the papers filed in United States Patent and Trademark Office on 20 June 2002, which are being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 22 December 2000, applicant filed the international application, which claimed a priority date of 22 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 June 2001. A Demand for international preliminary examination in which the United States was elected was filed on 14 June 2001 prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 June 2002.

On 20 June 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee; an Information Disclosure Statement; an assignment document for recording; a First Preliminary Amendment; an Information Data Sheet and a combined declaration and power of attorney executed by joint inventors Clas Sonesson; Susanna Waters; Nicholas Waters and Joakim Tedroff. In addition, the document was executed by Ingela Marianne Svan, Liselott Ronnqvist and Jenny Carlberg as heirs and legal representatives to the estate of deceased joint inventor Bengt Andersson.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor,

SEP 25 02

administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 20 June 2002 is executed by the identified heirs / legal representatives of inventor Andersson. However, the declaration does not set forth the citizenship of the heirs. While applicant has provided an Information Data Sheet providing the residence, post office address and country of citizenship of the heirs, the citizenships do not appear on the declaration itself. The information must be provided for both the deceased joint inventor, Bengt Andersson and his surviving heirs. Absent this information it is not possible to grant applicant's request for status under 37 CFR 1.42 at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Derek A. Putonen
PCT Petitions Attorney
PCT Legal Office
Telephone 703-305-0130
Fax: 703-308-6459

14 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#5

Benton S. Duffett, Jr.
Burns, Doane, Swecker & Mathis, L.L.P.
P.O. Box 1404
Alexandria, Virginia 22313-1404

In re Application of	:	
SONESSON, et al.	:	
Application No.: 10/168,297	:	DECISION ON RENEWED
PCT No.: PCT/SE00/02673	:	
Int. Filing Date: 22 December 2000	:	PETITION UNDER
Priority Date: 22 December 1999	:	
Attorney Docket No.: 003300-965	:	37 CFR 1.42
For: NEW MODULATORS OF DOPAMINE	:	
NEUROTRANSMISSION	:	

This is a decision on applicant's "Renewed Petition Under 37 CFR 1.42" filed in United States Patent and Trademark Office (USPTO) on 20 November 2002. No petition fee is required.

BACKGROUND

On 20 September 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.42. Applicant was afforded two months to file any request for reconsideration.

On 20 November 2002, applicant filed the present renewed petition.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

As detailed in the decision mailed 20 September 2002, applicant's original petition was dismissed as the filed declaration failed to set forth the citizenship of the heirs of the deceased inventor. Applicants have currently filed a declaration which spells out the residence, post office address and country of citizenship of Bengt Andersson as well as that of the his heirs: Ingela Marianne Svan, Anders Kristoffer Lilja and Jenny Maria Carlberg. As such, it is proper to grant applicant's renewed petition at this time.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 22 December 2000 and a date of **20 November 2002** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Telephone 703-305-0130
Fax: 703-308-6459

#10

2 8 MAY 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, VA 22102

In re Application of DROZ et al
U.S. Application No.: 10/168,298
PCT Application No.: PCT/EP00/12666
Int. Filing Date: 13 December 2000
Priority Date Claimed: 22 December 1999
Attorney Docket No.: 449122029100
For: METHOD AND ARRANGEMENT FOR LOCALLY CONTROLLING A TESTING PROCESS IN A TELECOMMUNICATIONS NETWORK

DECISION

This is in response to applicant's "Transmittal Letter for Response to Notification of Defective Response" filed 07 May 2003.

BACKGROUND

On 13 December 2000, applicant filed international application PCT/EP00/12666, which claimed priority of an earlier Germany application filed 22 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 28 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 22 June 2002.

On 20 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 20 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 20 November 2002, applicant filed a declaration.

On 07 April 2003, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration filed 20 November 2002 is improper.

On 07 May 2003, applicant filed the present request to accept the declaration.

DISCUSSION

The declaration filed 20 November 2002 is improper. Specifically, the declaration contains three sheets labeled as "Page 3" and two sheets labeled as "Page 4". It is not sufficient to submit only a signature page in lieu of a complete declaration. In addition, three of the sheets are printed on one paper stock, while the remaining four sheets are printed on a different paper stock. Furthermore, one of the sheets labeled as "Page 4" appears to have been processed by facsimile transmission. Each of these deficiencies raises doubt as to whether all pages of the declaration were before each declarant at the time of execution. The declaration filed with the present response is improper for similar reasons. Applicant must file either: (1) a single complete declaration which is presented to and executed by all of the inventors or (2) multiple complete declarations, each of which is presented to and executed by at least one of the inventors.

CONCLUSION

For the reasons above, the request to accept the declaration is DISMISSED without prejudice.

Because the present response appears to be bona fide but does not fully comply with the Notification of Defective Response, applicant is given a time limit of ONE (1) MONTH from the mail date of this decision to file a properly executed declaration or a petition under 37 CFR 1.47, if applicable. No extension of this time limit is available under 37 CFR 1.136. The period for response set in the Notification of Missing Requirements mailed 20 August 2002 was extendable until 20 March 2003, but no further extensions are available. Failure to timely file a proper response will result in ABANDONMENT of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

21 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, VA 22102

In re Application of DROZ et al	:	
U.S. Application No.: 10/168,298	:	
PCT Application No.: PCT/EP00/12666	:	
Int. Filing Date: 13 December 2000	:	DECISION
Priority Date Claimed: 22 December 1999	:	
Attorney Docket No.: 449122029100	:	
For: METHOD AND ARRANGEMENT FOR LOCALLY CONTROLLING A TESTING PROCESS IN A TELECOMMUNICATIONS NETWORK	:	

This is in response to applicant's " Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 06 August 2003.

BACKGROUND

On 13 December 2000, applicant filed international application PCT/EP00/12666, which claimed priority of an earlier Germany application filed 22 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 28 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 22 June 2002.

On 20 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 20 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 20 November 2002, applicant filed a declaration.

On 07 April 2003, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration filed 20 November 2002 is improper.

On 07 May 2003, applicant filed a request to accept the declaration.

On 28 May 2003, this Office mailed a decision dismissing the 07 May 2003 request. The decision set a one month non-extendable time limit for response.

International application PCT/EP00/12666 became abandoned as to the United States for failure to timely respond to the 28 May 2003 decision.

On 06 August 2003, applicant filed the present petition under 37 CFR 1.137(b).

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 13 December 2000, and a date under 35 U.S.C. 371(c) of 06 August 2003.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

06 MAY 2004

A10

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018

In re Application of	:	
KOMP, Guenther et al.	:	
Application No.: 10/168,360	:	
PCT No.: PCT/EP00/12463	:	DECISION ON
Int. Filing Date: 09 December 2000	:	
Priority Date: 22 December 1999	:	REQUEST
Attorney's Docket No.: 520.1009	:	
For: METHOD AND CIRCUIT	:	UNDER 37 CFR 1.497(d)
ARRANGEMENT FOR THE SECURE	:	
TRANSMISSION IN DIGITAL	:	
TRANSMISSION SYSTEMS	:	

This decision is in response to applicants' "Petition to Correct Inventorship Under 37 CFR 1.497(d)," filed in the United States Patent and Trademark Office on 23 February 2004.

BACKGROUND

On 09 December 2000, applicants filed international application PCT/EP00/12463, which claimed a priority date of 22 December 1999. On 25 May 2001, applicants timely filed a demand for international preliminary examination. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 June 2001. The thirty month deadline for entry into the national stage in the United States expired on 24 June 2002 (22 June 2002 was a Saturday).

On 20 June 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration.

On 22 August 2002, the Office mailed a "Notification of Missing Requirements," (Form PCT/DO/EO/905) noting, *inter alia*, that an oath or declaration of the inventors complying with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required, that the declaration that applicants had submitted listed an extra inventor and that there were no papers showing that the third inventor was an inventor on this application.

On 21 October 2002, applicants resubmitted copies of the earlier filed declaration listing three inventors.

On 15 January 2003, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration did not comply with 37 CFR 1.497(a)-(b) and that there was no legal documentation identifying inventor Karl-Heinz Troendle.

On 30 January 2003 applicant resubmitted a copy of the declaration executed by Karl Heinz Troendle.

On 20 January 2004, the Office mailed Notification of a Defective Response indicating that applicants had to furnish a declaration listing only the inventors on the international application or to furnish a request under 37 CFR 1.497(d).

On 23 February 2004, applicants submitted the instant request, accompanied by a certificate of first class mailing indicating it was deposited on 20 February 2004.

DISCUSSION

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1), (2) and (3) have been satisfied. Applicant has furnished the required statement from Mr. Karl-Heinz Troendle. The processing fee has been submitted. Assignee has furnished written consent.

The declaration supplied on 20 June 2002 was three pages. It included 2 pages "1 of 2" and 1 page "2 of 2". This indicates that at least two declarations were executed, but that applicants pieced them together to create a single declaration. The declarations must be submitted as executed by the inventors. The declarations submitted on 21 October 2002 comply with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, the request under 37 CFR 1.497(d) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt. The date under date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 21 October 2002.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 11 2008

OFFICE OF PETITIONS

In re Application of
Eugeny Makeyev, et al.
Application No. 10/168,380
Filed: July 19, 2002
Attorney Docket No. 034144-0102

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 September 5, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Foley & Lardner, LLP has been revoked by the assignee of the patent application on September 27, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: DR. SCOTT MCBRIDE
ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE
SUITE 1100
MILWAUKEE, WI 53202

27 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON, MA 02110-2804

In re Application of	:	
BRUNNER, GEORG et al.	:: :	
U.S. Application No.: 10/168,381	:	DECISION ON
PCT No.: PCT/EP00/12892	:	
International Filing Date: 18 December 2000	:	PETITION
Priority Date: 23 December 1999	:	
Attorney's Docket No.: 07508-034US1	:	UNDER 37 CFR 1.181
For: REFLECTOR SYSTEM FOR	:	
DETERMINING POSITION	:	

Applicants filed "Request For Corrected Official Filing Receipt." It has been treated as a petition under 37 CFR 1.181.

Applicants request a corrected filing receipt to correct a misspelled inventor's name and an allegedly incorrect filing date. The inventor's name has been corrected and a corrected filing receipt is enclosed, but the "filing date" is correct.

As set forth in MPEP 1893.03(b), the filing date of a national phase of a PCT is the international filing date. The date that appears in the "filing date" field of the filing receipt is the date of completion of the 35 U.S.C. §371 (c) requirements. This is more clearly indicated in the current filing receipt forms. Applicants supplied a declaration of the inventors and completed the 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) requirements on 13 November 2002, as indicated. MPEP 1893.03(b).

For the above reasons, the Petition Under 37 CFR 1.181 is **GRANTED** in part and **DISMISSED** in part. Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

Enc: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

COPY MAILED

JUN 13 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Kazuki Nakamura et al :
Application No. 10/168,397 :
Filed: June 21, 2002 :
Attorney Docket No. 7412/73104 :

This is a decision on the petition under 37 CFR 1.313 (c)(2), filed June 7, 2005, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on 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]

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

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

---

[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).

This matter is being referred to Technology Center AU 2883 for processing of the request for continued examination under 37 CFR 1.114.

Wan Laymon

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

cc: FITCH EVEN TABIN & FLANNERY
1801 K STREET, NW, SUITE 401L
WASHINGTON, DC 20006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AKIN GUMP STRAUSS HAUER & FELD
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

COPY MAILED

JUL 14 2006

OFFICE OF PETITIONS

In re Application of	:	
Susumu Kobayashi et al	:	
Application No. 10/168,415	:	ON PETITION
Filed: June 20, 2002	:	
Attorney Docket No. 10059-424US	:	

This is a decision on the petition, filed July 13, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on June 2, 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 1745 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. _____

Date : July 14, 2006

COPY MAILED
JUL 14 2006
OFFICE OF PETITIONS

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Susumu Kobayashi et al
Application No. :10/168,415
Filed :June 20, 2002

The above-identified application has been assigned Patent No. 7,081,315 and an issue date of July 25, 2006.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of July 25, 2006:

"All reference to Patent No. 7,081,315 to Susumu Kobayashi et al of Japan for HIGH POLYMER ELECTROLYTE FUEL CELL appearing in the Official Gazette of July 25, 2006 should be deleted since no patent was granted."

Karen Creasy

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

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

3 1 MAR 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

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

Patrick J. Halloran
Aventis Pasteur, Inc.
Intellectual Property - Knerr Building
One Discovery Drive
Swiftwater, PA 18370

In re Application of EMTAGE, et al. U.S. Application No.: 10/168,417 PCT No.: PCT/CA01/00005 Int. Filing Date: 05 January 2001 Priority Date: 05 January 2000 Attorney Docket No.: 11014-18-US For: ENHANCING THE IMMUNE RESPONSE TO AN ANTIGEN BY PRESENSITIZING WITH AN INDUCING AGENT PRIOR TO IMMUNIZING WITH THE INDUCING AGENT AND THE ANTIGEN	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 15 November 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 05 January 2001, applicants filed international application PCT/CA01/00005, which claimed priority of an earlier application filed 05 January 2000. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 12 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 July 2002.

On 21 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a Sequence Listing. Applicant did not file an executed oath or declaration of the inventors.

On 29 August 2002, applicants were mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicants of the

need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date as well as payment of the $130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 15 November 2002, applicants responded with the present petition to accept the present oath or declaration without the signature of inventor Charles Dwo Yuan Sia accompanied by a declaration executed by joint inventors Peter Emtage, Brian Barber and Sambhara Suryprakash. Applicants have authorized the deduction of charges from Deposit Account No.: 50-0244. Applicants' response was due by 29 October 2002, therefore the present filing will be considered to contain a request for a one-month extension of time. The $110.00 extension fee will be charged to Deposit Account No.: 50-0244. With the filing of the petition for a one-month extension of time applicant's petition is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1), applicants have provided the required petition fee of $130.00.

Regarding Item (3), the petition states the last known addresses of the non-signing inventor: Charles Dwo Yuan Sia.

Accordingly, Items (1) and (3) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." In the present petition, applicants claim that Mr. Sia refuses to execute the oath or declaration. However, it is unclear whether Mr. Sia has been presented with a complete copy of the application papers as required. The declaration of Jacqueline Ostrosky seems to imply that Mr. Sia was merely sent a copy of the declaration and assignment document; not a complete set of application papers. This is insufficient. In addition, the nature of the purported refusal is unclear. The petition states that, "Inventor Charles Dwo Yuan Sia ("Mr. Sia") has indicated his intention to not sign any documents relating to the above-referenced patent application." However,

applicant has not provided any evidence showing a documented refusal by Mr. Sia where he expressly refuses to execute the declaration. In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Charles Dwo Yuan Sia, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding Item (4), the accompanying declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor contains two "Pages 2 of 2." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

For the reasons stated above, it would not be appropriate to accept the application without the signature of Charles Dwo Yuan Sia under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Applicants are advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#8

21 JUL 2003

Patrick J. Halloran
Aventis Pasteur, Inc.
Intellectual Property - Knerr Building
One Discovery Drive
Swiftwater, PA 18370

In re Application of EMTAGE, et al. U.S. Application No.: 10/168,417 PCT No.: PCT/CA01/00005 Int. Filing Date: 05 January 2001 Priority Date: 05 January 2000 Attorney Docket No.: 11014-18-US For: ENHANCING THE IMMUNE RESPONSE TO AN ANTIGEN BY PRESENSITIZING WITH AN INDUCING AGENT PRIOR TO IMMUNIZING WITH THE INDUCING AGENT AND THE ANTIGEN	DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Response to Decision on Petition Under 37 CFR 1.47(a) Dated March 31, 2003" filed 20 May 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 31 March 2003, applicants were mailed a decision dismissing applicants' petition under 37 CFR 1.47(a) to accept the present application without the signature of applicant/inventor Charles Dwo Yuan SIA. Applicants were afforded two months to file any request for reconsideration.

On 20 May 2003, applicants filed the present renewed petition accompanied by four separate declarations executed by each of the applicant/inventors.

DISCUSSION

The renewed petition under 37 CFR 1.47(a) is moot since one of the declarations filed 20 May 2003 has been executed by the previous non-signing applicant/inventor Charles Dwo Yuan SIA. The declarations filed 20 May 2003 are acceptable under 37 CFR 1.497.

CONCLUSION

For the reasons above, the second renewed petition under 37 CFR 1.47(a) is **DISMISSED as moot**.

The application has an international filing date of **05 January 2001** and will be given a date of **20 May 2003** under 35 U.S.C 371(c).

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Richard Cole
Legal Examiner
Office of PCT Legal Administration

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATRICK J. HALLORAN
AVENTIS PASTEUR INC.
KNERR BUILDING
ONE DISCOVERY DRIVE
SWIFTWATER, PA 18370

COPY MAILED

FEB 2 3 2007

OFFICE OF PETITIONS

In re Application of
EMTAGE, et al.
Application No. 10/168,417
Filed: May 20, 2003
Attorney Docket No. 11014-18-US

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 21, 2006 and re-submitted December 11, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed February 21, 2006 , which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 22, 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 an Election; (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

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

This application is being referred to Technology Center Art Unit 1645.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: **PATRICK J. HALLORAN, PH.D., J.D**
3141 MUIRFIELD ROAD
CENTER VALLEY, PA 18034

UNITED STATES PATENT AND TRADEMARK OFFICE

MAY - 5 2004

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

TERENCE P. LO
AGENT FOR APPLICANTS
INCYTE CORPORATION
3160 PORTER DRIVE
PALO ALTO, CALIFORNIA 94304

In re Application of	:
YANG et al.	:Petition to Review Lack of Unity
Serial No: 10/168,425	:Under 37 C.F.R. 1.144
Filed: June 21, 2002	:
Attorney Docket No: PI-0003USN	:

This is in response to applicant's petition under 37 CFR 1.144, filed July 16, 2003, requesting review of the Examiner's lack of unity requirement mailed February 14, 2003. The delay in acting on this petition is regretted.

BACKGROUND

This application is a U.S. national stage application properly filed under 35 USC 371.

The Examiner instituted a lack of unity requirement of claims 1-28 into fourteen groups in an office action which was subsequently made final. In particular, the following lack of unity between Groups I and II is at issue:

Group I, claims 1,2,16 and 17, drawn to protease polypeptides.

Group II, claims 3-7, 9, 11 and 12, drawn to polynucleotides encoding protease polypeptides.

The Examiner further instituted a restriction between polypeptides of SEQ ID NO: 1-14 for Group I and for Group II a restriction between nucleotides of SEQ ID Nos. 15-28 or nucleotide sequences (e.g. generic of sequences) which encode a single polypeptide from among SEQ ID NO: 1-14.

In the response dated April 11, 2003 to the lack of unity requirement Applicant elected, with traverse, Group II and polynucleotides encoding polypeptide SEQ ID No: 2 including the nucleotide SEQ ID No. 16. The examiner then considered the traversal, found it not persuasive and make the lack of unity holding final.

RELEVANT AUTHORITY

An international or a national stage application are considered to have unity of invention where there exists a "special technical feature" that defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. See PCT Rule 13.2; 37 CFR 1.475(a), (b)(1) and (2).

In addition to the categories provided for in 37 CF 1.475(b) (1-5), unity of invention is provided for in the following context:

> *Claim 1: Protein X*
> *Claim 2: DNA sequence encoding protein X.*

wherein expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity of invention between claims 1 and 2 is accepted.

See MPEP 1893.03(d) and Annex B, Part 2 of the PCT Administration Instructions, Example 17.

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims and

> *(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims;*
> *(ii) If however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on the claim need to be carefully considered. If there is no link remaining an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) may be raised. See ANNEX B: Unity of Invention Part 1 "Instructions Concerning Unity of Invention" MPEP AI-6 (Rev. 1. Feb. 2003).*

Regarding the determination of a "special technical feature" under Rule 13.2 when dealing with "Markush Practice", MPEP: Annex B "Unity of Invention Part 1 Instructions Concerning Unity of Invention" and "Part 2 Examples Concerning Unity of Invention" is instructive.

In accordance with Annex B (f) "Markush Practice", the requirement of a technical interrelationship and the same or corresponding special technical feature as defined in Rule 13.2, shall be considered to be met when the alternatives are of a "similar nature" which occurs when the following criteria are fulfilled:

> *(A) all alternatives have a common property or activity, and*
>
> *(B)(1) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or*

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a "recognized class of chemical compounds" in the art to which the invention pertains.

The words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention"; "In other words each member could be substituted one for the other, with the expectation that the same result would be achieved".

DISCUSSION

Applicant's petition and the file record have been carefully considered.

Applicants are correct that the above-identified application is a national stage application submitted under 35 U.S.C. 371 to which "unity of invention", and not U.S. restriction practice is applicable. See MPEP section 1893.03(d). The lack of unity between independent polypeptide claims of Group I and independent polynucleotide claims of Group II is therefore at issue.

Independent original claim 1 (corresponding to Group I) and claim 3 (corresponding to Group II) were as follows:

> 1. An isolated polypeptide comprising an amino acid sequence selected from the group consisting of:
> a) an amino acid sequence selected from the group consisting of SEQ ID NO: 1-14,
> b) a naturally occurring amino acid sequence having at least 90% sequence identity to an amino acid sequence selected from the group consisting of SEQ ID NO: 1-14 and
> c) a biologically active fragment of an amino acid sequence selected from the group consisting of SEQ ID NO: 1- 14, and
> d) an immunogenic fragment of an amino acid sequence selected from the group consisting of SEQ ID NO: 1-14.
>
> 3. An isolated polynucleotide encoding a polypeptide of claim 1.

The present independent claims of Group I (corresponding to amended claim 1) and Group II (corresponding to amended claim 3 and new claims 11 and 96) follow:

> 1. (amended) An isolated polypeptide encoded by a polynucleotide of claim 3.
>
> 3. (amended) An isolated polynucleotide encoding a polypeptide selected from the group consisting of:
> a) a polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 1-14,

b) a polypeptide comprising a naturally occurring amino acid sequence at least 90% identical to an amino acid sequence selected from the group consisting of SEQ ID NO: 1-14 and
c) a polypeptide comprising a polypeptide fragment, wherein the polypeptide fragment consists of a fragment of an amino acid sequence selected from the group consisting of SEQ ID NO: 1- 14, and wherein the polypeptide fragment has protease activity.

11. An isolated polynucleotide selected from the group consisting of:
a) a polynucleotide comprising a polynucleotide sequence selected from the group consisting of SEQ ID NO: 15-28,
b) a polynucleotide comprising a naturally occurring polynucleotide sequence at least 90% identical to a polynucleotide sequence selected from the group consisting of SEQ ID NO: 15-28,
c) a polynucleotide complementary to the polynucleotide of a),
d) a polynucleotide complementary to the polynucleotide of b), and
e) an RNA equivalent of a)-d).

96. An isolated polynucleotide selected from the group consisting of:
a) a polynucleotide comprising at least 60 contiguous nucleotides of a polynucleotide sequence selected from the group consisting of the polynucleotide sequence consisting of nucleotides 1- 214 of SEQ ID NO: 16, the polynucleotide sequence consisting of nucleotides 1-569 of SEQ ID NO: 16, the polynucleotide sequence consisting of nucleotides 359-824 of SEQ ID NO: 16, and the polynucleotide sequence consisting of nucleotides 756-933 of SEQ ID NO: 16,
b) a polynucleotide comprising a polynucleotide sequence selected from the group consisting of the polynucleotide sequence consisting of nucleotides 324-395 of SEQ ID NO: 16, the polynucleotide sequence consisting of nucleotides 539-570 of SEQ ID NO: 16, the polynucleotide sequence consisting of nucleotides 686-1218 of SEQ ID NO: 16 and the polynucleotide sequence consisting of nucleotides 976-1422 of SEQ ID NO: 16,
c) a polynucleotide complementary to a polynucleotide of a),
d) a polynucleotide complementary to a polynucleotide of b), and
e) an RNA equivalent of a)-d).

Applicant argues that in accordance with PCT Administration Instructions, Example 17, the claims of Group I and Group II should possess unity of invention.

It is first noted that the representative claims (both original and later amended claims) above are drawn to a genus of nucleotides encoding a genus of polypeptides and not a genus of nucleotides encoding a single protein as in Example 17. Accordingly, in the first instance, unity of invention pursuant to Example 17 may not be applicable.

Applicant's argument is additionally misplaced since PCT Rule 13.2 and Example 17 specifically indicates that unity of invention between the protein and its corresponding encoding

nucleotide requires that the protein and the DNA sequence exhibit corresponding special technical features, i.e., make a contribution over the prior art.

With respect to the original claims, it was noted by the Examiner that the technical feature linking the inventions, nucleic acids encoding proteases, cannot serve as a unifying feature since proteases are well known in the art as demonstrated by the Scarisbrick et al. 1997 reference cited by Examiner. Additionally, neither the isolated polynucleotide of claim 3, nor the isolated polypeptide of claim 1 exhibit a corresponding special technical feature since the Bandman reference teaches isolated polynucleotides that encode immunogenic fragments of SEQ ID No. 2 within the scope of the original claims. See e.g. Examiner office action dated 5/16/2003 pages bottom of page 8 to page 10.

Accordingly, Applicant's arguments regarding Example 17, as applied to the original claims is not persuasive.

Additionally, Applicant's arguments regarding Example 17, as applied to the present claims (e.g. amended claims 1and 3; and newly presented claims 11 and 96) were considered but deemed nonpersuasive for the following reasons.

The deletion of "immunogenic fragment" in amended claim 3 obviated the applicability of the Bandman reference regarding unity of invention. Nevertheless, amended claim 3 part c) recites a Markush of isolated polynucleotides encoding polypeptide fragments of SEQ ID NO: 1-14 possessing protease activity, which lacks a same or corresponding technical feature under PCT Rule 13.2 since the claim fails to recite common polynucleotide structure, i.e. a significant structural element is shared by all of the alternatives that is necessary to encode a protease active polypeptide fragment for any of SEQ ID NO: 1-14. Nor is there any evidence of record that would serve to establish that the polynucleotides constitute a "recognized class of chemical compounds" in that one could be substituted one for the other, with the expectation that the same result would be achieved.

With regard to newly presented isolated polynucleotides of claims 11 and 96, it is first noted these polynucleotides lack the functional limitation required by Example 17 since claims 11 and 96 are not required to encode any polypeptide. Claim 11 part (b) defines the polynucleotide only in terms of structure and reads upon polynucleotides which are 90% identical to SEQ ID Nos 15-28. A polynucleotide containing a stop codon truncating the open reading frame or the presence of a splice site which results in a open reading frame shift would fit into the required structural limitation but it not encode the polypeptide having at least 90% identity to SEQ ID No 1-14. The complementary sequences encompassed by parts (c) and (d) of claims 11 and 96 are non-coding strands of any length. Transcription and translation of a non-coding strand would not result in the polypeptides of Group I. Within the large numbers of polynucleotides encompassed by Claims 11 and 96, many which could encode a polypeptide would not encode the polypeptides of Group I. Additionally, parts (c) and (d) of claims 11 and 96 would appear to lack a special technical feature in view of the Wang et al. 20030204075 reference teaching of SEQ ID Nos 166,361 and 166,362 comprising residues of 496-771 of SEQ ID No 16 which would represent complementary polynucleotides of polynucleotide sequences presented in parts (a) and (b) of these claims. See e.g. 35 USC 102(e) rejection over Wang et al. in the office action

dated 1/20/04 (pages 21-22). For these reasons, Groups I and II lack a same or corresponding technical feature, as required by PCT Rule 13.2.

Applicant further argues that "at the very least, the unity of invention standard requires that claims drawn to polypeptides of SEQ ID No 2 be examined together with the claims currently under consideration, drawn to polynucleotides encoding SEQ ID No 2 (including polynucleotides of SEQ ID No 16)".

Applicant appears to be arguing that the Examiner's "restriction" between the single SEQ ID No 16 (which encodes SEQ ID No 2) and nucleotide sequences (e.g. generic of sequences) encoding SEQ ID No 2 in the office action dated 2/14/2003 page 4, fourth line from the bottom is contrary to unity practice.

Applicant's argument is misguided since unity of invention has to be considered in the first instance only in relation to independent claims. As already discussed, the Examiner has provided permissible *a posteriori* evidence that there isn't a special technical feature linking the polynucleotides of original claim 3 to the polypeptides of claim 1 in light of the prior art of record. Accordingly, the Examiner's "restriction" is in conformance with unity of invention standards. Additionally, citation of the Wang et al. 20030204075 reference as anticipatory under 102(e) of polypeptide fragments of SEQ ID No 16 in the office action dated 1/20/04 (pages 21-22) indicates that polynucleotides derived from SEQ ID NO: 16 do not share a special technical feature with the polypeptide of SEQ ID NO: 2.

DECISION

Applicant's petition to withdraw the lack of unity requirement between Groups I and II under 37 CFR 1.144 is **DENIED** for the reasons set forth above.

Upon reconsideration, the non-final office action dated January 20, 2004 has been withdrawn, and the application will be forwarded to the Examiner for preparation of a supplemental Office action consistent with this decision.

Any request for consideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0512 or by facsimile transmission at (571) 872-9306.

Bruce Kisliuk
Director, Technology Center 1600.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Pauley Petersen Kinne & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates IL 60195

MAILED

OCT 21 2009

OFFICE OF PETITIONS

In re Patent No. 6,891,040
Issue Date: May 10, 2005
Application No. 10/168,440
Filed: October 17, 2002
Attorney Docket No. SCP-114

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 20, 2009.

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

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

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

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. 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 appropriate the proper power attorney documents should also be submitted.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

Cc: Kendal Sheets
CPA North America, LLC
225 Reinekers Lane, Suite 400
Alexandria, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

NOV 16 2007

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

PERMAN & GREEN, LLP
425 POST ROAD
FAIRFIELD, CT 06824

In re Application of	:
Hans-Herman Schulz	:
Serial No.: 10/168,441	: SUSPENSION OF ACTION
Filed: June 21, 2002	:
Attorney Docket No.: 785-011004-US	:

This is in reply to the petition under 37 CFR 1.103(a) to suspend action in this application at applicant's request for a period of six months, filed August 27, 2007.

BACKGROUND

Applicants filed a petition to suspend prosecution in this application on August 27, 2007, on the basis that a sale of business interests of the assignee has just been completed, including transfer of the instant application and the acquiring interests have not reached an understanding of a strategy for continuing prosecution of this application.

DISCUSSION

§ 1.103 Suspension of action by the Office.

(a) Suspension for cause . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
(1) A showing of good and sufficient cause for suspension of action; and
(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

The reasons for suspension set forth do not appear to relate to a decision on the merits of patentability of the application. Further, no details as to why the prosecution strategy should change or how it should change is set forth, nor when such decision will be made. It is unlikely that sale of this application (and any other properties) was undertaken without proper preparation therefor which preparation should have included an assessment of potential prosecution and other actions. Further applicants had an opportunity when filing RCE papers on August 27, 2007, to request a three month suspension under 37 CFR 1.103(c), which would have been granted with payment of the fee, but chose not to do so.

DECISION

The petition is **DENIED.**

The application will be forwarded to the examiner for further action.

Should there be any questions with respect to this action, please contact the examiner or 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 Office general facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

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

ECOLAB INC.
MAIL STOP ESC-F7, 655 LONE OAK DRIVE
EAGAN, MN 55121

Mail Date: 04/20/2010

Applicant	: Friedrich Von Rheinbaben	: DECISION ON REQUEST FOR
Patent Number	: 7638504	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/168,442	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/18/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **572** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 04-07

Paper No: __

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

COPY MAILED

APR 2 3 2007

OFFICE OF PETITIONS

In re Application of	:	
Iwamoto, et al.	:	DECISION
Application No.: 10/168,444	:	
Filing Date: 7 October, 2002	:	
Attorney Docket No. 09793822-0167	:	

This is a decision on the petition filed on 12 September, 2006, improvidently entitled "Petition to Rescind Holding of Abandonment," and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

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

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

BACKGROUND

The record reflects that:

- the Examiner mailed a final Office action on 16 September, 2004, to which Petitioner replied with, *inter alia*, an after-final amendment on 21 January, 2005, which the Examiner appears to have entered on 4 February, 2005, but thereafter concluded was not a proper reply, not of right and did not *prima facie* place the application in condition for allowance, and the Examiner mailed an Advisory Action on 16 February, 2005;

- the Office mailed a Notice of Abandonment on 23 August, 2005;

- the Office withdrew that Notice on 13 September, 2005, however, the Abandonment was reinstated on 29 August, 2006;

- Petitioner filed the instant petition and alleged that the Examiner, by an undated Interview Summary reflecting a 4 March, 2005, interview, seems to have agreed to withdraw the finality of the 12 January, 2005, Office action, and reconsider the amendment;

- a telephone conference with the Supervisory Patent Examiner on 17 April, 2007, indicated that the interview summary appeared not to be part of the application record until Petitioner's 12 September, 2006, filing, and so was not in evidence and, thus, not considered at the time the Notice of Abandonment was reinstated on 29 August, 2006.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

---

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

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

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

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

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

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

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

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

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document,

STATUTES, REGULATIONS AND ANALYSIS

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

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

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

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

---

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.

[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.

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]

Petitioner appears to have satisfied the showing requirements described above.

---

[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).

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

* * *

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

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. * **

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

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.)

* * *

CONCLUSION

It appears that Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is **granted**, and the Notice of Abandonment mailed on 29 August, 2006, hereby is **vacated**.

This application is released to Technology Center 1700 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

---

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

Paper No. 7

COPY MAILED

AUG 15 2003

OFFICE OF PETITIONS

ON PETITION

PARK & SUTTON LLP
3255 WILSHIRE BLVD
SUITE 1110
LOS ANGELES, CA 90010

In re Application of
Lee et al.
Application No.10/168450
Filed: JUne 21, 2002
Attorney Docket Number: 1544.05

This is a decision on the petition under 37 CFR §1.137(a), filed July 24, 2003. This petition is being treated under 37 CFR §1.181(no fee) as a petition to withdraw the holding of abandonment for the above-identified application.

The petition to withdraw the holding of abandonment is **GRANTED**.
The petition under 37 CFR 1.137(a) is being **Dismissed as Moot**.

This application was held abandoned for failure to timely submit a response to the October 15, 2002 non-final Office Action. The Office Action set a one (1) month shortened statutory period for reply. Extensions of time pursuant to 37 C.F.R. §1.136(a) were available. Petitioner was informed of the above- identified application's abandonment by the Notice of Abandonment mailed on June 17, 2003.

Petitioner maintains a response to the October 15, 2002 Office Action was submitted on December 13, 2002 with a request for a one month extension of time. In support, petitioner has provided a copy of an stamped post card receipt. The postcard acknowledges receipt of transmittal, a check, response to Office Action and Extension of time on December 13, 2002. The postcard receipt serves as prima facie evidence the documents listed were received at the USPTO. Furthermore a review of the Revenue Accounting and Management (RAM) shows receipt of the $55.00 check towards the one month extension of time on December 13, 2002. However, the documents have not been located in the file. Accordingly the documents submitted with the instant petition will be used in response to the Office Action.

Based on the facts stated in the instant petition, and the corroborative evidence provided, it is concluded that the holding of abandonment was improperly imposed.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Since the petition has been granted under 37 CFR §1.181, the Petitioner's request to have the petition considered under 37 CFR §1.137(a) is dismissed as moot. The $55.00 petition fee will be refunded to deposit account 16-0310.

This application is being forwarded to Technology Center 1651 for further processing.

Telephone inquiries concerning this matter may 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
www.uspto.gov

PILLSBURY WINTHROP LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 10500
MCLEAN, VA 22102

COPY MAILED

JAN 18 2007

OFFICE OF PETITIONS

In re Application of
Taro Komiya et al
Application No. 10/168,451
Filed: October 11, 2002
Attorney Docket No. P 291690

ON PETITION

This is a decision on the petition, filed July 7, 2006, 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 November 10, 2005, 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 February 11, 2006.

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

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

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

By facsimile: (571) 273-8300
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

Attachment: Advisory Action

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/168,451	KOMIYA ET AL.	
	Examiner	Art Unit	
	Jeffrie R. Lund	1763	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered; or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Jeffrie R. Lund
Primary Examiner
Art Unit: 1763

Continuation of 11. does NOT place the application in condition for allowance because: the arguments do not ovecome the rejection of record, and are based on limitations in the specification that are not claimed.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PILLSBURY WINTHROP LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 10500
MCLEAN, VA 22102

COPY MAILED

AUG 0 2 2007

OFFICE OF PETITIONS

In re Application of	:	
Taro Komiya et al	:	
Application No. 10/168,451	:	ON PETITION
Filed: October 11, 2002	:	
Attorney Docket No. P 291690	:	

This is a decision on the renewed petition under 37 CFR 1.137(b), filed March 19, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed November 10, 2005, which set a shortened statutory period for reply of three (3) months. Three-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on May 11, 2006.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on March 19, 2007.

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

This matter is being referred to Technology Center AU 1763 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: PA

DATE : 08/30/05

TO SPE OF : ART UNIT 2859

SUBJECT : Request for Certificate of Correction on Patent No.: 10/168484 6871999

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.

ATTN: Please respond and send to Scan
Thank You For Your Assistance

A Green

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.

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

Comments:

D Gutierrez

Diego Gutierrez
~~Supervisory Patent Examiner~~
SPE
Technology Center 2800

2859
Art Unit

PTOL-308 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

FEB 15 2006

OFFICE OF PETITIONS

In re Application of
Robert A. Lee et al.
Application No. 10/168,496
Filed: February 26, 2003
Attorney Docket No.: APTLTD.019APC

ON PETITION

This is a decision on the petition filed October 18, 2005, under 37 CFR 1.181, to withdraw the holding of abandonment for the above-identified application.

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

The application was held abandoned on May 26, 2005, for failure to timely submit a timely response to the non-Final Office Action mailed February 25, 2005, which set a three month period for reply. Accordingly, a Notice of Abandonment was mailed September 9, 2005.

Petitioner asserts that a response was filed and, in support, petitioner has submitted, *inter alia*, a copy of the response in the form of an amendment, a three month extension of time request which bears a certificate of mail date of August 24, 2005 and a post card receipt date stamped August 29, 2005 by the USPTO.

A search of the application file and the USPTO records reveals that in fact, an amendment was filed on August 29, 2005. As well, the three month extension of time fee in the amount of $1020.00 was properly posted on August 29, 2005 to the finance account for the above referenced application. Accordingly, the Notice of Abandonment mailed September 9, 2005 was mailed in error and is hereby withdrawn. No petition fee is due and none has been charged.

This matter will be referred to Technology Center 1771 for appropriate action on the amendment filed August 29, 2005.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

24 SEP 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

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

#3

COLLARD & ROE
1077 Northern Boulevard
Rosyln, New York 11576-1696

In re Application of:	:	
KELLER, Gerhard	:	DECISION ON PETITION TO
U.S. Application No.: 10/168,514	:	REVIVE ABANDONED
PCT No.: PCT/EP00/05082	:	APPLICATION UNDER 37
International Filing Date: 02 June 2000	:	CFR 1.137(b)
Priority Date: 04 June 1999	:	
Attorney's Docket No.: KELLER-9 (PCT)	:	
For: METHOD FOR PRODUCING TUBULAR	:	
CONTAINERS	:	

The petition to revive under 37 CFR 1.137(b) filed 21 June 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "[t]his application became abandoned unintentionally" is construed as being the statement required by 37 CFR 1.137(b)(3), that is, 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 this is not a proper interpretation of applicant's statement, applicant **must** contact this Office immediately.

Applicant has now submitted the small entity basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that the 21 June 2002 submission also included a translation of the international application into English, an executed declaration in compliance with 37 CFR 1.497, and the required surcharge and processing fees.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. 371 date is 21 June 2002.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

JUN 27 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Bruno M. Ameduri, et al. :
Application No. 10/168,523 :
Filed: November 20, 2002 :
Attorney Docket No. 224485USOPCT :

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

The petition is **GRANTED**.

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

The application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application No. 11/106,571 on April 15, 2005.

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

The application is being referred to Files Repository.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 1/25/05

TO SPE OF : ART UNIT 1712

SUBJECT : Request for Certificate of Correction on Patent No.: 6783850

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.

Lamonte Newsome

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:

Randy Gulakowski

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

SPE

1712

Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 24 2004

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

LORI L. KERBER
INCYTE CORPORATION
3160 PORTER DRIVE
PALO ALTO, CALIFORNIA 94304

In re Application of	:
YANG et al.	:Petition to Review Lack of Unity
Serial No: 10/168,582	:Under 37 C.F.R. 1.144
Filed: June 20, 2002	:
Attorney Docket No: PI-0002USN	:

This is in response to applicant's petition under 37 CFR 1.144, filed 25 February 2004, requesting review of the Examiner's lack of unity requirement mailed 25 July 2001.

BACKGROUND

This application is a U.S. national stage application properly filed under 35 USC 371.

The Examiner instituted a lack of unity requirement of claims 1-28 into 132 groups in an office action which was subsequently made final. In particular, the following lack of unity between Group VI and Group XVIII is at issue:

> Group VI, claims 1,2, 9, 16-18, drawn to polypeptide having SEQ ID NO:6.
>
> Group XVIII, claims 3-7, 11 and 12, drawn to polynucleotide encoding SEQ ID NO:6 or having SEQ ID NO 18.

In the response dated 3 September 2003 to the lack of unity requirement Applicant elected, with traverse, Group XVIII and polynucleotides encoding polypeptide SEQ ID NO:6 including the nucleotide SEQ ID NO:18. The examiner then considered the traversal, found it not persuasive and made the lack of unity holding final.

RELEVANT AUTHORITY

An international or a national stage application are considered to have unity of invention where there exists a "special technical feature" that defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. See PCT Rule 13.2; 37 CFR 1.475(a), (b)(1) and (2).

PCT Rule 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

PCT Administrative Instructions, Annex B, Part 2, Example 17 states:

> *Claim 1: Protein X*
> *Claim 2: DNA sequence encoding protein X.*

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity of invention between claims 1 and 2 is accepted.

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.

DISCUSSION

Applicant's petition and the file record have been carefully considered.

Applicants are correct that the above-identified application is a national stage application submitted under 35 U.S.C. 371 to which "unity of invention", and not U.S. restriction practice is applicable. See MPEP section 1893.03(d). The lack of unity between independent polypeptide claims of Group VI and independent polynucleotide claims of Group XVIII is therefore at issue.

Independent claim 1 (corresponding to Group VI) and claims 3 and 11 (corresponding to Group XVIII) are reproduced below:

> 1. An isolated polypeptide comprising an amino acid sequence selected from the group consisting of:
> a) an amino acid sequence selected from the group consisting of SEQ ID NO: 1-12,

b) a naturally occurring amino acid sequence having at least 90% sequence identity to an amino acid sequence selected from the group consisting of SEQ ID NO: 1-12 and
c) a biologically active fragment of an amino acid sequence selected from the group consisting of SEQ ID NO: 1- 12, and
d) an immunogenic fragment of an amino acid sequence selected from the group consisting of SEQ ID NO: 1-12.

3. An isolated polynucleotide[1]
comprising an amino acid sequence selected from the group consisting of:
a) an amino acid sequence selected from the group consisting of SEO ID NO:6. and
b) a naturally occurring amino acid sequence having at least 99% sequence identity to an amino acid sequence comprising the sequence of SEO ID NO:6.

11. An isolated polynucleotide comprising a polynucleotide sequence selected from the group consisting of:
a) a polynucleotide sequence comprising the nucleotide sequence of SEQ ID NO:18
b) a naturally occurring polynucleotide sequence having at least 99% sequence identity to the polynucleotide sequence of a)
c) a polynucleotide sequence complementary to a),
d) a polynucleotide sequence complementary to b), and
e) an RNA equivalent of a)-d).

Applicant argues that in accordance with PCT Administrative Instructions, Example 17, the claims of Groups VI and Group XVIII should possess unity of invention. Applicants have argued and added emphasis to the following sentence of Example 17:

The protein and the DNA sequence exhibit corresponding special technical features.

Applicants appear to be arguing that this sentence is a conclusion directed at any particular combination of DNA and protein inventions. This is not persuasive. This sentence is understood to present background facts relating to this particular example which specifies that in these claims, the DNA encodes the protein, the DNA and protein make a contribution over the prior art. In the inventions of Example 17, the groups share a technical feature which makes a contribution over the prior art, therefore, unity is accepted.

Applicant's argument is misplaced since PCT Rule 13.2 and Example 17 specifically indicates that unity of invention between the protein and its corresponding encoding nucleotide sequence requires that the protein and the DNA sequence exhibit corresponding special technical features, i.e., make a contribution over the prior art.

The inventions under consideration here do not fit into the pattern of Example 17 and therefore are not considered to have unity of invention for the following reasons. It is first noted that the

[1] It appears that the amendment to Claim 3 inadvertently removed an essential phrase "encoding a polypeptide". It is unlikely that applicants intend to claim hybrid molecules, such as polynucleotides that comprise polypeptides. For this reason, Claim 3 is being interpreted as reciting "polynucleotides encoding polypeptides comprising...."

representative claims 3 and 11 above are drawn to a genus of nucleotides encoding a genus of polypeptides and not a genus of nucleotides encoding a single protein as in Example 17. Accordingly, in the first instance, unity of invention pursuant to Example 17 may not be applicable.

With respect to claim 1, it was noted in the first Office action (page 5, lines 7-11) that the polypeptide, as broadly claimed, does not make a contribution over the prior art. Claim 1 encompasses biologically active fragments, such as the Tyr-Arg bioactive peptide (residues 293-294 of SEQ ID NO:6), which is taught by the Sigma Chemical Company Catalog (1993, page 1067).

Similarly, the nucleic acids encoding kinases, cannot serve as a unifying feature in view of GenBank Accession Number L77564 which was cited in the rejection under 35 USC 102(b) in the Office action mailed 26 November 2003. Claim 3(b) has been amended to recite sequences encoding polypeptides having at least 99% sequence identity to SEQ ID NO:6. The attached sequence alignment shows that L77564 has 99.4% sequence identity with SEQ ID NO:18, thus demonstrating the polynucleotide claims fail to make a contribution over the prior art. Accordingly, Applicant's arguments regarding Example 17, as applied to the inventions as claimed are not persuasive.

Additionally, Applicant's arguments regarding Example 17, as applied to the present claims (e.g. original claim 1 and newly amended claims 3 and 11) were considered but deemed nonpersuasive for the following reasons.

With regard to the isolated polynucleotides of claim 3 and 11, it is first noted these polynucleotides lack the functional limitation required by Example 17 since claims 3 and 11 are not required to encode any polypeptide.[2] Claim 11(b) defines the polynucleotide only in terms of structure and reads upon polynucleotides which are at least 99% identical to SEQ ID NO:18. A polynucleotide containing a stop codon truncating the open reading frame or the presence of a splice site which results in an open reading frame shift would fit into the required structural limitation but it would not encode the polypeptide having at least 99% identity to SEQ ID NO:6. The complementary sequences encompassed by parts (c) and (d) of claim 11 are non-coding strands of any length. Transcription and translation of a non-coding strand would not result in the polypeptide having SEQ ID NO:6. Within the large numbers of polynucleotides encompassed by Claim 11, many which could encode a polypeptide would not encode the polypeptides of Group VI. For these reasons, Groups VI and XVIII lack a same or corresponding technical feature, as required by PCT Rule 13.2. The protein invention and the polynucleotide invention lack a one-to-one correspondence.

Applicant further argues "at the very least, the unity of invention standard requires that claims drawn to polypeptides of SEQ ID NO:6 be examined together with the claims currently under consideration, drawn to polynucleotides encoding SEQ ID NO:6 (e.g., polynucleotides of SEQ ID NO:18)".

---

[2] See previous footnote concerning the apparent typographical error in the amendment to claim 3

Applicant appears to be arguing that the Examiner's "restriction" between the single SEQ ID NO: 18 (which encodes SEQ ID NO:6) and nucleotide sequences (e.g. generic of sequences) encoding SEQ ID NO:6 is contrary to unity practice.

Applicant's argument is misguided since unity of invention has to be considered in the first instance only in relation to independent claims. As already discussed, the Office has provided permissible *a posteriori* evidence that there isn't a special technical feature linking the polynucleotides of claims 3 and 11 to the polypeptides of claim 1 in light of the prior art of record. Accordingly, the Examiner's "restriction" is in conformance with unity of invention standards.

DECISION

Applicant's petition to withdraw the lack of unity requirement between Groups VI and XVIII under 37 CFR 1.144 is **DENIED** for the reasons set forth above.

The application will be forwarded to the Examiner for consideration of the amendment filed 27 February 2004.

Any request for consideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600.

Bruce Kisliuk
Director, Technology Center 1600.

```
                    GenCore version 5.1.6
              Copyright (c) 1993 - 2004  Compugen Ltd.

OM protein - nucleic search, using frame_plus_p2n model

Run on:         April 19, 2004, 12:38:39 ; Search time 1 Seconds
                                           (without alignments)
                                           1.293 Million cell updates/sec

Title:          us-10-168-582-6
Perfect score:  1814
Sequence:       1 MDDATVLRKKGYIVGINLGK.........ETSRAKDHHISGAEVGKAST 358

Scoring table:  PAM250
                Xgapop 10.0 , Xgapext  0.5
                Ygapop 10.0 , Ygapext  0.5
                Fgapop  6.0 , Fgapext  7.0
                Delop   6.0 , Delext   7.0

Searched:       1 seqs, 1806 residues

Minimum DB seq length: 0
Maximum DB seq length: inf

Post-processing: Listing first 50 summaries

Command line parameters:
-MODEL=frame+_p2n.model -DEV=soft -Q=us-10-168-582-6 -DB=177564.gb_pr
-SUFFIX=pto -OUT=align6_1377762_p250 -MINMATCH=0.1 -LOOPCL=0 -LOOPEXT=0
-UNITS=bits -START=1 -END=-1 -MATRIX=pam250 -TRANS=human40.cdi -LIST=50
-DOCALIGN=200 -THR_SCORE=escore -ALIGN=1 -MODE=LOCAL -OUTFMT=pto -NORM=ext
-HEAPSIZE=500 -NCPU=6 -NO_XLPXY -NEG_SCORES=0 -LONGLOG -THREADS=1 -XGAPOP=10
-XGAPEXT=0.5 -FGAPOP=6 -FGAPEXT=7 -YGAPOP=10 -YGAPEXT=0.5 -DELOP=6 -DELEXT=7

Database :      177564.gb_pr:*

     Pred. No. is the number of results predicted by chance to have a
     score greater than or equal to the score of the result being printed,
     and is derived by analysis of the total score distribution.

                                  SUMMARIES

                    %
Result              Query
  No.    Score   Match Length DB  ID                      Description
 ---------------------------------------------------------------------------
    1     1804    99.4   1806  1  HUMDGSG                 ACCESSION:L77564
 c  2      172     9.5   1806  1  HUMDGSG                 ACCESSION:L77564


                                  ALIGNMENTS

RESULT 1
HUMDGSG
LOCUS       HUMDGSG                 1806 bp    mRNA    linear   PRI 15-JUN-1996
DEFINITION  Homo sapiens DGS-G mRNA, 3' end.
ACCESSION   L77564
VERSION     L77564.1  GI:1377762
KEYWORDS    .
SOURCE      Homo sapiens (human)
  ORGANISM  Homo sapiens
            Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
            Mammalia; Eutheria; Primates; Catarrhini; Hominidae; Homo.
REFERENCE   1  (bases 1 to 1806)
  AUTHORS   Gong,W., Emanuel,B.S., Collins,J., Kim,D.H., Wang,Z., Chen,F.,
            Zhang,G., Roe,B. and Budarf,M.L.
  TITLE     A transcription map of the DiGeorge and velo-cardio-facial syndrome
            minimal critical region on 22q11
  JOURNAL   Hum. Mol. Genet. 5 (6), 789-800 (1996)
  MEDLINE   96372815
   PUBMED   8776594
COMMENT     Original source text: Homo sapiens cDNA to mRNA.

FEATURES             Location/Qualifiers
     source          1. .1806
                     /organism="Homo sapiens"
                     /mol_type="mRNA"
                     /db_xref="taxon:9606"
     mRNA            <1. .1806
                     /product="DGS-G"
                     /evidence=experimental

Alignment Scores:
Pred. No.:                0              Length:         1806
Score:                    1804.00        Matches:        354
Percent Similarity:       100.00%        Conservative:   4
Best Local Similarity:    98.88%         Mismatches:     0
Query Match:              99.45%         Indels:         0
DB:                       1              Gaps:           0

us-10-168-582-6 (1-358) x HUMDGSG (1-1806)

Qy          1 MetAspAspAlaThrValLeuArgLysLysGlyTyrIleValGlyIleAsnLeuGlyLys 20
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        593 ATGGACGATGCCACAGTCCTAAGGAAGAAGGGTTACATCGTAGGCATCAATCTTGGCAAG 652

Qy         21 GlySerTyrAlaLysValLysSerAlaTyrSerGluArgLeuLysPheAsnValAlaVal 40
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        653 GGTTCCTACGCAAAAGTCAAATCTGCCTACTCTGAGCGCCTCAAGTTCAATGTGGCTGTC 712

Qy         41 LysIleIleAspArgLysLysThrProThrAspPheValGluArgPheLeuProArgGlu 60
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        713 AAGATCATCGACCGCAAGAAAACACCTACTGACTTTGTGGAGAGATTCCTTCCTCGGGAG 772

Qy         61 MetAspIleLeuAlaThrValAsnHisGlySerIleIleLysThrTyrGluIlePheGlu 80
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        773 ATGGACATCCTGGCAACTGTCAACCACGGCTCCATCATCAAGACTTACGAGATCTTTGAG 832

Qy         81 ThrSerAspGlyArgIleTyrIleIleMetGluLeuGlyValGlnGlyAspLeuLeuGlu 100
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        833 ACCTCTGACGGACGGATCTACATCATCATGGAGCTTGGCGTCCAGGGCGACCTCCTCGAG 892

Qy        101 PheIleLysCysGlnGlyAlaLeuHisGluAspValAlaArgLysMetPheArgGlnLeu 120
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        893 TTCATCAAGTGCCAGGGAGCCCTGCATGAGGACGTGGCACGCAAGATGTTCCGACAGCTC 952

Qy        121 SerSerAlaValLysTyrCysHisAspLeuAspIleValHisArgAspLeuLysCysGlu 140
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db        953 TCCTCCGCCGTCAAGTACTGCCACGACCTGGACATCGTCCACCGGGACCTCAAGTGCGAG 1012

Qy        141 AsnLeuLeuLeuAspLysAspPheAsnIleLysLeuSerAspPheGlyPheSerLysArg 160
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db       1013 AACCTTCTCCTCGACAAGGACTTCAACATCAAGCTGTCTGACTTTGGCTTCTCCAAGCGC 1072

Qy        161 CysLeuArgAspSerAsnGlyArgIleIleLeuSerLysThrPheCysGlySerAlaAla 180
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db       1073 TGCCTGCGGGACAGCAATGGGCGCATCATCCTCAGCAAGACCTTCTGCGGGTCGGCAGCA 1132

Qy        181 TyrAlaAlaProGluValLeuGlnSerIleProTyrGlnProLysValTyrAspIleTrp 200
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db       1133 TATGCAGCCCCCGAGGTGCTGCAGAGCATCCCCTACCAGCCCAAGGTGTATGACATCTGG 1192

Qy        201 SerLeuGlyValIleLeuTyrIleMetValCysGlySerMetProTyrAspAspSerAsp 220
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
Db       1193 AGCCTGGGCGTGATCCTGTACATCATGGTCTGCGGCTCCATGCCCTATGACGACTCCGAC 1252

Qy        221 IleLysLysMetLeuArgIleGlnLysGluHisArgValAsnPheProArgSerLysHis 240
              |||:::||||||||||||||||||||||||||||||||:::||||||||||||||||:::
Db       1253 ATCAGGAAGATGCTGCGTATCCAGAAGGAGCACCGTGTGGACTTCCCGCGCTCCAAGAAC 1312

Qy        241 LeuThrCysGluCysLysAspLeuIleTyrHisMetLeuGlnProAspValSerGlnArg 260
              ||||||||||||||||||||||||||||||:::||||||||||||||||||||||||||||
Db       1313 CTGACCTGCGAGTGCAAGGACCTCATCTACCGCATGCTGCAGCCCGACGTCAGCCAGCGG 1372

Qy        261 LeuHisIleAspGluIleLeuSerHisSerTrpLeuGlnProProLysProLysAlaThr 280
              ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
```

```
)b      1373 CTCCACATCGATGAGATCCTCAGCCACTCGTGGCTGCAGCCCCCCAAGCCCAAAGCCACG 1432

)y       281 SerSerAlaSerPheLysArgGluGlyGluGlyLysTyrArgAlaGluCysLysLeuAsp 300
             ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
)b      1433 TCTTCTGCCTCCTTCAAGAGGGAGGGGGAGGGCAAGTACCGCGCTGAGTGCAAACTGGAC 1492

)y       301 ThrLysThrGlyLeuArgProAspHisArgProAspHisLysLeuGlyAlaLysThrGln 320
             ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
)b      1493 ACCAAGACAGGCTTGAGGCCCGACCACCGGCCCGACCACAAGCTTGGAGCCAAAACCCAG 1552

)y       321 HisArgLeuLeuValValProGluAsnGluAsnArgMetGluAspArgLeuAlaGluThr 340
             ||||||||||||||||||||||||||||||||||||||||||||||||||||||||||||
)b      1553 CACCGGCTGCTGGTGGTGCCCGAGAACGAGAACAGGATGGAGGACAGGCTGGCCGAGACC 1612

)y       341 SerArgAlaLysAspHisHisIleSerGlyAlaGluValGlyLysAlaSerThr 358
             ||||||||||||||||||||||||||||||||||||||||||||||||||||||
)b      1613 TCCAGGGCCAAAGACCATCACATCTCCGGAGCTGAGGTGGGGAAAGCAAGCACC 1666
```

Search completed: April 19, 2004, 12:38:41
Job time : 2 secs

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

COPY MAILED

JAN 2 2 2004

OFFICE OF PETITIONS

KIRK DAMMAN
LEWIS RICE AND FINGERSH, L.C.
ATTN: BOX IP DEPT.
500 N. BROADWAY, SUITE 2000
ST. LOUIS, MO 63102-2147

In re Application of
Andreas Hecht
Application No. 10/168,585
Filed: September 19, 2002
Attorney Docket No. 21/1171US

NOTICE

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

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

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

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

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
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306.**

This file is being forwarded to Technology Center AU 2631.

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

11 MAR 2004

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Milde Hoffberg & Macklin
10 Bank Street
Suite 460
White Plains, New York 10606

In re Application of	:	
KUTZKE	:	
Application No.: 10/168,592	:	
PCT No.: PCT/EP00/13339	:	
Int. Filing Date: 29 December 2000	:	DECISION ON PETITION
Priority Date: 30 December 1999	:	
Attorney Docket No.: HBC248-KFM	:	
For: DEVICE FOR HANGING TOWELS		

This is a decision on applicant's "Response to Notification of Abandonment" filed 05 March 2004, which is being treated as petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 29 December 2000, applicant filed international application PCT/EP00/13339 which claimed a priority date of 20 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 July 2001. A Demand was filed for International Preliminary Examination prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 June 2002.

On 22 June 2002, applicant filed a Transmittal Letter for entry into the national stage accompanied, *inter alia,* by: the requisite basic national fee; a translation of the international application; and a preliminary amendment.

On 27 August 2002, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 02 March 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 August 2002 within the time period set therein.

On 05 March 2004, applicant filed the present petition which was accompanied, among other things: a copy of the declaration/power of attorney filed 27 August 2002 and a post card receipt dated 27 August 2002.

DISCUSSION

A review of the present application reveals that the declaration and power of attorney in response to the Notice of Missing Requirements filed 27 August 2002 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicant has provided a copy of their date-stamped filing receipt. The receipt identifies the application by docket number and serial/application number. The receipt itemizes declarations executed by the three joint-inventors. The receipt is stamped "Rec'd. PCT/PCT 27 AUG 2002" across its face is sufficient to indicate that the declaration and power of attorney was in fact received in the Office on 27 August 2002.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is GRANTED.

This application will be given an international filing date of 29 December 2000 and a date of **27 August 2002** under 35 U.S.C. 371. The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

04 AUG 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

Andrew Fessak
White & Case, LLP
Patent Department
1155 Avenue of the Americas
New York, NY 10036

In re Application of DODGSON, et al. Application No.: 10/168,597 PCT No.: PCT/GB00/04894 Int. Filing Date: 20 December 2000 Priority Date: 24 December 1999 Atty. Docket No.: 1103326-0693 For: APPARATUS FOR AND METHOD OF MAKING ELECTRICAL MEASUREMENTS ON AN OBJECT	DECISION ON PETITION UNDER 37 CFR 1.55(c)

This decision is in response to applicant's "Petition For Acceptance of Unintentionally Delayed Priority Claims Under 37 C.F.R. § 1.55(c)" filed 21 March 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 20 December 2000, applicant filed international application PCT/GB00/04894, which claimed priority of an earlier United Kingdom application filed 24 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 June 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 24 June 2002.

On 24 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, payment of the full, U.S. basic national fee required by 35 U.S.C. 371(c)(1).

On 21 March 2005, applicant filed the present petition under 37 CFR 1.55

DISCUSSION

Pursuant to 37 CFR 1.55(c), petitions to accept an unintentionally delayed priority claims are applicable only to priority claims under 35 U.S.C. 365(a) and not to priority claims under 35 U.S.C. 365(b). Applicant's petition fee will be refunded to Deposit Account No. 23-1703.

Applicant is advised that the situation can be rectified through the filing of a continuation application of the present U.S. national stage application.

CONCLUSION

Applicant's petition under 37 CFR 1.55(c) is **DISMISSED as moot**.

This application is being returned to Technology Center AU 1744.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

10 AUG 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

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Application of DODGSON et al	:	
U.S. Application No.: 10/168,598	:	
PCT Application No.: PCT/GB00/04887	:	
Int. Filing Date: 20 December 2000	:	DECISION
Priority Date Claimed: 24 December 1999	:	
Attorney Docket No.: 1103326-0694	:	
For: APPARATUS FOR AND METHOD OF	:	
MAKING ELECTRICAL MEASUREMENTS	:	
ON OBJECTS	:	

This is in response to applicant's "Petition for Acceptance of Unintentionally Delayed Priority Claim Under 37 C.F.R. § 1.55(c)" filed 21 March 2005.

BACKGROUND

On 20 December 2000, applicant filed international application PCT/GB00/04887, which claimed priority of an earlier United Kingdom application filed 24 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 June 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 24 June 2002.

On 24 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 21 March 2005, applicant filed the present petition under 37 CFR 1.55.

On 02 August 2005, this Office mailed a communication in response to the 21 March 2005 petition.

DISCUSSION

Pursuant to 37 CFR 1.55(c), petitions to accept an unintentionally delayed priority claims are applicable only to priority claims under 35 U.S.C. 365(a) and not to priority claims under 35 U.S.C. 365(b). Applicant's petition fee will be refunded to Deposit Account No. 23-1703.

Applicant is advised that the situation can be rectified through the filing of a continuation application of the present U.S. national stage application.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.55 is DISMISSED.

The communication mailed 02 August 2005 is hereby VACATED.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

27 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Gwendolyn D. Spratt
Needle & Rosenberg, P.C.
The Candler Building
127 Peachtree Street, N.E.
Atlanta, GA 30303-1811

In re Application of
SAMPSON et al.
Application No.: 10/168,602
PCT No.: PCT/US99/13421
Int. Filing Date: 14 June 1999
Priority Date: 11 June 1999
Attorney Docket No.: 14114.0300US
For: RAF PROTEIN KINASE THERAPEUTICS

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 21 July 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted the basic national fee of $890 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

However, a review of the application papers received by the Office on 21 July 2002 reveal that the declaration is defective. Specifically, the declaration identifies a different inventor than that indicated in the published international application. Namely, the declaration identifies and is signed by "Jennifer Crook Whitmon" whereas the international application identifies "Jennifer Crook."

If the inventor's name has since changed, applicant must file a petition under 1.182 in accordance with MPEP 605.04(c) in order to accept the previously filed declaration.

Applicant is hereby given **TWO MONTHS** from the mailing date of this communication to file the proper response. The proper response would be: if the inventor's name has changed, a petition under 37 CFR 1.182; or if the inventor's name has not changed, an oath or declaration identifying the same inventors identified in the published international application together with an explanation as to why the inventors executed a declaration

identifying "Jennifer Crook Whitmon" as an inventor. Failure to provide the proper response will result in abandonment. Extension of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

10 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Gwendolyn D. Spratt
Needle & Rosenberg, P.C.
The Candler Building
127 Peachtree Street, N.E.
Atlanta, GA 30303-1811

In re Application of	:	
SAMPSON et al.	:	
Application No.: 10/168,602	:	DECISION ON PETITION
PCT No.: PCT/US99/13421	:	
Int. Filing Date: 14 June 1999	:	
Priority Date: 11 June 1999	:	
Attorney Docket No.: 14114.0300US	:	
For: RAF PROTEIN KINASE THERAPEUTICS		

This decision is in response to applicants' "PETITION UNDER 37 CFR 1.182" filed on 21 November 2002. Applicants are requesting to change the name of the third named inventor from Jennifer Crook to Jennifer Crook Whitmon due to marriage. The petition was accompanied by an affidavit signed by Jennifer Crook Whitmon. The petition fee under 37 CFR 1.17(h) has been enclosed.

DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order.

The petition has been reviewed and is approved.

CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Jennifer Crook to Jennifer Crook Whitmon is **GRANTED**.

This application is being forwarded to United States/Elected Office for further processing with the name of the inventor as Jennifer Crook Whitmon and for review of the

national stage papers submitted 21 June 2002 and, if appropriate, preparation and mailing of the Notification of Acceptance of Application under 35 U.S.C. 371 (Form PCT/DO/EO/903) indicating a date of **21 June 2002** under 35 U.S.C. 371(c).

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

0 9 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, N.Y. 10023

In re Application of
BOULARI-SARANSAR, Masud
U.S. Application No.: 10/168,605
PCT No.: PCT/DK00/00740
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: U 014088-4
For: A TERMINATION DEVICE E.G. FOR A MULTICONDUCTOR

DECISION

The decision is in response to the papers submitted on 27 November 2002.

BACKGROUND

On 28 August 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicant was given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 27 November 2002, applicant submitted the instant petition ("Pet.") which was accompanied by, *inter alia*, the petition fee of $130.00; the surcharge fee; a declaration titled "Details of our Efforts to reach nonsigning inventor: Masud Bolouri-Saransar; copies of several foreign language documents; a document titled "Proof of Need to Prevent Irreparable Damage or Preserve the Rights of the Parties; and a document tiled "Statement Establishing Proprietary Interest by Person Signing on Behalf of Nonsigning Inventor."

DISCUSSION

The Form PCT/DO/EO/905 mailed 28 August 2002 provided applicant only two months to provide a response with extensions of time available pursuant to 37 CFR 1.136(a). The instant response was mailed 27 November 2002. Accordingly, a one-month extension of time fee of $110.00 will be charged to Deposit Account No. 12-0425 as authorized.

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventors cannot be reached after diligent effort, (3) a statement of the last known address of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee has been paid. The last known address of the sole inventor, Masud Bolouri-Saransar is listed in the petition as:

Malmbergsvej
17, ot.th,
DK-2850
Nærum, Denmark

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP), states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage."

In the instant petition, the 37 CFR 1.47(b) applicant states that "[i]rreparable damage will result from the passing of the 30 months' term for entering the US National Stage from the International Application and the international publication of the invention 12 July 2001." This statement is sufficient.

Therefore, items (1), (3) and (6) of 37 CFR 1.47(b) are satisfied.

Concerning item (2), the 37 CFR 1.47(b) applicant claims that the sole inventor "cannot be found." Pet. at ¶ 1. Section 409.03(d) of the MPEP discusses the requirements to show that an inventor cannot be reached and states, in part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the

statement.

In this case, the 37 CFR 1.47(b) applicant has submitted a declaration of facts describing the efforts used to contact the nonsigning sole inventor. However, the declaration did not indicate that the person signing the declaration had the requisite firsthand knowledge of all the facts. Moreover, the 37 CFR 1.47(b) applicant did not provide an English translation all of the documentary evidence. The USPTO does not accept foreign language documents as evidence without an accompanying English translation.

Thus, item (2) of 37 CFR 1.47(b) has not been satisfied.

Regarding item (4), section 409.03(b) of the MPEP requires that a declaration signed by the 37 CFR 1.47(b) applicant must be provided. Here, the 37 CFR 1.47(b) applicant has not provided such a declaration.

Hence, item (4) of 37 CFR 1.47(b) is also not satisfied.

Finally, section 409.03(f) of the MPEP discusses the proof required to show the requisite proprietary interest required by item (5) and states, in part that:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:
>
> (A) the invention has been assigned to the applicant, or
> (B) the inventor has agreed in writing to assign the invention to the applicant, or
> (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

In the instant petition, the 37 CFR 1.47(b) applicant claims that the nonsigning sole inventor has assigned the above-captioned invention and has included a copy of this assignment. A review of the document titled 'Assignment of Patent Matters in Denmark" signed by the sole inventor reveals that there is no patent number indicated on the assignment and the assignment was limited to the intellectual property rights for Denmark. The copy of the document titled "Assignment" assigning rights to Lexel A/S for the international application PCT/DK00/00740 was not signed by the sole inventor and is therefore, not relevant to this requirement.

The 37 CFR 1.47(b) applicant must show that the sole inventor assigned all applicable rights including international rights to them for the above-captioned application. Moreover, the 37 CFR 1.47(b) applicant has not provided a statement under 37 CFR 3.73(b) as required by the MPEP.

Consequently, item (5) of 37 CFR 1.47(b) is not satisfied.

Since the 37 CFR 1.47(b) applicant failed to meet item(s) (2), (4) and (5), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

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

25 SEP 2003

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, N.Y. 10023

In re Application of
BOULARI-SARANSAR, Masud
U.S. Application No.: 10/168,605
PCT No.: PCT/DK00/00740
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: U 014088-4
For: A TERMINATION DEVICE E.G. FOR A MULTICONNECTOR

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(b)

The decision is in response to the "Renewed Petition Under 37 CFR 1.47(b)" submitted 08 September 2003.

BACKGROUND

On 09 April 2003, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Petitioner failed to meet all of the requirements of items (2), (4) and (5) of 37 CFR 1.47(b).

On 08 September 2003, petitioner submitted the instant renewed petition which was accompanied by, *inter alia*, a declaration signed by Christian Levin Nielsen on behalf of Lexel A/S; copies of letters, postal receipts and internet searches with accompanying English translations; and a copy of a document titled "Agreement on Rules, Rights and Confidentiality" signed by the sole inventor with an accompanying English translation.

DISCUSSION

The 37 CFR 1.47(b) applicant failed to satisfy items (2), (4) and (5) of 37 CFR 1.47(b) in the petition filed 27 November 2002. A decision was mailed 09 April 2003 providing the 37 CFR 1.47(b) applicant two months to respond with extensions of time available pursuant to 37 CFR 1.136(a). The instant response was received 08 September 2003. Accordingly, a three-month extension fee of $930.00 has been charged to Deposit Account No. 12-0425 as authorized.

Item (2) of 37 CFR 1.47(b) was not satisfied because petitioner submitted a declaration of facts without indicating whether the person signing the declaration had the requisite firsthand knowledge of all the facts. It was also noted that petitioner did

not provide an English translation of the documentary evidence and that foreign language documents are not accepted as evidence without an accompanying English translation.

In the renewed petition, the 37 CFR 1.47(b) applicant has submitted a declaration by Chéri Rehøj who recounts the efforts used to locate the sole inventor. The 37 CFR 1.47(b) applicant also included copies of the letters sent, internet searches made, and postal receipts returned with accompanying English translations. A review of the declaration and documentary evidence submitted shows that the petitioner has made a diligent effort to locate the nonsigning sole inventor. Thus, item (2) of 37 CFR 1.47(b) is satisfied.

Regarding item (4), section 409.03(b) of the MPEP requires that a declaration signed by the 37 CFR 1.47(b) applicant must be provided. The 37 CFR 1.47(b) applicant failed to provide such a declaration in the initial petition.

In the renewed petition, the 37 CFR 1.47(b) applicant has provided a declaration. signed by Christian Levin Nielsen who states that he is authorized to sign the declaration on behalf of Lexel A/S pursuant to 37 CFR 3.73(b)(2)(i). The name, residence, last known post office address and citizenship of the sole inventor are listed on the declaration. This declaration satisfies section 409.03(b) of the MPEP and 37 CFR 1.497(a) and (b). Thus item (4) of 37 CFR 1.47(b) is also satisfied.

Concerning item (5), petitioner failed to prove that the sole inventor transferred international rights in PCT/DK00/00740 to the 37 CFR 1.47(b) applicant with an assignment in the initial petition.

In the renewed petition, the 37 CFR 1.47(b) applicant submitted a copy of a Danish document along with an accompanying English translation. Counsel claims that this document is an addendum to the employment contract between the sole inventor and the Lexel A/S. The employment contract was executed by the sole inventor, Masud Bolouri-Saransar. A statement under 37 CFR 3.73(b) was also provided. However, item (5) is still not satisfied.

Section 409.03(f) of the MPEP states, in part:

> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. **If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met.** A typical agreement to assign is an employment agreement

where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. **When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.** (Emphasis added).

Here, the 37 CFR 1.47(b) has not submitted a statement by a person having firsthand knowledge of the facts that the above-captioned invention was made by Mr. Masud Bolouri-Saransar while employed by the 37 CFR 1.47(b) applicant as required by the MPEP. Moreover, the 37 CFR 1.47(b) applicant needs to explain how they exercised their rights under this employment agreement with regards to the above-identified invention.

Since petitioner failed to meet item (5) of 37 CFR 1.47(b), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

CONCLUSION

The renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

25 FEB 2004

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, N.Y. 10023

In re Application of
BOULARI-SARANSAR, Masud
U.S. Application No.: 10/168,605
PCT No.: PCT/DK00/00740
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: U 014088-4
For: A TERMINATION DEVICE E.G. FOR A MULTICONNECTOR

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(b)

The decision is in response to the "Response to Decision on Petition Under 37 CFR 1.47(b) and Renewed Petition" submitted 15 January 2004.

BACKGROUND

On 25 September 2003, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Petitioner failed to meet the requirements of item (5) of 37 CFR 1.47(b) as outlined in section 409.03(f) of the MPEP.

On 15 January 2004, applicant submitted the instant renewed petition which was accompanied by, *inter alia*, a declaration and an English translation of an addendum to an employment contract signed by the sole inventor.

On 30 January 2004, petitioner filed a substitute declaration and statement for the copies mailed 15 January 2004.

DISCUSSION

The 37 CFR 1.47(b) applicant was given two months to respond to the 25 September 2003 decision. The instant response was received 15 January 2003. Accordingly, a two-month extension fee of $420.00 has been charged to Deposit Account No. 12-0425 as authorized.

The addendum to the employment contract signed by the sole inventor was previously submitted on 08 September 2003. This addendum shows that the employment agreement would cover all rights including international rights for the above-captioned application. However, item (5) was still not satisfied because the 37 CFR 1.47(b) did not provide a statement by a person having firsthand knowledge of the

facts that the above-captioned invention was made by Mr. Masud Bolouri-Saransar while employed by the 37 CFR 1.47(b) applicant.

In this renewed petition, the 37 CFR 1.47(b) applicant states, "[t]hat the named inventor made this invention is not in dispute, because the inventor had to sign in 2000 for the origin PCT application designating the US. Therefore, sufficient facts have been presented." Ren.Decl. at ¶ 3.

These statements are not sufficient.

The 37 CFR 47(b) applicant must provide a statement by a person with firsthand knowledge of the facts attesting that the above-captioned invention was made by Mr. Masud Bolouri-Saransar while employed by the 37 CFR 1.47(b) applicant. Thus, item 5 of 37 CFR 1.47(b) is still not satisfied.

It is also noted that the 37 CFR 1.47(b) applicant filed a declaration signed by IB Stanley Madsen as Patents Manager of Lexel A/S.

CONCLUSION

For the reason noted above, the renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

12 MAR 2004

#13

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, N.Y. 10023

In re Application of
BOULARI-SARANSAR, Masud
U.S. Application No.: 10/168,605
PCT No.: PCT/DK00/00740
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: U 014088-4
For: A TERMINATION DEVICE E.G. FOR A MULTICONNECTOR

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(b)

The decision is in response to the "Response to Decision and Renewed Petition" submitted 02 March 2004 and documents submitted via facsimile on 11 March 2004.

BACKGROUND

On 23 February 2004, applicants purportedly filed a statement of facts in support of filings on behalf of the nonsigning inventor.

On 25 February 2004, a decision dismissing applicant's renewed petition under 37 CFR 1.47(b) was mailed. Petitioner had failed to provide a declaration by a person having firsthand knowledge of the facts that the above-captioned invention was made by Mr. Masud Bolouri-Saransar while employed by the 37 CFR 1.47(b) applicant.

On 02 March 2004, petitioner submitted the instant response claiming that the required statement of facts were mailed 23 February 2004.

On 11 March 2004, after a call from James Thomson, Office of PCT Legal Administration, petitioner submitted via facsimile a copy of documents purportedly filed 23 February 2004 and a date-stamped postcard receipt for those documents.

DISCUSSION

The 37 CFR 1.47(b) applicant claims that the decision dated 25 February 2004 dismissing applicant's petition under 37 CFR 1.47(b) did not consider relevant documents because they were not mailed until 23 February 2004 and apparently crossed in the mail.

A review of the above-captioned application reveals that the papers purportedly

filed 23 February 2004 were still not located in the above-captioned application.

Papers Originally Filed 23 February 2004

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. Applicant must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, the 37 CFR 1.47(b) applicant provided a copy of the date-stamped filing receipt for the documents submitted 23 February 2004. The filing receipt records that a "Transmittal of Statement of Facts in Support of Filing on Behalf of Non-Signing Inventor" was received in the USPTO. The filing receipt is stamped "OIPE FEB 23 2004" across its face. The U.S. application number and attorney docket number were listed on the postcard receipt.

Accordingly, applicant has provided *prima facie* evidence that this response was originally received by the USPTO on 23 February 2004.

Petition Under 37 CFR 1.47(b)

The decision dated 25 February 2004 stated that item (5) of 37 CFR 1.47(b) was not satisfied because the 37 CFR 1.47(b) did not provide a statement by a person having firsthand knowledge of the facts that the above-captioned invention was made by Mr. Masud Bolouri-Saransar while employed by the 37 CFR 1.47(b) applicant.

The 37 CFR 1.47(b) applicant filed papers on 23 February 2004, titled "Transmittal of Statement of Facts in Support of Filing on Behalf of Non-Signing Inventor" by Mr. Stanley Madsen, Patent Manager of LK A/S, who states that "[i]n November 1999, the inventor Masud Bolouri-Saransar told me he had an idea which he explained and visualized to me. From the middle of November and until the end of December 1999, I and our Patent Attorney . . . wrote and prepared together, on behalf of my company LK A/S and Masud Bolouri-Saransar, the patent application that Massud had assigned to LK A/S."

The statement of facts by Mr. Madsen along with the prior filed evidence, *i.e.*, the "Assignment of Patent Matters in Denmark," the addendum to the employment contract, and a statement under 37 CFR 3.73(b), shows sufficient proprietary interest in the above-captioned application and meets the requirements of section 409.03(f) of the MPEP. Therefore, item (5) of 37 CFR 1.47(b) is satisfied.

Accordingly, petitioner has now met all of the requirements of 37 CFR 1.47(b).

CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 27 November 2002 and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 29 December 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 23 February 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

12 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. Masud Boulari-Saransar
Malmbergsvej
17, ot.th,
Nærum, Denmark

In re Application of
BOULARI-SARANSAR, Masud
U.S. Application No.: 10/168,605
PCT No.: PCT/DK00/00740
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: U 014088-4
For: A TERMINATION DEVICE E.G. FOR A MULTICONNECTOR

Mr. Boulari-Saransar:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

William R. Evans
LADAS & PARRY
26 West 61st Street
New York, N.Y. 10023

20 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#7

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

In re Application of	:	
Masud Bolouri-Saransar	:	
Application No. 10/168,606	:	
PCT No.: PCT/DK00/00739	:	DECISION ON PETITION
International Filing Date: 29 December 2000	:	UNDER 37 CFR 1.47(b)
Priority Date: 30 December 1999	:	
Attorney Docket No.: U014087-6	:	
For: AN ELECTRIC CIRCUIT BOARD AND	:	
MULTICONNECTOR	:	

This is a decision on the applicant's petition under 37 CFR 1.47(b) filed 27 November 2002, to accept the application without the signature of sole inventor, Masud Bolouri-Saransar.

08/22/2003 SNAJARRO 00000001 120425 10168606
01 FC:1251 110.00 DA

BACKGROUND

On 29 December 2000, applicant filed international application PCT/DK00/00739 which claimed a priority date of 30 December 1999 and designated the United States. The thirty-month period for paying the basic national fee in the United States was midnight, 30 June 2002.

On 24 June 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 USC 371(c)(1).

On 27 August 2002, the United States Designated/Elected Office mailed Notification of Missing Requirements under 35 USC 371 indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed along with the surcharge for the later filing of the oath or declaration. The notification set a two-month time limit in which to respond. Extension of the time set for reply were available pursuant to 37 CFR 1.136(a).

On 27 November 2002, applicant filed the instant petition under 37 CFR 1.47(a). The petition was accompanied by a statement detailing the efforts to reach the non-signing inventor, copies of the results of an Internet search conducted, and copies of an assignment. In order for the petition to be

considered a timely response to the Notification of Missing Requirements Under 35 USC 371, applicant must obtain a one-month extension of time. Pursuant to an authorization from applicant found in the application file, deposit account 12-0425 will be charged $110.00 for the extension of time.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, (4) an oath or declaration signed by each 37 CFR 1.47(b) applicant on his behalf and on behalf of the non-signing inventor, (5) proof of proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or prevent irreparable damages. Applicant has satisfied items (1), (3), and (4)

As to item (2), the evidence is not convincing that the inventor could not be reached. Applicant maintains that contact was made with a person at the last known address for the inventor who indicated that he was acquainted with the inventor. Although applicant suggests that the person was less than cooperative with applicant's efforts to find the inventor, the fact that a person was found at the last known address who was familiar with the inventor suggests that the inventor can be reached and indicated that he would pass on the information to the inventor. There is no indication that a copy of the complete application papers was sent to the inventor at this address. Before the inventor will be deemed to have refused to join the application, applicant must provide some proof that a complete copy of the application papers was sent to the last known address of the inventor.

As to item (4), Section 409.03(b) of the *Manual of Patent Examining Procedure* (MPEP) requires that the 37 CFR 1.47(b) applicant, or other authorized party of interest, execute the oath or declaration on behalf of, and as agent for, the non-signing inventor. An executed oath or declaration was not found among the petition papers. An oath or declaration executed by an appropriate party on behalf of, and as agent for, the non-signing inventor must be filed in order for status under 37 CFR 1.47 to be accorded the above-cited application.

As to item (5), applicant has failed to show proof of proprietary interest in the application. Although an assignment was filed to establish the proprietary interest of 37 CFR 1.47(b) applicant, the assignment is confusing and does not appear to reflect an assignment of the non-signing inventor of his rights to the above-cited invention to the 37 CFR 1.47(b) applicant. Section 409.03(f) of the MPEP provides that:

> [i]f the application is assigned, a copy of the assignment in (in the English language) must be submitted. The assignment must clearly indicate that the invention described un the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) must also be submitted.

Further, relative to the non-signing inventor, the assignment filed does not identify the invention being assigned and was not accompanied by a statement pursuant to 36 CFR 3.73. Further, the assignment is only partially translated into the English language. The assignment filed is insufficient for the purposes of establishing proprietary interest under 37 CFR 1.47(b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Masud Bolouri-Saransar under 37 CFR 1.47(b) at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED, without prejudice**.

Applicant's are hereby afforded **TWO (2) MONTHS** from the mailed date of this decision to file wither 1) an oath or declaration in compliance with 37 CFR 1.497(a)-(b) signed by all inventors or (2) a renewed petition satisfying the requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter titled, "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Mail Stop PCT, Commissioner for Patents, PO Box 1450, Alexandria, Virginia, 22313-1450.

Boris Milef
PCT Legal Advisor
Office of PCT Legal Administration

Kenya A. McLaughlin
PCT Detailee
Office of PCT Legal Administration

Telephone (703)305-0010
Facsimile (703) 308-6459

22 DEC 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

#9

William R. Evans
c/o Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar et al.	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 01 4088-4	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)" and petition under 37 CFR 1.137(b) filed on 23 March 2004.

DISCUSSION

Petition Under 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the required reply (in the form of a renewed petition under 37 CFR 1.47(b)) has been submitted. Accordingly, requirement (1) has not been satisfied.

Regarding requirement (2), the petition fee accompanied the instant petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. In a decision mailed on 20 August 2003, the petition under 37 CFR 1.47(b) filed on 27 November 2002 was dismissed without prejudice because it failed to satisfy requirements (2), (4) and (5).

With regard to requirement (2), the instant renewed petition is accompanied by a "Statement" signed by Cheri Rehoj, detailing her efforts to contact the non-signing inventor, Masud Bolouri-Saransar. Her statement is accompanied by supporting documentation, including copies of the results electronic searches conducted in an effort to locate Mr. Bolouri-Saransar. The documentation also includes a copy and a translation of a letter written to Mr. Bolouri-Saransar at his last known address on 26 June 2003, and a copy of notation allegedly made by the Danish postal authorities and represented by Ms. Rehoj as indicating that "the distribution is returned, because the receiver has moved." Based on the totality of the evidence now of record, it would be appropriate to conclude that Mr. Bolouri-Saransar could not be found or reached after diligent effort, within the meaning of 37 CFR 1.47(b).

Concerning requirement (4), the instant renewed petition is accompanied by a declaration executed on behalf of Mr. Bolouri-Saransar by Ib Stanley Madsen, who is identified in the accompanying "Statement Establishing Proprietary Interest..." as being "authorized to sign the statement on behalf of the juristic person," Lexel A/S. However, said "Statement Establishing Proprietary Interest..." only asserts that Mr. Madsen has the authority to sign that particular paper, not that he has been given blanket authority to sign any other papers on behalf of assignee. Counsel is required to submit a declaration which clearly indicates that the person signing it on behalf of assignee is in fact empowered to sign the declaration, and which clearly indicates the name of the assignee (e.g., Lexel A/S, or LK) granting him/her the authority to execute the declaration on its behalf. It is also noted that the declaration is defective in that page 2 includes an uninitialed alteration to the application number.

Regarding requirement (5), the previous decision, mailed on 20 August 2003, cited MPEP 409.03(f), which provides that

> If the application is assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) must also be submitted.

The "Statement Establishing Proprietary Interest..." accompanying the instant

petition attempts to meet this requirement by "attaching a copy of the agreement whereby the nonsigning inventor agreed to assign this invention." Inspection of the attached agreement (and its English translation) reveals, at most, that Mr. Bolouri- Saransar may have been obliged under Danish law to assign the invention to LK and/or the Lexel Concern under certain conditions, but that under certain other conditions (as in paragraph 7), Mr. Bolouri- Saransar would be "granted the right to exploit the invention" in "countries in which LK does not intend to apply for rights of invention." Inspection of the "Assignment" document filed on 22 August 2002 and signed by Ib Stanley Madsen reveals that the United States is not listed among the states to which said document is directed. This suggests that, in fact, the United States was among the "countries in which LK does not intend to apply for rights of invention." As such, it appears that Mr. Bolouri-Saransar may not have been under any obligation to assign his rights, but instead that he may have retained the right to individually pursue patent protection in the United States. Counsel has not established that Mr. Bolouri- Saransar actually signed an assignment of his rights in this U.S. national stage application, as required by 37 CFR 3.73(b). As such, requirement (5) has not been satisfied.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this decision to respond (extendable under 37 CFR 1.136(a)). Failure to timely reply will result in **ABANDONMENT**.

Any request for reconsideration of this decision should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and/or "Renewed Petition Under 37 CFR 1.47(b)" and should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

03 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 01 4088-4	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)" filed on 03 February 2005.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. In a decision mailed on 22 December 2004, the petition under 37 CFR 1.47(b) filed on 23 March 2004 was dismissed without prejudice because it failed to satisfy requirements (4) and (5).

The decision mailed on 22 December 2004 indicated that requirement (4) had not been satisfied because the

> instant renewed petition is accompanied by a declaration executed on behalf of Mr. Bolouri-Saransar by Ib Stanley Madsen, who is identified in the accompanying "Statement Establishing Proprietary Interest..." as being "authorized to sign the statement on behalf of the juristic person," Lexel A/S. However, said "Statement Establishing Proprietary Interest..." only asserts that Mr. Madsen has the authority to sign that particular paper, not that he has been given blanket authority to sign any other papers on behalf of assignee. Counsel is required to submit a declaration which clearly indicates that the person signing it on behalf of assignee is in fact empowered to sign the declaration, and which clearly indicates the name of the assignee (e.g., Lexel A/S, or LK) granting him/her the authority to execute the declaration on its behalf. It is also noted that the declaration is defective in that page 2 includes an uninitialed alteration to the application number.

In response, counsel observes that the General Power of Attorney filed on 23 February 2004 grants sufficient authority to Mr. Ib Stanley Madsen to sign the declaration on behalf of assignee. Upon reconsideration, Mr. Madsen is deemed to have enjoyed authority to sign the declaration on behalf of the assignee. Nonetheless, the declaration remains defective because of the uninitiated alteration of the application number on page 2. Although counsel characterizes this alteration as a mere font difference, inspection of the document reveals that it has in fact been altered by pen. A copy of said page is attached hereto for applicant's convenience. Furthermore, on page 4, the application number's last digit appears to have been changed from "7" to – 6 – using white-out. *See also* the first page of the "Statement Establishing Proprietary Interest" filed on 23 February 2004, wherein the last digit of the application number has been altered to –6 – in ink. In addition, the declaration is defective for the further reason that the declaration document itself does not specifically identify the assignee. As such, requirement (4) still has not been satisfied.

The decision mailed on 22 December 2004 indicated that requirement (5) had not been satisfied due to

MPEP 409.03(f), which provides that

> If the application is assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) must also be submitted.

> The "Statement Establishing Proprietary Interest..." accompanying the instant petition attempts to meet this requirement by "attaching a copy of the agreement whereby the nonsigning inventor agreed to assign this invention." Inspection of the attached agreement (and its English translation) reveals, at most, that Mr. Bolouri- Saransar may have been obliged under Danish law to assign the invention to LK and/or the Lexel Concern under certain conditions, but that under certain other conditions (as in paragraph 7), Mr. Bolouri-Saransar would be "granted the right to exploit the invention" in "countries in which LK does not intend to apply for rights of invention." Inspection of the "Assignment" document filed on 22 August 2002 and signed by Ib Stanley Madsen reveals that the United States is not listed among the states to which said document is directed. This suggests that, in fact, the United States was among the "countries in which LK does not intend to apply for rights of invention." As such, it appears that Mr. Bolouri-Saransar may not have been under any obligation to assign his rights, but instead that he may have retained the right to individually pursue patent protection in the United States. Counsel has not established that Mr. Bolouri- Saransar actually signed an assignment of his rights in this U.S. national stage application, as required by 37 CFR 3.73(b).

In response, counsel summarizes and replies to the decision's discussion of requirement (5) by stating that "the decision on petition of December 22, 2004, refuses the

agreement with the Statement Establishing Proprietary Interest because the inventor would be granted rights in 'countries in which LK does not intend to apply for rights of invention.' Wherever such countries may be, they are axiomatically not the U.S. where the decision and this Reply deal with LK's intent to apply for rights of invention." Counsel's attention is again directed to the "Assignment" document filed on 22 August 2002 which explicitly does NOT include the United States among the countries to which it is directed. The fact that the purported assignee now seeks to obtain patent protection in the United States does not, taken alone, serve to establish that ownership of the U.S. rights to the invention lies with Lexel. Indeed, it is not clear from the totality of the evidence of record whether the assignment interest (if any) currently resides in Lexel A/S or with LK. Moreover, as explained in the previous decision, the evidence of record also supports the possibility that ownership of the application (with respect to the United States) remains with or has reverted to Mr. Bolouri-Saransar. Clarification of the ambiguity in the assignment status of this application is required. Counsel may wish to consider obtaining and filing a new assignment from LK to Lexel in which it is clearly indicated that LK's interest in this particular application and with respect to the U.S. are conveyed to Lexel. In view of the uncertainty addressed in the previous decision and amplified hereinabove, and in the absence of any further evidentiary showing in support of counsel's position, it would be inappropriate at this time to conclude that requirement (5) has been satisfied.

DECISION

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this decision to respond (extendable under 37 CFR 1.136(a)). Failure to timely reply will result in **ABANDONMENT**.

Any request for reconsideration of this decision should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and/or "Renewed Petition Under 37 CFR 1.47(b)" and should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

enc: copy of Page 2 of declaration
(Filed 23 February 2004)
showing alteration

29 SEP 2006

#13

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 01 4088-4	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)" filed on 26 May 2005.

DISCUSSION

In a decision mailed on 03 March 2005, the petition under 37 CFR 1.47(b) filed on 03 February 2005 was dismissed without prejudice because it failed to satisfy requirements (4) and (5). More specifically, the decision indicated that

> In response, counsel observes that the General Power of Attorney filed on 23 February 2004 grants sufficient authority to Mr. Ib Stanley Madsen to sign the declaration on behalf of assignee. Upon reconsideration, Mr. Madsen is deemed to have enjoyed authority to sign the declaration on behalf of the assignee. Nonetheless, the declaration remains defective because of the uninitiated alteration of the application number on page 2. Although counsel characterizes this alteration as a mere font difference, inspection of the document reveals that it has in fact been altered by pen. A copy of said page is attached hereto for applicant's convenience. Furthermore, on page 4, the application number's last digit appears to have been changed from "7" to – 6 – using white-out. *See also* the first page of the "Statement Establishing Proprietary Interest" filed on 23 February 2004, wherein the last digit of the application number has been altered to –6 – in ink. In addition, the declaration is defective for the further reason that the declaration document itself does not specifically identify the assignee. As such, requirement (4) still has not been satisfied.

and

> In response, counsel summarizes and replies to the decision's discussion of requirement (5) by stating that "the decision on petition of December 22, 2004, refuses the agreement with the Statement Establishing Proprietary Interest because the inventor would be granted rights in 'countries in which LK does not intend to apply for rights of invention.' Wherever such countries may be, they are axiomatically not the U.S. where the decision and this Reply deal with LK's intent to apply for rights of invention." Counsel's attention is again directed to the "Assignment" document filed on 22 August 2002 which explicitly does NOT include the United States among the countries to which it is directed. The fact that the purported assignee now seeks to obtain patent protection in the United States does not, taken alone, serve to establish that ownership of the U.S. rights to the invention lies with Lexel. Indeed, it is not clear from the totality of the evidence of record whether the assignment interest (if any) currently resides in Lexel A/S or with LK. Moreover, as explained in the previous decision, the evidence of record also supports the possibility that ownership of the application (with respect to the United States) remains with or has reverted to Mr. Bolouri-Saransar. Clarification of the ambiguity in the assignment status

of this application is required. Counsel may wish to consider obtaining and filing a new assignment from LK to Lexel in which it is clearly indicated that LK's interest in this particular application and with respect to the U.S. are conveyed to Lexel. In view of the uncertainty addressed in the previous decision and amplified hereinabove, and in the absence of any further evidentiary showing in support of counsel's position, it would be inappropriate at this time to conclude that requirement (5) has been satisfied.

The instant renewed petition is accompanied by a declaration document nominating Masud Bolouri-Saransar as the sole inventor. The eighth page of this document alludes to a "Signature for inventor who refuses to sign or cannot be found or reached by person authorized under 37 C.F.R. Section 1.47. Number of pages added 9." The nine attached pages include a "Statement Establishing Proprietary Interest...," a Danish-language document, and a translation of said document which is indicated to be an "Addendum to Masud Bolouri-Saransar's employment contract during his employment within the Lexel Concern." However, inspection of the declaration itself reveals that it has not been signed on behalf of Mr. Bolouri-Saransar. Rather, the signature of Ib Stanley-Madsen appearing on the "Statement Establishing Proprietary Interest..." appears only to execute that "Statement...," and not the declaration itself. As such, requirement (4) has not been satisfied.

The renewed petition urges that requirement (5) has been satisfied on the basis of an "attached Assignment from LK to Lexel specifically with respect to the U.S., which is submitted in response to the consideration of counsel suggested in the Decision." Review of the record reveals that, on 23 February 2004, petitioner also filed an assignment executed by Mr. Bolouri-Saransar assigning rights to LK in the Danish priority application PA 1999001876, the priority of which is claimed in PCT/DK00/00739. Petitioner also filed on that date a signed Danish language addendum to Mr. Bolouri-Saransar's employment agreement (and English translation thereof), along with a statement by I. Stanley Madsen that

> In November 1999 the inventor Masud Bolouri-Saransar told me he had an idea which he hereafter explained and visualized to me. From the middle of November and until the end of December 1999, I and our Patent Attorney... wrote and prepared together, on behalf of my company LK A/S and Masud Bolouri-Saransar, the patent application that Masud has assigned to LK A/S...

This statement, along with the other evidence of record, satisfies the requirements of MPEP 409.03(f). As sufficient proprietary interest has been established, requirement (5) has now been met.

DECISION

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this decision to respond (extendable under 37 CFR 1.136(a)). Failure to timely reply will result in **ABANDONMENT**.

Any request for reconsideration of this decision should be entitled "Renewed Petition Under 37 CFR 1.47(b)" and should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

17 NOV 2006

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

#15

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 01 4088-4	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)..." filed on 10 October 2006.

DISCUSSION

In a decision mailed on 29 September 2006, the petition under 37 CFR 1.47(b) filed on 26 May 2005 was dismissed without prejudice because it failed to satisfy requirements (4) and (5). More specifically, the decision indicated that

> The instant renewed petition is accompanied by a declaration document nominating Masud Bolouri-Saransar as the sole inventor. The eighth page of this document alludes to a "Signature for inventor who refuses to sign or cannot be found or reached by person authorized under 37 C.F.R. Section 1.47. Number of pages added 9." The nine attached pages include a "Statement Establishing Proprietary Interest...," a Danish-language document, and a translation of said document which is indicated to be an "Addendum to Masud Bolouri-Saransar's employment contract during his employment within the Lexel Concern." However, inspection of the declaration itself reveals that it has not been signed on behalf of Mr. Bolouri-Saransar. Rather, the signature of Ib Stanley-Madsen appearing on the "Statement Establishing Proprietary Interest..." appears only to execute that "Statement...," and not the declaration itself. As such, requirement (4) has not been satisfied.

In response, counsel indicates that "the DECISION overlooks the Declaration filed on June 8, 2005. Copies of the Transmittal of Substitute Declaration with attachments and its postcard receipt are attached for renewal of the PETITION UNDER 37 CFR 1.47(b)." The renewed petition is accompanied by copies of a "Transmittal of Substitute Declaration," an eight-page Declaration document, and a copy of a return postcard receipt itemizing the "Transmittal of Substitute Declaration" and stamped as received by "OIPE" on 10 June 2005. MPEP 503 states in part that

> A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is

being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application). The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

Further inspection of the postcard receipt in question reveals that, though it itemized a "Transmittal of Substitute Declaration" (i.e., a transmittal letter), it did not explicitly itemize the declaration itself. Following the practice outlined at MPEP 503, since the declaration itself was not specifically and properly itemized on the date-stamped postcard receipt, the postcard receipt does not serve a *prima facie* evidence of receipt of the declaration document on the date stamped. Therefore, the declaration document accompanying the petition is not being regarded as a copy of a declaration document filed on the requested earlier date.

Inspection of the declaration reveals that it has been executed on behalf of Masud Bolouri-Saransar by Ib Stanley-Madsen. This declaration is acceptable for purposes of compliance with 37 CFR 1.497(a) and (b). As such, requirement (4) of 37 CFR 1.47(b) has now been satisfied. Accordingly, it would now be appropriate to grant the requested relief under 37 CFR 1.47(b).

DECISION

The petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known addresses of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **10 October 2006**.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

17 NOV 2006

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Masud Bolouri-Saransar
Malmbergsvej 17, st. th.
DK-2850 Naerum
DENMARK

In re Application of
Bolouri-Sarandar
Application No. 10/168,606
PCT No.: PCT/DK00/00739
Int. Filing Date: 29 December 2000
Priority Date: 30 December 1999
For: An Electrical Circuit Board
And A Multiconnector

Dear Mr. Bolouri-Saransar:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as the sole inventor.

As the named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for 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).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

Ladas & Parry
26 West 61st Street
New York, NY 10023

United States Patent and Trademark Office

17 NOV 2006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of the inventor. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Masud Bolouri-Saransar) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/DK00/00739 and was filed on December 29, 2000 in the name of Masud Bolouri-Saransar for the invention entitled AN ELECTRICAL CIRCUIT BOARD AND A MULTICONNECTOR. The national stage application number is 10/168,606 and has a 35 U.S.C. 371(c)(1), (2) and (4) date of October 10, 2006.

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

0 8 JAN 2007

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 01 4088-4	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector		:

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)..." filed on 18 December 2006.

DISCUSSION

In a decision mailed on 17 November 2006, the renewed petition under 37 CFR 1.47(b) filed on 10 October 2006 was granted. This application was determined to be entitled to a date of 10 October 2006 under 35 U.S.C. 371(c)(1), (2) and (4). This date was assigned since applicants did not establish the filing of a declaration in compliance with the requirements of 37 CFR 1.497(a) and (b) until 10 October 2006, despite the fact that the petition filed on 10 October 2006 argued that "the DECISION overlooks the Declaration filed on June 8, 2005. Copies of the Transmittal of Substitute Declaration with attachments and its postcard receipt are attached for renewal of the PETITION UNDER 37 CFR 1.47(b)." The decision mailed on 17 November 2006 found that petitioner had not adequately shown earlier receipt of an acceptable declaration, and cited an excerpt from MPEP 503 which explains in part that

> The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Further, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The decision further stated that

> Further inspection of the postcard receipt in question reveals that, though it itemized a "Transmittal of Substitute Declaration" (i.e., a transmittal letter), it did

> not explicitly itemize the declaration itself. Following the practice outlined at MPEP 503, since the declaration itself was not specifically and properly itemized on the date-stamped postcard receipt, the postcard receipt does not serve a *prima facie* evidence of receipt of the declaration document on the date stamped. Therefore, the declaration document accompanying the petition is not being regarded as a copy of a declaration document filed on the requested earlier date.

In the instant renewed petition, counsel argues that "the 371 date should be June 8, 2005," arguing that

> The DECISION finds the postcard receipt for a Transmittal of Substitute Declaration insufficient to prove the "attached declaration" referred to in the one line Transmittal. However, the DECISION says nothing about the actual receipt date of either the Transmittal or "attached declaration."
>
> Actual receipt of the "attached declaration" June 8, 2005, in correspondence with the actual receipt of the Transmittal of Substitute Declaration proved by the postcard, would establish that 371 date. Therefore, it is a fact necessary but omitted from the DECISION, which requires supplementation on this basis.
>
> While the DECISION finds the postcard receipt prima facie evidence of receipt of the TRANSMITTAL OF SUBSTITUTE SPECIFICATION, the reference in its one line on one page to the "attached declaration" raises a suggestion of receipt of more than one page. The Patent Office should not be so limited as to receipt stamp for one page that refers in its one line to an "attached declaration" without concern that nothing is attached. Therefore, there is some evidence of receipt that justifies adding the necessary fact to the DECISION and, in the event of actual receipt, changing the 371 date to June 8, 2005.

In response, it is noted as a preliminary matter that the application file does not include a declaration document allegedly filed on 08 June 2005, either alone or attached to a transmittal letter; rather, the file merely includes a declaration filed on 10 October 2006 which is allegedly a copy of a declaration filed on 08 June 2005. It is also noted that the return postcard receipt in question, which accompanied the renewed petition filed on 10 October 2006, was stamped as received by "OIPE JUN 10 2005," rather than the "June 8, 2005" date discussed by petitioner.

Counsel appears to argue that the itemization of a "Transmittal of Substitute Declaration" on the postcard receipt in controversy inherently establishes that a declaration document was included with said "Transmittal of Substitute Declaration," or that the declaration should be considered to have been included with the transmittal letter because said transmittal letter references an "attached declaration." However, this would be tantamount to "incorporating by reference in the postcard receipt, the items listed in a transmittal letter," a practice which MPEP 503 explicitly states to be improper. Instead, the practice described at MPEP 503 emphatically requires that the postcard receipt clearly and specifically itemize each of the particular component(s) in order to serve as *prima facie* evidence of receipt of the component(s) itemized thereon. In the instant case, the postcard receipt specifically itemized a "Transmittal of Substitute Declaration" but did not itemize a declaration document. It would be improper to grant the requested relief based on speculation, implication or supposition that a declaration document may have been present when none was in fact itemized on the return postcard receipt. Since the evidence of record does not establish that a declaration in compliance with 37 CFR 1.497(a) and (b) was filed on the requested date of 08 June 2005, it would not be appropriate to revise the 35 U.S.C. 371(c)(1), (2) and (4) date of this application as requested by applicant at this time.

DECISION

The petition is **DISMISSED**, without prejudice.

Any request for reconsideration of this decision should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

0 5 MAR 2007

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ladas & Parry
26 West 61st Street
New York, NY 10023

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 014087-6	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(b)..." filed on 22 January 2007.

DISCUSSION

In a decision mailed on 08 January 2007, the "Renewed Petition Under 37 CFR 1.47(b)..." filed on 18 December 2006 (which requested adjustment of the 35 U.S.C. 371(c)(1), (2) and (4) date) was dismissed without prejudice because

> In response, it is noted as a preliminary matter that the application file does not include a declaration document allegedly filed on 08 June 2005, either alone or attached to a transmittal letter; rather, the file merely includes a declaration filed on 10 October 2006 which is allegedly a copy of a declaration filed on 08 June 2005. It is also noted that the return postcard receipt in question, which accompanied the renewed petition filed on 10 October 2006, was stamped as received by "OIPE JUN 10 2005," rather than the "June 8, 2005" date discussed by petitioner.
>
> Counsel appears to argue that the itemization of a "Transmittal of Substitute Declaration" on the postcard receipt in controversy inherently establishes that a declaration document was included with said "Transmittal of Substitute Declaration," or that the declaration should be considered to have been included with the transmittal letter because said transmittal letter references an "attached declaration." However, this would be tantamount to "incorporating by reference in the postcard receipt, the items listed in a transmittal letter," a practice which MPEP 503 explicitly states to be improper. Instead, the practice described at MPEP 503 emphatically requires that the postcard receipt clearly and specifically itemize each of the particular component(s) in order to serve as *prima facie* evidence of receipt of the component(s) itemized thereon. In the instant case, the postcard receipt specifically itemized a "Transmittal of Substitute Declaration" but did not itemize a declaration document. It would be improper to grant the requested relief based on speculation, implication or supposition that a declaration document may have been present when none was in fact itemized on the return postcard receipt. Since the evidence of record does not establish that a declaration in compliance with 37 CFR 1.497(a) and (b) was filed on the requested date of 08

> June 2005, it would not be appropriate to revise the 35 U.S.C. 371(c)(1), (2) and (4) date of this application as requested by applicant at this time.

Counsel again argues for revision of the 35 U.S.C. 371(c)(1), (2) and (4) date, stating in part that

> Copies of the Transaction History and Image File Wrapper for the application are attached, and neither shows even the Transmittal of Substitute Declaration which the postcard receipt has shown was received. There is, therefore, evidence of loss in the Patent Office.
>
> The Patent Office should produce the Transmittal of Substitute Declaration of June 10, 2005, that it got to show that the Declaration was not therewith or give the Applicant the benefit of the Declaration the Applicant states was filed with the Transmittal of Substitute Declaration June 10, 2005, saying so.
>
> That the Transmittal of June 10th is not prima facie evidence of receipt of the Declaration the Transmittal says was attached is not to say that it is no proof. Instead, there is clear evidence of loss even of the Transmittal in the Patent Office and not a shred of proof that the Declaration was not filed with the lost Transmittal. It such a case, the clear preponderance of evidence is on the side of receipt of the Declaration with the Transmittal of Substitute Declaration that the Patent Office has lost.

This argument is not persuasive. As noted by petitioner, the IFW system does not include the declaration allegedly filed on 10 June 2005. However, this does not establish "loss in the Patent Office" of the Declaration, since it has not been established that a Declaration actually accompanied the Transmittal letter which was itemized on the postcard receipt.

With regard to counsel's request to "produce the Transmittal...," it is noted that, though the Transmittal letter was itemized on the postcard receipt, it is not currently present in the application file; this is corroborated by counsel's own statement that the Transmittal Letter is not present. Thus, it is clearly not possible to honor petitioner's request. Nonetheless, the mere fact that the Transmittal letter is absent from the application file does not establish that the Declaration itemized thereon was actually filed. Rather, in the absence of the proper itemization of the Declaration on the postcard receipt, its itemization on the Transmittal letter at most shows that applicants intended to file a Declaration, not that it was actually filed. Counsel's statement that there is "not a shred of proof that the Declaration was not filed with the lost Transmittal" is not persuasive because the burden is not on the USPTO to prove that correspondence not properly itemized on a return postcard receipt was not filed. Rather, the burden of proof lies with applicant to provide evidence that the correspondence in question was actually filed, despite the fact that the official record suggests otherwise. The postcard receipt practice provides an avenue for applicants to prove that correspondence was filed with the Office, but that practice imposes a burden on applicants to properly itemize correspondence on the postcard receipt. In this case, applicants clearly failed to follow the instructions provided by MPEP 503 to properly itemize the correspondence on the postcard receipt instead of just on the Transmittal letter (again, MPEP 503 explains in part that "Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items"). Applicants point out that "That the Transmittal of June 10th is not prima facie evidence of receipt of the Declaration the Transmittal says was attached is not to say that it is no proof." However, in the absence of a proper showing consistent with the policy explained at MPEP 503, applicants have not provided sufficient evidence to rebut the presumption that the contents of the official record accurately reflect the correspondence which was actually filed. In this situation, it

would not be appropriate to rely upon mere conjecture to provide the missing evidence that the correspondence in question was actually filed.

DECISION

The petition is **DISMISSED**, without prejudice.

Any request for reconsideration of this decision should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ladas & Parry
26 West 61st Street
New York, NY 10023

16 MAY 2007

In re Application of	:	
Bolouri-Saransar	:	
Application No.: 10/168,606	:	DECISION
PCT No.: PCT/DK00/00739	:	
Int. Filing Date: 29 December 2000	:	ON
Priority Date: 30 December 1999	:	
Attorney Docket No.: U 014087-6	:	PETITION
For: An Electrical Circuit Board	:	
And A Multiconnector	:	

This is a decision on applicants' "Petition To Invoke Supervisory Authority" filed on 16 March 2007.

DISCUSSION

In a decision mailed on 05 March 2007, the "Renewed Petition Under 37 CFR 1.47(b)..." filed on 22 January 2007 was dismissed, without prejudice. Said petition sought acceptance of a declaration document filed on 10 October 2006 as a copy of a declaration allegedly filed on 10 June 2005, on the basis of postcard receipt evidence. The petition was dismissed without prejudice because

> *This argument is not persuasive. As noted by petitioner, the IFW system does not include the declaration allegedly filed on 10 June 2005. However, this does not establish "loss in the Patent Office" of the Declaration, since it has not been established that a Declaration actually accompanied the Transmittal letter which was itemized on the postcard receipt.*
>
> *With regard to counsel's request to "produce the Transmittal...," it is noted that, though the Transmittal letter was itemized on the postcard receipt, it is not currently present in the application file; this is corroborated by counsel's own statement that the Transmittal Letter is not present. Thus, it is clearly not possible to honor petitioner's request. Nonetheless, the mere fact that the Transmittal letter is absent from the application file does not establish that the Declaration itemized thereon was actually filed. Rather, in the absence of the proper itemization of the Declaration on the postcard receipt, its itemization on the Transmittal letter at most shows that applicants intended to file a Declaration, not that it was actually filed. Counsel's statement that there is "not a shred of proof that the Declaration was not filed with the lost Transmittal" is not persuasive because the burden is not on the USPTO to prove that correspondence not properly itemized on a return postcard receipt was not filed. Rather, the burden of proof lies with applicant to provide evidence that the correspondence in question was actually filed, despite the fact that the official record suggests otherwise. The postcard receipt practice provides an avenue for applicants to prove that correspondence was filed with the Office, but that practice imposes a burden on applicants to properly itemize correspondence on the postcard receipt. In this case, applicants clearly failed to follow the instructions provided by MPEP 503 to properly itemize the correspondence on the postcard receipt instead of just*

on the Transmittal letter (again, MPEP 503 explains in part that "Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items"). Applicants point out that "That the Transmittal of June 10th is not prima facie evidence of receipt of the Declaration the Transmittal says was attached is not to say that it is no proof." However, in the absence of a proper showing consistent with the policy explained at MPEP 503, applicants have not provided sufficient evidence to rebut the presumption that the contents of the official record accurately reflect the correspondence which was actually filed. In this situation, it would not be appropriate to rely upon mere conjecture to provide the missing evidence that the correspondence in question was actually filed.

In response, petitioner argues that

Supervisory authority is invoked because the postcard receipt, while not prima facie evidence of receipt of the "attached declaration" nevertheless is the only evidence of record. Between no evidence and some evidence, supervisory authority should go with the only evidence of the receipt.

The Patent Office has no record of the TRANSMITTAL or its "attached declaration." The only evidence thereof is the postcard proving that the Patent Office got the TRANSMITTAL, which it lost, thereby providing evidence or at least suggestion that it lost the "attached declaration," too.

The TRANSMITTAL was received 10 June 2005. The declaration filed as the "attached declaration" was dated in Denmark 12 May 2005.

Between the two, the complete absence of any evidence at the Patent Office and the evidence that at TRANSMITTAL of an "attached declaration" dated 12 May was filed 10 June 2005 and subsequently lost in the Patent Office, the preponderance of evidence and, in fact, the only evidence is for the "attached declaration" and, therefore, a 371 date of 10 June 2005 on supervisory authority.

Upon consideration of petitioner's argument, and in view of the nature of the postcard evidence of record, it would be appropriate to treat the declaration filed on 10 October 2006 as a copy of the declaration filed on 10 June 2005. Consequently, the Notice of Acceptance (Form PCT/DO/EO/903) mailed on 05 December 2006, which shows a date under 35 U.S.C. 371(c)(1), (2) and (4) of "10/10/2006," is hereby **VACATED**.

DECISION

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a new Notice of Acceptance (Form PCT/DO/EO/903). The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **10 June 2005**.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

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

LAW OFFICES OF STUART J. FRIEDMAN
28930 RIDGE ROAD
MT. AIRY, MD 21771

Mail Date: 04/21/2010

Applicant	: Andre Kudelski	: DECISION ON REQUEST FOR
Patent Number	: 7668311	: RECALCULATION of PATENT
Issue Date	: 02/23/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/168,608	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/24/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **967** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

MAILED

MAY 11 2009

OFFICE OF PETITIONS

In re Application of :
IAN SHERRINGTON :
Application No. 10/168,619 :
Filed: September 16, 2002 :
Atty Docket No. 31229-181998 :

LETTER REGARDING
PATENT TERM ADJUSTMENT

This letter is in response to the "Request for Recalculation of Patent Term Adjustment" filed February 24, 2009. Pursuant to applicant's duty of good faith and candor to the Office, applicant requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the initial Determination of Patent Term Adjustment is **GRANTED to the extent indicated herein**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **656 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 24, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment was 710 days. On February 24, 2009, applicant submitted the instant comment.

Applicant requests that the Office recalculate the period of patent term adjustment. Applicant states that the correct Patent Term Determination is 681 days. Applicant indicates that

applicant should be assessed a delay of 29 days for the filing of a Supplemental Amendment submitted on May 8, 2008.

A review of the application history reveals that applicant should have been assessed a delay under 37 CFR 1.704(c)(8) for the submission of the Supplemental Amendment on May 8, 2008. Additionally, applicant should have been assessed a delay under 37 CFR 1.704(c)(8) for the submission of an Information Disclosure Statement on June 2, 2008.

37 CFR 1.704(c)(8) provides:

> (8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

It is undisputed that after filing a response on April 9, 2008, applicant filed a Supplemental Amendment on May 8, 2008, and an Information Disclosure Statement on June 2, 2008. The record does not support a conclusion that the examiner expressly requested the filing of either the Supplemental Amendment or the Information Disclosure Statement. Further, a review of the Information Disclosure Statement, filed June 2, 2008, reveals that applicant did not include a proper statement under 37 CFR 1.704(d).[1] Thus, applicant failed to engage in reasonable efforts to conclude prosecution of the application.

---

[1] Pursuant to 37 CFR 1.704(d):

> A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Pursuant to 37 CFR 1.704(c)(8), a first period of reduction of 29 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, April 10, 2008, and ending on the date that the Supplemental Amendment was filed, May 8, 2008. Pursuant to 37 CFR 1.704(c)(8) a second period of reduction of 54 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, April 10, 2008, and ending on the date that the Information Disclosure Statement was filed, June 2, 2008.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application … will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." The first period of reduction of 29 days pursuant to 37 CFR 1.704(c)(8) totally overlaps with the second period of reduction of 54 days. Accordingly, a single period of reduction of 54 days is being entered for these two periods of reduction.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **656 days** (952 days of Office delay - 269 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in applicant's favor, the Office will not assess the $200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicant for applicant's good faith and candor in bringing this to the attention of the Office.

Applicant is reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicant will be notified in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Monday
Date: 5/11/2009

PALM INTRANET

Time: 11:49:59

PTA Calculations for Application: 10/168619			
Application Filing Date:	09/16/2002	PTO Delay (PTO):	952
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	242
Post-Issue Petitions:	0	Total PTA (days):	656
PTO Delay Adjustment:	-54		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
86	05/11/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		54	
70	11/24/2008	MAIL NOTICE OF ALLOWANCE	107		51
69	11/21/2008	ISSUE REVISION COMPLETED			
68	11/06/2008	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
67	11/06/2008	DOCUMENT VERIFICATION			
66	11/06/2008	EXAMINER'S AMENDMENT COMMUNICATION			
65	11/06/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
64	11/06/2008	CASE DOCKETED TO EXAMINER IN GAU			
63	11/05/2008	NOTICE OF ALLOWABILITY			
59	06/02/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
58	10/22/2008	CASE DOCKETED TO EXAMINER IN GAU			
57	10/06/2008	CASE DOCKETED TO EXAMINER IN GAU			
56	06/02/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
55	06/02/2008	DATE FORWARDED TO EXAMINER			
54	05/08/2008	SUPPLEMENTAL RESPONSE			
53	04/09/2008	NEW OR ADDITIONAL DRAWING FILED			
52	05/14/2008	DATE FORWARDED TO EXAMINER			
51	04/09/2008	RESPONSE AFTER NON-FINAL ACTION		91	47
50	04/09/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
49	04/24/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
48	04/23/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			

47	10/09/2007	MAIL NON-FINAL REJECTION			
46	10/04/2007	CASE DOCKETED TO EXAMINER IN GAU			
45	10/03/2007	CASE DOCKETED TO EXAMINER IN GAU			
44	10/01/2007	NON-FINAL REJECTION			
43	09/05/2007	DATE FORWARDED TO EXAMINER			
42	08/27/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
41	09/05/2007	DATE FORWARDED TO EXAMINER			
40	08/27/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		93	36
39	09/05/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
38	08/27/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
37	08/27/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
36	02/26/2007	MAIL FINAL REJECTION (PTOL - 326)			
35	02/23/2007	FINAL REJECTION			
34	01/16/2007	DATE FORWARDED TO EXAMINER			
33	12/22/2006	RESPONSE AFTER NON-FINAL ACTION		58	29
32	12/22/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
31	12/22/2006	NEW OR ADDITIONAL DRAWING FILED			
30	11/16/2006	CASE DOCKETED TO EXAMINER IN GAU			
29	07/25/2006	MAIL NON-FINAL REJECTION			
28	07/24/2006	NON-FINAL REJECTION			
26	09/16/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
25	05/19/2006	DATE FORWARDED TO EXAMINER			
24	05/10/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
23	05/10/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
22	04/15/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	03/10/2006	MAIL RESTRICTION REQUIREMENT	845		-1
18	03/09/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
17	02/02/2006	TRANSFER INQUIRY TO GAU			
16	01/10/2006	FILE MARKED FOUND			
15	06/07/2005	TRANSFER INQUIRY TO GAU			
14	05/09/2005	TRANSFER INQUIRY TO GAU			

13	01/06/2005	FILE MARKED LOST			
12	06/15/2004	TRANSFER INQUIRY TO GAU			
11	09/16/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
10.7	09/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	09/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	03/16/2004	CASE DOCKETED TO EXAMINER IN GAU			
8	02/06/2003	TRANSFER INQUIRY TO GAU			
7	12/09/2002	APPLICATION DISPATCHED FROM OIPE			
6	12/03/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
5	11/29/2002	NOTICE OF DO/EO ACCEPTANCE MAILED			
3	09/16/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

30 APR 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

#15

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Richard S Barth
Frishauf Holtz Goodman Langer & Chick
767 Third Ave 25th Floor
New York NY 10017-2023

In re Application of	:	
STUBER et al.	:	
Application No.: 10/168,639	:	DECISION ON
PCT No.: PCT/DE00/04610	:	
Int. Filing Date: 27 December 2000	:	PETITION
Priority Date: 23 December 1999	:	
Attorney Docket No.: 02329/RSB	:	
For: METHOD FOR QUICKLY DETECTING	:	
MICROBIAL DNA/RNA, KIT THEREFOR AND	:	
THE USE OF SAID METHOD	:	

This decision is in response to the submission filed on 11 February 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 27 December 2000, applicants filed international application PCT/DE00/04610, which claimed a priority date of 23 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 05 July 2001. A Demand for international preliminary examination in which the United States was elected, was filed on 20 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2002 (23 June 2002 being a Sunday).

On 20 June 2002, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage under 35 U.S.C. 371 accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of inventors, and the processing fee for providing the English translation later than thirty months from the priority date.

On 24 July 2002, applicants submitted an English translation of the International Application as filed.

On 30 August 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form

PCT/DO/EO/905) indicating, *inter alia*, that a translation of the application into English and a copy of the "Sequence Listing" in computer readable form must be provided. The NOTIFICATION OF MISSING REQUIREMENTS set a two-month extendable time period.

On 27 March 2003, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that a copy of the "Sequence Listing" in computer readable form must be provided.

On 02 April 2003, applicants submitted a "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" which was accompanied by, *inter alia*, a computer-readable form of the sequence listing on diskette.

On 11 June 2003, the DO/EO/US mailed a second NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that a corrected diskette of the sequence listing was required.

On 08 July 2003, submitted a second "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" which was accompanied by, *inter alia*, a computer-readable form of the sequence listing on diskette.

On 13 January 2004, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to properly respond to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 mailed 30 August 2002. (The computer-readable form of the sequence listing on diskette submitted 08 July 2003 contained errors.)

On 11 February 2004, applicants submitted the instant submission which included, *inter alia*, a petition for revival under 37 CFR 1.137(b), a computer readable form of the sequence listing on diskette, and a notification of loss of entitlement to small entity status.

DISCUSSION

Petition to Revive Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted an acceptable computer-readable form of the sequence listing on diskette as well as a paper copy of the corrected sequence listing with an amendment

directing its entry into the specification on 11 February 2004.

As to item (2), applicant submitted the petition fee of $1,330 on 11 February 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

Loss of Entitlement to Small Entity Status

The notification of loss of entitlement to small entity status under 37 CFR 1.27(g)(2) is acknowledged.

DECISION

For the reasons set forth above, the petition under 37 CFR 1.137(b) is **GRANTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

21 JAN 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

Merchant & Gould PC
P.O. Box 2903
Minneapolis, MN 55402-0903

In re Application of OLLIKAINEN	:	
U.S. Application No.: 10/168,649	:	
PCT Application No.: PCT/FI00/01136	:	COMMUNICATION
Int. Filing Date: 22 December 2000	:	
Priority Date Claimed: 23 December 1999	:	
Attorney Docket No.: 11902.0053USW1	:	
For: MULTINODE SERVER	:	

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 22 December 2000, applicant filed international application PCT/FI00/01136, which claimed priority of an earlier Finland application filed 23 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 23 June 2002.

On 21 June 2002, applicant filed a continuation application of PCT/FI00/01136 under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

On 17 September 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 October 2002, applicant filed an executed declaration.

On 13 December 2002, DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

DISCUSSION

A review of the application file reveals that the application papers filed 21 June 2002 were improperly treated as a national stage filing under 35 U.S.C. 371.

CONCLUSION

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 17 September 2002 is hereby VACATED.

The Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed13 December 2002 is hereby VACATED.

This application is being forwarded to the Office of Initial Patent Examination for processing of the application as a continuation application under 35 U.S.C. 111(a) and for issuance of a corrected filing receipt.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

MAR 15 2002

10/168651

DT15 Rec'd PCT/PTO JUN 21 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Diana Hamlet-Cox
INCYTE GENOMICS, INC.
3160 Porter Drive
Palo Alto, CA 94304

In re Application of INCYTE GENOMICS, INC. PCT No.: PCT/US00/35095 Int. Filing Date: 20 December 2000 Priority Date: 23 December 1999 Docket No.: PI-0005 PCT For: TRANSPORTERS AND ION CHANNELS	DECISION ON PETITION UNDER 37 CFR 1.10(c)

This decision is in response to applicant's "Request for a Corrected Filing Date" filed 17 January 2002 which has been treated as a petition under 37 CFR 1.10(c). No petition fee is required.

BACKGROUND

Applicant filed international application PCT/US00/35095 using Express Mail service claiming priority to a United States patent application filed 23 December 1999. Applicant was given an international filing date of 22 December 2000 by the United States Receiving Office (RO/US).

On 23 January 2001, the RO/US mailed a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) showing that the international filing date was 22 December 2000.

On 17 January 2002, applicant filed the instant petition which was accompanied by *inter alia*, a copy of Express Mail label No. "EL675714320US" showing a "Date-In" of 12 December 2000 and a copy of the transmittal letter filed with the Request.

DISCUSSION

Any correspondence received by the United States Patent and Trademark Office ("Office") delivered by Express Mail will be considered filed in the Office on the date of deposit with the USPS. 37 CFR § 1.10(a). Moreover, 37 CFR § 1.10(c) states:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date

of deposit as shown by the "date - in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date - in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date - in," and of any other official notation by the USPS relied upon to show the date of deposit.

A review of the application file reveals that all the requirements of 37 CFR 1.10(c) have been satisfied.

The Express Mail label number "EL675714320US" is listed on the transmittal letter accompanying the Request and associated documents under a heading titled "Certificate Under 37 CFR 1.10."

Applicant included a copy of Express Mail label number "EL675714320US" with the instant petition which indicates that the "Date-In" was "12 20 00" and is stamped by the USPS as received in Palo Alto CA on "DEC 20 2000." Moreover, a review of the USPTO's USPS Express Mail Information Database for "EL675714320US" shows that the package was accepted by the USPS on "12/20/2000" at 04:47 p.m. This confirms that the documents were received by the USPS on 20 December 2000.

Accordingly, applicant has met all the requirements of 37 CFR 1.10(c).

CONCLUSION

For the reasons above, applicant's petition to correct the international filing date pursuant to 37 CFR 1.10(c) is **GRANTED**.

The Form PCT/RO/105 mailed 23 January 2001 certifying that the international filing date is 22 December 2000 is hereby **VACATED**.

This application is being returned to the RO/US for the correction of the application file and PTO records to indicate an international filing date of **20 December**

2000, for the preparation and mailing of a new Form PCT/RO/105, and for the forwarding of a copy of the decision to the International Bureau.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

03 MAR 2005

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Charles N.J. Ruggiero
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

In re Application of Dominguez-Montes Serial No.: 10/168,652 PCT No.: PCT/ES01/00109 Int. Filing Date: 19 March 2001 Priority Date: None Attorney's Docket No.: 0001035USU/2206 For: SYSTEM FOR REPRODUCING THREE-DIMENSIONAL IMAGES	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This decision is responsive to the "STATEMENT UNDER 37 C.F.R. § 1.137(b) IN SUPPORT OF APPLICANT'S PETITION FOR REVIVAL OF PATENT APPLICATION UNINTENTIONALLY ABANDONED" filed 28 December 2004.

BACKGROUND

On 19 March 2001, applicants filed international application PCT/ES01/00109. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 26 September 2002. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 19 September 2003.

On 21 June 2002, applicants filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a translation of the published international application, a preliminary amendment, and the basic national fee of $520 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/168,655.

On 24 October 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

On 15 October 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) within the time period set therein.

On 28 December 2004, applicants filed the current petition along with copies of a declaration and transmittal letter that contained a first class mail certificate having a date of 08 November 2002.

DISCUSSION

37 CFR 1.8, states in part:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Applicant informed the Office of the previous mailing approximately two months after receiving the Notice of Abandonment. Applicant provided a copy of the previously mailed correspondence and certificate of mailing along with the petition to revive. With respect to element (3), the office has interpreted this element to require a statement from a person of firsthand knowledge of the facts, i.e., a statement from Alex Nulman. Therefore, applicant has not provided the required statement.

CONCLUSION

The petition to revive the application is **DISMISSED**.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Debra Brittingham
Office of PCT Legal Administration
DSB/BM:dsb

Tel: (571) 272-3280
Fax: (571) 273-0459

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

03 OCT 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Charles N.J. Ruggiero
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

In re Application of	:	
Dominguez-Montes	:	
Serial No.: 10/168,652	:	
PCT No.: PCT/ES01/00109	:	
Int. Filing Date: 19 March 2001	:	DECISION
Priority Date: None	:	
Attorney's Docket No.: 0001035USU/2206	:	
For: SYSTEM FOR REPRODUCING	:	
THREE-DIMENSIONAL IMAGES	:	

This decision is responsive to the renewed petition filed 23 August 2005.

BACKGROUND

On 19 March 2001, applicants filed international application PCT/ES01/00109. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 26 September 2002. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 19 September 2003.

On 21 June 2002, applicants filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a translation of the published international application, a preliminary amendment, and the basic national fee of $520 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/168,655.

On 24 October 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

On 15 October 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) within the time period set therein.

On 28 December 2004, applicants filed a petition along with copies of a declaration and transmittal letter that contained a first class mail certificate having a date of 08 November 2002.

On 03 March 2005, the petition was dismissed due to applicant's failure to provide a statement from someone having firsthand knowledge of the facts.

On 23 August 2005, applicants filed the current renewed petition along with a statement of Alex Nulman.

DISCUSSION

37 CFR 1.8, states in part:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Applicant informed the Office of the previous mailing approximately two months after receiving the Notice of Abandonment. Applicant provided a copy of the previously mailed correspondence and certificate of mailing along with the petition to revive.

With respect to element (3), applicant has now provided a statement from Alex Nulman. However, the statement from Mr. Nulman does not appear to rely on specific recollection of the facts. Any affidavits should be from persons having a personal and specific recollection of the facts regarding the preparation and mailing of these papers apart from a review of the law firm's records and the firm's normal and routine procedures for filing applications. That is, the affidavits should include an account of events, including the preparation of the package for

mailing and the insertion of the papers in the package for mailing, that would cause one to remember the preparation and mailing of the application papers in question.

CONCLUSION

The petition to revive the application is **DISMISSED without prejudice**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Debra Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Tel: (571) 272-3280
Fax: (571) 273-0459

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

25 AUG 2006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Charles N.J. Ruggiero
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

In re Application of	:
Dominguez-Montes	:
Serial No.: 10/168,652	: DECISION ON
PCT No.: PCT/ES01/00109	:
Int. Filing Date: 19 March 2001	: PETITION
Priority Date: None	:
Attorney's Docket No.: 0001035USU/2206	: UNDER 37 CFR 1.181
For: SYSTEM FOR REPRODUCING	:
THREE-DIMENSIONAL IMAGES	:

This decision is responsive to the renewed petition filed under 37 CFR 1.181 on 05 December 2005.

BACKGROUND

On 19 March 2001, applicants filed international application PCT/ES01/00109. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 26 September 2002. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 19 September 2003.

On 21 June 2002, applicants filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a translation of the published international application, a preliminary amendment, and the basic national fee of $520 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/168,655.

On 24 October 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

On 15 October 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) within the time period set therein.

On 28 December 2004, applicants filed a petition along with copies of a declaration and transmittal letter that contained a first class mail certificate having a date of 08 November 2002.

On 03 March 2005, the petition was dismissed due to applicant's failure to provide a statement from someone having firsthand knowledge of the facts.

On 23 August 2005, applicants filed a renewed petition along with a statement of Alex Nulman.

On 03 October 2005, the petition was again dismissed because the statement from Mr. Nulman did not appear to rely on specific recollection of the facts.

On 05 December 2005, applicant filed the current petition along with a new affidavit from Mr. Nulman.

DISCUSSION

37 CFR 1.8, states in part:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Applicant informed the Office of the previous mailing approximately two months after receiving the Notice of Abandonment. Applicant provided a copy of the previously mailed correspondence and certificate of mailing along with the petition to revive.

With respect to element (3), applicant has now provided a statement from Alex Nulman. This statement relies on Mr. Nulman's pecific recollection of the facts.

CONCLUSION

The petition under 37 CFR 1.181 to withdraw the holding of abandonment the application is **GRANTED**.

This application is being forwarded to national stage processing for preparation of the "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) and the according of a 35 U.S.C. 371 (a) (1), (2) and (4) date of 08 November 2002.

Debra Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Tel: (571) 272-3280
Fax: (571) 273-0459

17 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Patrick J. Hagan
Dann, Dorfman, Herrell, and Skillman
1601 Market Street
Philadelphia, PA 19103

In re Application of	:	
CHATER et al	:	
Application No.: 10/168,663	:	
PCT No.: PCT/GB00/04972	:	
Int. Filing Date: 20 December 2000	:	NOTIFICATION
Priority Date: 23 December 1999	:	
Attorney Docket No.: 03801-P29029USO	:	
For: METHODS AND MATERIALS RELATING TO GENE EXPRESSION	:	

This application is before the Office of PCT Legal Administration for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 20 December 2000, applicants filed international application PCT/GB00/04972 which claimed a priority date of 23 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 July 2001. A demand for internatioanal preliminary examination, in which the United States was elected, was filed on 29 June 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2002.

On 21 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 27 August 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b), a computer readable form of the sequence listing, and a paper copy or compact disc of the sequence listing as well as an amendment directing its entry into the specification were required.

On 25 October 2002, applicants submitted a declaration of inventors.

On 17 March 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that a computer readable form of the sequence listing and a paper copy or compact disc of the sequence listing as well as an amendment directing its entry into the specification were required within one month from the date of the notice or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. The notification indicated that no extension of this time limit may be granted.

On 18 April 2003, applicants submitted a computer readable form of the sequence listing, a paper copy of the sequence listing, as well as an amendment directing its entry into the specification, and a statement that the paper copy and computer readable form of the sequence listing are identical and do not contain any new matter. The response was accompanied by "Certificate of Mailing by Federal Express" certifying that the response was deposited with Federal Express on 17 April 2003.

On 27 May 2002, the DO/EO/US mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) indicating the 35 U.S.C. 371© date of the above-identified application as 25 October 2002.

On 18 August 2003, applicant contacted the PCT Special Programs Office to inquire as to the status of the application, because the response to the Notification of Defective Response had been received by the USPTO on 18 April 2003, one day after the expiration of the period for response to the Notice of Defective Response.

DISCUSSION

The period for response to the NOTICE OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) expired on 17 August 2003. Although applicants filed a "Certificate of Mailing by Federal Express" certifying that the response was deposited with Federal Express on 17 April 2003, together with their response, the provisions of 37 CFR 1.8, "Certificate of mailing or transmission" apply only to deposit of the correspondence with the U.S. Postal Service, and do not extend to a commercial delivery service. 37 CFR 1.6(a) specifies that ""[c]orrespondence received in the Patent and Trademark Office is stamped with the date of receipt as follows..." and the enumerated exceptions do not include deposit with a commercial delivery service. Therefore, the response to the NOTICE OF DEFECTIVE RESPONSE was not timely filed and the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 was mailed in error.

CONCLUSION

The NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 mailed 27 May 2002 is VACATED for the reasons set forth above. This application is being forwarded to

the National Stage Processing Branch of the Office of PCT Operations for issuance of a NOTICE OF ABANDONMENT.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Susan C. Wolski
PCT Special Programs Examiner
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-3984
Facsimile: (703) 308-6459

Leonard E. Smith
PCT Legal Examiner

16 DEC 2003

#12

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

In re Application of CHATER et al. Serial No.: 10/168,663 PCT No.: PCT/GB00/04972 Int. Filing Date: 20 December 2000 Priority Date: 23 December 1999 Attorney's Docket No.: 0380-P02909US0 For: METHODS AND MATERIALS RELATING TO GENE EXPRESSION	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 16 October 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the sequence listing required in response to the 17 March 2003 Notification of Defective Response was provided on 18 April 2003. The required petition fee of $1330 has been paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c) date is **25 October 2002.**

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
Office of Patent Cooperation Treaty
Legal Administration Office

Telephone: (703) 306-5467
Facsimile : (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/3/10

TO SPE OF : ART UNIT 3752

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/168668 Patent No.: 7651037B2

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

Virginia Tolbert
Certificates of Correction Branch
571-272-0460

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: _____

Len Tran / SPE AU 3752 4/5/10

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

James P Zeller
Marshall Gerstein & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6357

Mail Date: 04/30/2010

Applicant	: Paul R. Drury	: DECISION ON REQUEST FOR
Patent Number	: 7651037	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/168,668	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 04/04/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **141** 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.

07 MAY 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

David J. Levy, Corporate Intellectual Property
GLAXOSMITHKLINE
Five Moore Drive, P.O. Box 13398
Research Triangle, North Carolina 27709-3396

In re Application of	:	
CRIPPS et al.	:	
Serial No.: 10/168,672	:	DECISION ON PETITION
PCT No.: PCT/GB00/04939	:	
Int. Filing Date: 23 November 2000	:	
Priority Date: 23 November 1999	:	
Atty. Docket No.: PG3894USW	:	
For: PHARMACEUTICAL AEROSOL FORMULATION OF SALMETEROL AND FLUTICASONE PROPIONATE	:	

This decision is in response to applicants' "Request for Corrected Filing Receipt" filed 07 March 2003 and 08 April 2003. Applicants are requesting to correct the name of the inventors (applicants) to Alan Leslie Cripps and Paul Johnson on the Official Filing Receipt. This communication is being treated as a Petition under 37 CFR 1.181. No petition fee is due.

The published international application and declaration for the national stage application of PCT/GB00/04939 lists the inventors as ALAN LESLIE CRIPPS and PAUL JOHNSON. Therefore, the request for corrected filing receipt under 37 CFR 1.181 is granted.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for the preparation and mailing of a corrected Filing Receipt with the name of the inventors as Alan Leslie Cripps and Paul Johnson.

This application will then be returned to Art Unit 1614 for further prosecution.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
10/168,696	06/20/2002	Wayne D. Jung	JJI13.PCT.US	1369

7590 05/17/2005

Loudermild Associate
PO Box 3607
Los Altos, CA 94024-0607

EXAMINER
EVANS, FANNIE L

ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SM

042005

Loudermilk & Associates
PO Box 3607
Los Altos CA 94024-0607

MAY 0 3 2005

In re Application of:
Jung et al.
Serial No.: 10/168,696
Filed: June 20, 2002
Attorney Docket No.: JJ113.PCT.US

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed on July 11, 2004, to accept the papers filed May 17, 2004 in application serial No. 10/039,420 as having been timely filed for the instant application. The petition is being treated as a petition under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above identified application.

The petition is **DENIED**.

The application became abandoned by operation of law (37 C.F.R. § 1.135) for failure to timely file a response to the non-final Office Action mailed on December 11, 2004. A Notice of Abandonment has not been mailed.

Petitioner asserts that a response including an amendment and a petition for a two-month extension of time was timely facsimile transmitted on May 11, 2004 in response to the Office Action of December 11, 2003. Petitioner states that on the second page of the transmission, which was the first page of the amendment, the application information for which the transmission was intended was erroneously identified as application Serial No. 10/039,420. Based on a review of PAIR, petitioner concludes that the facsimile transmission was separated into two separate papers with the extension of time entered in the instant application but the amendment incorrectly entered in Serial No. 10/039,420.

A review of the file record of Serial No. 10/039,420 reveals that an entry was made in PALM/PAIR indicating that an amendment was received on May 17, 2004, but this amendment was not of record in the image file wrapper of that application. Furthermore, a review of the file record of application serial No. 10/168,696 reveals that the extension of time was received in the mailroom on May 17, 2004 with a certificate of mailing on May 11, 2004, not a certificate of transmission on May 11, 2004 as stated in the petition.

Minor errors in the identification of an application on a paper filed with the Office, such as transposed numbers or typographical errors, can be corrected by the Office provided the correct

identification can be quickly discovered. See M.P.E.P. § 502. However, the Office did not discover the error because the information on the first page of the amendment filed May 11, 2004 is to a completely different application. The error in listing a different application number on the amendment is not and cannot be considered as a minor error in the identification of the application as set forth in section 502 of the M.P.E.P.

Pursuant to 37 C.F.R. § 1.8(b) a correspondence not received by the Office will be considered timely filed if the party (1) promptly informs the Office of the previous transmission, (2) supplies an additional copy of the previously transmitted correspondence and certificate, and (3) includes a statement which attests on a personal knowledge basis to the previous timely transmission and a copy of the sending unit's report confirming transmission. Petitioner has not filed a true copy of the previous transmission, as evidenced by the fact that the amendment filed July 11, 2004 contained the correct information such as serial number in the caption data, or a report confirming that the facsimile transmission was successful.

Petitioner may wish to consider filing a petition under 37 C.F.R. 1.137 (a) or (b) to revive the application.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely.

Inquiries regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

Janice A. Falcone

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

SM

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

042005

Loudermilk & Associates
PO Box 3607
Los Altos CA 94024-0607

MAY 0 3 2005

In re Application of:
Jung et al.
Serial No.: 10/168,696
Filed: June 20, 2002
Attorney Docket No.: JJ113.PCT.US

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed on July 11, 2004, to accept the papers filed May 17, 2004 in application serial No. 10/039,420 as having been timely filed for the instant application. The petition is being treated as a petition under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above identified application.

The petition is **DENIED**.

The application became abandoned by operation of law (37 C.F.R. § 1.135) for failure to timely file a response to the non-final Office Action mailed on December 11, 2004. A Notice of Abandonment has not been mailed.

Petitioner asserts that a response including an amendment and a petition for a two-month extension of time was timely facsimile transmitted on May 11, 2004 in response to the Office Action of December 11, 2003. Petitioner states that on the second page of the transmission, which was the first page of the amendment, the application information for which the transmission was intended was erroneously identified as application Serial No. 10/039,420. Based on a review of PAIR, petitioner concludes that the facsimile transmission was separated into two separate papers with the extension of time entered in the instant application but the amendment incorrectly entered in Serial No. 10/039,420.

A review of the file record of Serial No. 10/039,420 reveals that an entry was made in PALM/PAIR indicating that an amendment was received on May 17, 2004, but this amendment was not of record in the image file wrapper of that application. Furthermore, a review of the file record of application serial No. 10/168,696 reveals that the extension of time was received in the mailroom on May 17, 2004 with a certificate of mailing on May 11, 2004, not a certificate of transmission on May 11, 2004 as stated in the petition.

Minor errors in the identification of an application on a paper filed with the Office, such as transposed numbers or typographical errors, can be corrected by the Office provided the correct

PAGE 4/14 * RCVD AT 6/19/2005 4:27:40 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:408 342 1868 * DURATION (mm-ss):05-44

identification can be quickly discovered. See M.P.E.P. § 502. However, the Office did not discover the error because the information on the first page of the amendment filed May 11, 2004 is to a completely different application. The error in listing a different application number on the amendment is not and cannot be considered as a minor error in the identification of the application as set forth in section 502 of the M.P.E.P.

Pursuant to 37 C.F.R. § 1.8(b) a correspondence not received by the Office will be considered timely filed if the party (1) promptly informs the Office of the previous transmission, (2) supplies an additional copy of the previously transmitted correspondence and certificate, and (3) includes a statement which attests on a personal knowledge basis to the previous timely transmission and a copy of the sending unit's report confirming transmission. Petitioner has not filed a true copy of the previous transmission, as evidenced by the fact that the amendment filed July 11, 2004 contained the correct information such as serial number in the caption data, or a report confirming that the facsimile transmission was successful.

Petitioner may wish to consider filing a petition under 37 C.F.R. 1.137 (a) or (b) to revive the application.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely.

Inquiries regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

Janice A. Falcone

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

PAGE 5/14 * RCVD AT 6/19/2005 4:27:40 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:408 342 1868 * DURATION (mm-ss):05-44

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Loudermild Associate
PO Box 3607
Los Altos, CA 94024-0607

COPY MAILED
MAY 1 8 2006
OFFICE OF PETITIONS

In re Application of :
Jung, et al. :
Application No. 10/168,696 : ON PETITION
Filed: June 20, 2002 :
Attorney Docket No.JJ113.PCT.US

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

A review of the application file reveals that a non-final Office action was mailed on December 11, 2003, allowing a shortened statutory period for reply of three months from its mailing date. On May 17, 2004, a request for an extension of time was filed, but there is no indication from the file record that a proper response to the non-final Office action was filed on May 17, 2004. On June 11, 2004, applicant filed a communication explaining that an amendment responsive to the non-final Office action was sent via facsimile on May 11, 2004, but that the amendment contained incorrect identifiers and was likely matched with an incorrect application file. The copy of the amendment that was allegedly filed contained a certificate of mailing under 37 CFR 1.8 indicating that the amendment was deposited with the United States Postal Service on May 11, 2004. Petitioner has filed a copy of an Office date-stamped postcard acknowledging receipt of an amendment and request for an extension of time on May 17, 2004.

Section 711.03(c) of the *Manual of Patent Examining Procedure* provides in pertinent part that:

> 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.

It is noted the a response to the non-final Office action was due on May 11, 2004, and that the postcard acknowledges receipt of the amendment and extension of time on May 17, 2004. In this case, however, the undersigned is considering the postcard *prima facie* evidence that the Office received the amendment and request for extension of time within the second month. This is important because of the apparent misrouting of the amendment due to applicant's failure to include proper identifiers on the amendment itself. It is apparent that amendment intending to be responsive to the non-final Office action was

received. As to the timeliness of the amendment, the undersigned again relies on Section 711.03 of the MPEP, which states in pertinent part, that:

> 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).

While there was some question as to whether the amendment was mailed or faxed on May 11, 2004, petitioner indicates that the amendment was, in fact, mailed on May 11, 2004. The instant petition was accompanied by a copy of the amendment as it was originally filed which contained a certificate of mailing dated May 11, 2004. The amendment, although providing incorrect identifiers, is determined to have been deposited with the United States Postal Service on May 11, 2004. Taken together, the Office date-stamped postcard and certificate of mailing demonstrate that the amendment was timely mailed and received by the Office. This is sufficient to withdraw the holding of abandonment. The holding of abandonment is withdrawn, accordingly.

Petitioner is cautioned to provide correct identifiers on all future correspondence filed to avoid inordinate delays in the prosecution of the application.

It is noted that a Notice of Non-Complaint Amendment was mailed on July 23, 2004, which was responsive to the copy of the May 11, 2004, amendment that was filed on July 11, 2004. The Notice of Non-Compliant Amendment allowed an extendable period for reply of one-month from its mailing date. On November 1, 2004, applicant filed a response with a request for an extension of time within the second month. It does not appear that the November 1, 2004, response has been considered on its merits. The examiner must determine at what point in the prosecution process it is most appropriate to resume examining the application.

The application file is being forwarded to Technology Center 2800, GAU 2877 for further processing.

Inquiries regarding this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LOUDERMILK & ASSOCIATES
PO BOX 3607
LOS ALTOS, CA 94024-0607

COPY MAILED
JUN 0 9 2008

In re Application of	:	
Wayne D. Jung, et al.	:	
Application No. 10/168,696	:	ON PETITION
Filed: June 20, 2002	:	
Attorney Docket No. JJI13.PCT.US	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 19, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to timely file an acceptable reply within the meaning of 37 CFR 1.113 to the final Office action of September 25, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). A two (2) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on February 27, 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) (1).

The drawings fail to comply with the requirement of 37 CFR 1.84(d) which states:

Drawings: One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

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.

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) 272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

JAN 1 7 2008

OFFICE OF PETITIONS

Amersham Biosciences Corporation
800 Centennial Avenue
Piscataway, NJ 08855

In re Application of Tjerneld et al. :
Application No. 10/168,710 : Decision on Petition
Filing Date: September 3, 2002 :
Attorney Docket No. PU9969 :

This is a decision on the petition under 37 CFR 1.181, filed July 27, 2007, to withdraw the holding of abandonment.

The petition is **granted.**

A Notice of Abandonment has not been mailed. Petitioner states, during a telephone conversation on July 19, 2007, the examiner informed petitioner the application was abandoned. As a result, petitioner filed the instant petition.

The Office mailed a final Office action on September 6, 2006. The Office action set a three (3) month shortened statutory period for reply.

A reply to the final Office action has been matched with the file. The file indicates the reply was filed on December 6, 2006.

The Office of Petitions contacted the examiner who confirmed the reply filed December 6, 2006, was a proper reply to the final Office action.

Since a timely and proper reply was filed in response to the final Office action, the application is not abandoned.

Technology Center Art Unit 1654 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

Pet. Dec.

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

td

JUL 1 1 2005

Mailed :
In re Application of
Ittemann et al.
Serial No. 10/168,715
Filed: June 24, 2002
For: PREPARATION OF THERMOPLASTIC MOLDING COMPOSITION USING MAGNESIUM OXIDE

DECISION ON PETITION

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed May 19, 2004.

On May 19, 2004, a two way restriction requirement was made by the examiner under 35 USC 121. The examiner took the position that the groupings of claims were related as a process and an article. Applicants traversed the restriction requirement in a response filed September 20, 2004. The examiner prepared an Ex Parte Quayle action that was mailed on December 15, 2004 that required applicants to either cancel the non-elected claims or take other appropriate action. A one month time period was given for applicants to respond.

On January 11, 2005, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that a lack of unity exists between the groups of claims.

DECISION

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/EP00/12915 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B.

The examiner improperly restricted the instant application under 35 USC 121 which does not apply to U.S. National Phase Applications.

Accordingly, no lack of unity has been shown and Petitioner's arguments are persuasive. The petition to withdraw the restriction requirement is **GRANTED**.

The application is being forwarded to the examiner for rejoinder of the non-elected claims and examination thereof.

JMStone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST
WASHINGTON DC 20005

18 MAY 2004

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Sughrue Mion PLLC
2100 Pennsylvania Ave, NW
Suite 800
Washington, DC 20037

In re Application of CUBERO PITEL, José Antonio et al. Application No.: 10/168,720 PCT No.: PCT/ES99/00713 Int. Filing Date: 31 December 1999 Priority Date: None Attorney Docket No.: Q-70683 For: METHOD FOR MANUFACTURING PRINTED CIRCUIT BOARDS	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to "Petition to Withdraw Holding of Abandonment," filed in the United States Patent and Trademark Office on 01 March 2004.

BACKGROUND

On 31 December 1999, applicants filed international application PCT/ES99/00713. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 July 2001. A demand for international preliminary examination was filed on 30 July 2001. The deadline for entry into the national stage in the United States was 30 June 2002.

On 24 June 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 August 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 05 February 2004, the Office mailed Notice of Abandonment Under 37 CFR 1.53(f) or (g) indicating the application went abandoned for failure to timely reply to the Notice to File Missing Parts mailed 26 August 2002.

On 10 February 2004, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application went abandoned for failure to timely reply to the Notification of Missing Requirements mailed 26 August 2002.

On 12 February 2004, the Office mailed Withdrawal of Previously Sent Notice, without an explanation.

On 01 March 2004, applicants filed a petition to withdraw the holding of abandonment.

11 AUG 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Sughrue Mion PLLC
2100 Pennsylvania Ave, NW
Suite 800
Washington, DC 20037

In re Application of	:	
CUBERO PITEL, José Antonio et al.	:	
Application No.: 10/168,720	:	DECISION ON
PCT No.: PCT/ES99/00713	:	
Int. Filing Date: 31 December 1999	:	PETITION
Priority Date: None	:	
Attorney Docket No.: Q-70683	:	UNDER 37 CFR 1.181
For: METHOD FOR MANUFACTURING	:	
PRINTED CIRCUIT BOARDS	:	

This decision is in response to "Renewed Petition Under 37 CFR §1.181," filed in the United States Patent and Trademark Office on 25 May 2004.

BACKGROUND

On 31 December 1999, applicants filed international application PCT/ES99/00713. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 July 2001. A demand for international preliminary examination was filed on 30 July 2001. The deadline for entry into the national stage in the United States was 30 June 2002.

On 24 June 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 August 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 05 February 2004, the Office mailed Notice of Abandonment Under 37 CFR 1.53(f) or (g) indicating the application went abandoned for failure to timely reply to the Notice to File Missing Parts mailed 26 August 2002.

On 10 February 2004, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application went abandoned for failure to timely reply to the Notification of Missing Requirements mailed 26 August 2002.

On 12 February 2004, the Office mailed Withdrawal of Previously Sent Notice, without an explanation.

On 01 March 2004, applicants filed a petition to withdraw the holding of abandonment.

On 18 May 2004, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicant's petition without prejudice.

On 25 May 2004, applicants submitted a renewed petition under 37 CFR 1.181.

DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received,* 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) and (2) were previously satisfied.

Item (3) has now been satisfied

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 10 February 2004 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 01 March 2004.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ZAGORIN O'BRIEN GRAHAM LLP (149)
7600B N. CAPITAL OF TX HWY
SUITE 350
AUSTIN TX 78731

COPY MAILED

DEC 07 2009

OFFICE OF PETITIONS

In re Application of :
Jim L. Lee :
Patent No. 6,897,617 :
Application No. 10/168,723 :
Filed: June 21, 2002 :
Attorney Docket No. 149-0012

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to Terri Johnson at (571) 272-2991.

Ramesh Krishnamurthy

for Chris Bottorff
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

GIBBONS DEL DEO DOLAN GRIFFINGER & VECCHIONE
ONE RIVERFRONT PLAZA
NEWARK, NJ 07102-5497

COPY MAILED

SEP 21 2005

OFFICE OF PETITIONS

In re Patent No. 6,720,322 :
Issue Date: April 13, 2004 :
Application No. 10/168,752 : LETTER
Filed: June 24, 2002 :
Attorney Docket No. 10928-0004

This is in response to the paper filed April 25, 2005 which is being treated as a petition under 37 CFR 1.28(b) requesting that status as a Small Entity be removed.

In accordance with the April 25, 2005 request, status as a Small Entity has been removed.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

21 MAY 2004

21 MAY 2004

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

#7

Kenneth F. Mitchell
ASTRAZENECA PHARMACEUTICALS LP
Global Intellectual Property
1800 Concord Pike
Wilmington, DE 19850-5437

In re Application of BROWN et al. Application No.:10/168,755 PCT No.: PCT/SE00/02610 Int. Filing Date: 19 December 2000 Priority Date: 23 December 1999 Attorney Docket No.:100163-IP US For: COMPOUNDS AND METHODS FOR THE TREATMENT OF PAIN	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 1.137(a)," filed 25 March 2004. This petition is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181. Accordingly, no petition fee is required.

BACKGROUND

On 18 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1), a copy of the international application as required by 35 U.S.C. 371(c)(2). An oath as required by 35 U.S.C. 371(c)(4) was not filed.

On 26 August 2002, the United States Designated/Elected Office (DO/EO) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date, and a surcharge for providing the oath or declaration later than 30 months from the priority date must be submitted within two months of the date of the Notification or by 32 months from the priority date, whichever is later. The period for response expired 26 October 2002, two months from the mail date of the Notification.

On 26 October 2002, the application became abandoned because applicants failed to respond to the Notification within the time period provided.

On 25 March 2004, applicants filed the petition to revive including a statement that the Notice was never received by ASTRAZENECA PHARMACEUTICALS LP at the address associated with the Customer Number 22466. Filed with the petition was a copy of the Log of Incoming USPTO Mail for the dates 17 July 2002 through 01 July 2003, regarding which applicants state that every document from the USPTO was logged in by date, docket number, type of document, and number of pages. The Log purportedly shows that the Notice was never received. The petition was not accompanied by a fee.

DISCUSSION

Pursuant to 1156 OG 53, under the section "Withdrawing the Holding of Abandonment When Office Actions are Not Received", the OG Notice states in part

> "The showing required to establish the failure to receive an Office actio[n] must consist of a statement from the practitioner stating that the Office action 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."

In order to establish non-receipt of an Office action, applicants must provide: (1) a statement 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 and docketed attached to and referenced in the practitioner's statement.

A review of the papers filed 25 March 2003 reveals that the evidence submitted by applicants is *insufficient* to establish that the 26 August 2002 Notification was not received by applicants and, consequently, that the abandonment was unavoidable. Applicants have provided a statement from the practitioner, Kenneth F. Mitchell, stating that the Notification was not received, which satisfies element (1) above. Although the practitioner attests that a search of a log of incoming mail for the Notification was made and although a copy of the log is attached to the petition, such a log does not constitute a *docket* as required by the OG Notice. 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 the practitioner's statement. Thus, what the Office now requires, as set forth in the OG notice, are the docket reports for the law firm for when the response is due. Thus, the required evidence is the docket report for the time period of 26 October 2002 (when the oath or declaration fees were due). Additionally, there has been no statement provided by the practitioner attesting that a search of the *file jacket* indicates that the Notification was not received. Therefore, elements (2) and (3) above have not been satisfied.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **Dismissed**.

Also, for the reasons above, the petition under 37 CFR 1.137(a) is **Dismissed**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

A proper response must include an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for submitting the oath or declaration later than 30 Months from the priority date.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner of Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jim Foster
Detail
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

09 SEP 2004

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Kenneth F. Mitchell
ASTRAZENECA PHARMACEUTICALS LP
Global Intellectual Property
1800 Concord Pike
Wilmington, DE 19850-5437

In re Application of :
BROWN, Dean Gordon *et al* :
U.S. Application No.: 10/168,755 :
PCT No.: PCT/SE00/02610 :
Int. Filing Date: 19 December 2000 :
Priority Date: 23 December 1999 :
Attorney Docket No.: 100163-1P US :
For: COMPOUNDS AND METHODS FOR :
THE TREATMENT OF PAIN :

DECISION ON RENEWED PETITION UNDER 37 CFR 1.181

This decision is in response to applicants' "Renewed Petition Under 37 C.F.R. § 1.181" filed 23 July 2004.

BACKGROUND

On 21 May 2004, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed due to applicants' failure to provide a copy of the docket record where the nonreceived Office Action would have been entered had it been received and docketed.

On 23 July 2004, applicants filed this renewed petition which was accompanied by, *inter alia*, an executed declaration and a copy of a computer docket entry for the above-captioned application.

DISCUSSION

As previously indicated, the showing required to establish the failure to receive an Office communication consists of: (1) a statement from the practitioner declaring that the Office communication was not received by the practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and, (3) 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 practitioners' statement. Petitioners failed to satisfy items (2) and (3) in the initial petition.

In the renewed petition, counsel states that "a search made by me personally of the file jacket and docket records where the nonreceived Office Action would have been

entered had it been received, a copy of which is enclosed herewith, indicates that the Office action was not received." This satisfies item (2).

Petitioners also submitted a copy of a computer docket sheet containing information on Docket Number 100163 only. A review of this record does not indicate that the Notification of Missing Requirements mailed 26 August 2002 was received. However, this docket record does not satisfy the requirement outlined in § 711.03(c) of the MPEP which states, in part:

> 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. (Emphasis added).

A single document containing only docket information on the U.S. application in question shows no other corroborating information to add weight and credibility to the information contained therein and can be too easily manipulated. In order to satisfy the docket record requirement to prove nonreceipt of an Office communication, applicants must provide a copy of counsel's docket records for the date upon which a response to the Notification of Missing Requirements was due (*i.e.*, 26 October 2002). An example of such a record would be a daily "tickler" report or a daily log showing all applications for which a response is due on that date. The docket report showing only the subject application does not satisfy this requirement.

Therefore, item (3) is not yet satisfied.

CONCLUSION

Applicants' renewed petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The subject application remains **ABANDONED**.

Applicants provided an executed declaration in compliance with 37 CFR 1.497(a) and (b) with the renewed petition as requested. The $130.00 surcharge fee has been charged to Deposit Account No. 26-0166 as authorized.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any

reconsideration request should include a copy of the complete docket record for the date upon which a response to the Notification of Missing Requirements was due. No fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-645;
(571) 273-3302 (after 30 September 2004)

18 NOV 2004

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Kenneth F. Mitchell
ASTRAZENECA PHARMACEUTICALS LP
Global Intellectual Property
1800 Concord Pike
Wilmington, DE 19850-5437

In re Application of
BROWN, Dean Gordon *et al*
U.S. Application No.: 10/168,755
PCT No.: PCT/SE00/02610
Int. Filing Date: 19 December 2000
Priority Date: 23 December 1999
Attorney Docket No.: 100163-1P US
For: COMPOUNDS AND METHODS FOR THE TREATMENT OF PAIN

DECISION ON RENEWED PETITION UNDER 37 CFR 1.181

This decision is in response to applicants' "Response to Decision on Renewed Petition Under 37 C.F.R. § 1.181" filed 20 September 2004.

BACKGROUND

On 09 September 2004, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed due to applicants' failure to provide a copy of the global docket record for the time period where a response was required.

On 20 September 2004, applicants filed this renewed petition which was accompanied by, *inter alia*, two computer logs showing all actions docketed for Kenneth Mitchell and for all U.S. actions docketed for all AstraZeneca's attorneys during the period of 26-28 October 2002.

DISCUSSION

The above-captioned application was abandoned for failure to respond to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) mailed 26 August 2002. Applicants claim that the Form PCT/DO/EO/905 was never received.

However, applicants have been unable to provide all the evidence required to show that the office action was not received. *See* § 711.03(c) MPEP. Specifically, applicants failed to provide a copy of the docket record showing all applications for which a response was due on 26 October 2002.

In this renewed petition, applicants have provided a copy of the computer log

showing all actions docketed for Kenneth Mitchell during the period of 26-28 October 2002 and a copy of a computer log for all U.S. actions docketed for all AstraZeneca's attorneys during this same period. Counsel also reveals how all actions are entered in the law firm's electronic docketing system and "docketed as to the due dates for response and as to any permissible extensions." Counsel also explains that the docket provided includes 28 October 2002 since the due date of 26 October 2002 was a Saturday.

A review of both logs verifies that the Form PCT/DO/EO/905 mailed in the above-captioned application on 26 August 2002 was not received. The docket number 100163 of the above-captioned application was not listed. Applicants have now met all elements required to establish nonreceipt of an Office action.

CONCLUSION

In view of the above, the renewed petition to withdraw the holding of abandonment is **GRANTED**.

The Notice of Abandonment mailed 04 March 2004 is hereby **VACATED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 19 December 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 23 July 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OCT 19 2005

MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH NY 10510-9227

In re Application of ERSOY et al. Application No. 10/168,769 Filed: June 19, 2002 For: CONTROL DEVICE FOR THE BRAKING SYSTEM OF A MOTOR VEHICLE	: : : : :	DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office (USPTO), on May 12, 2005. There is no fee for this petition.

The petition is **DENIED**.

A review of the file record indicates that a Notice of Abndoenment was mailed on March 30, 2004 for failure to respond to the Office Action mailed May 05, 2003 which set forth a three-month, extendable period in which to respond.

Applicant requests withdrawal of holding of abandonment as he contends that a response was timely filed on August 05, 2003. A copy of the alleged August 05, 2003 response was faxed to Examiner Sy on December 17, 2003. On January 23, 2004 Applicant's representative was notified that the copy received December 17, 2003 failed to include a Certificate of Transmission as alleged by applicant. Applicant submitted by fax on January 26, 2004 a Certificate of Transmission and a Statement under 37 CFR 1.8(b)(3). The January 26, 2004 submission was resubmitted on April 05, 2004 as there was some confusion as whether or not all seven pages were received and scanned into the electronic file. All seven pages submitted on January 26, 2004 and resubmitted on April 05, 2004 have been received and scanned into the electronic file.

Petitioner's evidence of a timely filing based on a Certificate of Transmission is considered to be insufficient. In this regard, any petition to withdraw the holding of abandonment based upon a Certificate of Transmission must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission or Mailing which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the original response on the date indicated on the Certificate of Mailing (see 37 CFR 1.8 and MPEP 512), by the person who signed the certificate.

The Certificate of Transmission is not acceptable evidence to accord the August 05, 2003 filing date to the copy of the response as is fails to fully identify the papers of the response it accompanied and thus fail to meet requirement (1) above. When a Certificate of Mail or Transmission is presented on a separate sheet, the sheet must fully identify the paper(s) it accompanied. Without the proper identifying data, the Certificate of Mail or Transmission will not be acceptable evidence to accord the filing date of the original to the copy. MPEP 512. There is nothing identifying an amendment and terminal disclaimer on the Certificate of Transmission.

The transmission verification report generated by the fax machine sending the amendment and referenced in the 37 CFR 1.8(b)(3) Statement is not acceptable evidence to accord the August 05, 2003 filing date to the copy of the response, as there is nothing serving to identify exactly what was submitted and thus no "tie-in" between the copy of the submission and the receipt date.

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.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive. The required items should be promptly submitted under a cover letter entitled "Petition to Revive."

Further correspondence with respect to a petition to revive should be addressed as follows:

By Mail: Deputy Commissioner of Patent Examination Policy
Box 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 should be directed to the Office of Petitions Staff at (571) 272-3282.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6587

KJD/rjc 10/06/05

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

Paper No. None

MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH NY 10510-9227

COPY MAILED

MAR 17 2006

OFFICE OF PETITIONS

In re Application of
Metin Ersoy et al.
Application No. 10/168,769
Filed: June 19, 2002
Attorney Docket Number: 70549
Title: CONTROL DEVICE FOR THE BRAKING SYSTEM OF A MOTOR VEHICLE

DECISION ON RENEWED PETITION UNDER 37 C.F.R. §1.181

This is a decision on the renewed petition filed December 13, 2005, pursuant to 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed May 5, 2003, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on August 6, 2003. A notice of abandonment was mailed on March 30, 2004.

With the original petition, submitted on May 12, 2004, Petitioner asserted that a response to this communication was timely submitted via facsimile transmission on August 5, 2003. The original petition was dismissed via the mailing of a decision on October 19, 2005.

With this renewed petition, Petitioner has again requested that the holding of abandonment in the above-identified application be withdrawn. It is clear that a response was timely submitted. Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that petitioner has met his burden of establishing that a submission was timely submitted.

Accordingly, the petition under 37 C.F.R. §1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN.**

The Technology Center will be notified of this decision.

It is noted in passing that a copy of the transmission of August 5, 2003 was re-submitted to the Office on December 17, 2003, and this 16 page submission consists of a 1 page cover sheet, a 1 page amendment to the specification, 5 pages of claims, 7 pages of remarks, and a 2 page terminal disclaimer.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FEB 23 2005

MAILED
FEB 23 2005
OFFICE OF THE DIRECTOR
TC 3600

William Collard
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

In re Application of
Bernhard Riepler
Application No. 10/168,776
Filed: October 28, 2002
For: BOARD-LIKE GLIDING DEVICE, IN PARTICULAR A SKI OR SNOWBOARD

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on September 27, 2004.

The petition is **DISMISSED**.

A review of the file record reveals that a First Office Action rejection was mailed January 26, 2004, setting a three-month shortened statutory period for response. Since no reply was received from applicant before the expiration of the six-month statutory period for reply, the application became abandoned at midnight on July 26, 2004. A Notice of Abandonment was mailed on September 23, 2004.

The present petition indicates that a response was filed by mail on April 19, 2004. In support thereof, petitioner submits a copy of a response that includes a Certificate of Mailing signed by Maria Guastella, and dated April 19, 2004. Applicant also submits a post card receipt showing a USPTO date stamp of May 11, 2004. Since the postcard receipt has a date stamp outside the period for reply, which ended at midnight on April 26, 2004, and no extensions of time were purchased, applicant cannot rely on the postcard receipt and must rely on the Certificate of Mailing, dated April 19, 2004, to show that the response was timely filed.

Any petition to withdraw the holding of abandonment based upon a Certificate of Mailing must provide the following:

(1) A copy of the original response bearing a signed Certificate of Mailing which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) <u>by the person who signed the certificate</u> attesting to the personal knowledge of mailing the response on the date indicated on the Certificate of Mailing (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above, the petition fails under requirement (2) to provide a proper statement under 37 CFR 1.8(b)(3) attesting to personal knowledge of sending the

original response by mail on the date indicated on the certificate, by the person who signed the certificate, in this instance Maria Guastella.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.181."

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/rwg: 2/03/05

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 12 2005

William Collard
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

In re Application of Bernhard Riepler Application No. 10/168,776 Filed: October 28, 2002 For: BOARD-LIKE GLIDING DEVICE, IN PARTICULAR A SKI OR SNOWBOARD	: : : :	**DECISION ON RENEWED PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is a decision on the Petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on March 17, 2005.

The petition is **GRANTED** in view of the following evidence of timely filing:

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____.

☒ Certificate of Mailing/Transmission signed on April 19, 2004, and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted, dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

☐ Originally sent response, filed_____.

This application is being forwarded to the Supervisory Legal Instruments Examiner for withdrawal of the abandonment and then to the examiner for prompt action.

KJD/js: 8/2/05

KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

May 17, 2006

Patent No. : 7,011,331 B2
Ser. No. : 10/168,776
Inventor(s) : Hiroshi Takumori, et al.
Issued : March 14, 2006
Title : **BOARD-LIKE GLIDING DEVICE, IN PARTICULAR A SKI OR SNOWBOARD**
Docket No. : **RIEPLER-2(PCT)**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Antonio Johnson
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 111 or (703) 308-8309

WILLIAM COLLARD
COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN NY 11576

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FRISHAUF HOLTZ GOODMAN & CHICK PC
220 FIFTH AVENUE
16TH FLOOR
NEW YORK NY 10001-7708

COPY MAILED
DEC 15 2006
OFFICE OF PETITIONS

In re Patent No. 7,098,226	:	DECISION ON
Ban, et al.	:	PATENT TERM ADJUSTMENT
Issue Date: August 29, 2006	:	AND NOTICE OF INTENT
Application No. 10/168,777	:	TO ISSUE
Filed: June 21, 2002	:	CERTIFICATE OF
Attorney Docket No. 02336/HG	:	CORRECTION

This is a decision on the "REQUEST FOR REINSTATEMENT FOR ALL OF THE PERIOD OF ADJUSTMENT REDUCED BY THE PATENT OFFICE", filed September 7, 2006. Patentees request that the patent term adjustment indicated on the patent be corrected from three hundred twenty (320) days to four hundred forty (440) days.

The petition is **GRANTED**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **four hundred forty (440)** days.

On August 29, 2006, the above-identified application matured into U.S. Patent No. 7,098,226. The instant request for reconsideration filed September 7, 2006 was timely filed within two months of the date the patent issued. See §1.705(d). The Patent issued with a Patent Term Adjustment of three hundred twenty (320) days.

Patentees fail to state whether the patent is subject to a terminal disclaimer.

A review of the application filed reveals that applicants were assessed delay of one hundred twenty (120) days for the submission of a "SUBSTANCE OF INTERVIEW" on February 16, 2006. A Substance of Interview is not identified as one of the papers the filing of which the Director has specifically deemed not to be a failure to engage in reasonable efforts under 37 C.F.R. §1.704(c)(10).[1] Nevertheless, under the circumstances of this case, it is concluded that the filing of applicants' "SUBSTANCE OF INTERVIEW" is not a failure to engage under 37 C.F.R. §1.704(c)(10). Accordingly, the assessment of one hundred twenty (120) days of applicant delay with respect to this filing is not warranted.

In view thereof, the correct determination of PTA at the time of issuance is four hundred forty (440) days (539 days of PTO delay and 99 days of applicant delay).

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **four hundred forty (440))** days subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enc: draft certificate of correction

---

[1] See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. 111 (June 26, 2001).

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,098,226 B2

DATED : August 29, 2006

INVENTOR(S) : Ban, 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 (320) days

Delete the phrase "by 320 days" and insert – by 440 days—

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.go

MAIL

Paper No. 5

MAR 1 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of
Wijnand Van Stam
Application No. 10/168,782
Filed: June 21, 2002
For: **INTELLIGENT PEER-TO-PEER SYSTEM AND METHOD FOR COLLABORATIVE SUGGESTIONS AND PROPAGATION OF MEDIA**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request For Withdrawal as Attorney or Agent of record filed on January 13, 2004.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Attorneys/agents listed in the request to withdraw are withdrawn.

It is noted that the Attorney of Record did not check either box within the request indicating a change of address. However, based upon the fact a new address was incorporated within the request and also indicated within the letter attached to the request, the combination of the aforementioned evidence will be construed as a request to change the correspondence address. All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

The file is being returned to TC 2600 Central Files to await examination in appropriate turn.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

Cc: Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, CA 95125-5106

12 MAR 2003

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MILLEN WHITE ZELANO & BRANIGAN
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201

In re Application of	:	
PETROV, Orlin, et al.	:	
U.S. Application No.: 10/168,794	:	COMMUNICATION
PCT No.: PCT/EP00/13027	:	
International Filing Date: 20 December 2000	:	
Priority Date: 23 December 1999	:	
Attorney's Docket No.: SCH 1890	:	
For: METHOD FOR PRODUCING 4-(HETERO-ARYL-METHYL)-HALOGEN-1(2H)-PHTH-ALAZINONES	:	

This application is before the PCT Legal Office for issues arising under 35 U.S.C. 371.

BACKGROUND

On 20 December 2000, applicants filed international application PCT/EP00/13027 which claimed a priority date of 23 December 1999 and which designated the United States. On 05 July 2001, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 05 May 2001, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 24 June 2002 (23 June 2002 was a Sunday).

On 24 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 05 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements indicating that a declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than thirty months after the priority date were required.

On 01 November 2002, applicants filed a "Response To Notification Of Missing Requirements" accompanied by the required surcharge and an executed declaration.

DISCUSSION

The published international application identifies one of the four inventors as Tamas HEINER. On the declaration filed 01 November 2002, the "Tamas" in this inventor's name has been crossed out and replaced by "Thomas." The change was made in handwriting, and is not initialed (the citizenship of this inventor has also been changed on the declaration, from Hungary to German, in a second uninitialed, handwritten notation).

Applicants must provide clarification as to why the name for this inventor is listed differently in the international application and the present declaration. If factually appropriate, a proper response could be a statement that the name published in the international application resulted from a typographical or transliteration error, and that the correct name for this inventor is Thomas, as set forth in the present declaration.

In addition, a new copy of the declaration is required in which the handwritten changes to the name and citizenship information for Mr. HEINER have been initialed by such inventor.

CONCLUSION

As set forth above, the declaration filed on 01 November 2002 cannot be accepted under 37 CFR 1.497.

Applicants must file an acceptable explanation regarding the discrepancy between inventor HEINER's first name in the declaration and in the published international application, and they must submit a corrected declaration in which inventor HEINER has verified the handwritten changes in his first name and citizenship contained in the declaration filed 01 November 2002.

Applicants must reply within **TWO (2) MONTHS** from the mail date of this decision. Failure to file a proper response in a timely manner will result in **ABANDONMENT** of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

17 SEP 2003

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MILLEN WHITE ZELANO & BRANIGAN
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201

In re Application of	:	
PETROV, Orlin, et al.	:	
U.S. Application No.: 10/168,794	:	DECISION
PCT No.: PCT/EP00/13027	:	
International Filing Date: 20 December 2000	:	
Priority Date: 23 December 1999	:	
Attorney's Docket No.: SCH 1890	:	
For: METHOD FOR PRODUCING 4-(HETERO-ARYL-METHYL)-HALOGEN-1(2H)-PHTH-ALAZINONES	:	

In a Communication mailed by this Office on 12 March 2003, applicants were informed that the declaration filed on 01 November 2002 could not be accepted. Specifically, the Communication stated that an explanation was required for the discrepancy between inventor Heiner's first name in the international application (Tamas) and in the declaration (Thomas), and that Mr. Heiner's initialization of the handwritten change in his citizenship was required.

On 11 June 2003, applicants filed the response considered herein (with the required one month extension fee). The response included a statement by inventor Heiner that his name had been changed from Tamas to Thomas. The submission also included a copy of the declaration on which Mr. Heiner initialed the name and citizenship changes.

The 11 June 2003 submission makes clear that the discrepancy in inventor Heiner's name was not the result of a typographical error, but rather an official change of name. In instances where an inventor has changed his or her name after the application has been filed, the Manual of Patent Examining Procedure at § 605.04(c) requires a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and "an affidavit signed by the inventor **with both names** setting forth the procedure whereby the change of name was effected, or certified copy of the court order." Here, applicants' 11 June 2003 submission included the authorization to charge Deposit Account No. 13-3402 for required fees. Based on this authorization, Deposit Account No. 13-3402 will be charged the required $130 petition fee. However, applicants have not submitted the required affidavit signed by Mr. Heiner in both his former and present names (Mr. Heiner signed only in his present name). Applicants have therefore not provided the requirements for a grantable petition to change the inventor's name.

Based on the above, the name-of-record for Mr. Heiner here remains Tamas Heiner, as set forth in the international application. The declaration filed on 01 November 2002 is therefore defective (on the present record) for failure to properly identify all the inventors herein.

CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Tamas HEINER to Thomas HEINER is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to file a renewed petition under 37 CFR 1.182. Such renewed petition must include the required affidavit from the inventor whose name has changed, singed with both his former and present names, as discussed above.

Failure to file a timely and proper response will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

09/24/2003 SHAJARRO 00000011 133402 10168794
01 FC:1460 130.00 DA

17 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

#9

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MILLEN WHITE ZELANO & BRANIGAN
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201

In re Application of	:	
PETROV, Orlin, et al.	:	
U.S. Application No.: 10/168,794	:	DECISION ON PETITION
PCT No.: PCT/EP00/13027	:	UNDER 37 CFR 1.182
International Filing Date: 20 December 2000	:	
Priority Date: 23 December 1999	:	
Attorney's Docket No.: SCH 1890	:	
For: METHOD FOR PRODUCING 4-(HETERO-	:	
ARYL-METHYL)-HALOGEN-1(2H)-PHTH-	:	
ALAZINONES	:	

In a decision issued by this Office on 17 September 2003, applicants were informed that a petition under 37 CFR 1.182 was required to correct the name of applicant Tamas Heiner to Thomas Heiner, the name in which he executed the filed declaration.

On 14 November 2003, applicant filed the "Renewed Petition Under 37 CFR 1.182" considered herein. The petition includes the required statement from the inventor signed in both names and explaining the name change. Applicants had previously been charged the required petition fee. Applicants have therefore now provided all the requirements for a grantable petition.

The petition under 37 CFR 1.182 is **GRANTED**. The name of record for the pertinent inventor is corrected to Thomas Heiner. Based on this correction, the declaration filed by applicants on 11 June 2003 is now acceptable under 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 11 June 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/5/07

TO SPE OF : ART UNIT 3635

SUBJECT : Request for Certificate of Correction on Patent No.: 6840017 B1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

Carl D. Friedman
Supervisory Patent Examiner
Group 3600
SPE

3635
Art Unit

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.
10/168,803	11/12/2002	Timothy Martin Coker	699.41726X00	2477

20457 7590 05/06/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER
BEN, LOHA

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/108,803			

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.

☐ A reply (with Certificate of Mailing or Transmission of _____) was received on _____ which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

☐ A proposed reply was received on _____ , but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

☐ A reply was received on _____ , but it does not constitute a proper reply, or a *bona fide* attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in the last box below).

☐ No reply has been received.

☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85)(or Notice of Publication Fee Due).

☐ The submitted fee of $_____ is insufficient. A balance of $ _____ is due.
The issue fee by 37 CFR 1.18 is $_____ . The publication fee, if required, by 37 CFR 1.18(d) is $_____.

☒ The issue fee and publication fee, if applicable, have not been received.

☐ Applicant's failure to timely file corrrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).

☐ Proposed corrected drawings were received on_____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.

☐ No corrected drawings have been received.

☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all the applicants.

☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon filing of a continuing application.

☐ The decision by the Board of Patent Appeals and Interferences rendered on_____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ The reason(s) below: _____

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

UNITED 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.5

MAIL

MAR 0 5 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of
ALI et al.
Application No. 10/168,808
Filed: June 21, 2002
For:

INTELLIGENT SYSTEM AND METHODS OF RECOMMENDING MEDIA CONTENT ITEMS BASED ON USER PREFERENCES

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as agent of record filed on January 13, 2004.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Attorneys/agents listed in the Request to withdraw are withdrawn.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

The file is being returned to TC 2600 Technical Support Staff to update the correspondence address and then will be forwarded to the files repository.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

Cc: Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, CA 95125-5106

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : September 19,2007

TO SPE OF : ART UNIT 2624

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/168,811 Patent No.: 7233691 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

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: _____

Matthew C. Bella

MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

2624
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

#10

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE WA 98104-7092

MAILED

OCT 1 2003

Office of the Director
Group 3600

Paper No. 10

In re Application of:
Aloys Wobben
Serial No. 10/168814
Filed: October 7, 2002
For: BUTT JOINT FOR HOLLOW PROFILES

DECISION ON PETITION TO MAKE SPECIAL (ENERGY)

This is a decision on the petition filed July 7,2003 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 is *"related to a wind power installation that generates electricity"* and that "*wind power is one type of energy than can generate electrical power without incurring pollution to air, water or soil*". Specifically, "*generating electrical power from wind power requires no coal, petroleum, wood, or other consumable resources and therefore maintains and preserves the living environment*". These statements, are inadequate to establish for the record that the invention "the discovery or development of energy resources " or "the more efficient utilization and conservation of energy". Applicant has described how wind power in general materially enhances the quality of the environment but has not provided a link or relationship between how the present invention itself, "a butt joint", adds to the discovery or development of energy resources. Further, applicant provides no evidence as to how the "butt joint" offers more efficient utilization or how it conserves energy. Since applicant's invention is not to wind power itself but rather to a butt joint applicant must provide explanation as to how the butt joint contributes to the discovery or development of energy resources or in the alternative specifically how it provides conservation of energy.

For the above stated reasons, the petition is **DISMISSED**.

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/ekn: 9/17/03

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

COPY MAILED

AUG 3 1 2004

OFFICE OF PETITIONS

In re Application of	:
Andrey Livchak and Philip Meredith	:
Application No. 10/168,815	: DECISION ON PETITION
Filed: May 5, 2003	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 243/302 U.S.	:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 15, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to prior-filed provisional Application No. 60/175,208, filed January 10, 2000, as set forth in a concurrently filed amendment.

The petition is **DISMISSED**.

A review of this application file discloses that the instant application was filed on June 24, 2002 as a national stage entry of International PCT/US01/00770. The first claim made for priority to the above-noted provisional application appears in the oath filed on May 5, 2003. However, this claim was not presented within the time period provided by 37 CFR 1.78(a)(5)(ii). Accordingly, as this application has a filing date after November 29, 2000 and the claim for priority was not made within the period specified in 37 CFR 1.78(a)(5)(ii), this is a proper petition under 37 CFR 1.78(a)(6).

A petition under 37 CFR 1.78(a)(6) must be filed during the pendency of the nonprovisional application and must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition fails to satisfy item (1) above. In this regard, the amendment to add a claim for priority to the above-noted, prior-filed provisional application states: "This is [a] continuation

of International Application No. PCT/US01/00770, filed January 10, 2001 which claims the benefit of US Provisional Application 60/175,208, filed January 10, 2000." Since the instant application is the national stage entry of International Application PCT/US01/00770, the instant application is incorrectly denoted as a "continuation." It is merely enough to indicate in the amendment (or in an ADS in accordance with 37 CFR 1.76(a)(5)) that the instant application claims priority to provisional Application No. 60/175,208, filed January 10, 2000.

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment[1] deleting the improper reference of this application as a continuation of the above-noted PCT application, along with a renewed petition under 37 CFR 1.78(a)(6), is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Window located at: U.S. Patent and Trademark Office 220 20th Street S Customer Window, Mail Stop Petitions Crystal Plaza Two Lobby, Room 1B03 Arlington, VA 22202
By fax:	(703) 872-9306 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.[2]

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] *Note* 37 CFR 1.121

[2] Effective September 27, 2004, the phone number will be 571-272-3218.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

COPY MAILED

SEP 2 2 2004

OFFICE OF PETITIONS

In re Application of	:	
Livchak et al.	:	
Application No. 10/168,815	:	DECISION GRANTING PETITION
Filed: May 5, 2003	:	UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 243/302 U.S.	:	

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed September 14, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application is the national stage entry of International Application No. PCT/US01/00770, which was filed on January 10, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/175,208, which was filed on January 10, 2000, for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Also, the reference to the prior-filed provisional application was submitted during the pendency of the nonprovisional application for which the benefit is sought. *See* 35 U.S.C. §119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §119(e), the petition to accept an unintentionally delayed claim of benefit to prior-filed provisional Application No. 60/175,208 is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Paralegal Liana Chase at (703) 306-0482 or at (571) 272-3206 after September 28, 2004.

The application is being forwarded to Technology Center AU 3749 for appropriate action on the amendment submitted September 14, 2004, including consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No. 60/175,208.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 5

MAIL

MAR 1 0 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of
BEACH et al.
Application No. 10/168,839
Filed: June 21, 2002
For:

DISTRIBUTED , INTERACTIVE TELEVISION PROGRAM GUIDE; SYSTEM AND METHOD

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as agent of record filed on January 13, 2004.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Attorneys/agents listed in the Request to withdraw are withdrawn.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

The file is being returned to TC 2600 Technical Support Staff to update the correspondence address and then will be forwarded to the files repository.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

Cc: Hickman Palermo Truong & Becker LLP
1600 Willow Street
San Jose, CA 95125-5106

Ex. Ngoc Vu

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20070711

DATE : 6/20/07

TO SPE OF : ART UNIT 2623

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/168,839 Patent No.: 7228556

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:

CLAIM 20, line 56 does NOT Apply
CLAIM 45, line 7 does NOT Apply

SPE, ACTING — 2623 Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

AUG 14 2007

OFFICE OF PETITIONS

THOMAS J. KOWALSKI, ESQ.
FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

In re Application of	:	
Tomas Hanke et al	:	
Application No. 10/168,843	:	DECISION ON PETITION
Filed: September 24, 2002	:	
Attorney Docket No. 111438-151	:	

This is a decision on the petition, filed March 15, 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 Restriction Requirement (Office Action) mailed September 29, 2005, which set a one (1) month shortened statutory period for reply. A Notice of Abandonment was mailed on May 16, 2006.

Petitioner asserts that the Office action dated September 29, 2005 was not received.

A review of the written record indicates an irregularity in the mailing of the Office action of September 29, 2005. In this regard, the Office received an Associate Power of Attorney/change of address on January 15, 2004, prior to the mailing of the Office action of September 29, 2005. Office records were not updated to reflect this new change of address. Accordingly, as the Office action was mailed to an incorrect address, the Notice of Abandonment mailed May 16, 2006 is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to Technology Center Art Unit 1648 to consider the Response/Election of March 15, 2007.

Karen Creasy
Petitions Examiner
Office of Petitions

1 0 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

The Procter & Gamble Company
Intellectual Property Division
Winton Hill Technical Center - Box 161
6110 Center Hill Avenue
Cincinnati, OH 45224

In re Application of SCHMIDT et al	:	
U.S. Application No.: 10/168,878	:	
Int. Application No.: PCT/US00/34743	:	DECISION
Int. Filing Date: 20 December 2000	:	
Priority Date: 23 December 1999	:	
Attorney Docket No.: CM2260Q	:	
For: LIQUID HANDLING MEMBER WITH A	:	
MEMBRANE ASSEMBLY COMPRISING A	:	
MEMBRANE WETTING REGION	:	

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a)" filed 07 March 2003.

BACKGROUND

On 20 December 2000, applicant filed international application PCT/US00/34743, which claimed priority of an earlier European Patent Office application filed 23 December 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 April 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2002.

On 21 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, inter alia, the basic national fee required by 35 U.S.C. 371(c)(1).

On 26 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 March 2003, applicant filed the present petition under 37 CFR 1.137(a) including an executed declaration.

DISCUSSION

The Notification of Missing Requirements set a two month time period for response. The response period was extendable by five months under 37 CFR 1.136(a). Thus, the deadline for responding to the Notification of Missing Requirements was 26 March 2003. Because the transmittal letter filed 21 June 2002 included an authorization to charge any required fees to a deposit account, the executed declaration filed 07 March 2003 was timely filed and the application was never abandoned.

Even though the petition under 37 CFR 1.137(a) is moot because the application was never abandoned, applicant is advised that the present petition does not contain an adequate showing that abandonment of the present application, if such were the case, was unavoidable. Specifically, applicant could have filed a petition under 37 CFR 1.47(a).

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(a) is DISMISSED AS MOOT.

The application has an International Filing Date under 35 U.S.C. 363 of 20 December 2000 and a date under 35 U.S.C. 371(c) of 07 March 2003.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision including: (1) charging $1,960.00 to Deposit Account No. 16-2480 for a five month extension of time and (2) charging $130.00 to Deposit Account No. 16-2480 for the surcharge set forth in 37 CFR 1.492(e).

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

14 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Michael Striker
Striker, Striker & Stenby
103 Neck Road
Huntington, New York 11743

In re Application of	:	
WEIGOLD et al.	:	
U.S. Application No. 10/168,902	:	DECISION ON PETITION
PCT No.: PCT/DE01/03624	:	
Int. Filing Date: 20 September 2001	:	
Priority Date: 25 October 2000	:	
Attorney Docket No.: 2174	:	
For: ELECTRIC-MOTOR-DRIVEN PUMP AND METHOD FOR REDUCING SUCH A PUMP	:	

This is a decision on applicants' "Petition Pursuant to 37 CFR 1.47(a) to Accept Patent Application Without the Signature of All Inventots" filed 30 January 2003 to accept the application without the signature of joint inventor, Matthias Schmitz. The required petition fee of $130 (37 CFR 1.17) will be charged to Deposit Account no. 19-4675.

BACKGROUND

On 20 September 2001, applicants filed international application PCT/DE01/03624 which claimed a priority date of 25 October 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 02 May 2002.

On 21 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; and an unexecuted declaration.

On 26 August 2002, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 January 2003, applicants filed the present petition under 37 CFR 1.47(a) and a three-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) has been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application paper should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition reveals that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Matthias Schmitz. No documentary evidence to support the refusal or the attempt was provided in the petition.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Matthias Schmitz and when such papers were sent and that Matthias Schmitz has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

With regard to Item (3), petitioner has not provided a statement of the last known address of the missing inventor.

As to Item (4), a review of the declaration filed on 30 January 2003 reveals that declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes duplicate sheets. It is unclear if the inventors were presented with only their signature page, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 30 January 2003, which is improper. (See MPEP 201.03, Page 200-7) Therefore, in order to satisfy this item, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Matthias Schmitz under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Facsimile: 703-308-6459

DT14 R PCT/PTO 16 SEP 2003

PCT

OIPE JC95 SEP 16 2003 PATENT & TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: *Attorney Docket #:* 2174

In re:

Applicant: WEIGOLD, T., et al

Serial No.: 10/168,902

Filed: June 21, 2002

For: ELECTRIC-MOTOR-DRIVEN PUMP, AND METHOD FOR PRODUCING SUCH PUMP

RESPONSE TO DECISION ON PETITION

September 11, 2003

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, Virginia 22313-1450

Attention: Office of PCT Legal Administration

Reference is made to the Decision on Petition dated April 14, 2003. .

Applicant now submits herewith a Declaration of Karin Mindner, a secretary employed by the assignee of the subject invention. In her Declaration, Karin Mindner states that she sent the Declaration papers for signature to Matthias Schmitz, however, the papers were returned and Mr. Schmitz could not be located.

MAIL STOP DAC

10/21/2003 SNAJARRO 00000009 194675 10168902

01 FC:1253 930.00 DA

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
On 9/12/03

Further attached are emails which Karin Mindner circulated trying to locate a current address for Mr. Schmitz.

It thus appears clear that the applicant did make a diligent effort to try and find or reach Mr. Schmitz, but could not successfully do so.

The last known address of Mr. Schmitz is Eckberg Str. 19A, Baden-Baden, Germany.

It is noted that in the Petition to Accept the Application Without the Signature of an Inventor, the statement was made, upon information and belief, that the inventor had refused to sign the application papers. It now appears that this was a misunderstanding and that in fact inventor could not be reached despite diligent effort. This misunderstanding is regretted.

It has been noted that the Declaration filed with the Petition includes duplicate sheets and it is therefore unclear if the inventors were presented with only their signature page, in which case the execution would be improper. Counsel did not compile the Declaration into a single document.

The filing of a newly executed Declaration which complies with 37 C.F.R. 1.497(a)(b) has been required. Applicant intends to promptly file such a Declaration,

but delays have occurred in obtaining the signatures of all of the inventors, it being noted that some 12 inventors appear in the subject application.

It is requested that the extension fee be debited to the account of the undersigned #19-4675.

Respectfully submitted,

Michael J. Striker
Attorney for Applicant
Reg. No.: 27233
103 East Neck Road
Huntington, New York 11743

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) (Large Entity)	Docket No. 2174

In Re Application Of: **WEIGOLD, T., ET AL**

Serial No.	Filing Date	Examiner	Group Art Unit
10/168,902	06/21/2002		

Invention: **ELECTRIC-MOTOR-DRIVEN PUMP AND METHOD FOR REDUCING SUCH A PUMP**

OIPE JC95
SEP 16 2003
PATENT & TRADEMARK OFFICE

TO THE COMMISSIONER FOR PATENTS:

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of 06/14/2003 (*Date*) in the above-identified application.

The requested extension is as follows (check time period desired):

☐ One month ☐ Two months ☒ Three months ☐ Four months ☐ Five months

from: **JUNE 14, 2003** (*Date*) until: **SEPTEMBER 14, 2003** (*Date*)

The fee for the extension of time is **$930** and is to be paid as follows:

☐ A check in the amount of the fee is enclosed.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **19-4675**

☒ 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. **19-4675**

Signature

Dated: **SEPTEMBR 12, 2003**

I certify that this document and fee is being deposited on **SEP. 12, 2003** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature of Person Mailing Correspondence

MICHAEL J. STRIKER

Typed or Printed Name of Person Mailing Correspondence

cc:

OIPE JC95
SEP 16 2003
PATENT & TRADEMARK OFFICE

DECLARATION

I, **Karin Mindner**, hereby state the following:

At all times relevant hereto, I was and currently am a secretary employed by Robert Bosch GmbH, which was the employer of Matthias Schmitz.

On or about May 16, 2003, I sent a letter to Matthias Schmitz together with a Declaration and Assignment relating to the entry into the National Phase in the United States of PCT/DE01/03624. A copy of the letter and a translation thereof are attached hereto.

I did not receive a response from Matthias Schmitz and I eventually located another possible address for him. On August 8, 2002, I again sent an urgent letter to Matthias Schmitz asking that he sign the entry into the National Phase of PCT Application Serial No. PCT/DE01/03624. A copy of this letter and translation are attached hereto.

On October 29, 2002, I circulated an email among prior colleagues of the inventor Matthias Schmitz asking if anybody knew his current address, but nobody was aware of another address where he could be reached.

A copy of my email and the responses thereto are attached hereto.

I hereby declare that all statements made herein of my own knowledge are true and that all statements on information and belief are believed to be true; and further that those statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 10. Sept. 2003

Karin Mindner

KARIN MINDNER

OIPE JC95
SEP 16 2003
PATENT & TRADEMARK OFFICE

Erinnerung! 23. Mai 2003

Erinnerung! -4. Juni 2003

EILT SEHR!!! 24. Juni 2003

-4. Juli 2003

Herrn
Matthias Schmitz
Kananoher Str. 34

30855 Langenhagen

33181

ZGE4 Mindner 44846 16.05.2003
R. 39090

zurück an ZGE4-Frau Mindner

Nationale Phase in USA
Stichwort im Hause: Innenläufer - Motorpumpe

Sehr geehrter Herr Schmitz,

für den Eintritt in die nationale Phase in USA der obengenannten PCT-Anmeldung bitten wir Sie als Erfinder/Miterfinder um Ihre Unterschrift (ausgeschriebener Vor- und Zuname) an den bezeichneten Stellen des folgenden Formulars:

"Declaration" (Erfindererklärung)

Bitte verwenden Sie Tinte oder Kugelschreiber.

DIESER VORGANG EILT! Bitte senden Sie schnellstmöglich die unterzeichneten Unterlagen zurück an die

Robert Bosch GmbH
Patentabteilung ZGE4
Frau Mindner
Postfach 30 02 20

D-70442 Stuttgart

Vielen Dank!

Mit freundlichen Grüßen

ROBERT BOSCH GMBH
Zentralstelle Patente E4

C:\plasworkdir\Schmitz3.doc

OIPE JC95
SEP 1 6 2003
PATENT & TRADEMARK OFFICE

Mindner Karin (ZGE4)

Von: Stephan Kristina (ZGE4)
Gesendet: Freitag, 16. Mai 2003 09:52
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US eilt sehr!

30855 langenhagen

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Freitag, 16. Mai 2003 09:51
An: Stephan Kristina (ZGE4)
Betreff: AW: R. 39090 US eilt sehr!

In Ordnung - und die PLZ, Stadt?

Danke!

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH
ZGE4
Postfach 30 02 20
D-70442 Stuttgart
BOSCH
Tel.: ++49/(0)711/811-44846
Fax: ++49/(0)711/811-33181
email: karin.mindner@de.bosch.com

-----Ursprüngliche Nachricht-----
Von: Stephan Kristina (ZGE4)
Gesendet: Freitag, 16. Mai 2003 09:50
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US eilt sehr!

siehe telekomauskunft:
kananoher str. 34

ich trag es gleichmal in die erfinderdaten ein.
tina

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Freitag, 16. Mai 2003 09:47
An: Stephan Kristina (ZGE4)
Betreff: R. 39090 US eilt sehr!
Wichtigkeit: Hoch

16.05.03

Hallo Kristina,

könntest Du bitte vom Einwohnermeldeamt die neue Anschrift des Erfinders Matthias Schmitz herausfinden - seine ehemalige Anschrift war:
Tegeler Str. 14, 30853 Langenhagen.

Der Vorgang eilt sehr.

Vielen Dank!

Mit freundlichen Grüßen

OIPE JC95
SEP 1 6 2003
PATENT & TRADEMARK OFFICE

Mindner Karin (ZGE4)

Von: Zierer Gerald (BUEW/TEF14) *
Gesendet: Dienstag, 29. Oktober 2002 20:01
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US Eilt sehr!!

Fehlmeldung,seit H. Schmitz ausgeschieden ist, habe ich keinen Kontakt mehr zu ihm.

mit freundlichem Gruß

BüW/TEF14

G. Zierer

Tel.: 07223/ 82 1552
Fax:07223/ 82 7647
e-mail: gerald.zierer@de.bosch.com

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Dienstag, 29. Oktober 2002 10:34
An: Weigold Thomas (BE-WS/P-WDA) *; Zierer Gerald (BUEW/TEF14) *; Pfetzer Johannes (BE-ET/ENG2) *; Riehl Guenther (BE-EB/MOE3) *; Rocklage-Marliani Gerta (BhW/FVB11) *; Heidrich Torsten (FV/SLT1) *
Betreff: R. 39090 US Eilt sehr!!
Wichtigkeit: Hoch

29.10.02

Sehr geehrte Damen und Herren,

für eine Patentanmeldung in den USA benötigen wir dringend die neue Privatanschrift Ihres Miterfinders Herrn Matthias Schmitz. Vielleicht könnten Sie uns seine Anschrift oder auch seine Telefon-Nr. kurz per E-Mail mitteilen?

Für Ihre hiermit verbundene Mühe bedanken wir uns im Voraus.

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH
ZGE4
Postfach 30 02 20
D-70442 Stuttgart

BOSCH

Tel.: ++49/(0)711/811-44846
Fax: ++49/(0)711/811-33181
email: karin.mindner@de.bosch.com

OIPE JC95
SEP 1 0 2003
PATENT & TRADEMARK OFFICE

Mindner Karin (ZGE4)

Von: Pfetzer Johannes (BE-ET/ENG2) *
Gesendet: Dienstag, 29. Oktober 2002 11:12
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US Eilt sehr!!

Guten Tag Frau Mindner,

leider mir nicht bekannt.
Mir ist nur bekannt, dass H. Schmitz zu VW wechselte.

Mit freundlichen Grüßen

Johannes Pfetzer

Robert Bosch GmbH
Abt. BE-ET/ENG2
Postfach 1163
77813 Bühl
Johannes.Pfetzer@de.bosch.com
☎ ++49 (0)7223-82 3069
++49 (0)7223-82 7500

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Dienstag, 29. Oktober 2002 10:34
An: Weigold Thomas (BE-WS/P-WDA) *; Zierer Gerald (BUEW/TEF14) *; Pfetzer Johannes (BE-ET/ENG2) *; Riehl Guenther (BE-EB/MOE3) *; Rocklage-Marliani Gerta (BhW/FVB11) *; Heidrich Torsten (FV/SLT1) *
Betreff: R. 39090 US Eilt sehr!!
Wichtigkeit: Hoch

29.10.02

Sehr geehrte Damen und Herren,

für eine Patentanmeldung in den USA benötigen wir dringend die neue Privatanschrift Ihres Miterfinders Herrn Matthias Schmitz. Vielleicht könnten Sie uns seine Anschrift oder auch seine Telefon-Nr. kurz per E-Mail mitteilen?

Für Ihre hiermit verbundene Mühe bedanken wir uns im Voraus.

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH ⊖ BOSCH
ZGE4 ☎ Tel.: ++49/(0)711/811-44846
Postfach 30 02 20 Fax: ++49/(0)711/811-33181
D-70442 Stuttgart email: karin.mindner@de.bosch.com

Mindner Karin (ZGE4)

OIPE JC95
SEP 1 6 2003
PATENT & TRADEMARK OFFICE

Von: Rocklage-Marliani Gerta (BhW/FVB11) *
Gesendet: Dienstag, 29. Oktober 2002 11:00
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US Eilt sehr!!

Hallo Frau Mindner,
ich befürchte, dass keiner mehr Kontakt zu Herrn Schmitz hat. Ich weiß, dass er bei VW in Wolfsburg arbeitet. Das ist leider aber schon alles. Es tut mir leid, dass ich Ihnen nicht mehr helfen kann.
Mit freundlichen Grüßen
Gerta Rocklage

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Dienstag, 29. Oktober 2002 10:34
An: Weigold Thomas (BE-WS/P-WDA) *; Zierer Gerald (BUEW/TEF14) *; Pfetzer Johannes (BE-ET/ENG2) *; Riehl Guenther (BE-EB/MOE3) *; Rocklage-Marliani Gerta (BhW/FVB11) *; Heidrich Torsten (FV/SLT1) *
Betreff: R. 39090 US Eilt sehr!!
Wichtigkeit: Hoch

29.10.02

Sehr geehrte Damen und Herren,

für eine Patentanmeldung in den USA benötigen wir dringend die neue Privatanschrift Ihres Miterfinders Herrn Matthias Schmitz. Vielleicht könnten Sie uns seine Anschrift oder auch seine Telefon-Nr. kurz per E-Mail mitteilen?

Für Ihre hiermit verbundene Mühe bedanken wir uns im Voraus.

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH
ZGE4
Postfach 30 02 20
D-70442 Stuttgart
BOSCH
Tel.: ++49/(0)711/811-44846
Fax: ++49/(0)711/811-33181
email: karin.mindner@de.bosch.com

Mindner Karin (ZGE4)

Von: Weigold Thomas (BE-WS/P-WDA) *
Gesendet: Dienstag, 29. Oktober 2002 10:42
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US Eilt sehr!!

Ist mir nicht bekannt.

Mit freundlichen Grüßen

Thomas Weigold

Robert Bosch GmbH
BE-WS/P-WDA
Thomas Weigold

Postfach 1163
D-77813 Bühl

Tel.: 07223-82-2151
Fax: 07223-82-2605
PC-Fax: 07223-82-7151
Email: thomas.weigold2@de.bosch.com
Besucher: Hauptstraße 34; D-77830 Bühlertal

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Dienstag, 29. Oktober 2002 10:34
An: Weigold Thomas (BE-WS/P-WDA) *; Zierer Gerald (BUEW/TEF14) *; Pfetzer Johannes (BE-ET/ENG2) *; Riehl Guenther (BE-EB/MOE3) *; Rocklage-Marliani Gerta (BhW/FVB11) *; Heidrich Torsten (FV/SLT1) *
Betreff: R. 39090 US Eilt sehr!!
Wichtigkeit: Hoch

29.10.02

Sehr geehrte Damen und Herren,

für eine Patentanmeldung in den USA benötigen wir dringend die neue Privatanschrift Ihres Miterfinders Herrn Matthias Schmitz. Vielleicht könnten Sie uns seine Anschrift oder auch seine Telefon-Nr. kurz per E-Mail mitteilen?

Für Ihre hiermit verbundene Mühe bedanken wir uns im Voraus.

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH ⊖ BOSCH
ZGE4 Tel.: ++49/(0)711/811-44846
Postfach 30 02 20 Fax: ++49/(0)711/811-33181
D-70442 Stuttgart email: karin.mindner@de.bosch.com

Mindner Karin (ZGE4)

Von: Riehl Guenther (BE-EB/MOE3) *
Gesendet: Dienstag, 29. Oktober 2002 10:41
An: Mindner Karin (ZGE4)
Betreff: AW: R. 39090 US Eilt sehr!!

Guten Tag,

leider habe ich keine Adresse oder Tel. Nr.

Meine letzte Information ist, dass Herr Schmitz zum 1.7.2000 zu VW - Wolfsburg gewechselt hat.

Gruß
G. Riehl

-----Ursprüngliche Nachricht-----
Von: Mindner Karin (ZGE4)
Gesendet: Dienstag, 29. Oktober 2002 10:34
An: Weigold Thomas (BE-WS/P-WDA) *; Zierer Gerald (BUEW/TEF14) *; Pfetzer Johannes (BE-ET/ENG2) *; Riehl Guenther (BE-EB/MOE3) *; Rocklage-Marliani Gerta (BhW/FVB11) *; Heidrich Torsten (FV/SLT1) *
Betreff: R. 39090 US Eilt sehr!!
Wichtigkeit: Hoch

29.10.02

Sehr geehrte Damen und Herren,

für eine Patentanmeldung in den USA benötigen wir dringend die neue Privatanschrift Ihres Miterfinders Herrn Matthias Schmitz. Vielleicht könnten Sie uns seine Anschrift oder auch seine Telefon-Nr. kurz per E-Mail mitteilen?

Für Ihre hiermit verbundene Mühe bedanken wir uns im Voraus.

Mit freundlichen Grüßen
Karin Mindner

Robert Bosch GmbH
ZGE4
Postfach 30 02 20
D-70442 Stuttgart
BOSCH
Tel.: ++49/(0)711/811-44846
Fax: ++49/(0)711/811-33181
email: karin.mindner@de.bosch.com

Eingang! -7. Nov. 2002

EILT SEHR!!!

Herrn
Matthias Schmitz
Tegeler Str. 14

30853 Langenhagen

33181

ZGE4 Mindner 44846 23.10.2002
R. 39090

zurück an ZGE4-Frau Mindner

Nationale Phase in USA
Stichwort im Hause: Innenläufer-Motorpumpe

Sehr geehrter Herr Schmitz,

für den Eintritt in die nationale Phase in USA der obengenannten PCT-Anmeldung bitten wir Sie als Erfinder/Miterfinder um Ihre Unterschrift (ausgeschriebener Vor- und Zuname) an den bezeichneten Stellen der folgenden Formulare:

1. "Declaration" (Erfindererklärung)
2. "Assignment" (Übertragungserklärung).

Bitte verwenden Sie Tinte oder Kugelschreiber.

DIESER VORGANG EILT! Bitte senden Sie schnellstmöglich die unterzeichneten Unterlagen zurück an die

Robert Bosch GmbH
Patentabteilung ZGE4
Frau Mindner
Postfach 30 02 20

D-70442 Stuttgart

04. Dez 02

Vielen Dank!

Mit freundlichen Grüßen

ROBERT BOSCH GMBH
Zentralstelle Patente E4

\\FE24999\PLASPROD$\plas_dummydir\PLASDOCS\PF\39090\Schmitz3.doc

Letter **EXTREMELY URGENT!**

To: Matthias Schmitz
Kananoher Str. 34
30855 Langenhagen

Date: May 16, 2003

Re: National Phase in the U.S.
In-house keyword: Inner-Rotor Motor Pump

Dear Mr. Schmitz,

As we enter the national phase in the U.S. with the PCT application described above, we kindly ask that you, as the inventor/co-inventor, sign the following form on the lines indicated (please spell out your first and last names in entirety):

Declaration

Please use ink or a ball-point pen.

THIS MATTER IS URGENT! Please return the signed forms to the address below as soon as possible:

Robert Bosch GmbH
Patent Department, ZGE4
Ms. Mindner
P.O. Box 30 02 20
D-79442 Stuttgart

Thank you very much in advance.

ROBERT BOSCH GMBH
Main Patent Dept. E4

Translator's note: The rest of this document is an exchange of e-mails detailling how the employees found Mr. Schmitz's new address.

Letter EXTREMELY URGENT!

To: Matthias Schmitz
Eckbergstr. 19a
Baden-Baden

Date: August 8, 2002

Re: National Phase in the U.S.
In-house keyword: Inner-Rotor Motor Pump

Dear Mr. Schmitz,

As we enter the national phase in the U.S. with the PCT application described above, we kindly ask that you, as the inventor/co-inventor, sign the following forms on the lines indicated (please spell out your first and last names in entirety):

1. Declaration
2. Assignment

Please use ink or a ball-point pen.

THIS MATTER IS URGENT! Please return the signed forms to the address below as soon as possible:

Robert Bosch GmbH
Patent Department, ZGE4
Ms. Mindner
P.O. Box 30 02 20
D-79442 Stuttgart

Thank you very much in advance.

ROBERT BOSCH GMBH
Main Patent Dept. E4

Internal E-mail correspondence at Bosch:

From: Karin Mindner (ZGE4)

Date: October 29, 2002

Re: R. 39090 US – Extremely urgent!

To: Thomas Weingold, Gerald Zierer, Johannes Pfetzer, Guenther Riehl, Gerta Rocklage-Marliani, Torsten Heidrich

Dear Ladies and Gentlemen:

We urgently need to locate the home address of Mr. Matthias Schmitz, one of your co-inventors, to file a patent application in the U.S. Do any of you have his new address or telephone number?

Thank you in advance.

Karin

Response from Guenther Riehl on 10/29/2002:

Unfortunately I do not have his address or phone number. The last thing I heard about Mr. Schmitz is that he started work at VW in Wolfsburg on July 1, 2000.

Response from Gerald Zierer on 10/29/200:

I have not been in contact with Mr. Schmitz since he left the company..

Response from Johannes Pfetzer on 10/29/2002:

Sorry, I can't help you. All I know is that he went to VW.

Response from Gerta Rocklage-Marliani on 10/29/2002:

I'm afraid that none of us are in touch with Mr. Schmitz anymore. I know he works at VW in Wolfsburg now. That's all I know, sorry.

Response from Thomas Weigold on 10/29/2002:

I don't know.

[Fax page no. 7 is the same as the previous page, except that it is dated October 23, 2002 and includes a handwritten word at the top of the page:]

REMINDER!

17 OCT 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael Striker
Striker, Striker & Stenby
103 Neck Road
Huntington, New York 11743

In re Application of	:	
WEIGOLD et al.	:	
U.S. Application No. 10/168,902	:	DECISION ON PETITION
PCT No.: PCT/DE01/03624	:	
Int. Filing Date: 20 September 2001	:	
Priority Date: 25 October 2000	:	
Attorney Docket No.: 2174	:	
For: ELECTRIC-MOTOR-DRIVEN PUMP AND METHOD FOR REDUCING SUCH A PUMP	:	

This is a decision on applicants' "Response to Decision on Petition" filed 16 September 2003, which is being treated as a Renewed Petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Matthias Schmitz. The three-month extension of time fee ($930) will charged to Deposit Account no. 19-4675.

BACKGROUND

On 20 September 2001, applicants filed international application PCT/DE01/03624 which claimed a priority date of 25 October 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 02 May 2002.

On 21 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; and an unexecuted declaration.

On 26 August 2002, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 January 2003, applicants filed the present petition under 37 CFR 1.47(a) and a three-month extension of time. The petition was dismissed in a Decision dated 14 April 2003.

On 16 September 2003, applicants filed the present renewed petition under 37 CFR 1.47(a) and a three-month extension of time fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1) has been satisfied.

As to item (2), petitioner states that Matthias Schmitz cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Matthias Schmitz. The declaration of Karin Mindner alleges that inventor Matthias Schmitz cannot be found or located, however, no documentary evidence to support the attempt(s) was provided with Ms. Mindner's declaration. Were any of the letters mailed to the last known address returned or stamped by the courier as undeliverable? As stated above, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied by a person having firsthand knowledge of the facts. Lastly, the single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Mr. Schmitz.

With regard to Item (3), petitioner has provided a statement of the last known address of the missing inventor.

As to Item (4), the declaration filed via facsimile on 30 September 2003 is in compliance with 37 CFR 1.497(a)-(b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Matthias Schmitz under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Facsimile: 703-308-6459

13 NOV 2003

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael Striker
Striker, Striker & Stenby
103 Neck Road
Huntington, New York 11743

In re Application of	:	
WEIGOLD et al.	:	
U.S. Application No. 10/168,902	:	DECISION ON PETITION
PCT No.: PCT/DE01/03624	:	
Int. Filing Date: 20 September 2001	:	
Priority Date: 25 October 2000	:	
Attorney Docket No.: 2174	:	
For: ELECTRIC-MOTOR-DRIVEN PUMP AND METHOD FOR REDUCING SUCH A PUMP	:	

This decision is in response to applicants' "Renewed Petition Under 37 CFR 1.47(a)" filed 03 November 2003. In a decision dated 17 October 2003, applicants' petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Matthais Schmitz, was dismissed.

The petition for status under 37 CFR 1.47(a) is moot since the declaration filed 03 November 2003 with the present renewed petition was executed by the named inventor, the previous non-signing inventor, Matthais Schmitz. The declarations filed 30 September 2003 and 03 November 2003 are acceptable under 37 CFR 1.497.

For the reasons above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED as MOOT**.

The application has an international filing date of 20 September 2001 under 35 U.S.C. 363 and a date of **04 November 2003** under 35 U.S.C. 371(c).

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DEC 28 2004

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA GA 30309

In re Application of Bill E. Cham Serial No.: 10/168,905 Filed: November 25, 2002 Attorney Docket No.: 44378/275258	: PETITION TO MAKE SPECIAL

This is in response to the petition filed October 27, 2004, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, X. Therefor the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission to the Office general facsimile number, 703-872-9306.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

FEB 09 2007

OFFICE OF PETITIONS

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

In re Application of Kuczynski, et al. Application No. 10/168,931 Filed: September 10, 2002 Attorney Docket No. U 014017-7	DECISION GRANTING PETITION AND WITHDRAWING THE HOLDING OF ABANDONMENT

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed December 14, 2006.

The petition under 37 CFR 1.181 is **GRANTED**.

The holding of abandonment is **WITHDRAWN**.

The above-identified application was held abandoned for failure to timely file a response to the final Office action mailed May 18, 2006. This Office action set a shortened statutory period of three (3) months. A Notice of Abandonment was mailed on November 30, 2006.

A review of the application file reveals the presence of a Notice of Appeal, filed November 22, 2006. The amendment was made timely by including a Certificate of Mailing under 37 CFR 1.8 dated November 20, 2006, by including a three month extension of time, and because of the fact that November 18, 2006 fell on a Saturday. See 37 CFR 1.7(a). Furthermore, Office records indicate that the fee for the three month extension of time was received on November 22, 2006.

In view of the above, the holding of abandonment is withdrawn.

The matter is being forwarded to Group Art Unit 1771 for consideration of the RCE filed December 26, 2006.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

RATNERPRESTIA
P O BOX 980
VALLEY FORGE PA 19482-0980

COPY MAILED

JAN 2 0 2006

OFFICE OF PETITIONS

In re Application of	:	
Murrer et al.	:	
Application No. 10/168,933	:	DECISION ON PETITION
Filed: November 5, 2002	:	
Attorney Docket No. JMYT-261US	:	

This is a decision on the petition under 37 CFR 1.181, filed on January 9, 2006, to withdraw the holding of abandonment.

On September 28, 2004, the Office mailed a nonfinal Office action, which set a three-month shortened statutory period to reply. In the apparent absence of a timely response, the Office mailed a Notice of Abandonment on November 2, 2005.

Petitioner asserts that a proper response was filed timely. In support of the petition, petitioner submits a copy of a returned, date-stamped postcard receipt,[1] acknowledging receipt of a request for an extension of time and an amendment in the USPTO on March 30, 2005. The copy of the Transmittal Letter, submitted with the original response, contained a certificate of mailing dated March 28, 2005. Copies of the documents are included with this petition.

The USPTO finance records indicate that the Office charged petitioner's Deposit Account for the extension of time fee on March 31, 2005.

In view of the above, petition is **granted.** The holding of abandonment is hereby withdrawn and the application will return to pending status.

This matter is being referred to Technology Center Art Unit 1752 for further processing.

[1] Section 503 of the MPEP states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO."

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 14 2004

In re Application of	:
Aloys Wobben	:
Application No. 10/168,934	: DECISION ON PETITION
Filed: October 7, 2002	:
Attorney Docket No. 970054.417USPC	:

This is a decision on the petition to make special filed on July 7, 2003. The petition is based upon the practice described in MPEP § 708.02(VI) "Energy." Therefore, no petition fee is required.

The petition is granted.

The petition to make special based upon the practice in MPEP § 708.02(VI) is deemed to satisfy all of the requirements therefore. Accordingly, the examiner will treat this application as special throughout its prosecution. Prior to the next 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 Supervisory Patent Examiner of Patent Examining Art Unit 3745 is being informed of this decision, and will advise the examiner to take future action consistent therewith.

PETITION GRANTED.

Stephen Marcus, Special Program Examiner,
Technology Center 3700

Seed Intellectual Property Law Group PLLC
701 Fifth Ave.
Suite 6300
Seattle, WA 98104-7092

23 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Shalom Wertsberger
Saltamar Innovations
30 Fern Lane
South Portland, ME 04106

In re Application of KESANIEMI	:	
U.S. Application No.: 10/168,938	:	
PCT Application No.: PCT/FI00/01119	:	DECISION
Int. Filing Date: 20 December 2000	:	
Priority Date Claimed: 28 December 1999	:	
Attorney Docket No.: 0223US-Kesaniemi	:	
For: OPTICAL FLOW AND IMAGE FORMING	:	

This is in response to applicant's "Status Inquiry" filed 11 June 2003, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 20 December 2000, applicant filed international application PCT/FI00/01119, which claimed priority of an earlier Finland application filed 28 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 June 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 28 June 2002.

On 24 June 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 27 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 20 September 2002, applicant purportedly filed an executed declaration in response to the Notification of Missing Requirements.

On 11 June 2003, applicant filed the present petition along with a copy of the declaration purportedly filed on 20 September 2002 and a copy of a return postcard receipt.

DISCUSSION

The evidence of record is sufficient to establish that the declaration was originally filed on 20 September 2002. Specifically, the copy of the return postcard, which includes the declaration in its itemized contents and which bears a USPTO date stamp of 20 September 2002, serves as *prima facie* evidence that the declaration was received by the USPTO on 20 September 2002.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 20 December 2000, and a date under 35 U.S.C. 371(c) of 20 September 2002.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

1 0 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Vernon W. Francissen
GARDNER CARTON & DOUGLAS
191 N. Wacker Drive, Suite 3700
Chicago, IL 60606

In re Application of WELLS, Thomas, et al. U.S. Application No.: 10/168,944 PCT No.: PCT/US00/35552 International Filing Date: 29 December 2000 Priority Date: 30 December 1999 Attorney's Docket No.: P1555USA For: ELECTRONIC SAFE DEPOSIT BOX	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed on 01 October 2002. Applicants have submitted the required petition fee.

BACKGROUND

On 29 December 2000, applicants filed international application PCT/US00/35552 which claimed a priority date of 30 December 1999 and which designated the United States.

On 30 July 2001, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 30 June 2002.

On 25 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 18 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the small entity surcharge for filing the declaration later than 30 months after the priority date were required.

On 01 October 2002, applicants filed responsive materials which included payment of the required surcharge, a declaration executed by one of the two named inventors (Thomas E. Wells) and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of the nonsigning inventor Eric K. Yee, whom applicants assert cannot be located after diligent effort.

DISCUSSION

In order for the application to be accepted without the signature of the nonsigning inventor, applicants must submit a grantable petition under 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the proper petition fee, (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

The petition included payment of the $130 petition fee and it sets forth the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicant has submitted a declaration containing an unexecuted signature block for the nonsigning inventor and executed by the other inventor. Item (3) is therefore satisfied.

Regarding item (4), the proof required to show that a nonsigning inventor cannot be reached after diligent effort is set forth in section 409.03(d) of the MPEP, which states:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> ...
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, the attempts to contact the nonsigning inventor are set forth in the statement of facts executed by above-named counsel. This statement demonstrates that applicants have mailed application materials to the nonsigning inventor's last two known addresses. However, the statement does not set forth any efforts made to locate the inventor after applicants learned that the inventor had left his last known address. Applicants must describe such search efforts before it can be concluded that the nonsigning inventor cannot be reached after diligent effort. Item (4) is therefore not satisfied.

Based on the foregoing, applicants have not satisfied all the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning inventor cannot be located after diligent effort including, as discussed above, evidence of efforts made by applicants to locate the nonsigning inventor after learning that his last known address was not current.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

29 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Vernon W. Francissen
GARDNER CARTON & DOUGLAS
191 N. Wacker Drive, Suite 3700
Chicago, IL 60606

In re Application of WELLS, Thomas, et al. U.S. Application No.: 10/168,944 PCT No.: PCT/US00/35552 International Filing Date: 29 December 2000 Priority Date: 30 December 1999 Attorney's Docket No.: P1555USA For: ELECTRONIC SAFE DEPOSIT BOX	DECISION ON PETITION UNDER 37 CFR 1.181 AND RENEWED PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' 23 July 2003 submission of a renewed petition under 37 CFR 1.47(a) and a petition under 37 CFR 1.181 to confirm the 03 April 2003 filing of the renewed petition under 37 CFR 1.47(a) (the petition under 37 CFR 1.181 was supplemented on 24 July 2003). No petition fees are required.

BACKGROUND

The procedural background for this application is set forth in the decision mailed by this Office on 10 February 2003. In that decision, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not submitted adequate evidence that a diligent effort had been made to locate the nonsigning inventor.

On 23 July 2003, applicants filed a copy of the renewed petition considered herein, accompanied by a petition under 37 CFR 1.181 seeking to confirm that the renewed petition was originally filed on 03 April 2003. The petition under 37 CFR 1.181 was accompanied by, among other materials, illegible copies of a return postcard and related Express Mail label. On 24 July 2003, applicants supplemented the petition under 37 CFR 1.181 with clearer copies of the return postcard and Express Mail label.

DISCUSSION

A. Petition Under 37 CFR 1.181

Based on applicants' statements and the legible versions of the stamped return postcard and Express Mail label filed on 24 July 2003, it is concluded that the renewed petition under 37 CFR 1.47(a) attached to the present submission was originally filed on 03 April 2003. The renewed petition is therefore considered a timely response to the previous decision.

B. Petition Under 37 CFR 1.47(a)

The renewed petition includes a firsthand statement describing efforts made to locate the nonsigning inventor, with supporting exhibits. These materials, in combination with the original petition materials, satisfies the requirement that applicants demonstrate a diligent effort to locate the nonsigning inventor. Accordingly, all of the requirements for a grantable petition have now been met. The petition is appropriately granted.

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED**. Accordingly, the renewed petition under 37 CFR 1.47(a) is treated as having been filed on 03 April 2003 as a timely response to the previous decision.

The renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address set forth in the petition, and notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The 35 U.S.C. 371 date is 01 October 2002.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

29 JUL 200

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Eric K. YEE
4558 Crestwood Street
Freemont, California 94538-4023

In re Application of: WELLS, Thomas, et al.
U.S. Application No.: 10/168,944
PCT No.: PCT/US00/35552
International Filing Date: 29 December 2000
Priority Date: 30 December 1999
Attorney's Docket No.: P1555USA
For: ELECTRONIC SAFE DEPOSIT BOX

Dear Mr. YEE:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a). Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

Counsel of Record:
Vernon W. Francissen
GARDNER CARTON & DOUGLAS
191 N. Wacker Drive, Suite 3700
Chicago, IL 60606

Pet. Dec.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mailed: 4/19/05

dss
Paper Number

In re application of
Schottek et al.
Serial No.10/168,952
Filed: June 24, 2002
For: TRANSITIONMETAL,COMPOUND, LIGAND SYSTEM, CATALYST SYSTEM AND ITS USE FOR THE POLYMERIZATION AND COPOLYMERIZATION OF OLEFINS

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181, filed January 07, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment mailed December 30, 2004, be withdrawn since the applicant did not receive the Office letter mailed June 16, 2004.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, MPEP 711.03(c). 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 June 16, 2004. The evidence provided includes a statement by the petitioner that the Office letter, mailed June 16, 2004 was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Office letter was not received. Also provided is a copy of the attorney's application docket records where the Office letter 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 June 16, 2004 and restarting of the period of response from the remail date thereof.

The Petition is **GRANTED**.

JMstone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Keil & Weinkauf
1350 Connecticut Avenue, N.W.
Washington, D.C. 20036

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

rvk

Mailed: 4/21/05 Paper No. _____

In re application of:
Nobuaki Kido et al
Serial No.: 10/168,982
Filed: June 26, 2002
For: HYDROGENATED STYRENE POLYMER AND OPTICAL DISK SUBSTRATE :

DECISION ON PETITION

This is a response to the REQUEST FOR RECISION OF ISSUED NOTICE OF ABANDONMENT OR, IN THE ALTERNATIVE, PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed January 14, 2005. The request asks that the abandonment, as set forth in the Notice of Abandonment of March 23, 2004, for failure to timely file a proper response to the Office letter dated September 02, 2003 be withdrawn. The requester asserts that applicants timely filed a proper response and a Petition for Extension of Time on March 02, 2004.

DECISION

The instant request is accepted as a petition under 37 C.F.R. 1.181 (no fee).

A review of the petitioner's evidence provided with the instant petition indicates that the request has merit. The evidence presented is sufficient to establish that the applicants did file the proper response to the Office letter of September 02, 2003 in a timely manner. The evidence provided includes: 1) copies of the Response and Petition for Three Months Extension with a check in the amount of $950.00 filed March 02, 2004; and 2) a copy of the returned stamped postcard confirming receipt of the Response and Petition for Extension of Time by the USPTO dated March 02, 2004.

Therefore, the abandonment dated March 23, 2004 was in error. A review of the

instant application file indicates that this error was administratively corrected via Notice of Rescinded Abandonment dated March 09, 2005. Therefore, no further action is required.

The Petition is **DISMISSED.**

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

SUGHRUE MION, PLLC
2100 PENNSYVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

COPY MAILED

AUG 2 4 2006

OFFICE OF PETITIONS

In re Patent of :
Lunner et al. :
Patent No. 6,844,304 :
Issue Date: January 18, 2005 :
Application No. 10/168,990 :
Filing Date: June 26, 2002 :
Attorney Docket No. 611-62 :

Decision on Petition

This is a decision in response to the paper filed January 27, 2005, which is being treated as a petition under 37 CFR 3.81 to accept the correction of the assignee data on the front page of the above-identified patent.

The request under 37 CFR 3.81 is **GRANTED**.

37 CFR 3.81(b) reads:

> Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter.

In other words, the request under 37 CFR 3.81(b) will be granted when:

(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

Petitioner has met the requirements set forth above. Therefore, the request is granted.

The Certificates of Correction Branch will be informed of the instant decision and will issue the requested certificate of correction in due course.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

COPY MAILED

NOV 05 2007

OFFICE OF PETITIONS

In re Application of
Tomas Christian Fredrik Mecklin
Application No. 10/168,996
Filed: June 21, 2002
Attorney Docket No. P12360-US1

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 3, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, June 13, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 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 an amendment, (2) the petition fee of $1500, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

This application is being referred to Technology Center AU 2616 for appropriate action by the Examiner in the normal course of business on the reply received July 3, 2007.

April M. Wise
Petitions Examiner
Office of Petitions

02 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Anthony J. Janiuk
Waters Corporation
34 Maple Street.
Milford, MA 01757

In re Application of
LEE et al.
Application No.: 10/169,002
PCT No.: PCT/US00/13028
Int. Filing Date: 12 May 2000
Priority Date: 14 May 1999
Attorney Docket No.: WAA-213PCT
For: DESTRUCTIBLE SURFACTANTS AND USES THEREOF

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 12 March 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee of $710 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the thirty-month period is required.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Philip S Johnson
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

COPY MAILED
AUG 0 2 2006
OFFICE OF PETITIONS

In re Application of Janssens et al. :
Application No. 10/169,011 : Decision on Petition
Filing Date: June 19, 2002 :
Attorney Docket No. JAB-1543 :

This is a decision on the petition under 37 CFR 1.137(a), filed July 21, 2004, to revive the above-identified application. The petition is also being treated under 37 CFR 1.181 (no fee) as a petition to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 is **granted**.

The petition under 37 CFR 1.137(a) is **dismissed as moot**.

Facts:

The Office mailed a non-final Office on March 28, 2003.

A Notice of Abandonment was mailed June 2, 2004. The Notice stated petitioner had never filed a reply to the March 28, 2003 Office action.

On or before June 10, 2004, the file wrapper for the instant application was lost by the USPTO.

The instant petition was filed July 21, 2004. The petition asserts a reply to the non-final Office action was timely filed. In support of the petition, petitioner has submitted a date-stamped postcard receipt, indicating an amendment was received by the Office on June 24, 2003. A copy of the amendment accompanies the petition.

The lost file has been reconstructed. Reconstruction of the file wrapper was completed June 6, 2006.

Discussion:

The original amendment filed June 24, 2003, was not matched with the file and cannot be located. However, M.P.E.P. 503 states, "[a] postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is

concluded the amendment was timely filed in the Patent and Trademark Office but not matched with the application file.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Since the petition has been granted under 37 CFR 1.181, petitioner's request to have the petition considered under 37 CFR 1.137(a) is dismissed as moot. A petition fee is not required for a petition to withdraw holding of abandonment under 37 CFR 1.181. Therefore, the $130 charged to petitioner's deposit account on July 22, 2004, will be credited back to petitioner's deposit account.

Appreciation:

The Office sincerely appreciates petitioner's assistance in reconstructing the file wrapper.

The Office apologizes for the delay in rendering a decision on the instant petition.

The next step to be taken by the Office:

Technology Center Art Unit 1624 will be informed of the instant decision. Thereafter, the amendment originally filed on June 24, 2003, will be entered and considered by the examiner 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

jm

Mailed : 5-17-07

In re application of	:	
Lang et al.	:	DECISION ON
Serial No. 10/169,025	:	PETITION
Filed : June 27, 2004	:	
For: FILTER DEVICE		

This is a decision on the PETITION UNDER 37 CFR 1.181 TO REQUIRE ENTRY OF THE AMENDMENT TO THE SPECIFICATION submitted August 14, 2004.

On August 14, 2004, an amendment after final was submitted with a proposed amendment to the specification. The examiner responded to the after-final amendment with an advisory action mailed August 26, 2004 refusing entry of the amendment. Subsequent to the advisory action, the application was subject to an appeal, the decision for which was rendered on September 29, 2005. Applicant filed a request for reconsideration of the Board decision, which was denied February 22, 2006. On February 28, 2006, the instant petition under 37 CFR 1.181 was filed to formally request the entry of the amendment submitted on August 14, 2004.

DECISION

Rule 1.181, Section (f) states:
§ 1.181 Petition to the Commissioner

(f) 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.

The instant petition was filed approximately 18 months after the advisory action was mailed serving notice of the denial of entry of the amendment to the specification. Also, no previous requests have been made for entry of the amendment. This is clearly not a timely filed petition. Accordingly, the instant petition is **DISMISSED.**

10/169,025

Jacqueline M. Stone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

MARK S. BICKS
ROYLANCE ABRAMS BERDO & GOODMAN
SUITE 600
1300 19th STREET NW
WASHINGTON DC 20036

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

jm

Mailed: 6-13-07

In re application of	:	
Lang et al.	:	DECISION ON
Serial No. 10/169,025	:	PETITION
Filed: June 27, 2002	:	
For: FILTER DEVICE		

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE OFFICE ACTION mailed January 30th, 2007.

On February 22, 2006, applicant submitted a petition to require entry of an amendment to the specification. A non-final rejection was mailed May 15, 2006 and a final rejection was mailed January 30th, 2007. Applicant is requesting the final office of January 30th be withdrawn until the Petition submitted February 28th, 2006 is resolved.

DECISION

It is noted that the petition filed February 28, 2006 to require entry of the amendment to the specification was dismissed, thereby requiring no alteration to the current prosecution. Accordingly, this petition is DISMISSED.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

MARK S. BICKS
ROYLANCE ABRAMS BERDO & GOODMAN
SUITE 600
1300 19th STREET NW
WASHINGTON DC 20036

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

0 5 JAN 2007

Martin D. Moynihan
PRTSI, Inc.
P.O. Box 16446
Arlington, VA 22215

In re Application of	:	
REISNER et al	:	
U.S. Application No.: 10/169,028	:	DECISION ON PETITION
PCT Application No.: PCT/IL00/00872	:	UNDER 37 CFR 1.78(a)(3)
International Filing Date: December 28, 2000	:	
Attorney Docket No.: 02/23777	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 7, 2006, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in 37 CFR 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The

relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. See MPEP Section 201.11, Rev. 5, August 2006, Reference to Prior Application. The amendment filed March 7, 2006 fails to state the relationship of Application No. 09/477,737, filed January 5, 2000, to the instant application.

Furthermore, the reference to add the prior-filed application on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP 201.06(c) and 608.04(b).

Before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required.

With regard to item (3) above, the petition states, "The entire delay between the date the priority claim was due under paragraph 37 CFR 1.78(a)(5)(ii) and the date the priority claim was filed was unintentional." This statement is interpreted as 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. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Bryan Lin at (571) 272-3303.

Bryan Lin
Bryan Lin
Legal Examiner
Office of PCT Legal Administration

BMilef
Boris Milef
Legal Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: —

DATE : 10/31/06

TO SPE OF : ART UNIT 3743

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/169034 Patent No.: 7080642 B2

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

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: _____

SPE

3771
Art Unit

11 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

James C. Forbes
PHARMACIA CORPORATION
Global Patent Department
Post Office Box 1027
St. Louis, MO 63006

In re Application of DESAI, Subhash *et al* U.S. Application No.: 10/169,039 PCT No.: PCT/US00/34754 Int. Filing Date: 20 December 2000 Priority Date: 22 December 1999 Attorney Docket No.: 3280/3/US For: DUAL-RELEASE COMPOSITIONS OF A CYCLOOXYGENASE-2 INHIBITOR.	:	**DECISION** **UNDER** **37 CFR 1.47(a)**

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a)" filed on 22 May 2003.

BACKGROUND

On 28 August 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 02 April 2003, applicants filed a document titled "Response to the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) Mailed 28 August 2002" which was accompanied by, *inter alia*, a check of $1,970.00 for a five-month extension of time fee, and a declaration signed by two of the four joint inventors.

On 22 April 2003, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration submitted was not in compliance with 37 CFR 1.497(a) and (b) because the first and second listed inventors did not sign. Applicants were given a time limit of one month from the date of this Notification or within the time remaining in the Form PCT/DO/EO/905, whichever is longer.

On 22 May 2003, applicants submitted the instant petition which was accompanied by, *inter alia*, a document titled "Declaration in Support of Petition Under 37 C.F.R. 1.47(a)" ("Decl.") signed by Steven J. Sarussi; a copy of a letter dated 03 November 2002; and a declaration signed by three of the four listed joint inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor. Applicants failed to satisfy item (2).

Concerning item (1), the $130.00 petition fee has been paid.

With regard to item (3), applicants satisfy this requirement by listing the last known address of the nonsigning co-inventor, Subhash Desai as:

1011 Greenwood Avenue
Wilmette, IL 60091

Regarding item (4), applicants included a Declaration signed by three of the four co-inventors. All the inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the MPEP and is in compliance with 37 CFR 1.497(a) and (b).

Thus, items (1), (3) and (4) of 37 CFR 1.47(a) have been satisfied.

Concerning item (2), the 37 CFR 1.47(a) applicants allege that Mr. Desai refuses to join in the above-captioned application. In support of this claim, the 37 CFR 1.47(a) applicants included a declaration signed by Mr. Steven J. Sarussi who claims first-hand knowledge. Mr. Sarussi declares that "[o]n October 18, 2002, I provided Dr. Desai a Declaration/Power of Attorney for the Application and a letter requesting that he execute the Declaration. In a letter dated November 3, 2002, pertaining to the Application, Dr. Desai acknowledged receipt of the Declaration/Power of Attorney and requested that I forward to him a copy of the Application. On November 6, 2002, I forwarded a copy of the Application to Dr. Desai." Decl. at ¶ 5.

Mr. Sarussi claims that Dr. Desai is requesting compensation to review several patent applications including the above-captioned application. A copy of a letter sent by the nonsigning co-inventor to the 37 CFR 1.47(a) applicants dated 03 November 2002 was submitted with the instant petition. However, a review of this letter shows that it concerns another U.S. application and is not pertinent to his alleged refusal to sign the above-captioned application.

Mr. Sarussi also claims that he discussed the situation with Dr. Desai on November 6, 2002 and wrote him on 28 February 2003 "asking him whether he intended to execute the Declaration/Power of Attorney, and if not, to explain his reasons." Id. at ¶¶ 7 - 8. Mr. Sarussi maintains that the nonsigning inventor has not

responded to his requests to execute the documents. Id. Finally, Mr. Sarussi states that he also left telephone messages for Dr. Desai on 23 January 2003, 28 March 2003 and 21 May 2003, but Dr. Desai did not return any of the calls. Id. at ¶¶ 9-10

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains what is required to prove a refusal by an inventor and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The declaration by Mr. Sarussi would be sufficient to demonstrate that Dr. Desai's conduct constitutes a refusal to join in the above-captioned application if the 37 CFR 1.47(a) applicants also furnished documentary evidence verifying the facts outlined in the declaration as required by the MPEP above. For example, the 37 CFR 1.47(a) applicants must provide documentary evidence that Dr. Desai was furnished a complete copy of the above-captioned application, including specification, claims and drawings on 06 November 2003 as stated in paragraph 5 of Mr. Sarussi's declaration. Moreover, a copy of the letter dated 28 February 2003 should also be provided.

For this reason, item (2) is not yet satisfied. Accordingly, it is not appropriate to accept this application under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

20 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

James C. Forbes
PHARMACIA CORPORATION
Global Patent Department
Post Office Box 1027
St. Louis, MO 63006

In re Application of DESAI, Subhash *et al* U.S. Application No.: 10/169,039 PCT No.: PCT/US00/34754 Int. Filing Date: 20 December 2000 Priority Date: 22 December 1999 Attorney Docket No.: 3280/3/US For: DUAL-RELEASE COMPOSITIONS OF A CYCLOOXYGENASE-2 INHIBITOR.	**DECISION ON** **RENEWED PETITION** **UNDER 37 CFR 1.47(a)**

This decision is in response to the papers filed on 23 February 2004 which are treated as a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 11 September 2003, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed because they failed to satisfy item (2) of 37 CFR 1.47(a).

On 23 February 2004, applicants submitted the instant response which was accompanied by, *inter alia*, an executed declaration signed by the nonsigning joint inventor, a $130.00 surcharge fee, and a five-month extension and a $2010.00 extension fee.

DISCUSSION

In the renewed petition under 37 CFR 1.47(a), applicants filed a declaration signed by the nonsigning joint inventor, Subhash Desai. This declaration reveals that it is in compliance with 37 CFR 1.497(a) and (b).

CONCLUSION

Since the nonsigning co-inventor has executed a declaration, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

The instant renewed petition was received on 23 February 2004. Thus, only a four-month extension and fee are required. The extension fee is $1,480.00, not $2,010.00. Moreover, the $130.00 surcharge fee for filing the declaration late was previously paid. Deposit Account No. 19-1025 will be credited back $660.00.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 December 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 23 February 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PHARMACIA CORPORATION
GLOBAL PATENT DEPARTMENT
POST OFFICE BOX 1027
ST. LOUIS MO 63006

COPY MAILED

JUN 12 2008

OFFICE OF PETITIONS

In re Patent No. 7,220,434	:	
DESAI et al.	:	
Issue Date: May 22, 2007	:	LETTER REGARDING PTA
Application No. 10/169,039	:	
Filed: February 23, 2004	:	
Atty Docket No. 3280/3/US	:	

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed June 28, 2007. Patentee requests that the determination of patent term adjustment under 35 U.S.C. § 154(b) be reviewed for accuracy.

The request for review of the determination of patent term adjustment (PTA) is **dismissed**.

On May 22, 2007, the above-identified application matured into U.S. Patent No. 7,220,434, with a revised patent term adjustment of two days. On June 28, 2007, patentee submitted the instant comment. Patentee directs the Office's attention the date of the filing of the Declaration on December 9, 2002, and the Request for Continued Examination (RCE) on October 12, 2005.

A review of the application history supports a conclusion that the number of days adjusted for Office delay and the number of days reduced for Patentee's delay was correct.

With regard to the date of the response to the Notice of DO/EO Missing Requirements, the Office concludes that it is not a basis for reduction of the patent term. Specifically, 37 CFR 1.704(b) provides that the period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or

transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. "The three-month period in 37 CFR 1.704(b) applies to the Office notices and letters issued as part of the pre-examination processing of an application[.]" MPEP 2732. "These notices include: (1) a Notice of Incomplete Nonprovisional Application (except as to any period prior to the filing date ultimately accorded to the application); (2) a Notice to File Missing Parts of Non-Provisional Application; (3) a Notice of Informal Application; (4) a Notice to File Corrected Application Papers Filing Date Granted; or (5) a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures." Id.

The Notice of DO/EO Missing Requirements is not identified among the examples above. The Notice of DO/EO Missing Requirements is not a notice or action by the Office making a rejection, objection, argument, or other request within the meaning of 35 U.S.C. 154(b)(2)(C)(ii) or 37 CFR 1.704(b). The Office further notes that the Notice of DO/EO Missing Requirements of August 28, 2002, and the Notice of Defective Response of April 22, 2003, were mailed before the application fulfilled the requirements of 35 U.S.C. 371 on February 23, 2004. Thus, any period of time in excess of three months that are taken to reply to the Notice of DO/EO Missing Requirements is not a basis for reduction of the patent term adjustment.

Furthermore, a review of the application history confirms that the period of adjustment under 37 CFR 1.704(b) was correctly determined as 58 days, counting the number of days beginning on the day after the date that is three months after the date of mailing of the final Office action, September 21, 2006, and ending on the date the RCE was filed, November 17, 2006.

In view thereof, the revised Patent Term Adjustment remains two days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell at (571) 272-3211.

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PHARMACIA CORPORATION
GLOBAL PATENT DEPARTMENT
POST OFFICE BOX 1027
ST. LOUIS MO 63006

COPY MAILED

OCT 01 2008

OFFICE OF PETITIONS

In re Patent No. 7,220,434	:
DESAI et al.	: **CORRECTED** LETTER REGARDING
Issue Date: May 22, 2007	: PTA AND NOTICE OF
Application No. 10/169,039	: INTENT TO ISSUE
Filed: February 23, 2004	: CERTIFICATE OF CORRECTION
Attorney Docket No. 3280/3/US	:

This is a **CORRECTED** letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed June 28, 2007. Patentee requests that the determination of patent term adjustment under 35 U.S.C. § 154(b) be reviewed for accuracy.

The request for review of the determination of patent term adjustment (PTA) is **granted** to the extent indicated herein.

Patentee is given **TWO (2) MONTHS** from the mailing date of this letter to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **zero (0) days.**

On May 22, 2007, the above-identified application matured into U.S. Patent No. 7,220,434, with a revised patent term adjustment of two (2) days. On June 28, 2007, patentee submitted the instant comment. On June 12, 2008, the Office mailed a letter dismissing the request for review of the determination of patent term adjustment. However, upon further review of the application history, the Office concludes that the determination of patent term adjustment under 35 U.S.C. 154(b) of two (2) days

is incorrect. Accordingly, the Office is issuing the instant corrected letter and vacating the letter mailed on June 12, 2008.

In the instant comment, patentee directs the Office's attention to the filing of the response to the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) ("Notification of Missing Requirements") and the Request for Continued Examination (RCE) on November 17, 2006.

With regard to the filing of the response to the Notification of Missing Requirements, the Office concludes that patentee failed to engage in reasonable efforts to conclude processing of this application. Patentee filed a complete and proper response on May 22, 2003, in excess of the three-month period from the mailing date of the Notification of Missing Requirements. See 37 CFR 1.704(b). Accordingly, the period of adjustment should have been reduced by 175 days, counting the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notification of Missing Requirements, November 29, 2002, and ending on the date a complete and proper reply was filed, May 22, 2003. Thus, a period of reduction of 175 days is being entered.

With regard to the filing of the Request for Continued Examination (RCE) on November 17, 2006, the Office concludes that the period of adjustment under 37 CFR 1.704(b) was correctly determined as 58 days, counting the number of days beginning on the day after the date that is three months after the date of mailing of the final Office action, September 21, 2006, and ending on the date the RCE was filed, November 17, 2006.

In view thereof, the revised Patent Term Adjustment is **zero (0) days.**

As this letter was submitted as an advisement to the Office of an error in patentee's favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell at (571) 272-3211.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,220,434 B2

DATED : May 22, 2007

INVENTOR(S) : Desai 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 2 days

Delete the phrase "by 2 days" and insert – by 0 days--

14 JUL 2004

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mark D. Moore, Ph.D.
WILLIAMS, MORGAN & AMERSON
10333 Richmond
Suite 1100
Houston, TX 77042

In re Application of	:	
THRESHER et al.	:	
Application No.:10/169,050	:	DECISION ON
PCT No.: PCT/AU00/01596	:	
Int. Filing Date: 22 December 2000	:	PETITION
Priority Date: 24 December 1999	:	
Attorney Docket No.: 4050.001500	:	UNDER 37 CFR 1.181
For: REPRESSIBLE STERILITY OF	:	
ANIMALS	:	

This decision is in response to applicants' "Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," filed 06 April 2004. No petition fee is required.

BACKGROUND

On 22 December 2000, applicants filed international application PCT/AU00/01596, which claimed priority to an earlier Australian application filed 24 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2002.

On 24 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and payment of the Surcharge for providing the oath or declaration later than 30 months from the priority date. There was no customer number identified in the transmittal letter. However, the following address for sending correspondence to applicants was provided in the transmittal letter:

"Mark D. Moore, Ph.D.
WILLIAMS, MORGAN & AMERSON
7676 Hillmont, Suite 250
Houston, TX 77040."

On 11 November 2002, applicants submitted a "Request for Customer Number Data Change" to the United States Patent and Trademark Office, requesting a change of address for Customer Number 23720 to *Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042.*

On 13 December 2002, the United States Patent and Trademark Office (USPTO) mailed a Notice of Customer Number Record Change, indicating that the change of address to Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042 had been recorded with respect to the Customer Number 23720.

On 06 May 2003, applicants filed a status inquiry with respect to the application, indicating that applicants had yet to receive a Notice to File Missing Parts of Application.

On 06 November 2003, the United States Designated/Elected Office (DO/EO) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a copy of the sequence listing in computer readable form, as required in 37 CFR 1.821(e) and PCT Rule 13*ter*.1(a)(ii), and an Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date, must be filed. The period for response expired 06 January 2004, two months from the mail date of the Notification.

On 26 February 2004, applicants filed a second status request with respect to the application. Again, applicants stated that they had not yet received the Notice to File Missing Parts of Application. However, the second status request was accompanied by a Change of Correspondence Address form which both identifies the Customer Number 23720 and indicates a change in the address for the application to *Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042.*

On 25 March 2004, the USPTO mailed a copy of the Notification of Missing Requirements to applicants' new address.

On 06 April 2004, applicants filed the instant petition, accompanied by, *inter alia*,: a copy of the Request for Customer Number Data Change which had been filed on 11 November 2002, a copy of the Notice of Customer Number Record Change which had been mailed on 13 December 2002, a copy of the status inquiry which was filed on 06 May 2003, a copy of a return receipt post card indicating reception by the USPTO of a status inquiry on 09 May 2003, a copy of the second status inquiry which was filed on 26 February 2004, a copy of the Change of Correspondence Address filed with the second status request, a "Statement of Mark D. Moore re Petition to the Commissioner Under 37 CFR § 1.181 to Reissue Notification of Missing Requirements Under 35 U.S.C. 371 and to Restart the Time Period for Replying to Such Notice" (affidavit of practitioner Mark D. Moore), a "Statement of Shawn Smith re Petition to

the Commissioner Under 37 CFR § 1.181 to Reissue Notification of Missing Requirements Under 35 U.S.C. 371 and to Restart the Time Period for Replying to Such Notice," and a "Patent Information Print" of a docketing record for the application.

DISCUSSION

MPEP 601.03 states in part:

"Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office."

In the affidavit of practitioner Mark D. Moore, the practitioner states that Notification of Missing Requirements was not received by the practitioner's firm and attests that a thorough search of the docketing records and the file wrapper indicates that the Notification of Missing Requirements was not received. The "Patent Information Print," attached to the affidavit and referred to by applicant as being a docket report, appears to actually be a printed history of the one application with respect to statistics and actions taken by the practitioner, and it does not appear to provide a manner which establishes sufficient evidence of lack of receipt of the Notification.

The question of lack of receipt is moot, however, since it is evident that the Notification was mailed to the appropriate correspondence address of the application at the time of the mailing of the Notification. Even if applicants correctly state that the mailing address of the Notification was applicants' former correspondence address, there was no change of address filed with respect to the application until 26 February 2004, well after mailing of the Notification. Although it is apparent that applicants did file a change of address with respect to the Customer Number 23720 before the Notification was mailed, there is no indication that the Customer Number 23720 was identified with the application when the change of address was requested. The transmittal form PTOL 1390 filed by applicants on 24 June 2002, which dictates the address where correspondence is to be mailed, does not identify a customer number for the address or for the application. A review of every other paper which was filed in the application on or before the mailing date of the Notification (06 November 2003) finds that no customer number was identified therewith. The first time that an application paper associated the Customer Number 23720 to the application was 26 February 2004, on the Change of Correspondence Address filed with respect to the application on that date. Accordingly, before 26 February 2004 the USPTO records for the application could not have associated the application with the Customer Number 23720, and any notice of change of address made with regard to a customer number alone could not have been applied to the application.

The deadline, 06 January 2004, for responding to the Notification of Missing

Requirements with an appropriate reply has passed.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **Dismissed**.

Also, for reasons indicated above, the application is **Abandoned** with respect to the National Stage in the United States.

Accordingly, the application is being returned to the National Stage Processing Division of the Office of PCT Operations for continued processing, including the preparation and mailing of the Notice of Abandonment.

If reconsideration of the merits of this petition is desired, it may be filed with a proper response within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). A proper response must include those elements required by the Notification of Missing Requirements mailed on 06 November 2003: an oath or declaration of the inventors in compliance with 37 CFR 1.497, and a computer readable form of the sequence listing in the application.

However, Applicant might instead consider filing a petition to revive the application under 37 CFR 1.137(b) from abandonment if the abandonment was unintentional. If applicants choose to file such a petition, it must be accompanied by a proper reply to the Notification mailed on 06 November 2003 (i.e. an oath or declaration of the inventors in compliance with 37 CFR 1.497, and a computer readable form of the sequence listing in the application), a petition fee under 37 CFR 1.17(m), 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.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner of Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jim Foster
Detail
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

05 AUG 2004

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mark D. Moore, Ph.D.
WILLIAMS, MORGAN & AMERSON
10333 Richmond
Suite 1100
Houston, TX 77042

In re Application of	:	
THRESHER et al.	:	
Application No.:10/169,050	:	DECISION ON RENEWED
PCT No.: PCT/AU00/01596	:	
Int. Filing Date: 22 December 2000	:	PETITION
Priority Date: 24 December 1999	:	
Attorney Docket No.: 4050.001500	:	UNDER 37 CFR 1.181
For: REPRESSIBLE STERILITY OF	:	
ANIMALS	:	

This decision is in response to applicants' "Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," filed 19 July 2004, applicants' "Second Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," filed 19 July 2004, and applicants' "Third Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," filed 20 July 2004, which taken together are being treated as a renewed petition under 37 CFR 1.181. No petition fee is required. The renewed petition is **GRANTED**.

BACKGROUND

On 22 December 2000, applicants filed international application PCT/AU00/01596, which claimed priority to an earlier Australian application filed 24 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 July 2001, prior to the expiration of nineteen months from the priority date. Accordingly the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2002.

On 24 June 2002, applicants filed a transmittal letter for entry into the national stage in the

United States, which was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and payment of the Surcharge for providing the oath or declaration later than 30 months from the priority date. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office (USPTO) on 05 July 2001. There was no customer number identified on the transmittal letter. However, the following address for sending correspondence to applicants was provided in the transmittal letter: Mark D. Moore, Ph.D. WILLIAMS, MORGAN & AMERSON, 7676 Hillmont, Suite 250 Houston, TX 77040.

About 16 October 2002, practitioner submitted a diskette which listed certain patent numbers and application numbers, and a cover letter which stated that the practitioner wished to have the patent numbers and application numbers be associated with the practitioner's Customer Number 023720 (i.e. 23720).

On 23 October 2002, the Patent Electronic Business Center (EBC), who processes customer number requests for the USPTO, faxed a letter to the practitioner, acknowledging receipt of practitioner's spreadsheet of application numbers and patent numbers which were to be associated with the practitioner's customer number. The faxed letter was a accompanied by an error report for review and correction by the practitioner.

On 25 October 2002, practitioner faxed a corrected copy of the error report back to the EBC.

On 11 November 2002, applicants submitted a "Request for Customer Number Data Change" to the United States Patent and Trademark Office, requesting a change of address for Customer Number 23720 to: Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042.

On 13 December 2002, the United States Patent and Trademark Office mailed a Notice of Customer Number Record Change, indicating that the change of address to: Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042 had been recorded with respect to the Customer Number 23720.

On 06 May 2003, applicants filed a status inquiry with respect to the application, indicating that applicants had yet to receive a Notice to File Missing Parts of Application. The status inquiry identified both the customer number 23720 and the address 10333 Richmond, Suite 1100, Houston, TX 77042.

On 06 November 2003, the United States Designated/Elected Office (DO/EO) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a copy of the sequence listing in computer readable form, as required in 37 CFR 1.821(e) and PCT Rule 13*ter*.1(a)(ii), and an Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date, must be filed. The period for response expired 06 January 2004, two months from the mail date of the Notification. The mailing address of the Notification was: Mark D. Moore,

Ph.D. WILLIAMS, MORGAN & AMERSON, 7676 Hillmont, Suite 250 Houston, TX 77040.

On 26 February 2004, applicants filed a second status request with respect to the application. Again, applicants stated that they had not yet received the Notice to File Missing Parts of Application. However, the second status request was accompanied by a Change of Correspondence Address form which both identifies the Customer Number 23720 and indicates a change in the address for the application to: Williams, Morgan & Amerson, P.C., 10333 Richmond, Suite 1100, Houston, TX 77042.

On 25 March 2004, the USPTO mailed a copy of the Notification of Missing Requirements to applicants' new address.

On 06 April 2004, applicants filed a petition under 37 CFR 1.181, requesting a reissue of the Notification of Missing Requirements and that the time period for replying the Notification be restarted. The petition was accompanied by, *inter alia*,: a copy of the Request for Customer Number Data Change which had been filed on 11 November 2002, a copy of the Notice of Customer Number Record Change which had been mailed on 13 December 2002, a copy of the status inquiry which was dated 06 May 2003, a copy of a return receipt post card indicating reception by the USPTO of a status inquiry on 09 May 2003, a copy of the second status inquiry which was filed on 26 February 2004, a copy of the Change of Correspondence Address filed with the second status request, a "Statement of Mark D. Moore re Petition to the Commissioner Under 37 CFR § 1.181 to Reissue Notification of Missing Requirements Under 35 U.S.C. 371 and to Restart the Time Period for Replying to Such Notice" (affidavit of practitioner Mark D. Moore), a "Statement of Shawn Smith re Petition to the Commissioner Under 37 CFR § 1.181 to Reissue Notification of Missing Requirements Under 35 U.S.C. 371 and to Restart the Time Period for Replying to Such Notice," and a "Patent Information Print" of a docketing record for the application.

On 14 July 2004, a decision dismissing the 06 April 2004 petition was mailed. Applicants were given a time period of two months in which to file a renewed petition under 37 CFR 1.181.

On 19 July 2004, applicants submitted the paper "Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," accompanied by, *inter alia*,: a printout of a list of certain patent numbers and patent application numbers which had been submitted on diskette to the USPTO, a copy of a letter to the USPTO, having a date 16 October 2002 identified thereon, explaining that the list of patent numbers and patent application numbers on the diskette were to be associated with the Customer Number 023720, a copy of the status inquiry dated 06 May 2003, and a copy of the post card indicating submission of the status inquiry on 08 May 2003. The printout list includes an entry "10/169,050."

On 20 July 2004, applicants submitted the paper, "Second Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements

Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," accompanied by, *inter alia*, a copy of the letter faxed from the EBC to the practitioner on 23 October 2002. The letter acknowledges receipt of a spreadsheet of application numbers and patent numbers to be associated with practitioner's customer number. The letter also refers to an error report, with which it has been faxed, which includes certain ones of the application numbers and patent numbers where review and verification by the practitioner was required.

Also on 20 July 2004, applicants further submitted the paper, "Third Renewed Petition To The Commissioner Under 37 C.F.R. § 1.181(a) To Reissue Notification Of Missing Requirements Under 35 U.S.C. 371 And To Restart The Time Period For Replying To Such Notice," accompanied by, *inter alia*, a copy of the corrected error report and a message confirmation sheet. The error report includes a list of application numbers and patent numbers thereon. The facsimile identifier on the report indicates that, before correction, the error report had been faxed from "USPTO PATENTS EBC" on 23 October 2002. The message confirmation sheet indicates that the corrected copy of the error report was faxed to the EBC on 25 October 2004.

DISCUSSION

It is evident from the record and the submissions of applicants that the address on the Notification of Missing Requirements, mailed 06 November 2003, was incorrect due to USPTO error, causing the Notification to be mailed to the wrong address. By at least as early as 25 October 2002, applicants had established to the USPTO an association between the Customer Number 23720 and the correspondence address of the application. Accordingly, when the Request for Customer Number Data Change was filed by applicants on 11 November 2002, which changed the address for the customer number, this constituted an effective request for change of correspondence address for the application. However, the USPTO did not change its records with respect to the correspondence address for the application as it should have, and this resulted in mailing the Notification to the wrong address.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.181 is **GRANTED**.

Also, for the reasons above, the time period for responding to the Notification of Missing Requirements is **VACATED**.

The application is being returned to the National Stage Processing Division of the Office of PCT Operations for continued processing, including the **re-mailing** of a Notice of Missing Requirements (PCT/DO/EO/905) indicating that a signed oath or declaration of the inventors and the surcharge set forth in 37 CFR 1.492(e) are due.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jim Foster
Detail
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS TX 75219

COPY MAILED

MAR 0 2 2009

OFFICE OF PETITIONS

In re Application of	:	
THRESHER, Ron et al.	:	
Application No. 10/169,050	:	DECISION ON PETITION
Filed: September 17, 2004	:	TO WITHDRAW
Attorney Docket No. **36677.28**	:	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 30, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Mark D. Moore on behalf of all attorneys of record who are associated with customer No. 27683. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Ron Thresher at the address indicated below.

There is an outstanding Office action mailed January 16, 2009 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **RON THRESHER**
50 BRAMBLE ROAD
RIDGWAY, TASMANIA
AUSTRALIA, 7054

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ALLAN RATNER
RATNER & PRESTIA
ONE WESTLAKES BERWYN SUITE 301
PO BOX 980
VALLEY FORGE, PA 19482-0980

MAILED

NOV 19 2009

OFFICE OF PETITIONS

In re Application of :
Shuichi Yoshida et al :
Application No. 10/169,052 : ON PETITION
Filed: November 4, 2002 :
Attorney Docket No. MTS-3352US

This is a decision on the petition, filed November 17, 2009 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 21, 2009 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2431 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

COPY MAILED
MAY 12 2006
OFFICE OF PETITIONS

In re Patent of :
Bauer et al. :
Application No. 10/169,053 : DECISION
Filed: August 28, 2002 : ON PETITION
Attorney Docket Number: GEI-094 :

This is a decision on the Request for Withdrawal of Notice of Abandonment, filed February 8, 2006. The Request is properly treated as a petition under 37 CFR §1.181(a).

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 "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed June 16, 2004. The Office communication set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been filed, this application became abandoned on July 17, 2004. A Notice of Abandonment was mailed on December 30, 2004, and re-mailed February 1, 2005.

The instant petition

Applicants request that the holding of abandonment in this application be withdrawn because Applicants did not receive the June 16, 2004 Office communication. Applicants provides that, while the office moved on October 1, 2003, the Post Office

forwarded mail without difficulty through October 1, 2004. Applicant's also file a change of correspondence with the instant petition.

Analysis

A review of Office records indicate that the final Office action was properly mailed to the correspondence address of record. Absent any irregularities in the mail, correspondence is presumed to have been delivered to the correspondence address of record. A review of the file reveals no irregularity in the mailing. Moreover, Office records indicate that the Office communication, mailed June 16, 2004, was returned as undeliverable by the United States Postal Service. Also returned as undeliverable was the December 30, 2004 Notice of Abandonment.

Further, Office records reveal that Applicants failed to file a Change of Correspondence Address until over 16 months after Applicants had changed their correspondence address.

Conclusion

The petition is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: 2201 South Clark Place
Customer Window
Crystal Plaza Two, Lobby Room 1B03
Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
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

HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

COPY MAILED
JUN 23 2006
OFFICE OF PETITIONS

In re Patent of	:	
Bauer et al.	:	
Application No. 10/169,053	:	DECISION
Filed: August 28, 2002	:	ON PETITION
Attorney Docket Number: GEI-094	:	

This is a decision on the Petition to revive the application under 37 CFR 1.137(b), filed June 12, 2006.

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed June 16, 2004. The Office communication set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been filed, this application became abandoned on July 17, 2004. A Notice of Abandonment was mailed on December 30, 2004, and re-mailed February 1, 2005.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). A Response to the Restriction/Election requirement was filed August 18, 2005. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 1621 for processing of the Response to the Restriction/Election requirement.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

COPY MAILED

APR 23 2008

OFFICE OF PETITIONS

In re Application of	:	
Jacques Bauer et al	:	
Application No. 10/169,053	:	ON PETITION
Filed: August 28, 2002	:	
Attorney Docket No. GEI-094	:	

This is a decision on the petition under 37 CFR 1.137(b), filed November 29, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 14, 2007, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 15, 2007.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1621 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

AUG 04 2006

Director's Office
Group 3700

DENNISON, SCHULTZ & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA VA 22314

In re Application of:
JACQUES GRANGER ET AL.
Serial No.: 10/169,069
Filed: July 31, 2002
Docket: 02124
Title: CLOSURE CAP FOR A STANDARD GLASS RING

DECISION ON PETITION TO WITHDRAW FINALITY AS PREMATURE

This is a decision on the petition filed on April 21, 2006 to withdraw the finality of the Office Action of March 3, 2006.

The petition is **DISMISSED as moot**.

In his April 21, 2006 petition the applicant requested a withdrawal of the finality of the Office action on March 3, 2006. In support of his petition, the applicant argues that the December 12, 2005 amendment did not necessitate a final rejection.

The record shows that:

1) On December 12, 2005 the applicant filed an amendment which cancelled a claim, and introduced a 37 C.F.R. 132 Declaration from one of the inventors to explain the basis of the invention.
2) On March 3, 2006, the examiner issued a final Office Action, rejecting the claims under 35 U.S.C. 103, and stating that the Declaration necessitated new grounds of rejection, thus making the Office Action final.
3) On April 21, 2006, the applicant filed the present petition to withdraw the finality of the Office Action. Specifically, the applicant argued that under 706.07(a), the cancellation of a claim could not have necessitated a new ground of rejection by the examiner. Moreover, the applicant argues that the Declaration does not constitute an amendment to the claims which could have necessitated a new ground of rejection by the examiner.
4) On June 2, 2006, the applicant submitted an amendment after final which included remarks which argued for the withdrawal of the rejection.
5) On June 20, 2006, the examiner issued a notice of allowance for the application. Specifically, the examiner found "Applicant's request for reconsideration of the finality

of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn."

In view of the history, the relief the applicant requested, namely the withdrawal of the finality of the March 3, 2006 Office Action, has already occurred. The application has already been allowed. Moreover, the examiner also specifically withdrew the finality of the March 3, 2006 Office Action. Accordingly, the petition is dismissed as moot.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

Karen M. Young

Karen M. Young, Director
Technology Center 3700

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20070821

DATE : August 21, 2007

TO SPE OF : ART UNIT 3673

SUBJECT : Request for Certificate of Correction on Patent No.: 7,186,060

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

SPE: Patricia L. Engle **Art Unit** 3673

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

C. Irvin McClelland
Oblon Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

MAILED
FROM DIRECTOR'S OFFICE

AUG 2 4 2007

TECHNOLOGY CENTER 3600

In re Application of:
Eiki Akimoto et al.
Appl. No. 10/169,081
Filed: July 8, 2002
For: TUBULAR CULVERT INTERIOR LINING METHOD AND LINING APPARATUS WITH SIMULTANEOUS INJECTION OF BACK-FILING MATERIAL

:PETITION TO INVOKE
:SUPERVISORY AUTHORITY
:UNDER 37 CFR 1.181

This is a decision on Applicant's Petition under 37 CFR 1.181 filed on September 26, 2006 to invoke supervisory authority.

The Petition is **GRANTED** to the extent indicated below.

On May 22, 2006, the Examiner issued a Notice of Allowability with an Examiner's Amendment. The Examiner's amendment included a correction to page 55, line 10 changing "95" to --9--. The Applicant then submitted an amendment under 37 C.F.R. 1.312 on August 4, 2006. The amendment requested that the Examiner's amendment to page 55, line 10 be undone and "9" be changed to --95--. The Examiner refused entry of the amendment under 37 C.F.R. 1.312 on August 21, 2006.

Petitioners have requested relief in the form of reconsideration and approval of the amendment filed under 37 CFR 1.312 on August 4, 2006. In the amendment filed under 37 CFR 1.312, Petitioners requested that the Examiner's Amendment to page 55, line 10 be reversed. The paragraph starting on line 1 of page 55 is a listing of reference characters and the elements that relate to the reference characters. The Examiner's Amendment changed the reference that was associated with the back filling material injection tube from reference character 95 to reference character 9. The specification, on line 9 of page 79 clearly states that the back filling material injection tube is associated with reference character 95.

Although changes to the specification to change the reference character when there is a disagreement between and reference character as used in the description and in the

drawings is permitted by MPEP 1302.04. The Examiner should have called to request the change be made since there was confusion in the format of the paragraph being changed.

The application has been issued as US Patent 7,186,060. Approval of the amendment under 37 C.F.R. 1.312 would be untimely. Therefore, the amendment will be incorporated into a *sua sponte* "Office mistake" Certificate of Correction that will be forwarded to Certificate of Corrections branch.

SUMMARY: The Petition is **GRANTED.**

Any questions regarding this decision should be directed to Patricia Engle at 571-272-6660.

Donald T. Hajec, Director
Technology Center 3600
571-272-5150

SNM/ple : 8/21/07

SM

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AUG 16 2007

In re Application of Naoya Kobayashi et al Serial No. 10/169,084 Filed: July 9, 2002 For: MAMMALIAN IMMORTALIZED LIVER CELL	: : : : : :	NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(b)

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR 1.313(b)(3).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon 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 Joseph Woitach at (571) 272-0739.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Christopher Low

Christopher Low, Acting Director
Technology Center 1600

KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON DC 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

18 JUN 2008

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON DC 20005

In re Application of:	:	
KOBAYASHI, Naoya, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/169,084	:	(37 CFR 1.78(a)(3))
PCT No: PCT/US02/06640	:	
International Filing Date: 15 March 2002	:	
Priority Date Claimed: 16 March 2001	:	
Atty Docket No.: 010334PCT	:	
For: A MAMMALIAN IMMORTALIZED	:	
LIVER CELL	:	

This is a decision on the "Petition Under 37 CFR 1.78(a)(3)" filed November 26, 2007. The petition seeks acceptance of an unintentionally delayed benefit claim under 35 U.S.C. 120 and 365(c). Deposit Account No. 01-2340 will be charged the required $1,410 petition fee.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii).

The present non-provisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after the 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).

A petition under 37 CFR 1.78(a)(3) must include the following:

(1) the reference to the prior-filed non-provisional application required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), unless previously submitted;
(2) the surcharge set forth in 37 CFR 1.17(t);
(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 petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(6) in that: (1) a reference to prior-filed non-provisional application 09/809,203 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 includes a proper statement of unintentional delay. Accordingly, having found that the

petition for acceptance of the unintentionally delayed claim for the benefit of priority under 35 U.S.C. 120 to prior-filed non-provisional U.S. application 09/809,203, filed 16 March 2001, satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the filing date 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 will include the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed non-provisional application, accompanies this decision on petition.

Any questions concerning this decision may be directed to Richard M. Ross at (571) 272-3296. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 1636 for appropriate consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. 120 to prior-filed non-provisional U.S. Application No. 09/809,203.

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

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
10/169,084	01/06/2003	1636	1404	010334NAT	15	4

CONFIRMATION NO. 7070

CORRECTED FILING RECEIPT

23850
KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON, DC 20005

OC000000030533437

Date Mailed: 06/18/2008

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)

Naoya Kobayashi, Okayama-shi, JAPAN;
Philippe Leboulch, Charlestown, FRANCE;
Noriaki Tanaka, Asakuchi-gun, JAPAN;
Toshiyoshi Fujiwara, Okayama-shi, JAPAN;
Toshinori Totsugawa, Hiroshima, JAPAN;

Power of Attorney:
Nicolas Seckel--44373

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US02/06640 03/15/2002
which is a CIP of 09/809,203 03/16/2001 ABN

Foreign Applications

If Required, Foreign Filing License Granted: 06/17/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/169,084**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
**** SMALL ENTITY ****

Title

MAMMALIAN IMMORTALIZED LIVER CELL

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign 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).

25 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

In re Application of	:	
SLANEC et al.	:	
Application No.: 10/169,089	:	DECISION ON
PCT No.: PCT/EP00/12104	:	
Int. Filing Date: 01 December 2000	:	PETITION UNDER
Priority Date: 03 December 1999	:	
Attorney Docket No.: P67986US0	:	37 CFR 1.137(b)
For: PEDAL SYSTEM FOR A MOTOR VEHICLE	:	
COMPRISING A DISPLACEMENT SENSOR	:	

This decision is in response to applicant's "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed 10 July 2002.

BACKGROUND

On 01 December 2000, applicants filed international application PCT/EP00/12104, which claimed a priority date of 03 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 June 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 June 2001, which was within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 June 2002.

On 10 July 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, the surcharge under 37 CFR 1.492(e) for providing an oath or declaration later than thirty months from the priority date, a purported translation of the international application into English, and the instant "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" which included an assertion of small entity status.

On 09 September 2002, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 08 October 2002, applicants submitted a declaration of inventors.

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:

(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicants submitted the basic national fee on 10 July 2002.

As to item (2), applicants submitted the petition fee for a small entity of $640.00 on 10 July 2002.

With regard to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) mailed 09 September 2002 is hereby VACATED since it was mailed before a decision on applicant's petition to revive under 37 CFR 1.137(b) was made.

The declaration of inventors filed 08 October 2002 is not in compliance with 37 CFR 1.497(a)-(b). Each declaration must be complete in and of itself. I.e., each declaration must identify, *inter alia*, each inventor. It is not clear from the declaration filed 08 October 2002 that each declaration presented to and signed by the inventors was complete. It appears that four inventors signed three separate declarations. However, only one declaration, which contains two first pages of a declaration and one second page, was provided. Thus, it is not clear that the declaration signed by Konrad Slanec and Gregory Joslin included the fourth inventor Uwe Neumann-Henneberg. Nor is it clear that the declaration signed by Gilbert Sammut included the fourth inventor Uwe Neumann-Henneberg. And it is not clear whether Uwe Neumann-Henneberg was presented with a first page of the declaration. Applicants must submit either a single declaration executed by all of the inventors or in the alternative a copy of the entire declaration for each signed declaration .

Although applicants did not indicate small entity status on the transmittal letter filed 10 July 2002 and paid the standard fee for the basic national fee and the surcharge under 37 CFR 1.492(e), small entity status is indicated in the petition to revive. Accordingly, Deposit Account 06-1358 will be credited the difference between the standard fee and the small entity fee for the basic national fee and the surcharge under 37 CFR 1.492(e). The processing fee under 37 CFR

1.492(f) has been charged to Deposit Account 06-1358.

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response. Extensions of time under 37 CFR 1.136(a) are available.

Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FITCH EVEN TABIN & FLANNERY
P O BOX 65973
WASHINGTON, DC 20035

COPY MAILED

MAY 11 2005

OFFICE OF PETITIONS

In re Application of :
Yoshihiro Tsukamoto et al :
Application No. 10/169,126 : DECISION GRANTING PETITION
Filed: June 27, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 7398/73142 :

This is a decision on the petition, filed April 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 December 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 the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the 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).*

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)
6,857,257	2005-02-22	10/169,151	2002-10-29	ANGELERI1

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	/jmf/	Date (YYYY-MM-DD)	2009-03-30
Name	Jay M. Finkelstein	Registration Number	21082

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6857257
Issue Date: February 22,2005
Application No. 10169151
Filed: October 29,2002
Attorney Docket No. ANGELERI1

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed March 30,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 30,2009 . 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.

25 JUN 2003

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

COLLARD & ROE, P.C.
1077 Northern Blvd.
Roslyn, New York 11576-1696

In re Application of :
VILLALON CASTILLA, Antonia :
U.S. Application No.: 10/169,175 :
PCT No.: PCT/ES00/00481 :
Int. Filing Date: 21 December 2000 : **DECISION**
Priority Date: 28 December 1999 :
Attorney Docket No.: VILLALON CASTILLA-1 :
For: THERMOSTIMULATION APPARATUS :
FOR THERAPEUTIC TREATMENTS :

This is a decision on the "Petition Under Rule 181" filed on 07 March 2003. This is treated as a request to restart the period for reply set forth in the Office communication mailed on 29 August 2002 to run from the date on which the Office communication was actually received. No fee is required.

BACKGROUND

On 29 August 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b), and a surcharge fee of $65.00 must be provided. Applicant was given two months to respond.

On 07 March 2003, applicant submitted the instant petition which was accompanied by, *inter alia*, a copy of counsel's docket records for various periods including the date the response was due (29 October 2002), an executed declaration and a check of $65.00 for the surcharge fee.

DISCUSSION

Section 710.06 of the Manual of Patent Examining Procedures (MPEP) states that the Office will grant a petition to restart the previously set period for reply to an Office action to run from the date of receipt of the Office action at the correspondence address when the following criteria are met:

(A) the petition is filed within two weeks of the date of receipt of the Office action at the correspondence address;

(B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g., at least 1 month of a 2- or 3-month reply period had elapsed); and

(C) the petition includes (1) evidence showing the date of receipt of the Office action at the correspondence address (e.g., a copy of the Office action having the date of receipt of the Office action at the correspondence address stamped thereon, a copy of the envelope (which contained the Office action) having the date of receipt of the Office action at the correspondence address stamped thereon, etc.), and (2) a statement setting forth the date of receipt of the Office action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the Office action at the correspondence address.

Here, petitioner provided a statement that the Office communication in question was received at the correspondence address of record via facsimile on 03 March 2003. The instant petition to reset was filed within two weeks of receipt of the Office communication. A substantial portion of the set reply period had elapsed on the date of receipt. Therefore, items (A) and (B) above are satisfied.

Concerning item (C), petitioner provided a copy of the law firm's docket printed on 05 September 2002 which shows the period 29 October 2002. Counsel explains that this is a copy of the firm's docket for the date that a response would have been due if the Form PCT/DO/EO/905 mailed 29 August 2002 had been received but that "[t]here is no entry for Missing Requirements for Villalon Castilla." Counsel also included a copy of the docket printed on 23 September 2002 for the same date.

A review of the evidence submitted verifies that counsel has no record that the Form PCT/DO/EO/905 mailed 29 August 2002 was ever received until sent via facsimile on 03 March 2003. Thus, applicant has also satisfied item (C) above.

CONCLUSION

Applicant's petition to reset the time period is hereby **GRANTED**.

The statutory period in the Form PCT/DO/EO/905 originally mailed 29 August 2002 is hereby reset to run from the receipt date of **03 March 2003**. This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJR.: 08-05

Paper No: __

COPY MAILED
AUG 1 2 2005
OFFICE OF PETITIONS

FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI & BIANCO P.L.
ONE BOCA COMMERCE CENTER
551 NORTHWEST 77TH STREET, SUITE 111
BOCA RATON FL 33487

In re Application of	:	
Boisonnet, et al.	:	
Application No. 10/169,237	:	DECISION
Filing Date: 27 June, 2002	:	
Attorney Docket No. 00-GR-148	:	

This is a decision on the petition filed on 1 August, 2005, alleging, *inter alia*, unavoidable delay under 37 C.F.R. §1.137(a), and unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.137(a) is **DISMISSED**; and
- under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the *ex parte Quayle* action (consisting of a cover/mail-date sheet (PTO-90C), a one-page Office Action Summary (PTOL-326), and a one-page detail of the action) mailed on 5 January, 2005, with reply due absent extension of time on or before Monday, 7 March, 2005;
- as to the petition under 37 C.F.R. §1.137(a), Petitioner submits the petition, the fee and a response intended as a reply (discussed below):

–and alleges, as the required showing, that the delay was unavoidable because his failure to respond was due to a docketing error made by a generally responsible and well-trained employee (who is not registered to practice before the Office);

–but fails to acknowledge that reasonable diligence–such as the review of the 5 January, 2005, *ex parte Quayle* action–on the part of the Petitioner (who is registered to practice before the Office) would have obviated the error; and

- Petitioner submits a response to the *ex parte Quayle* action in the form of an amendment as to formalities directed by the Examiner, submits a petition and fee under 37 C.F.R. §1.137(b), and makes 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]

---

[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).

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]))

As to the Allegation
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.

Petitioner failed to satisfy the "showing" requirement under 37 C.F.R. §1.137(a) .

As to the Allegation
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, the statement of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

Petitioner has satisfied the regulatory requirements under 37 C.F.R. §1.137(b) .

CONCLUSION

The instant petition:

- under 37 C.F.R. §1.137(a) hereby is **dismissed** (the fee previously was charged); and
- under 37 C.F.R. §1.137(b) hereby is **granted**, and, as authorized, the petition fee ($1,500.00) is charged to Deposit Account 50-1556

The instant application is released to Technology Center 2800 for further processing in due course.

---

[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.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

JUN 29 2004

Director's Office
Group 3700

MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

Paper No. 13

In re Application of
NATSUHARA ET AL.
Application No.: 10/169,249
Filed: June 28, 2002

DECISION ON PETITION

This is a decision on petitioner's request filed November 21, 2003, requesting supervisory review under 37 CFR 1.181 for 1) reconsideration of the amendment filed July 31, 2003 as being fully response and 2) reconsideration of the drawing requirement made by examiner in the office action mailed on May 21, 2003.

The petition is granted with respect to the amendment being fully responsive.

The petition is dismissed as moot with respect to the drawing requirement.

37 CFR 1.111 (a) (1) states:

If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See § 1.135 and 1.136 for time for reply to avoid abandonment.

MPEP 714.02 states in part:

In all cases where reply to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

As indicated in 37 CFR 1.111(a)(1) and MPEP 714.02, an applicant may respond without amendment as long as reconsideration or traversal is requested. Since petitioner's response of July 31, 2003 clearly includes a traversal of the drawing requirement as found on page 7 of the remarks, the amendment is considered fully responsive to the office action mailed on May 21,

2003. The petition is granted with respect to the amendment being fully responsive. Petitioner's fee of $950 for a three month extension of time will be refunded to deposit account 500417 since no further response was required to the office action of May 21, 2003.

With regard to the drawing requirement, since petitioner submitted a drawing with this petition, the question of whether a drawing is required is moot. The examiner is directed to consider the drawing in his next action.

Additionally petitioner was charged a $130 petition fee, no fee is required for this petition and the fee will also be refunded to deposit account 500417.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

30 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Stephen Y. Chow
Perkins, Smith & Cohen, LLP
One Beacon Street, 30th Floor
Boston, MA 02108

In re Application of SULLIVAN, Daniel L. Application No.: 10/169,250 PCT Application No.: PCT/US00/42498 International Filing Date: 30 November 2000 Priority Date: 30 November 1999 Attorney Docket No.: 13053-101US For: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR FACILITATING A TAX TRANSACTION	DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicant's "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 26 June 2002 is **GRANTED**.

BACKGROUND

On 30 November 2000, applicant filed international application number PCT/US00/42498. On 20 June 2001, a demand for international preliminary examination was submitted prior to nineteen months from the priority date. The deadline for entry into the United States National Stage was thirty months from the priority date, that is 30 May 2002.

On 26 June 2002, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, a petition to revive and the basic national fee.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant's statement that "the entire delay in filing the 35 U.S.C. 371(c) requirements from their due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). Applicant has paid

both the petition fee and the basic national fee. A terminal disclaimer is not required as application was filed on after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing, including preparation of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

2 9 OCT 2007

BURNS & LEVINSON, LLP
125 SUMMER STREET
BOSTON MA 02110

In re Application of	:	
SULLIVAN, Daniel et al.	:: :	
U.S. Application No.: 10/169,250	:	
PCT No.: PCT/US00/42498	:	DECISION ON
Int'l Filing Date: 30 November 2000	:	
Priority Date: 30 November 1999	:	PETITION
Attorney's Docket No.: 13053-101	:	
For: METHOD, SYSTEM AND	:	UNDER 37 CFR 1.181
COMPUTER PROGRAM	:	
PRODUCT FOR FACILITATING A	:	
TAX TRANSACTION	:	

Applicants filed "Petition to Correct Filing Date," on 16 March 2007. The Request has been treated as a petition under 37 CFR 1.181.

As set forth in MPEP 1893.03(b), the filing date of a national phase of a PCT is the international filing date. The "filing date" field on older filing receipts has been re-titled "filing or 371(c) date" on newer receipts to clearly distinguish it from the international filing date in a national phase application. The date in this field is the date of completion of the 35 U.S.C. §371 (c) requirements. Applicants supplied a declaration of the inventors and completed the 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) requirements on 18 November 2002, as indicated. MPEP 1893.03(b).

For the above reasons, the Petition Under 37 CFR 1.181 is **DISMISSED** without prejudice. Any further correspondence with respect to this matter may be filed electronically or if mailed, should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

29 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Alan M. Kagen
Nixon & Vanderhye
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

In re Application of TANAKA et al.	: DECISION ON
Application No.: 10/169,253	:
PCT No.: PCT/JP00/09342	: PETITION
Int. Filing: 27 December 2000	:
Priority Date: 28 December 1999	: UNDER 37 CFR 1.47(a)
Attorney Docket No.: 3688-6	:
For: METHOD OF PRODUCING METAL FERRULES, AND DEVICE THEREFOR	:

This is a decision on applicant's "Petition under 37 CFR 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 19 March 2003 in response to the Notification of Missing Requirements. Applicants also request a five month extension of time, which is granted.

BACKGROUND

On 26 August 2002, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration executed by the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge for filing the oath or declaration after the thirty month period was required.

On 19 March July 2003, in response to the Notification of Missing Requirements, applicants filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) along with a request for a five month extension of time. The petition requests the acceptance of the application without the signature of inventor, Yoshinari Kohno, on the grounds that the nonsigning inventor refused to execute the declaration. The petition includes the requisite petition fee and a declaration signed by the 37 CFR 1.47(a) applicant/inventor, Tetsuo Tanaka, on behalf of Yoshinari Kohno.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1) is satisfied with the payment of the petition fee. Item (4) is satisfied with the submission of a declaration in compliance with 37 CFR 1.497(a) and (b) executed by joint inventor, Tetsuo Tanaka. Counsel provided the last known address of Mr. Kohno, satisfying

Item (3).

With respect to item (2), the Declaration of Kijuro Kawakita, a Japanese patent attorney, accompanied the petition. Attorney Kawakita states that he forwarded a complete set of application papers (specification, claims, drawings, and declaration) to Mr. Kohno at his last known address on 24 June 2002 and that Mr. Kohno returned the application papers to him without execution including a letter indicating that he refused to sign the documents. Counsel further states that subsequently he "received a telephone call from Mr. Kohno on June 28, 2002 confirming that Mr. Kohno would not execute the document due to his refusal to cooperate with the joint inventor, Mr. Tanaka." Attorney Kawakita states that "in order to confirm Mr. Kohno's refusal to join in the application, I telephoned Mr. Kohno in October 2002 and on February 25, 2003 to again ask Mr. Kohno to execute the Declaration. Mr. Kohno, however, each time still refused to cooperate. Finally, I received another letter from Mr. Kohno on March 12, 2003 again confirming his refusal to join the application."

When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statements of facts. MPEP 409.03(d) Proof of Unavailability or Refusal (August 2001 Ed. p.400-28) Here Petitioner provided copies of Mr. Kohno's two letters of refusal written in the Japanese language and attached to Attorney Kawakita's statement as proof of Mr. Kohno's refusal to sign the declaration. However, an English translation of these letters was not provided and is necessary to satisfactorily support a conclusion of the inventor's express refusal to sign.

Petitioner has not yet satisfied the requirements of 37 CFR 1.47(a). Petitioner has not presented sufficient evidence to conclude that applicant/inventor refused to sign the application. What is required is a translation of Mr. Kohno's two letters attached to the declaration of Kijuro Kawakita as Exhibits 4 &5. Accordingly, it is inappropriate at this time to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467
Facsimile (703) 308-6459

22 OCT 2003

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Alan M Kagen
Nixon & Vanderhye
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

In re Application of TANAKA et al.	: DECISION ON
Application No.: 10/169,253	:
PCT No.: PCT/JP00/09342	: PETITION
Int. Filing: 27 December 2000	:
Priority Date: 28 December 1999	: UNDER 37 CFR 1.47(a)
Attorney Docket No.: 3688-6	:
For: METHOD OF PRODUCING METAL FERRULES, AND DEVICE THEREFOR	:

This is a decision on applicant's "Petition under 37 CFR 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 29 September 2003.

BACKGROUND

On 19 March July 2003, in response to the Notification of Missing Requirements, applicants filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Yoshinari Kohno on the grounds that the nonsigning inventor refused to execute the application.

On 29 July 2003, a decision dismissing applicant's petition was mailed indicating that applicant had failed to provide factual proof that the non-signing joint inventor refused to execute the application.

On 29 September 2003, applicant filed the instant renewed petition along with the statement of Kijuro Kawakita, a Japanese patent attorney, regarding Yoshinari Kohno's refusal to sign the application and a copy of Mr. Kohno's letter dated 12 March 2003 explaining his refusal to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant previously satisfied Items (1) and (3). With respect to item (2), applicant previously provided the Declaration of Kijuro Kawakita, a Japanese patent attorney. Attorney Kawakita stated that he forwarded a complete set of application papers (specification, claims, drawings, and declaration) to Mr. Kohno at his last known address on 24 June 2002 and that Mr. Kohno returned the application papers to him without execution indicating that he refused to sign the documents.

Mr. Kawakita stated:

> Subsequently, I received a telephone call from Mr. Kohno on June 28, 2002 confirming that Mr. Kohno would not execute the document due to his refusal to cooperate with the joint inventor, Mr. Tanaka. In order to confirm Mr. Kohno's refusal to join in the application, I telephoned Mr. Kohno in October 2002 and on February 25, 2003 to again ask Mr. Kohno to execute the Declaration. Mr. Kohno, however, each time still refused to cooperate. Finally, I received another letter from Mr. Kohno on March 12, 2003 again confirming his refusal to join the application.

(Kawakita Decl, ¶5)

A copies of Mr. Kohno's letters of 25 June 2002 andMarch 12, 2003, including English translations acknowledging his refusal to sign the documents, were provided with the renewed petition.

Attorney Kawakita, having firsthand knowledge of the facts, has provided a statement of facts along with the time and place of the refusal and proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor expressly refused to sign the application papers by his letter of 12 March 2003.

However, the petition under 37 CFR 1.47(a) cannot be granted at this time. A closer review of the declaration provided with the petition reveals it is not executed by the joint inventor *on behalf of* the non-signing inventor. While the declaration identifies and is executed by joint inventor Tanaka Tetsuo, it does not identify the non-signing inventor Yoshinari Kohno and does not provide Kohno's citizenship, residency and mailing address. Thus, the declaration is not in compliance with 37 CFR 1.497(a) and (b), and is not acceptable.

Petitioner has not yet satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

1 6 DEC 2003

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Alan M Kagen
Nixon & Vanderhye
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

In re Application of TANAKA et al. Application No.: 10/169,253 PCT No.: PCT/JP00/09342 Int. Filing: 27 December 2000 Priority Date: 28 December 1999 Attorney Docket No.: 3688-6 For: METHOD OF PRODUCING METAL FERRULES, AND DEVICE THEREFOR	DECISION ON SUPPLEMENT TO PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicant's "Supplement to Renewed Petition" under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 11 December 2003.

BACKGROUND

On 19 March July 2003, in response to the Notification of Missing Requirements, applicants filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Yoshinari Kohno on the grounds that the nonsigning inventor refused to execute the application.

On 29 July 2003, a decision dismissing applicant's petition was mailed indicating that applicant had failed to provide factual proof that the non-signing joint inventor refused to execute the application.

On 29 September 2003, applicant filed the instant renewed petition along with the statement of Kijuro Kawakita, a Japanese patent attorney, regarding Yoshinari Kohno's refusal to sign the application and a copy of Mr. Kohno's letter dated 12 March 2003 explaining his refusal to sign the application.

On 22 October 2003, a decision was mailed to applicants indicating declaration provided was not executed by the joint inventor *on behalf of* the non-signing inventor. The declaration identified and was executed by joint inventor Tanaka Tetsuo but it did not identify the non-signing inventor, Yoshinari Kohno and did not provide Kohno's citizenship, residency and mailing address. The declaration was not in compliance with 37 CFR 1.497(a) and (b), and was not acceptable.

On 11 December 2003, applicant filed a supplemental renewed petition under 37 CFR 1.47(a) along with a new executed declaration.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-

signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant previously satisfied Items (1),(2) and (3). With respect to Item (4), applicant has now provided the declaration executed by the joint inventor Tanaka Tetsuo *on behalf of* the non-signing inventor Yoshinari Kohno and provides Kohno's citizenship, residency and mailing address. Thus, the declaration is in compliance with 37 CFR 1.497(a) and (b), and is now acceptable.

Petitioner has satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

For the above reasons, the petition under 37 CFR §1.47(a) is **GRANTED.**

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 11 December 2003 and to mail a filing receipt. The application has an international filing date of 27 December 2000 under 35 U.S.C. 363, and a date of 11 December 2003 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

16 DEC 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

YOSHINARI KOHNO
25-1, SHIKAHAMA 2-CHOME, ADACHI-KU
TOKYO 123-0864 JAPAN

In re Application of TANAKA et al. Application No.: 10/169,253 PCT No.: PCT/JP00/09342 Int. Filing: 27 December 2000 Priority Date: 28 December 1999 Attorney Docket No.: 3688-6 For: METHOD OF PRODUCING METAL FERRULES, AND DEVICE THEREFOR	DECISION ON SUPPLEMENT TO PETITION UNDER 37 CFR 1.47(a)

Dear Mr. Kohno:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

Alan M. Kagen
Nixon & Vanderhye
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

1 6 DEC 2003

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventors. The inventor whose signature is missing (Yoshinari Kohno) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/JP00/09342 and was filed on 27 December 2000 in the names of Tetsuo Tanaka and Yoshinari Kohno entitled METHOD OF PRODUCING METAL FERRULES, AND DEVICE THEREFOR. The national stage application is assigned number 10/169,253 and has a 35 U.S.C. 371(c) date of 11 December 2003.

02 DEC 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Bruce E. Black
Office of Intellectual Property Counsel
3M Innovative Property Company
P.O. Box 333427
St. Paul, MN 55133-3427

In re Application of :
MAGARILL et al. : DECISION ON PETITION
U.S. Application No. 10/169,282 :
PCT No.: PCT/US01/50674 :
Int. Filing Date: 01 November 2001 :
Priority Date: 02 November 2000 :
Attorney Docket No.: USPL-83
For: OPTICAL SYSTEMS FOR REFLECTIVE LCDS

The above identified application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371. Additionally, this decision is a reply to "Request For Corrected Filing Receipt" filed 10 February 2003 and "Response under 37 CFR 1.111" filed 05 January 2004. No petition fee is required.

BACKGROUND

On 27 June 2002, applicants filed materials to initiate the U.S. national stage application of PCT International Application No. PCT/US01/50674, filed on 01 November 2001. This submission included: a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390); payment of the basic national fee; an Information Disclosure Sheet (IDS); a Preliminary Amendment; and an executed declaration of inventors. A copy of the PCT International Application No. PCT/US01/50674 was communicated to the United States Patent and Trademark Office from the International Bureau on 10 May 2002.

On 20 September 2002, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 27 June 2002. Subsequently, an Official Filing Receipt was issued indicating that "this application is a 371 of PCT/US01/50674 dated 11/01/2001 which claims benefit of 60/292,178 dated 18 May 2001." Further, the filing receipt incorrectly indicated that the application included two (2) drawings and twenty-one (21) total claims and three (3) individual claims.

On 10 February 2003, applicant filed "Request For Corrected Filing Receipt" which indicated errors in: the number of drawings; total claim and independent claims; domestic priority data, and title.

In response to an Office Action mailed by United States Patent and Trademark Office on 01 October 2003, applicant filed the present petition papers.

U.S. Application No. 10/169,282

DISCUSSION

Applicants state in the present petition that "[i]t appears that, through no fault of the Applicants, there was a mistake made by the UPSTO or International Bureau and that the PCT patent application that was transmitted to the UPSTO was PCT Application No. PCT/US02/15523. . .None of the documents filed by the Applicant requesting entry into National Phase reference this application." As noted above, the transmittal letter filed by applicant on 27 June 2002 reveals a clear request for the present application to be a national stage application of PCT International Application No. PCT/US01/50674, a copy of which was included with the submission. Based on this request, and the description of the subject specification, it is concluded that the contents of published international application PCT/US01/50674 were the proper description, claims, and drawings herein. It is also clear from the above facts that international application PCT/US02/15523 was improperly indexed by the USPTO as the intended subject of this application. Accordingly, the USPTO's treatment of international application PCT/US01/50674 as the subject matter of this application is appropriately corrected, as requested by applicants in the present petition.

CONCLUSION

The petition **GRANTED**.

The Office Action mailed 01 October 2003 is hereby **VACATED**.

The Official Filing Receipt will be corrected to read: "this application is a 371 of PCT/US01/50674 dated 11/01/2001 which claims benefit of 60/245,360 dated dated 11/02/2000." Further, the filing receipt will indicate that the application included six (6) drawings and thirty six (36) total claims and three (4) individual claims.

The application file will be corrected so that the specification, claims, drawings, and abstract from PCT/US01/50674 will be made the subject of the present application, and the Preliminary Amendment filed by applicant on 27 June 2002 will be applied thereto.

Leonard Smith
PCT Legal Examiner
Office of Legal Administration

Anthony Smith
Attorney-Advisor
Office of Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

31 MAR 2005

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Kathleen D. Rigaut
Dann, Dorfman, Herrell & Skillman, PC
1601 Market Street
Suite, 2400
Philadelphia, PA 19103-2307

In re Application of	:	
DRISCOLL, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/169,287	:	
Filing Date: 28 June 2002	:	UNDER 37 CFR 1.181
Atty Docket No.: Rut00-0062US	:	
For: COMPOSITIONS AND METHODS FOR	:	
GENE SILENCING	:	

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Missing Requirement Letter Under 37 CFR §1.181 (a)" filed 23 March 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 02 January 2001, applicant filed international application PCT/US01/01224, which claimed priority of an earlier application filed 30 December 1999. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 30 June 2002.

On 28 June 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 13 September 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 03 March 2005, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the NOTIFICATION OF MISSING REQUIREMENTS within the time period set therein and that above-identified application was abandoned as to the United States.

On 23 March 2005, applicant filed the present petition under 37 CFR 1.181 to withdraw

the holding of abandonment.

DISCUSSION

A review of the application file finds that the Form PCT/DO/EO/905 contained therein is a "Notification of Missing Requirements" for a different U.S. National stage application than the present application and thus is addressed to a different law firm. It appears that a Form PCT/DO/EO/905 was never prepared nor mailed for the application 10/167,287. As such, it is proper to grant applicant's petition at this time to withdraw the holding of abandonment.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The "NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909)" mailed on 03 March 2005 is hereby **VACATED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision; namely the issuance of a new "Notification of Missing Requirements" (Form PCT/DO/EO/905).

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 1

DATE : 2/7/05

TO SPE OF : ART UNIT 1756

SUBJECT : Request for Certificate of Correction on Patent No.: 6797446 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.

BEST AVAILABLE COPY

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.

- [x] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments:

MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

SPE

1756
Art Unit

6/6/5

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

13 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

William J. Hone
Fish & Richardson, P.C.
45 Rockefeller Plaza, Suite 2800
New York, NY 10111

In re Application of SABIN, et al. Application No.: 10/169,307 PCT No.: PCT/US00/04634 Int. Filing Date: 24 February 2000 Priority Date: 26 February 1999 Attorney Docket No.: 09155-005001 For: PREPARATION OF REFRIGERANT MATERIALS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 28 June 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "the entire period of delay was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted an executed declaration and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

Applicant is advised that the filed combined declaration and power of attorney does not comply with 37 CFR 1.497(a)-(b) in that the declaration does not identify the citizenship of the inventors.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration is required.

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TIMOTHY J. MARTIN, P.C.
9250 W. 5TH AVENUE, SUITE 200
LAKEWOOD, CO 80226

COPY MAILED

MAR 1 5 2004

OFFICE OF PETITIONS

In re Application of :
Juzer Jangbarwala :
Application No. 10/169,316 :
Filed: September 23, 2002 :
Attorney Docket No. 1707

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 1754.

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

Mailed: 10/21/04

rld
Paper Number

In re application of
Gerald B. Eaton et al.
Serial No. 10/169,330
Filed: August 9, 2002
For: UNIQUE SUPPORTED METALLOCENE CATALYST FOR PRODUCING SYNDIOTACTIC STYRENIC POLYMER

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181(a), filed July 13, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment mailed on June 28, 2004, for failure to timely file a proper reply to the Office letter mailed September 25, 2003 be withdrawn since applicants did timely file a reply December 16, 2003 as indicated in the Express Mail Label, and further evidenced by a copy of the Return Postcard identifying the papers filed (Reply Transmittal letter (4 Pages) in Duplicate; Reply Pursuant to 37 CFR § 1.111 (12 pages), and post card, all sent via Express Mail Label No. EV 325636683 US), and showing the USPTO receipt stamp dated December 16, 2003. (A copy of the reply is attached to the instant petition as well as a copy of the USPTO date stamped postcard receipt.)

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the evidence presented reveals that applicant's reply was properly filed on December 16, 2003 as evidenced by the Express Mail Label and stamped Return Postcard. Accordingly, any holding of abandonment for failure to timely file a proper reply to the Office letter mailed June 28, 2004 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for entry, processing and consideration of the reply originally filed on December 16, 2003 as indicated by applicant.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE, 46TH FLOOR
1650 MARKET STREET
PHILADELPHIA PA 19103

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 11/4/04

Paper No.: _____

TO SPE OF : ART UNIT 2800

SUBJECT : Request for Certificate of Correction on Patent No.: 6766276 B1

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:

The COC is accepted.

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

SPE

2857

Art Unit

OIPE JC103
AUG 1 1 2004
PATENT & TRADEMARK OFFICE

PATENT

Docket No.979-004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Dury
Serial No. : 10/169,339
Filed : September 30, 2002
For : METHOD AND DEVICE FOR DETECTING A DYSFUNCTION OF AN ULTRASONIC..

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

Certificate
AUG 1 3 2004
of Correction

Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached Request for Corrected Patent, Copy of the First Page of the Patent, and Return Postcard along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450.

Respectfully submitted,

SOFER & HAROUN, L.L.P.

By: Sandra Cirillo
Sandria Cirillo

Date: 8/9/04

Mailing Address:

SOFER & HAROUN, L.L.P.
317 Madison Avenue, Suite 910
New York, New York 10017
Tel:(212)697-2800
Fax:(212)697-3004

AUG 1 7 2004

OIPE JC183
AUG 1 1 2004
PATENT & TRADEMARK OFFICE

PATENT

Docket No. 979-004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dury

Patent No.: 6,766,276 B1

Issued: July 20, 2004

For: METHOD AND DEVICE FOR DETECTING A DYSFUNCTION OF ULTRASONIC FLOWMETER

REQUEST FOR CORRECTION OF PATENT UNDER 35 USC 254

Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed, please find a copy of the cover sheet for the above identified patent that has the word ULTRASONIC misspelled in the title and the wrong PCT filing date; the PCT filing date should be December 19, 1999.

Please issue a Certificate of Correction.

If any fees are required, please charge them to our Deposit Account No.: 19-2825, order no.: 979-004.

Respectfully Submitted,
SOFER & HAROUN, LLP

Joseph Sofer, Esq.
Reg. No. 34,438

Dated: 8/9/04

AUG 1 7 2004

US006 / 6B1

(12) **United States Patent**
Dury

(10) **Patent No.: US 6,766,276 B1**
(45) **Date of Patent: Jul. 20, 2004**

(54) **METHOD AND DEVICE FOR DETECTING A DYSFUNCTION OF AN ULATRASONIC FLOWMETER** ULTRASONIC

(75) Inventor: **Herve Dury**, Macon (FR)

(73) Assignee: **Actaris S.A.S.** (FR)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **10/169,339**

(22) PCT Filed: **Dec. 29, 1999** *

(86) PCT No.: **PCT/FR00/03590**

§ 371 (c)(1),
(2), (4) Date: **Sep. 30, 2002**

(87) PCT Pub. No.: **WO01/50095**

PCT Pub. Date: **Jul. 12, 2001**

(30) **Foreign Application Priority Data**

Dec. 29, 1999 (FR) 99 16699

(51) **Int. Cl.**[7] **G06F 11/30**

(52) **U.S. Cl.** **702/185**; 702/35; 702/45; 702/82; 702/185; 73/1.59; 73/1.31; 340/606; 324/357

(58) **Field of Search** 702/35, 45, 53, 702/1, 82–185; 73/1.59, 1.31; 340/606–609; 324/357

(56) **References Cited**

U.S. PATENT DOCUMENTS

4,188,624 A * 2/1980 Hochsprung et al. 340/606
4,882,934 A * 11/1989 Leffert et al. 73/861.04
4,966,141 A * 10/1990 Bacaner et al. 128/207.14
5,321,973 A * 6/1994 Sogawa 73/35.04
5,627,759 A * 5/1997 Bearden et al. 702/62
5,804,739 A 9/1998 Herrmann et al. 73/861.18
6,226,598 B1 * 5/2001 De Vanssay et al. 702/48
6,606,916 B2 * 8/2003 Bignell et al. 73/861.27

FOREIGN PATENT DOCUMENTS

EP	0797105	9/1997
EP	0829734	3/1998
GB	2022255	12/1979

OTHER PUBLICATIONS

Turnbull et al., 'Ultrasound Backscatter Microscope for Skin Imaging', Jan. 1993, IEEE, pp. 985–988.*
International Search Report dated May 4, 2001.

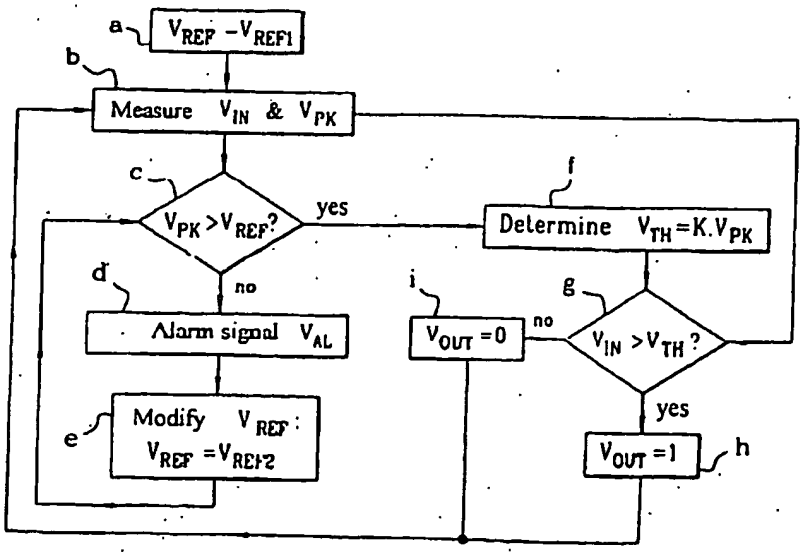
* cited by examiner

Primary Examiner—Marc S. Hoff
Assistant Examiner—Elias Desta
(74) *Attorney, Agent, or Firm*—Sofer & Haroun, LLP

(57) **ABSTRACT**

A method for detecting malfunctions in a flowmeter includes the measuring of the receive signal V_{IN} output by a transducer. A characteristic of the receive signal is compared to a predetermined reference characteristic V_{REF} and the peak voltage V_{PK} of the receive signal is stored. An alarm signal V_{AL} is generated when a trigger characteristic V_{DEC} of the receive signal is less than the predetermined reference characteristic. A threshold voltage V_{TH} is defined, proportional to the peak amplitude V_{PK} of the receive signal in such a manner that $V_{TH}=K\times V_{PK}$ where K is a factor depending on the transducer. The receive signal is compared with the threshold voltage and a conditioned output signal V_{OUT} is generated in a first state when the receive signal is greater than the threshold voltage, and in a second state when the receive signal is less than the threshold voltage.

17 Claims, 4 Drawing Sheets



UNITED STATES PATENT AND TRADEMARK OFFICE

MAR 24 2006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

GARY R. TANIGAWA
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203-1808

In re Application of	:
Benvenuto et al	:
Serial No. 10/169,351	: DECISION ON PETITION
Filed : 29 October 2002	:
Attorney Docket No. 4161-1	:

This letter is in response to the Petition under 37 C.F.R. 1.144, filed 12 December 2005, requesting review of the restriction requirement originally set forth in the communication mailed 19 April 2005 and made FINAL in the first Office action on the merits mailed 12 August 2005.

BACKGROUND

This application was filed on 29 October 2002 under 35 U.S.C. 371 and contained, as filed and amended, claims 1-33. The examiner mailed a restriction (i.e. Lack of Unity) requirement to applicants on 19 April 2005 in which the examiner divided the 33 claims into 65 groups. Because of the absence of a special technical feature, the examiner held that the groups of invention were not so linked as to form a single general inventive concept under PCT Rule 13.1.

On 13 May 2005 applicants spoke to the examiner and proposed to cancel existing claims 1-33 and add new claims 34-67. The examiner explained to applicants how under Rule 13.1 he would restrict new claims 34–67 into 20 groups and further require election of a single SEQ ID NO. within SEQ ID NOS. 31-48.

On 19 May 2005 applicants responded to the restriction requirement by canceling claims 1 - 33 and adding new claims 34-67. Applicants also elected Group I (now claims 37- 40 and SEQ ID NO. 31 for examination on the merits. Applicants requested reconsideration of the restriction on the basis that Groups VII-VIII, XIV and XIX do possess in common a special technical feature.

On 12 August 2005 the examiner mailed to applicants a first Office action on the merits in which claims 34 - 40 were examined to the extent that the antigen is Tat and the polypeptide pairs comprise a sequence of SEQ ID NOS. 31 and 32 (antibody F8). The examiner also withdrew claims 41 - 67 as directed to a non-elected invention. As the applicants requested, the examiner fully reconsidered the restriction requirement but still made the restriction requirement FINAL in this Office action. Claims 38-40 were rejected under 35 U.S.C. 112, second paragraph, as

indefinite; and claims 34-36 and 38-40 were rejected under 35 U.S.C. 112, first paragraph, as lacking enablement. Claims 34-37 were rejected under 35 U.S.C. 102(b) as anticipated by Tavladoraki et al and claims 34-39 were rejected under 35 U.S.C. 103(a) as unpatentable over Tavladoraki et al in view of Barbas et al.

On 12 December 2005 applicants filed a response to the Office action mailed 12 August 2005 in which claim 38 was amended and the rejections addressed appropriately. Also on 12 December 2005 applicants filed the instant Petition under 37 C.F.R. 1.144 requesting reconsideration of the restriction (i.e. Lack of Unity) requirement

On 12 January 2006 applicants filed a supplemental response to the non-final Office action mailed 12 August 2005 in which claim 34 was extensively amended.

DISCUSSION

The examiner holds that claims 34 - 67 can be properly divided into 20 separate groups because they do not relate to a single general inventive concept under PCT Rule 13.1 since, under PCT Rule 13.2, they lack the same or corresponding special technical feature. Hence, the Unity of Invention is lacking among the distinct inventions identified and further among the genus of polypeptides set forth in claims 34 and 37.

The examiner has restricted claims 34 - 67 into 20 groups and required further election of SEQ ID NOS. corresponding to a specific VH and VL region and a specific antigen. Applicants have elected SEQ ID NOS. 31 and 32, representing the heavy chain VH (framework peptides of SEQ ID NOS. 5 - 8) and Tat as the antigen.

Applicants traverse this restriction requirement on the basis of four issues.

(1) Applicants argue that claims 34-50, 56-59 and 64-67 all possess the same special technical feature (Groups I-VIII, XII, XIV, XVII and XIX)

Applicants argue that claims 34-50, 56-59 and 64-67 each possess a common "scaffolding" of the variable region (i.e. framework peptides of heavy chain VH and a light chain VL). They point to SEQ ID NOS. 82 and 83 as demonstrating this relatedness and commonality. Applicants state on page 4, lines 2 - 22 of the instant petition, "Therefore, SEQ ID NOS: 1 - 8 share a common structure: parts of the antibody variable region comprising the polypeptide pair of heavy chain VH and light chain VL."

Applicants' arguments have been fully considered but are not deemed persuasive. The applicants have pointed out the similarity among the variations in the scaffolding sequences. However, the amino acid substitutions permitted at the nine locations in the scaffold, gives rise to 952,560 different scaffolding sequences. Moreover, the antigen specificity is determined primarily by the complementary domain regions and also by the variations in the scaffolding. Therefore, there is no way to predict from applicant's scaffolding sequences, the final sequence of any antibody to a specific antigen without actually isolating the antibody and then sequencing the entire light chain

and heavy chain. For these reasons the Office agrees with the examiner that these numerous antibodies encompassed by claims 34 and 37 lack a common special technical feature.

While applicants may have defined more precisely the common variations in the light and heavy chains produced by plants, it was already known in the art at the time of the invention that antibodies from animals exhibit remarkable structural similarities while exhibiting highly specific antigen binding properties. Each antibody consists of four proteins, two light chains and two heavy chains linked by disulfide bonds into the shape of a "Y." Each light chain possesses a constant and a variable region. Each heavy chain possesses three constant domains and one variable domain. Additionally, carbohydrate moieties are attached to each CH_2 region. While all of this similarity is remarkable, the only way a person can determine the sequence of any antibody to a specific antigen is to sequence it in its entirety.

Additionally, applicants contend that the Tavladoraki et al. reference cannot be used to break unity of invention in this case because the claimed invention was not enabled by this reference.

Applicants' argument has been fully considered and found persuasive. Applicants contend that the Tavladoraki et al. reference is not enabling because it fails to teach a reliable method to obtain the specific F8 antibody and because it fails to provide the amino acid sequence of said antibody. Therefore, any specific scAb elected from claim 34 or 37 will also be examined along with its linking claim and with one process for preparing said antibody and one process for using said antibody (if such a claim were pending in the case.).

(2) Applicants point out that claim 34 is a linking claim that encompasses all of the various "scaffolding" sequences.

Applicant is correct in indicating that claim 34 is a linking claim which encompasses all of the antibody scaffoldings specified in the claims. This is true because while the language "consisting of" is closed, SEQ ID NOS: 1-3 and 7 contain variables at specific amino acid positions which may permit from three to seven different amino acids at these positions. This generic linking claim embraces 952,560 different scaffolding amino acid sequences.

As required by MPEP 809, the linking claim(s) must be examined with the elected invention and should any linking claim be allowed, the restriction requirement must be withdrawn. However, the allowance of the linking claims requires that the claim meet the requirements of 35 U.S.C. 112, first paragraph, as well as be free of the prior art.

(3) Applicants argue that under M.P.E.P. 1850 that the examiner is required to examine together product claims, methods of using said products, and methods of producing said products.

The Office agrees that where unity of invention exists in the claims, the examiner is required to search and examine claims directed to the product, a process for using said product, and a process for preparing said product. In the instant claims this would include all of the antibodies encompassed by claim 34 and one process for preparing and one method of using said product.

(4) Applicants argue that it would not be an undue burden on the examiner to search and examine Groups I-VIII, XII, XIV, XIX (esp. Groups I-VI, XII, and XVII) all together.

Applicants' argument is misplaced as search burden is not a criteria supporting a holding Lack of Unity in a National Stage application. The criteria is existence or lack of a special technical feature.

DECISION

For the above reasons, the Petition requesting withdrawal of the restriction made FINAL in the Office action mailed 12 August 2005, is **GRANTED-IN-PART.**

The Lack of Unity requirement is modified such that claims 37 and 40 are designated "linking claims" and are withdrawn from inclusion with Groups I-IV, however they will be examined with elected Group I. The remainder of the Lack of Unity is left undisturbed.

Since the Tavladoraki et al. reference does not break the unity of invention among a specific polypeptide and one process of preparing said polypeptide and one process for using said polypeptide, the polypeptide of claims 34 -37 will continue to be examined with the process for preparing said antibody in claims 38 - 40.

The application will be forwarded to the examiner for consideration of applicants' amendments filed 12 December 2005 and 12 January 2006 and further action not inconsistent with this decision.

Any request for reconsideration of this decision must be filed within two (2) months of the mailing date of this decision in order to be considered timely.

Should there by any questions regarding this decision, please contact Special Program Examiner, William R. Dixon, Jr. by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AUG 09 2006

GARY R. TANIGAWA
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203-1808

In re Application of	:
Benevenuto et al	:
Serial No.: 10/169,351	: PETITION DECISION
Filed: October 29, 2002	:
Attorney Docket No.: 4161-1	:

This is in response to the renewed petition under 37 CFR 1.144, filed May 24, 2006, requesting withdrawal of an improper restriction requirement.

BACKGROUND

The file history is set forth in the previous petition decision mailed March 24, 2006, and is not repeated herein. Since the petition decision the examiner has mailed a Final Office action to applicants on May 16, 2006, to which a response has not yet been filed. The petition asks for reconsideration of the previous petition decision.

DISCUSSION

The previous petition decision granted applicants initial petition in part, rejoining claims 34-40 as a single group and designating Claim 34 as a linking claim to be examined with the elected group. (Applicants had requested rejoining of claims 34-50, 56-59 and 64-65 in the initial petition.) Such is set forth on page 3 of the petition decision. Claim 34 is an independent claim. Inadvertently, the petition decision at page 4 indicated that claims 37 and 40, both dependent claims, are linking claims. This error in the decision was pointed out to applicants by the examiner in the Final Office action mailed May 16, 2006. Accordingly, the examiner examined linking claim 34 with the other elected claims, 35-40.

Applicant now requests again rejoinder of claims 42-43 (peptides) and 44-49 (antibodies), claims 56-58 (pharmaceutical compositions) and claims 65 and 67 (kits) with the examined claims based on claims 37 and 40 being linking claims. Applicants further urge claim 41 (producing peptides) and claim 50 (obtaining antibodies) and claims 57, 59, 64 and 66 (therapeutic or

diagnostic uses of peptides and antibodies) be examined together with the above claims. These are all of the claims requested to be rejoined in the pervious petition.

The restriction requirement and previous petition decision have been carefully reviewed and reconsidered. Other than the misdesignation of claims 37 and 40 in the page 4 summary of the decision as linking claims (as pointed out by the examiner), no error is seen in the decision.

DECISION

The renewed petition is **DENIED.** The previous petition decision is maintained as correct except for the error noted above.

Applicants remain under obligation to reply properly to the Final Office action mailed May 16, 2006, within the time period set therein, or as extended under 37 CFR 1.136(a).

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.

John L. LeGuyader.
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
209 MADISON STREET
SUITE 500
ALEXANDRIA VA 22314

COPY MAILED
NOV 24 2008

In re Application of	:	
Ferid ALLANI	:	
Application No. 10/169,355	:	DECISION ON PETITION
Filed: November 05, 2002	:	
Attorney Docket No. 0679-1001	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed November 07, 2007, and a three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. The appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on January 08, 2008. *See* MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $770.00; and (3) a proper statement of unintentional delay. Accordingly, the reply to the Notice of Appeal filed November 07, 2007 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

This application is being referred to Technology Center AU 2174 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.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

19 DEC 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael W. Garvey
Pearne & Gordon LLP
1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108

In re Application of	:	
Yoshio Adachi et al.	:	DECISION ON PETITION
Application No.: 10/169,359	:	
PCT No.: PCT/JP01/01415	:	UNDER 37 CFR 1.181
Int. Filing Date: 26 February 2001	:	
Priority Date: 29 February 2000	:	AND 1.47(a)
Attorney Docket No.: 34800	:	
For: IMAGING APPARATUS AND IMAGING	:	
APPARATUS ASSEMBLING METHOD	:	

This is a decision in response to a letter filed by facsimile on 12 November 2003 which is being treated as a petition under 37 CFR 1.181 requesting that a copy of a petition under 37 CFR 1.47(a) and a copy of a declaration filed therewith be accepted as having been originally filed on 13 August 2002. This decision is further responsive to the copy of the petition under 37 CFR 1.47(a) which requests that the above-identified application be accepted without the signature of co-inventor Tamotsu Kaneko.

BACKGROUND

On 26 February 2001, applicants filed international application PCT/JP01/01415, which claimed priority of an earlier application filed 29 February 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty month period for paying the basic national fee in the United States of America expired at midnight on 29 August 2002.

On 01 July 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 10 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements Under 35 U.S.C. 371 In The United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905). The Notification indicated that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) must be submitted within two months of its 10 September 2002 date of mailing or by 32 months from the priority

date, whichever is later, in order to avoid abandonment of the national stage application.

On 12 November 2003, applicants filed the instant petition. The petition included, *inter alia*, a copy of a Letter, a copy of a Petition Under Rule 47, a copy of a Combined Declaration And Power Of Attorney, and a copy of a postcard receipt. The instant petition indicates that the accompanying papers are true copies of those originally filed on 13 August 2002.

DISCUSSION

MPEP at section 503 states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facia* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Applicants' postcard receipt lists, *inter alia*, Declaration & Power of Attorney (4pgs), Letter, and Petition (2 pgs) and includes a U.S. Patent and Trademark Office (PTO) date stamp of 19 August 2002.

The evidence is sufficient to establish that the items listed on applicants' postcard receipt were originally filed in the PTO on 19 August 2002. It is noted that the copies of the correspondence listed on applicants' postcard receipt included a certificate of mailing dated 13 August 2002.

Regarding applicants' petition under 37 CFR 1.47(a), applicants request that the above-identified application be accepted without the signature of co-inventor Tamotsu Kaneko. The petition indicates that Tamotsu Kaneko has refused to execute the application based on a letter sent by the non-signing inventor to Matsushita Communication Industrial Co. (MCI).

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor.

With regard to item (1) above, the copy of the letter submitted with the instant petition includes authorization to charge counsel's deposit account any required fees.

With regard to item (2) above, the petition indicates that a copy of a letter requesting Mr. Kaneko's signature was attached as Exhibit A. However, no such exhibit was in fact attached. Furthermore, the petition indicates that Mr. Kaneko's refusal was expressed in a letter sent to MCI. A copy of such letter is not provided. Therefore, the petition lacks factual proof of Mr. Kaneko's refusal.

With regard to item (3) above, the petition does not recite Mr. Kaneko's last known address.

With regard to item (4) above, the petition is accompanied by a declaration which is executed by each inventor except Mr. Kaneko.

CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.181 is **GRANTED** to the extent that applicants' communications are accorded a date of receipt of 19 August 2002.

For the reasons stated above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(a) is desired, a proper response must be filed with TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Michael A. Neas
PCT Special Program Examiner
Office of PCT Legal Administration

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (703) 308-0954
Facsimile: (703) 308-6459

13 SEP 2004

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Michael W. Garvey
Pearne & Gordon LLP
1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108

In re Application of	:	
Yoshio Adachi et al.	:	DECISION ON PETITION
Application No.: 10/169,359	:	
PCT No.: PCT/JP01/01415	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 26 February 2001	:	
Priority Date: 29 February 2000	:	
Attorney Docket No.: 34800	:	
For: IMAGING APPARATUS AND IMAGING	:	
APPARATUS ASSEMBLING METHOD	:	

This is a decision in response to a letter filed on 20 May 2004 which is being treated as a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 26 February 2001, applicants filed international application PCT/JP01/01415, which claimed priority of an earlier application filed 29 February 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty month period for paying the basic national fee in the United States of America expired at midnight on 29 August 2002.

On 01 July 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 19 August 2002, applicants filed a petition under 37 CFR 1.47(a) requesting that the above-identified application be accepted without the signature of co-inventor Tamotsu Kaneko. The petition included a declaration signed by each inventor except Mr. Kaneko.

On 19 December 2003, a decision on petition was mailed indicating that applicants' petition under 37 CFR 1.47(a) was dismissed.

On 20 May 2004, applicants filed the present renewed petition accompanied by a declaration executed by Tamotsu Kaneko.

DISCUSSION

The submission of the declaration executed by previously non-signing joint inventor Tamotsu Kaneko completes applicants' requirements under 35 U.S.C. 371 (c)(4) and 37 CFR 1.497(a) and (b). Therefore, a petition under 37 CFR 1.47(a) is not required.

A review of the application file indicates that all the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

For the reasons stated above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED** as moot.

This application is being returned to the DO/EO/US for processing in accordance with this decision, including the issuance of a "Notification Of Acceptance Of Application Under 35 U.S.C. 371" (Form PCT/DO/EO/903) indicating a 35 U.S.C. 371 date of 20 May 2004.

Michael A. Neas
PCT Special Program Examiner
Office of PCT Legal Administration

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (703) 308-0954
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OCT 3 2006

FINNEGAN, HENDERSON, FARABOW, ET AL
MR. ERNEST F. CHAPMAN
1300 I STREET, N.W.
WASHINGTON, D.C. 20005-3315

In re Application of	:
Takemoto, Hiroshi et al.	:
Serial No.: 10/169362	: PETITION DECISION
Filed: July 02, 2002	:
Attorney Docket No.: 07541.0003	:

This is in response to the petition under 37 C.F.R. §§ 1.181 and 1.183 filed March 28, 2006, requesting 1) the examiner's pending objection under 37 C.F.R. § 1.75 (c) to claims 28-32 be withdrawn and 2) the time period under § 1.181(f) be extended under the Director's inherent authority and express authority under § 1.183.

BACKGROUND

A review of the file history shows that the examiner mailed a non-final Office action to applicants on January 13, 2005, including a restriction of the claims into Groups I-V, applicants' telephonic election with traverse of group I, claims 25, 26, 28-32 and 35 U.S.C. 112 rejections of claims 25, 26, 30 and 32 for various different reasons of indefiniteness. Then claims 28-32 were rejected as being dependent on claims 25 and 26.

Applicants replied on April 11, 2005, by arguing the restriction and amending claim 25, 26, 30 and 31 to overcome the examiners rejections and obviate the rejection on claims 28-32.

The examiner mailed a second another non-final rejection to applicants on June 30, 2005. Claims 28-32 were objected to under 37 C.F.R. 1.75(c) as being in improper form because they depend on claims 15 and 27 which were withdrawn, according to M.P.E.P. § 608.01 (n). Claims 28-32 were not considered and thus not treated on the merits. Claims 25 and 26 were rejected at the same time under 35 U.S.C. 103.

Applicants responded with arguments on September 23, 2005. M.P.E.P. § 608.01 (n) recites that for restriction practice some of the embodiments of the multiple dependent claim may be held withdrawn while other embodiments are considered on the merits.
See below.

C. Restriction Practice
For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim. Also, some embodiments of a multiple dependent claim may be held withdrawn while other embodiments are considered on their merits.

The response further proceeded to argue the 35 U.S.C. 103 rejection.

The examiner mailed a Final Office action to applicants on December 12, 2005 with the same objection and also without considering claims 28-32 on the merits.

To this the applicants filed this petition under 37 C.F.R. §§ 1.181 and 1.183 on March 28, 2006, requesting 1) the examiner's pending objection under 37 C.F.R. § 1.75 (c) to claims 28-32 be withdrawn and 2) the time period under § 1.181 (f) be extended under the Director's inherent authority and express authority under § 1.183.

On April 27, 2006, applicants filed an R.C.E. amending and thus correcting the multiple dependency of claims 28-32.

DISCUSSION

The 37 C.F.R. § 1.75(c) relied upon by the examiner states that

> "One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim."

It further states that

> "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered."

Claims 28-32 as amended in the paper filed April 11, 2005 were multiple dependent claims, however they were not "improperly multiple dependent". In other words they were not multiple dependent from multiple dependent claims and they also referred to the claims in the alternative.

Also M.P.E.P. § 608.01 (n) recites (as stated above) that for restriction purposes some of the embodiments of multiple dependent claims may be held withdrawn and others considered.

The examiner should have objected to the claims as containing non-elected subject matter and proceeded to examine the claims to the extent of all the limitations of the elected subject matter.

With regard to 37 C.F.R. 1.181(f), the time period set therein cannot be extended. However the rule is discretionary in stating that the petition "may be dismissed." In this instance, it has been decided not to dismiss the petition, as it relates to the propriety of an examiners' actions. In view of this invocation of 37 C.F.R. 1.183 to waive a requirement of the rules is unnecessary and dismissed as moot. (Note- invocation of 37 C.F.R. 1.183 is usually reserved for situations in which no remedy is possible absent waiver of a rule and justice requires such waiver.)

The petition under 37 C.F.R. § 1.181 is **GRANTED.**

The petition under 37 C.F.R. § 1.183 is **MOOT.**

The application will be forwarded to the examiner for consideration of the amendment filed April 27, 2006.

Should there be any questions about this decision please contact Ms. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED

APR 21 2010

OFFICE OF PETITIONS

In re Patent No. 7,582,665	:	DECISION ON REQUEST
Hiroshi Takemoto, et al.	:	FOR
Issue Date: September 1, 2009	:	RECONSIDERATION OF
Application No. 10/169,362	:	PATENT TERM ADJUSTMENT
Filed: July 2, 2002	:	AND
Atty Docket No. 07541.0003	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on October 29, 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 six hundred forty-two (642) days. This requested correction includes, pursuant to patentees' duty of candor and good faith to the Office, an additional period of reduction of 38 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 six hundred forty-two (642) days is **GRANTED to the extent indicated herein.**

Patentees disclose that a supplemental reply in the form of an IDS was filed on January 16, 2009, after a response was filed on December 9, 2008. Accordingly, a period of reduction pursuant to 37 CFR 1.704(c)(8) of 38 days will be entered (December 10, 2008 to January 16, 2009).

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 July 25, 2005 and ends on April 26, 2006, the day before the RCE was filed, and not April 27, 2006, the day of filing of the RCE as calculated by patentees. *See* 35 U.S.C. 154(b)(1)(B)(i). Thus, the over 3 year period is 276 not 277 days. As such, the correct patent term adjustment is 641, not 642 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 37 CFR 1.136.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **six hundred forty-one (641)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,582,665 B2

DATED : **September 1, 2009** **DRAFT**

INVENTOR(S) : Hiroshi Takemoto, 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 U.S.C. 154(b) by 403 days

Delete the phrase "by 403 days" and insert – by 641 days--

28 AUG 2002

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

DYKEMA GOSSETT PLLC
FRANKLIN SQUARE, THIRD FLOOR WEST
1300 I STREET, NW
WASHINGTON, DC 20005

In re Application of:	:	
NORLING, Fredrik, et al.	:	DECISION ON PETITION TO
U.S. Application No.: 10/169,364	:	REVIVE ABANDONED
PCT No.: PCT/SE00/02405	:	APPLICATION UNDER 37
International Filing Date: 01 December 2000	:	CFR 1.137(b)
Priority Date: 03 December 1999	:	
Attorney's Docket No.: 66291-334-7	:	
For: LOAD CELL	:	

The petition to revive under 37 CFR 1.137(b) filed 02 July 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required application documents from the due date of 03 June 2002 until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee, Deposit Account No. 04-2223 will be charged the $1,280 petition fee, and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

30 OCT 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Locke Liddell & Sapp LLP
2200 Ross Avenue, Suite 2200
Dallas, TX 75201

In re Application of KLEESIEK et al	:	
U.S. Application No.: 10/169,368	:	
PCT Application No.: PCT/EP00/13311	:	
Int. Filing Date: 28 December 2000	:	DECISION
Priority Date Claimed: 30 December 1999	:	
Attorney Docket No.: 020195-00002	:	
For: XYLOSYLTRANSFERASE AND	:	
ISOFORMS THEREOF	:	

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 22 July 2003.

BACKGROUND

On 28 December 2000, applicant filed international application PCT/EP00/13311, which claimed priority of an earlier European Patent Office application filed 30 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 12 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 01 July 2002 (30 June 2002 was a Sunday).

On 01 July 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 30 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a nucleotide and/or amino acid sequence listing in computer readable form must be filed.

On 27 December 2002, applicant filed a sequence listing in computer readable form.

On 19 May 2003, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that additional copies of the sequence listing in computer readable form must be filed.

International application PCT/EP00/13311 became abandoned as to the United States for failure to timely file a response to the Notification of Defective Response.

On 22 July 2003, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 28 December 2000, and a date under 35 U.S.C. 371(c) of 01 July 2002.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

COPY MAILED
APR 2 9 2005
OFFICE OF PETITIONS

In re Patent No. 6,734,203 :
Issue Date: May 11, 2004 :
Application No. 10/169,409 : ON PETITION
Filed: July 1, 2002 :
Attorney Docket No. **Q70807**

This is a decision on the petition filed April 11, 2005, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3222. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Deposit 19-4880 will be refunded $270.00 that was charged erroneously as the petition fee is only $130.00.

The file is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

[1] See *Official Gazette* of June 22, 2004.

08 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Wall Marjama & Bilinski, LLP
101 S. Salina Street, Suite 400
Syracuse, NY 13202

In re Application of	:	
Bley	:	DECISION ON
Application No.: 10/169,416	:	
Filing Date: 20 June 2002	:	PETITION UNDER
Attorney Docket No.: 327-091	:	
For: Method For Detecting And Localising Leaks	:	37 CFR 1.137(b)
And Suitable Devices For Carrying Out Said...	:	

This is a decision on applicant's petition under 37 CFR 1.137(b) filed on 20 June 2002.

BACKGROUND

International application PCT/EP00/11153 was filed on 10 November 2000 and claimed an earlier priority date of 14 December 1999. A Demand electing the United States was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 14 June 2002. The international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

Applicants filed the instant application papers and petition on 20 June 2002.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.
>
> * * *
>
> To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.
>
> Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Applicants' transmittal letter of 20 June 2002 indicated that the papers were being filed as "Required for filing date under 37 C.F.R. § 1.53(b)," therefore requesting treatment of the papers under 35 U.S.C. 111. Moreover, applicants paid the filing fee for a utility application under 35 U.S.C. 111 rather than the basic national fee for a national stage under 35 U.S.C. 371, as further reflected by the reference to 37 CFR 1.16(a) in the authorization to charge fees to counsel's deposit account. Moreover, the executed declaration of the inventor does not indicate that it is directed toward the PCT application; rather, it claims benefit of the international application under 35 U.S.C. 120. All of these facts serve as indicia that the application was intended to be filed under 35 U.S.C. 111. In view of these instructions, there was no clear indication that the papers were filed under 35 U.S.C. 371 rather than 35 U.S.C. 111. As such, the processing of the papers as an application filed under 35 U.S.C. 111 is proper.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/169,416) and the international application (PCT/EP00/11153) designating the United States were copending for purposes of establishing continuity, as discussed *infra*. In order to obtain benefit of the earlier international application, applicant must include in an application data sheet or amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/EP00/11153, filed 10 November 2000, which designated the United States and is now abandoned." *See* 37 CFR 1.78.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant <u>must</u> submit a certified copy of the priority document. The certified copy of a priority document submitted to the International Bureau for the national stage cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

Regarding the petition under 37 CFR 1.137(b), said petition is being treated as a petition to revive the international application for purposes of establishing co-pendency with the instant United States application filed under 35 U.S.C. 111.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question

whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the petition is accompanied by the required reply in the form of the instant continuing application under 35 U.S.C. 111.

Regarding requirement (2), the petition is accompanied by the petition fee.

Regarding requirement (3), the petition includes a statement that "the entire delay in filing the National Phase application by the due date until the filing of this petition was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) to revive international application number PCT/EP00/11153 with respect to the United States for purposes of establishing co-pendency with the instant application is **GRANTED**. As co-pendency has been established, said international application is again **ABANDONED** with respect to the United States.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing, including the preparation and mailing of a filing receipt.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

08 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OIPE JC42
DEC 05 2003
PATENT & TRADEMARK OFFICE

RECEIVED
AUG 12 2002
WALL MARJAMA & BILINSKI LLP

Wall Marjama & Bilinski, LLP
101 S. Salina Street, Suite 400
Syracuse, NY 13202

In re Application of	:	
Bley	:	DECISION ON
Application No.: 10/169,416	:	
Filing Date: 20 June 2002	:	PETITION UNDER
Attorney Docket No.: 327-091	:	
For: Method For Detecting And Localising Leaks	:	37 CFR 1.137(b)
And Suitable Devices For Carrying Out Said...	:	

This is a decision on applicant's petition under 37 CFR 1.137(b) filed on 20 June 2002.

BACKGROUND

International application PCT/EP00/11153 was filed on 10 November 2000 and claimed an earlier priority date of 14 December 1999. A Demand electing the United States was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 14 June 2002. The international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

Applicants filed the instant application papers and petition on 20 June 2002.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.
>
> * * *
>
> To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.
>
> Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Applicants' transmittal letter of 20 June 2002 indicated that the papers were being filed as "Required for filing date under 37 C.F.R. § 1.53(b)," therefore requesting treatment of the papers under 35 U.S.C. 111. Moreover, applicants paid the filing fee for a utility application under 35 U.S.C. 111 rather than the basic national fee for a national stage under 35 U.S.C. 371, as further reflected by the reference to 37 CFR 1.16(a) in the authorization to charge fees to counsel's deposit account. Moreover, the executed declaration of the inventor does not indicate that it is directed toward the PCT application; rather, it claims benefit of the international application under 35 U.S.C. 120. All of these facts serve as indicia that the application was intended to be filed under 35 U.S.C. 111. In view of these instructions, there was no clear indication that the papers were filed under 35 U.S.C. 371 rather than 35 U.S.C. 111. As such, the processing of the papers as an application filed under 35 U.S.C. 111 is proper.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/169,416) and the international application (PCT/EP00/11153) designating the United States were copending for purposes of establishing continuity, as discussed *infra*. In order to obtain benefit of the earlier international application, applicant must include in an application data sheet or amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/EP00/11153, filed 10 November 2000, which designated the United States and is now abandoned." *See* 37 CFR 1.78.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant <u>must</u> submit a certified copy of the priority document. The certified copy of a priority document submitted to the International Bureau for the national stage cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

Regarding the petition under 37 CFR 1.137(b), said petition is being treated as a petition to revive the international application for purposes of establishing co-pendency with the instant United States application filed under 35 U.S.C. 111.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question

whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the petition is accompanied by the required reply in the form of the instant continuing application under 35 U.S.C. 111.

Regarding requirement (2), the petition is accompanied by the petition fee.

Regarding requirement (3), the petition includes a statement that "the entire delay in filing the National Phase application by the due date until the filing of this petition was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) to revive international application number PCT/EP00/11153 with respect to the United States for purposes of establishing co-pendency with the instant application is **GRANTED**. As co-pendency has been established, said international application is again **ABANDONED** with respect to the United States.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing, including the preparation and mailing of a filing receipt.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

08 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OIPE JC42
DEC 05 2003
PATENT & TRADEMARK OFFICE

RECEIVED
AUG 12 2002
WALL MARJAMA & BILINSKI LLP

Wall Marjama & Bilinski, LLP
101 S. Salina Street, Suite 400
Syracuse, NY 13202

In re Application of	:	
Bley	:	DECISION ON
Application No.: 10/169,416	:	
Filing Date: 20 June 2002	:	PETITION UNDER
Attorney Docket No.: 327-091	:	
For: Method For Detecting And Localising Leaks	:	37 CFR 1.137(b)
And Suitable Devices For Carrying Out Said...	:	

This is a decision on applicant's petition under 37 CFR 1.137(b) filed on 20 June 2002.

BACKGROUND

International application PCT/EP00/11153 was filed on 10 November 2000 and claimed an earlier priority date of 14 December 1999. A Demand electing the United States was prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 14 June 2002. The international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

Applicants filed the instant application papers and petition on 20 June 2002.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.
>
> * * *
>
> To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.
>
> Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Applicants' transmittal letter of 20 June 2002 indicated that the papers were being filed as "Required for filing date under 37 C.F.R. § 1.53(b)," therefore requesting treatment of the papers under 35 U.S.C. 111. Moreover, applicants paid the filing fee for a utility application under 35 U.S.C. 111 rather than the basic national fee for a national stage under 35 U.S.C. 371, as further reflected by the reference to 37 CFR 1.16(a) in the authorization to charge fees to counsel's deposit account. Moreover, the executed declaration of the inventor does not indicate that it is directed toward the PCT application; rather, it claims benefit of the international application under 35 U.S.C. 120. All of these facts serve as indicia that the application was intended to be filed under 35 U.S.C. 111. In view of these instructions, there was no clear indication that the papers were filed under 35 U.S.C. 371 rather than 35 U.S.C. 111. As such, the processing of the papers as an application filed under 35 U.S.C. 111 is proper.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/169,416) and the international application (PCT/EP00/11153) designating the United States were copending for purposes of establishing continuity, as discussed *infra*. In order to obtain benefit of the earlier international application, applicant must include in an application data sheet or amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/EP00/11153, filed 10 November 2000, which designated the United States and is now abandoned." *See* 37 CFR 1.78.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant <u>must</u> submit a certified copy of the priority document. The certified copy of a priority document submitted to the International Bureau for the national stage cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

Regarding the petition under 37 CFR 1.137(b), said petition is being treated as a petition to revive the international application for purposes of establishing co-pendency with the instant United States application filed under 35 U.S.C. 111.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question

whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the petition is accompanied by the required reply in the form of the instant continuing application under 35 U.S.C. 111.

Regarding requirement (2), the petition is accompanied by the petition fee.

Regarding requirement (3), the petition includes a statement that "the entire delay in filing the National Phase application by the due date until the filing of this petition was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) to revive international application number PCT/EP00/11153 with respect to the United States for purposes of establishing co-pendency with the instant application is **GRANTED**. As co-pendency has been established, said international application is again **ABANDONED** with respect to the United States.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing, including the preparation and mailing of a filing receipt.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 2/27/08

TO SPE OF : ART UNIT 1621

SUBJECT : Request for Certificate of Correction on Patent No.: 6794418

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

SPE, Art Unit 1621

1621
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

INGRID A. BEATTIE
MINTZ LEVIN COHN FERRIS GLOVSKY
& POPEO
ONE FINANCIAL CENTER
BOSTON MA 02111

COPY MAILED

MAR 0 7 2006

OFFICE OF PETITIONS

In re Application of	:	
Hiroshi Takatsuji et al	:	
Application No. 10/169,426	:	ON PETITION
Filed: January 31, 2003	:	
Attorney Docket No. 25371-005 NATL	:	

This is a decision on the petition, filed March 3, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 16, 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 1638 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS TX 75202-3789

COPY MAILED

AUG 27 2007

OFFICE OF PETITIONS

In re Application of

COOK, et al.
Application No. 10/169,434
Filed: February 18, 2003
Attorney Docket No. **25791.10.04**

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 16, 2007.

The request is **NOT APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **TODD MATTINGLY**
KING & SPALDING LLP
1100 LOUISIANA STREE, SUITE 4000
HOUSTON, TX 77002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

30 SEP 2002

Arnold H. Krumholz
Lerner, David, Littenberg,
Krumholz & Mentlik, LLP
600 South Avenue West
Westfield, NJ 07090

In re Application of	:	
Dannenmaier	:	
Application No. 10/169456	:	DECISION ON
PCT No.: PCT/IB01/00184	:	
Int. Filing Date: 14 February 2001	:	PETITION UNDER
Priority Date: 17 February 2000	:	
Atty. Docket No.: GAMBRO-262	:	37 CFR 1.137(b)
For: Filter Comprising Membranes	:	
Made Of Hollow Fibers	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 02 July 2002.

BACKGROUND

This international application was filed on 14 February 2001, claiming priority of an application filed on 17 February 2000. No Demand electing the United States appears to have been filed prior to the elapse of 19 months from the priority date. Accordingly, the 20 month time period for paying the basic national fee in the United States expired at midnight on 17 October 2001. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

On 02 July 2002, applicants filed the instant petition.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), applicants have filed the required reply in the form of the basic national fee.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

Counsel's Deposit Account No. 12-1095 is being charged in the amounts of $130.00 for the surcharge under 37 CFR 1.492(e) and $130.00 for the processing fee under 37 CFR 1.492(f), as authorized by the petition.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of this application under 35 U.S.C. 371 is **02 July 2002**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

30 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Arnold H. Krumholz
Lerner, David, Littenberg, Krumholz & Mentlik, LLP
600 South Avenue West
Westfield, NJ 07090

In re Application of LOHMÜLLER, Heinrich Application No.: 10/169,460 PCT Application No.: PCT/IB01/00409 International Filing Date: 12 March 2001 Priority Date: 12 April 2000 Attorney Docket No.: GAMBRO-261 For: METHOD OF STEAM STERILISATION OF MEDICAL PRODUCTS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicant's "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 02 July 2002 is **GRANTED**.

BACKGROUND

On 12 March 2001, applicant filed international application number PCT/IB01/00409. A copy of the international application was transmitted by the International Bureau on 18 October 2001. The deadline for entry into the United States National Stage was twenty months from the priority date, that is 12 December 2001.

On 02 July 2002, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, a petition to revive and the basic national fee.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). Applicant has paid both the

petition fee and the basic national fee. A terminal disclaimer is not required as application was filed on after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

The application has an international filing date of 12 March 2001 under 35 U.S.C. §363 and a date of 02 July 2002 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

20 MAY 20[illegible]

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

William H. Dippert
Reed Smith LLP
599 Lexington Avenue
New York, NY 10022

In re Application of KANTER	:	
U.S. Application No.: 10/169,468	:	
Int. Application No.: PCT/IL00/00865	:	DECISION
Int. Filing Date: 28 December 2000	:	
Priority Date: 29 December 1999	:	
Attorney Docket No.: 501116.20501	:	
For: A SECURE AND LINEAR PUBLIC-KEY CRYPTOSYSTEM BASED ON PARITY-CHECK ERROR-CORRECTING CODE	:	

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 28 December 2000, applicant filed international application PCT/IL00/00865, which claimed priority of an earlier United States application filed 29 December 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 12 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 July 2002 (29 June 2002 was a Saturday).

On 01 July 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 28 August 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 06 January 2003, applicant filed an executed declaration.

On 19 March 2003, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned as to the United States for failure to timely reply to the Notification of Missing Requirements.

DISCUSSION

A review of the application file reveals that the Notification of Abandonment was mailed in error.

CONCLUSION

For the reasons above, the Notification of Abandonment (Form PCT/DO/EO/909) mailed 19 March 2003 is hereby VACATED.

The application has an International Filing Date of 28 December 2000 and a date under 35 U.S.C. 371(c) of 06 January 2003.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

13 SEP 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Robert D. Fish
Rutan & Tucker LLP
611 Anton Blvd., Suite 1400
Costa Mesa, CA 92626

In re Application of	:	
Hoppe et al.	:	
Application No. 10/169,496	:	DECISION
PCT No.: PCT/DE01/00009	:	
Int. Filing Date: 04 January 2001	:	ON
Priority Date: 07 January 2000	:	
Atty. Docket No.: 101020.0001US1	:	PETITION
For: Bait Device	:	

This is in response to the "Petition To Withdraw Holding Of Abandonment 37 CFR 1.181" filed on 02 June 2003 (a copy of which was filed on 06 April 2004).

BACKGROUND

This international application was filed on 04 January 2001, claimed an earliest priority date of 07 January 2000, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 12 July 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The 30 month time period for paying the basic national fee in the United States expired at midnight on 07 July 2002.

On 03 July 2002, applicants filed *inter alia* a Transmittal Letter.

On 19 May 2003, a "Notice of Abandonment Under 37 CFR 1.53(f) or (g)" was mailed to applicant, indicating that this application had become abandoned because "The reply received on 10/29/2002 was untimely."

DISCUSSION

Counsel requests that the holding of abandonment be withdrawn on the basis that

> We filed US national stage before the 30 month deadline on July 3, 2002. In our Transmittal Letter, we authorized your offices to charge the filing fee of $445.00 to Deposit Account 502191. We also authorized the PCT Office to charge any additional filing, extra claims, processing, extension and/or surcharge fees to the same deposit account.

Review of the application file reveals that the original copy of the Transmittal Letter, filed on 03 July 2002, is present in the application file wrapper. The Transmittal Letter

includes an authorization to charge the $445.00 basic national fee to counsel's deposit account. As this fee authorization was received prior to the expiration of the period to pay the basic national fee in the United States, the basic national fee is considered to have been timely received. Accordingly, the Notice of Abandonment is hereby **VACATED**.

DECISION

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371(c)(1), (2) and (4) is **21 November 2004**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
(571) 272-3283
Fax: (703) 308-6459
(571) 273-0459

19 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Young & Thompson
Second Floor
745 South 23rd Street
Arlington, VA 22202

In re Application of LOURENCO, Armindo, et al. Application No.: 10/169,510 PCT No.: PCT/FR01/00031 Int. Filing Date: 05 January 2001 Priority Date: 07 January 2000 Attorney Docket No.: 0509-1015 For: DEVICE FOR INJECTING A DOSE OF LIQUID IN PARTICULAR A MEDICINAL LIQUID	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 CFR §1.47(a)," filed in the United States Patent and Trademark Office on 16 December 2002.

BACKGROUND

On 05 January 2001, applicants filed international application PCT/FR01/00031, which claimed a priority date of 07 January 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 July 2001, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 08 July 2002 (07 July 2002 was a Sunday).

On 03 July 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by the basic national fee.

On 16 September 2002, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 16 December 2002, applicants submitted the petition under 37 CFR 1.47, accompanied by the fee for a one month extension of time and the petition fee.

On 09 April 2003, applicants submitted a declaration executed by the nonsigning inventor.

DISCUSSION

Applicants have received a declaration from the previously non-signing inventor. As the inventor is available and willing to sign, the petition under 37 CFR 1.47(a) is moot.

The declarations submitted on 09 April 2003 and 16 December 2002 do not comply with 37 CFR 1.497(a)-(b) as the citizenship of each inventor is not translated. Additionally, the declarations do not comply with 37 CFR 1.69, as they contain untranslated foreign language text.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

Applicants are required to furnish a declaration in compliance with 37 CFR 1.497(a)-(b) and 37 CFR 1.69 within TWO (2) MONTHS from the mail date of this decision. The cover letter should be entitled "Submission Under 37 CFR 1.497."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

30 SEP 200

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Young & Thompson
Second Floor
745 South 23rd Street
Arlington, VA 22202

In re Application of LOURENCO, Armindo, et al. Application No.: 10/169,510 PCT No.: PCT/FR01/00031 Int. Filing Date: 05 January 2001 Priority Date: 07 January 2000 Attorney Docket No.: 0509-1015 For: DEVICE FOR INJECTING A DOSE OF LIQUID IN PARTICULAR A MEDICINAL LIQUID	DECISION ON PETITION UNDER 37 CFR 1.69

This is a decision on applicants' "Response To Decision On Petition," filed in the United States Patent and Trademark Office on 11 September 2003.

BACKGROUND

On 05 January 2001, applicants filed international application PCT/FR01/00031, which claimed a priority date of 07 January 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 July 2001, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 08 July 2002 (07 July 2002 was a Sunday).

On 03 July 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by the basic national fee.

On 16 September 2002, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 16 December 2002, applicants submitted the petition under 37 CFR 1.47, accompanied by the fee for a one month extension of time and the petition fee.

On 09 April 2003, applicants submitted a declaration executed by the nonsigning inventor.

On 19 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(a)

dismissing applicants' petition as moot, but indicating that the declaration did not comply with 37 CFR 1.497(a)-(b) as the citizenship was in a foreign language and that the declaration contained untranslated foreign language text.

On 11 September 2003, applicants furnished translations of the earlier filed declarations.

DISCUSSION

On 11 September 2003, applicants furnished translations of the declarations submitted on 09 April 2003 and 16 December 2002, within two months of being requested to furnish such translations, in compliance with 37 CFR 1.69(b). Applicants' declaration now complies with 37 CFR 1.497(a)-(b).

CONCLUSION

Applicants' petition under 37 CFR 1.69 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §371 date of **11 September 2003**.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

3 1 MAR 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

SCHLUMBERGER INC.
Intellectual Property Dept.
30000 Mill Creek Ave., Suite 100
Alpharetta, GA 30022

In re Application of
GIRARD, Sophie *et al*
U.S. Application No.: 10/169,525
PCT No.: PCT/FR00/03500
Int. Filing Date: 13 December 2000
Priority Date: 30 December 1999
Docket No.: 76.0589
For: CARD ELEMENT WITH INTEGRATED CIRCUIT MOUNTED USING THE FLIP-CHIP TECHNIQUE

DECISION

ON PETITION UNDER

37 CFR 1.10(d)

This decision is in response to applicants' "Petition to Correct Filing Date and Date-In Discrepancy" ("Pet.") filed 06 November 2002 which is treated as a petition under 37 CFR 1.10(d). No petition fee is required.

BACKGROUND

On 13 December 2000, applicants filed international application PCT/FR00/03500 claiming priority to a French patent application filed 30 December 1999.

On 24 July 2001, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.,* 01 July 2002 (30 June 2002 was a Sunday).

Applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 using Express Mail and the national stage papers were given a filing date of 03 July 2002.

On 17 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) because applicants failed to provide a copy of the international application by thirty months pursuant to 37 CFR 1.495(b).

On 06 November 2002, applicants submitted the instant petition which was

accompanied by, *inter alia*, an "Affidavit of Inga L. Smith" ("Decl."); a copy of Express Mail mailing label for EV126118614US; a letter from the USPS dated 23 October 2002; a copy of the USPS Track/Confirm report for Express Mail EV126118614US; and another letter from the USPS dated 04 October 2002.

On 12 February 2003, applicants submitted via facsimile a copy of the petition previously submitted on 06 November 2002.

DISCUSSION

A review of the aforementioned file reveals that the DO/EO/US correctly granted a filing date of 03 July 2003 since USPS records indicated that Express Mail EV126118614US was accepted on 03 July 2002 at 1:10 a.m. in Atlanta, Georgia. There was no Express Mail label located in the file. Nevertheless, applicants argue that "the USPS has made an error and has incorrectly reported the express mailing date. Both, the shipment history and the mailing label are incorrect." Pet. at ¶ 3.

37 CFR 1.10(d) allows applicants to petition to correct an incorrectly entered "date in" of an Express Mail receipt and states that:

> (d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the"date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one

business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

The present petition is considered to have been filed promptly. Further, a review of the above-identified application verifies that a page titled "Certificate of Filing by Express Mail" accompanied the national stage papers and recorded the Express Mail No. EV126118614US. Thus, items (1) and (2) of 37 CFR 1.10(d) are satisfied.

Concerning item (3) of 37 CFR 1.10(d) above, petitioner argues that the correspondence was indeed deposited with the USPS on 01 July 2002 and should be awarded that date as the date entering the national phase. To support this claim, petitioner included a declaration of Inga L. Smith. Ms. Smith claims that "[o]n July 1, 2002, I personally deposited the application at the Express Mail drop box located at the US Post Office on Old Milton Parkway, Alpharetta, Georgia." Decl. at ¶ 2.

A copy of the Express Mail label No. EV126118614US was included in the instant petition. The "Date In" is listed as "7/02/02." Petitioner also included two letters from the USPS. The first letter by Ms. Sharonne Hughes of the USPS dated 04 October 2002 indicates that the "Express Mail piece was actually accepted on 7/2/02 at 03:41 AM." The second letter by Ms. Donna Puckett of the USPS dated 23 October 2002 indicated that "Express Mail in collection boxes are put in a special Express Bag here at the station then sent out to North Metro, then transferred to the AMC. We do not process collection Express Mail in the Alpharetta Post Office."

A review of Section 513 of the Manual of Patent Examining Procedure (MPEP) expands on the requirements of 37 CFR 1.10(d)(3) and states, in part:

> The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as "Express Mail." Evidence from the USPS may be the "Express Mail" Corporate Account Mailing Statement. Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.
>
> The reason the Office considers correspondence to have been filed as of the date of deposit as "Express Mail" is that this date

> has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the "Express Mail" mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."

In this case, petitioners have not provided evidence that came into being after deposit and within one business day of the deposit of the Express Mail documents. Instead, petitioners have submitted evidence from the USPS in the form of two letters supplemented with a declaration by Ms. Smith and a copy of the Express Mail mailing label. Petitioners argue that "[e]vidence from the US Postal Service shows that the USPS received the application July 1, 2002, but did not process and date-stamp the express package until July 2, 2002, at 3:41 am." Pet. at ¶ 5. This evidence refers to the letter from Ms. Puckett dated 23 October 2002.

A careful review of this evidence shows that it is not dispositive in proving that the aforementioned express mail package was delivered on 01 July 2002. The actual processing by the USPS occurred at 03:41 in the morning of 02 July 2002 which has been corroborated by the "Date In" on the Express Mail label. The fact that the express mail package was incorrectly entered on the USPS Track/Confirm records as 03 July 2002 at 01:10 a.m. does not prove that it was actually deposited in the USPS drop box prior to the last scheduled pick up at 05:15 p.m. on 01 July 2002. There is no schedule to reference included in the letter from the USPS of Ms. Puckett dated 23 October 2002 for picking up packages at the Alpharetta Post Office in Georgia. The declaration by Ms. Smith alone is not sufficient to overcome the evidence from the official USPS records. Moreover, section 513 of the MPEP also states, in part:

> 37 CFR 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked, **and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked.** On petition, the failure to obtain an "Express Mail" receipt with

> the "date-in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, **parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.**
>
> **A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. . . .**
>
> Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels **by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS.** Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log. (Emphasis added).

Applicants have not sufficiently established by the evidence from the USPS that the subject application was deposited on 01 July 2002. Applicants have also not submitted evidence such as a mail log indicating the date and time of deposit, or time of mail log entry completed within one business day after the deposit. For the reasons listed above, the evidence submitted in the instant petition is not sufficient to meet the requirements of 37 CFR 1.10(d)(3).

In light of the available evidence, applicants have <u>not</u> established to the satisfaction of the Commissioner that the above captioned application was deposited via Express Mail at the USPS on 01 July 2002.

CONCLUSION

Applicants' petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(d)."

Applicants are advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

01 JUL 2003

SCHLUMBERGER INC.
Intellectual Property Dept.
30000 Mill Creek Ave., Suite 100
Alpharetta, GA 30022

In re Application of
GIRARD, Sophie *et al*
U.S. Application No.: 10/169,525
PCT No.: PCT/FR00/03500
Int. Filing Date: 13 December 2000
Priority Date: 30 December 1999
Docket No.: 76.0589
For: CARD ELEMENT WITH INTEGRATED CIRCUIT MOUNTED USING THE FLIP-CHIP TECHNIQUE

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

Applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 08 May 2003 is hereby **GRANTED** as follows:

The appropriate basic national fee and petition fee have been paid. Applicants state that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required in this case. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A review of the application shows that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) has not been provided. In addition, a processing fee of $130.00 for providing the English translation later than 30 months from the earliest claimed priority date pursuant to 37 CFR 1.492(f) is required and has been charged to Deposit Account No. 50-2114 as authorized.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) is required.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

16 AUG 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

Rosemary Kellogg
1745 Shea Center Drive, Suite 330
Highlands Ranch, Colorado 80129

In re Application of Koppert, et al. Serial No.: 10/169,529 PCT No.: PCT/NL00/00965 Int. Filing Date: 28 December 2000 Priority Date: 28 December 1999 Attorney's Docket No.: VE.10 For: VESSEL PROVIDED WITH A SEALING RING	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This decision is responsive to the "PETITION FOR REVIVIAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)" filed 27 May 2005.

BACKGROUND

On 28 December 2000, applicants filed international application PCT/NL00/00965, which claimed priority of an earlier European application filed 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 July 2001. A Demand for international preliminary examination was filed on 30 July 2001. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 28 June 2002.

On 27 June 2002, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a copy of the international applicaton and a check for the basic national fee of $890. These papers were assigned Application No. 10/169,529.

On 13 September 2002, the United States Patent and Trademark mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee. The notification set a two-month time period in which to respond.

On 09 April 2003, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition and fee for a five-month extension of time, the surcharge under 37 CFR 1.492(e) and copy of a declaration executed by one of the inventors.

On 14 August 2003, the petition was dismissed as moot because if did not comply with 37 CFR 1.497(a)-(b). Applicant was given one month to comply with 37 CFR 1.497(a)-(b).

On 13 January 2005, a "NOTIFICATION OF AB ANDONMENT" (form PCT/DO/EO/909) was mailed to applicants indicating that the application had become abandoned for failure to respond to the petition decision mailed 14 August 2003.

On 27 May 2005, applicants filed the current petition to revive the application. The petition was accompanied by a declaration signed by both applicants.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied (1) by a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," (2) by a proper reply, (3) by the petition fee required by law (37 CFR 1.17(m)), and (4) if the international filing date of the application is before June 8, 1995, any petition to revive under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer and small entity fee of $55

Applicants have provided the required statement, a proper reply and the petition fee. Therefore, the petition to revive is GRANTED.

CONCLUSION

The petition to revive the application abandoned under 35 U.S.C. 371(d) is **GRANTED** as to the National Stage in the United States of America.

This application is being forwarded to the national stage office for preparation of a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) having a date of 27 May 2005 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

Debra Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Tel: (571) 272-3280
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JUL 22 2004

Paper No. 8

In re Application of
Svante Berggren
Application No. 10/169,540
Filed: June 28, 2002
Attorney Docket No. 12159

DECISION ON PETITION

This is a decision on the petition filed on May 10, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated August 26, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

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 1, 2003. The originally filed reply, which was in fact filed on December 1, 2003, has now been located and placed in the file. It is noted that the originally filed reply has affixed thereto a 37 CFR 1.8(a) certificate of mailing dated November 26, 2003, a date within the period for filing a reply to the Office letter in question. Based upon this evidence, it is clear that this application is not abandoned. In particular, see 37 CFR 1.8(b).

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for entry of the reply filed on December 1, 2003, certificate of mailing date November 26, 2003. Thereafter, the application will be forwarded to the examiner for action on the reply.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Orum & Roth
53 West Jackson Boulevard
Chicago, IL 60604

24 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Darryl L. Webster
Wyeth, Patent Law Department
Five Giralda Farms
Madison, NJ 07940

In re Application of
BODINE, Peter V.N.
U.S. Application No.: 10/169,545
PCT No.: PCT/US00/25035
Int. Filing Date: 13 September 2000
Priority Date: 13 September 1999
Docket No.: AHP-98134
For: PHARMACEUTICAL COMPOSITIONS AND METHODS OF USING SECRETED FRIZZLED . . .

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an International Application for Patent Designating the US Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with the national stage papers on 31 May 2002 is hereby **GRANTED** as follows:

The basic national fee of $890.00, extra claim fee of $162.00, independent claim fee of $$420.00, surcharge fee of $130.00, assignment fee of $40.00 and petition fee of $1,280.00 have been charged to Deposit Account No. 01-1300 as authorized. Applicant states that "[t]he entire delay in filing the 35 U.S.C. 371(c) requirements from their due date until filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required in this case. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497 was submitted with the national stage papers on 31 May 2002. Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 September 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **31 May 2002.**

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

12 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Anthony J. Janiuk
Waters Corporation
34 Maple Street
Milford, MA 01757

In re Application of	:	
Jeng-Jong Lee	:	
Application No.: 10/169,546	:	DECISION ON
PCT No.: PCT/US99/13241	:	
Int. Filing Date: 10 June 1999	:	
Priority Date: 12 June 1998	:	PETITION UNDER
Attorney's Docket No.: WAA-195 PCT	:	
For: Novel Ion Exchange Porous Resins for	:	
Solid Phase Extraction and Chromatography	:	37 CFR 1.137(b)

This is in response to "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 C.F.R. §1.137(b)" filed on 13 March 2002.

BACKGROUND

On 10 June 1999, this international application was filed, which claimed an earliest priority date of 12 June 1998.

A Demand was filed on 15 February 2000 for the above international application. Accordingly, the deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 12 December 2000. This international application became abandoned with respect to the United States at midnight on 12 December 2000 for failure pay the basic national fee.

On 13 March 2002, applicant filed in the United States Patent and Trademark Office (PTO) the instant petition, and a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and

(4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

Applicant's representative Deposit Account No.: 23-0503 has been charged to $1990.00 as indicated in the transmittal letter.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

15 JUN 2004

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Anthony J. Janiuk
WATERS CORPORATION
34 Maple Street, LG
Milford, Massachusetts 01757

In re Application of	:	
Peter Jeng-Jong LEE, et al.	:	
Application No.: 10/169,546	:	DECISION ON
PCT No.: PCT/US99/13241	:	PETITION
Int. Filing Date: 10 June 1999	:	UNDER 37 CFR 1.181
Priority Date: 12 June 1998	:	
Attorney Docket No.: WAA-195 C2	:	
For: NOVEL ION EXCHANGE POROUS	:	
RESINS FOR SOLID PHASE EXTRACTION	:	
AND CHROMATOGRAPHY	:	

This decision is in response to the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)" filed 17 December 2003, which is being treated as a petition under 37 C.F.R. 1.181 requesting acceptance of a copy of the "RESPONSE TO THE NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" filed with the petition as being submitted on 16 January 2003 in the above-captioned application. The petition is **GRANTED** as follows:

No petition fee is required.

The evidence submitted by applicant, which includes a copy of the postcard receipt with a USPTO mailroom stamped date of 16 January 2003 itemizing all the papers submitted on filing in the above-captioned application, is sufficient to establish that a Response to the Notice of Missing Requirements and a Declaration of the Inventors have been received in the Office on 16 January 2003. The postcard receipt clearly shows that a Transmittal Letter, a Response to Notice to Missing Requirements, a Request to Add First Named Applicant and Attorney Docket Number, A Fee Calculation sheet, a Combined Declaration & Power of Attorney, an Assignment document and a Prepaid Return Postcard for applicants Waters Investments Limited et al. and bearing docket No. WAA-195 C2 were addressed to the

"USPTO". Accordingly, acceptance of a copy of the declaration of the inventors as being filed on 16 January 2003 is appropriate.

With the acceptance of the declaration of the inventors filed with the petition as being submitted 16 January 2003, the Notification of Abandonment (Form PCT/DO/EO/909) issued by the Office on 09 December 2003 is hereby VACATED.

Since no petition fee is needed, applicant is hereby notified that $1,160.00 will be refunded, which amount represents the difference of the amount of $1,330.00 charged to Deposit Account No. 23-0503 on 22 December 2003 minus $130.00 surcharge for submitting a declaration after 30 months (fee code 1617) and $40.00 fee for the recordation of an assignment (fee code 8021).

The application is being returned to the United States Designated/Elected Office for further processing including the entry of the declaration of the inventors submitted on 19 December 2003 as being filed on 16 January 2003 and refund of $1,160.00 to Deposit Account No. 23-0503.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/LES:hn

Tel: (703) 308-6508

13 SEP 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

#21

Anthony J. Janiuk, Esq.
WATERS CORPORATION
34 Maple Street, LG
Milford, MA 01757

In re Application of	:	
Lee et al.	:	
Application No. 10/169,546	:	
PCT No.: PCT/US99/13241	:	
Int. Filing Date: 10 June 1999	:	DECISION
Priority Date: 12 June 1998	:	
Atty. Docket No.: WAA-195 C2	:	
For: Novel Ion Exchange Porous Resins	:	
For Solid Phase Extraction And...	:	

This is in response to the "Request To Add First Named Applicant And Attorney Docket Number" filed on 16 January 2003.

BACKGROUND

This international application was filed on 10 June 1999, designated the United States, and claimed an earlier priority date of 12 June 1998. The International Bureau communicated a copy of the published international application to the USPTO on 16 December 1999. A Demand electing the U.S. was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 12 December 2000.

On 15 June 2004, a "Decision On Petition Under 37 CFR 1.181" was mailed to applicants, according a 16 January 2003 date of filing to a declaration of the inventors submitted on 19 December 2003.

DISCUSSION

Inspection of the declaration treated as filed on 16 January 2003 reveals that it names a joint inventor, Peter Jeng Jong LEE, which differs from a name appearing in the published international application in that the given name of Peter does not appear in the published international application. Counsel states that "Applicant noticed that the First Name Applicant and the Attorney Docket Number is not on the Notification of Missing Requirements Noticed. Applicant asks the Examiner to correct as follows: First Named Applicant: Peter Jeng Jong Lee." In that this is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve this matter. Such a petition must be accompanied by the $130.00 petition fee and by verified statements by the inventor and any other individuals having first-hand knowledge of the error. These statements must set forth in detail the specific circumstances as to how and when the error was made and discovered, and must also state (if appropriate) that the mistake was an inadvertent error made without deceptive intent.

CONCLUSION

Counsel's request is **REFUSED**, without prejudice.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
(571) 272-3283 after 9/30
Fax: (703) 308-6459
(571) 273-0459 after 9/30

United States Patent and Trademark Office

#14

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Anthony J. Janiuk, Esq.
WATERS CORPORATION
34 Maple Street, LG
Milford, MA 01757

17 FEB 2006

In re Application of
Lee et al.
Application No. 10/169,546
PCT No.: PCT/US99/13241
Int. Filing Date: 10 June 1999
Priority Date: 12 June 1998
Atty. Docket No.: WAA-195 C2
For: Novel Ion Exchange Porous Resins For Solid Phase Extraction And...

DECISION

This is in response to the "Request For Reconsideration And To Add First Named Applicant And Attorney Docket Number" filed on 12 October 2004.

DISCUSSION

In a Decision mailed on 13 September 2004, the declaration filed on 16 January 2003 was not accepted under 37 CFR 1.497(a) and (b) because

> Inspection of the declaration treated as filed on 16 January 2003 reveals that it names a joint inventor, Peter Jeng Jong LEE, which differs from a name appearing in the published international application in that the given name of Peter does not appear in the published international application. Counsel states that "Applicant noticed that the First Name Applicant and the Attorney Docket Number is not on the Notification of Missing Requirements Noticed. Applicant asks the Examiner to correct as follows: First Named Applicant: Peter Jeng Jong Lee." In that this is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve this matter. Such a petition must be accompanied by the $130.00 petition fee and by verified statements by the inventor and any other individuals having first-hand knowledge of the error. These statements must set forth in detail the specific circumstances as to how and when the error was made and discovered, and must also state (if appropriate) that the mistake was an inadvertent error made without deceptive intent.

In response, counsel "respectfully submit[s] the filing of this petition should be unnecessary" because "there was an absence of any applicants identified in the Notice." However, it is respectfully observed that the salient issue is whether the declaration of inventorship nominates the same inventive entity as was named in the international application and, if not, whether any discrepancy arose from a mere typographic error or phonetic misspelling. In this case, the international application names "LEE, Jeng-Jong," whereas the declaration filed on 16 January 2003 names "LEE PETER JENG JONG." Although counsel argues that the two names refer to the same person, counsel's attention is drawn to MPEP 605.04(b), which provides in part that

> Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten

> version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee

Accordingly, treatment of this matter as a petition under 37 CFR 1.182 is appropriate.

Considering the merits of this petition under 37 CFR 1.182, counsel has provided an "Affidavit of Dr. Lee" which explains that

> At the time of the PCT application was filed, June 12, 1999, I was known as an had the legal name Jeng Jong Lee. I was a citizen of the Republic of China (Taiwan).
>
> Between the filing of the PCT Application and the filing of the Response to the Notification of Missing Requirements January 16, 2003, I became a United States citizen. After becoming a United States citizen, I desired to be known as Peter Jeng Jong Lee, or merely, Peter Lee.
>
> Papers originally filed on the PCT stage of prosecution correctly identified me as I was legally known "Jeng Jong Lee". However, my legal name at the time of the Response to the Notification of Missing Requirements was and still is "Peter Jeng Jong Lee".
>
> I did not change my legal name with the intent to deceive the Patent Office.

On the basis of these statements, it would be appropriate to grant the requested relief under 37 CFR 1.182.

CONCLUSION

The petition under 37 CFR 1.182 is **GRANTED**.

The $130.00 petition fee is being charged to counsel's Deposit Account No. 23-0503, as authorized by the petition.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **16 January 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

UNITED STATES 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 : June 18, 2009

Patent No. : 6,957,786 B2
Patent Issued : Oct. 25, 2005
Docket No. : 1512.2.110
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 .

The alleged error(s) Claims were renumbered upon allowance.Patentee is trying to maintain original numbering.the patent is printed in accordance with the record .In view of the foregoing, your request, in this matter(s), is hereby denied.

Further consideration/reconsideration will be given upon receipt of a Request for Reconsideration under, under the provision of U.SC.254 or 255 (C.F.R. 1.322 or 1.323), accompanied by the appropriate response or fee of $100, which should be directed to Decisions & Certificates of Correction Branch.

Ennis Young
Legal Instrument Examiner
(703) 756-1542

For Mary Diggs, Supervisor
Decisions & Certificates of Correction Branch
(703) 756-1580 or (703) 756-1814 (Receptionist)

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9-6-06

TO SPE OF : ART UNIT 3725

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/169593 Patent No.: 6957786

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.

Check claims

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☐ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☒ **Denied** — State the reasons for denial below.

Comments: Claims were renumbered upon allowance. Patentee is trying to maintain original numbering.

/Dana Ross/ — SPE

3725 — Art Unit

18 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Nils E. Pedersen
Wenderoth, Lind & Ponack, LLP
2033 K Street, N.W., Suite 800
Washington, D.C. 20006-1021

In re Application of	:	
MATSUSHIMA et al.	:	
Application No.: 10/169,606	:	DECISION ON
PCT No.: PCT/US01/51574	:	
Filing Date: 07 November 2001	:	PETITION UNDER
Priority Date: 07 November 2000	:	
Atty. Docket No.: 2002-0872A	:	37 CFR 1.181
For: DIGITAL DATA DISTRIBUTION SYSTEM		

This decision is in response to "Request for Correction of International Application Number in National Phase Application" filed 23 September 2002 which has been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 07 November 2001, applicants filed international application no. PCT/US01/51574 which claimed a priority date of 07 November 2000, and designated the United States. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 07 May 2003.

On 03 July 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials: a check in the amount of $2198 ($740 for the basic national fee, $1260 for independent claims, and $198 for extra claims); a preliminary amendment; and an unexecuted declaration. The Transmittal Letter submitted by the applicant misidentified the international application number as PCT/US01/42987, however, the Transmittal Letter otherwise properly identifies the title, inventor, international filing date, and priority date for the intended application PCT/US01/51574.

Based on the erroneous international application number listed on the Transmittal Letter, the present national stage application file was created for PCT/US01/42987, rather than for PCT/US01/51574.

On 10 September 2002, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 23 September 2002, applicants filed "Request for Correction of International Application Number in National Phase Application" which included: a corrected Transmittal

Letter identifying the international application as PCT/US01/51574; an executed declaration identifying international application PCT/US01/42987; a preliminary amendment; and a postcard receipt dated 07 November 2001 identifying the international application as PCT/US01/42987.

DISCUSSION

Applicants' state in the present petition that the "Notification of the International Application number and of the International Filing Date (PCT/RO/105) was received by the undersigned on August 8, 2002 . . . The due date for entering the national phase in the United States was July 7, 2002. Accordingly, applicants proceeded to enter the national phase employing the International Application number stamped upon the postcard receipt. Thus, the national phase application indicates an incorrect International Application PCT/US01/42987." Applicants confirm that the listing of PCT/US01/42987 in the original Transmittal Letter was an error and have provided a corrected Transmittal Letter indicating the PCT/US01/42987. Pursuant to petitioner's request, the national stage papers filed 03 July 2002 will be treated as a U.S. national stage submission for PCT/US01/51574 and the petition under 37 CFR 1.181 is granted. This national stage file (10/169,606) is the national stage of PCT/US01/51574.

The declaration submitted on 23 September 2002 is not in compliance with 37 CFR 1.497(a)(2). Specifically, the declaration is directed to an incorrect international application number (PCT/US01/42987). Therefore, applicants are required to submit a newly executed declaration identifying the international application as PCT/US01/51574.

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Missing Requirements (Form PCT/DO/EO/905) dated 10 September 2002 is hereby **VACATED**.

All documents pertaining to PCT/US01/42987 have been removed from the present application file.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for processing in accord with this decision, including: (1) correcting USPTO records so as to identify the present application as a national stage of PCT/US01/51574; and (2) mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905), to inform applicants that the oath/declaration is defective.

Anthony Smith

Anthony Smith
Attorney-Attorney
Office of PCT Legal Administration
Tel. (703) 308-6314
Fax (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WENDEROTH, LIND
& PONACK L.L.P.
2033 K. STREET, NW
SUITE 800
WASHINGTON DC 20006

COPY MAILED
SEP 18 2008

In re Application of	:	
Matsushima, et al.	:	
Application No. 10/169,606	:	DECISION ON PETITION
Filed: 3 July, 2002	:	
Attorney Docket No. 2002-0872A	:	

This is a decision on the petition under 37 C.F.R. §1.78(a)(3), filed on 25 June, 2007, and supplemented on 28 August, 2008, 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 by amendment filed with the petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 C.F.R. §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 C.F.R. §1.78(a)(2)(ii). In addition, the petition under 37 C.F.R. §1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C.§120 and 37 C.F.R. §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 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The requirements above have been satisfied, and the late claim for priority under 35 U.S.C. §120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to John Gillon, Attorney, at (571) 272-3214. 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 AU 2182 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. §120 to the prior-filed applications.

Anthony Knight
Supervisor
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
10/169,606	10/02/2003	2182	2328	2002-0872A	31	18

CONFIRMATION NO. 5725

CORRECTED FILING RECEIPT

52349
WENDEROTH, LIND & PONACK L.L.P.
2033 K. STREET, NW
SUITE 800
WASHINGTON, DC 20006

OC000000032133562

Date Mailed: 09/17/2008

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)

Hideki Matsushima, Hirakata, JAPAN;
Ryuichi Okamoto, Kadoma, JAPAN;
Mitsuhiro Inoue, Osaka, JAPAN;
Masayuki Kozuka, Arcadia, CA;

Power of Attorney:
Jeffrey Filipek--41471

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US01/51574 11/07/2001
which is a CON of 09/706,755 11/07/2000 ABN

Foreign Applications

If Required, Foreign Filing License Granted: 08/28/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/169,606**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

DIGITAL DATA DISTRIBUTION SYSTEM WITH SWITCHING UNIT, ONLINE ACQUISITION UNIT, AND CONVERSION UNIT FOR CONVERTING FROM FIRST TO SECOND FORMAT

Preliminary Class

710

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).

12 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Charles A. Muserlian
Bierman, Muserlian and Lucas
600 Third Avenue
New York, New York 10016

In re Application of :
GADEK et al. :
Application No.: 10/169,612 :
PCT No.: PCT/EP00/12877 :
Int. Filing Date: 12 December 2000 :
Priority Date: 15 December 1999 :
Attorney Docket No.: 146.1385 :
For: THIENYLALANINE DERIVATIVES AS INHIBITORS OF CELL ADHESION

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 01 July 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee of $1040 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the thirty-month period is required.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PA
TENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.g

Date Mailed : May 11, 2007
Patent No. :6,703,915 B1
Ser. No. :10/169626
Inventor(s) :Masaharu Iwai
Issued :March 9, 2004
Title: MAGNET ROLLER

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Magdalene Talley
For Cecelia Newman, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 116 or

Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

CBN/mt

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 10/3/07

Paper No.: ____

TO SPE OF : ART UNIT 2876

SUBJECT : Request for Certificate of Correction on Patent No.: 6976633

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☐ **Approved** — All changes apply.
- ☒ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

The request for C of C filed June 19, 2006 has been approved in part.

The requested corrections of col. 7, line 58, col. 8, line 59, col. 9, line 5, col. 13 line 15, col. 18,line 23, col. 20, line 4, and col. 23, line 66 have been approved.

The requested corrections of claims in the C of C and allowed claims do not correspond as shown in the index of renumbered claims. Therefore, the request is not approved.

/STEVEN S. PAIK/ — SPE

2887 — Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE
20 SEP 2002

#3

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Fish & Richardson, P.C.
225 Franklin Street
Boston, MA 02110-5070

In re Application of	:	
Kang	:	DECISION ON
Application No. 10/169636	:	
PCT No.: PCT/US01/00139	:	PETITION UNDER
Int. Filing Date: 02 January 2001	:	
Priority Date: 04 January 2000	:	37 CFR 1.137(b)
For: Pipet For Liquid Exchange	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 08 July 2002.

BACKGROUND

This international application was filed on 02 January 2001, claiming earliest priority of an application filed on 04 January 2000. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 05 July 2002 (as 04 July was a holiday). This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

On 08 July 2002, applicants filed the instant petition.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), applicants have filed the required reply in the form of the basic national fee.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes a statement that "the entire period

of delay was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration and a surcharge under 37 CFR 1.492(e).

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

COPY MAILED

OCT 20 2005

OFFICE OF PETITIONS

In re Application of	:	
Cleanthous et al.	:	
Application No. 10/169,638	:	ON PETITION
Filed: October 17, 2002	:	
Attorney Docket No. 0275D-000289/USB	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 24, 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 May 23, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on August 24, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee and publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply has been accepted as having been unintentionally delayed.

This matter is being referred to the Publishing Division for processing into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions

27 MAY 2004

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Robert L. McKellar
816 West Wackerly Street
Suite 2
Midland, MI 48640-2730

In re Application of	:	
DE BUYL, et al.	:	
U.S. Application No.: 10/169,647	:	DECISION ON PETITION
PCT No.: PCT/EP01/00070	:	
Int. Filing Date: 04 January 2001	:	UNDER 37 CFR 1.181
Priority Date: 06 January 2000	:	
Attorney Docket No.: SN-110	:	
For: ORGANOSILOXANE COMPOSITIONS	:	

This decision is in response to applicant's petition under 37 CFR 1.181 filed 10 March 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 04 January 2001, applicant filed international application PCT/EP01/00070, which claimed priority of an earlier application filed 06 January 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 July 2001. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 06 July 2002.

On 03 July 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 30 September 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. In addition, applicant was advised of the need to pay the surcharge for providing an oath or declaration of the inventor later than thirty months from the priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 29 September 2003, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 30 September 2002 within the time period set therein and that above-identified application was abandoned as to the United States.

On 24 October 2003, applicant filed the present petition to withdraw the holding of abandonment.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped postcard receipt. The postcard identifies the application by title, applicants and docket number. Among the items listed on the receipt is "8 pages of Declaration and Power of Attorney for USSN: 10/169,647." The postcard is stamped "OIPE Patent and Trademark Office JC344 OCT 03 2002." The evidence is sufficient to establish that the combined declaration and power of attorney for this application was received in the USPTO on 03 October 2002. An examination of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States were satisfied on 03 October 2002. As such, it is proper to **GRANT** applicant's petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

As authorized, the $130.00 surcharge for providing a signed oath or declaration of the inventors later than thirty months from the earliest claimed priority date will be charged to Deposit Account No.: 13-2492.

The "NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909)" mailed on 29 September 2003 is hereby **VACATED**.

This application will be given an international application filing date of 04 January 2001 and a date of **03 October 2002** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the DO/EO/US for processing in accordance with this decision

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

24 SEP 2

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

John J. McDonnell
McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive
Suite 3200
Chicago, IL 60606

In re Application of RUDERMAN et al	:	
U.S. Application No.: 10/169,648	:	
Int. Application No.: PCT/US00/32833	:	DECISION ON PETITION
Int. Filing Date: 01 December 2000	:	
Priority Date: 01 December 1999	:	UNDER 37 CFR 1.137(b)
Attorney Docket No.: 00-203-C	:	
For: CARDIOVASCULAR HEALTHCARE	:	
MANAGEMENT SYSTEM AND METHOD	:	

This is in response to applicant's "Petition to Revive Unintentionally Abandoned Application Under 37 C.F.R. § 1.137(b)" filed 02 July 2002.

BACKGROUND

On 01 December 2000, applicant filed international application PCT/US00/32833, which claimed priority of an earlier United States application filed 01 December 1999. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 June 2002 (01 June 2002 was a Saturday).

International application PCT/US00/32833 became abandoned as to the United States at midnight on 03 June 2002 for failure to pay the basic national fee.

On 02 July 2002, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless

previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be submitted.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : June 02, 2008

TO SPE OF : ART UNIT 2612

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/169654 Patent No.: 7324019 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.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments: Date

SPE

2612
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/30/09

TO SPE OF : ART UNIT 1654

SUBJECT : Request for Certificate of Correction for Appl. No.: 10169657 Patent No.: 7598222

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: _____

SPE, Art Unit 1654
Cecilia Tsay 1654

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ELI LILLY & COMPANY
PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS IN 46206-6288

MAILED

APR 14 2010

OFFICE OF PETITIONS

In re Application of	:	
Prouty et al.	:	DECISION ON REQUEST
Patent Number: 7,598,222	:	FOR RECONSIDERATION OF
Issue Date: 10/06/2009	:	PATENT TERM ADJUSTMENT
Application No. 10/169657	:	and
Filing or 371(c) Date: 06/28/2002	:	NOTICE OF INTENT TO ISSUE
Attorney Docket Number: X-11708	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on November 24, 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 five hundred twenty-eight (528) 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 five hundred twenty-eight (528) days is **GRANTED to the extent indicated herein**.

As to the "B" delay, the period is 404 days, not 433 days. Patentee calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The priority date of this application is January 27, 2000, and ends on September 4, 2006, the day before the RCE was filed, and is 404 days (not 433) days. See, 35 U.S.C. 154(b)(1)(B)(i).

Further as to the "B" delay, the period of adjustment of 404 days is reduced to the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, and the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. 154(b)(2)(A), 37 CFR 1.702(f). In this instance, the period of adjustment of 48 days pursuant to 37 CFR 1.702(a)(2) overlaps with the period of adjustment pursuant to 37 CFR 1.702(b). As such, the patent term adjustment is 451, not 528 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 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 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 four hundred fifty-one (**451**) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,598,222 B2

DATED : October 6, 2009

INVENTOR(S) : Prouty 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 95 days.

Delete the phrase "by 95 days" and insert – by 451 days--

15 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Barry C. Kane
MILLER, JOHNSON, SNELL & CUMMISKEY
Post Office Box 306
grand Rapids, Michaigan 49501-0306

In re Application of: SHA, Subin, et al. U.S. Application No.: 10/169,664 PCT No.: PCT/US99/30431 International Filing Date: 20 December 1999 Priority Date: 21 December 1998 Attorney's Docket No.: 24058.011 For: NON-NEWTONIAN FLOW FLUID-LOCKING MECHANISM FOR VEHICLES	DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 08 July 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statements in the petition and the accompanying "Statement In Support Of Petition Of Revival Of An Application For Patent Designated In The U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" meet the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that the 08 July 2002 submission also included an executed declaration in compliance with 37 CFR 1.497.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. 371 date is **08 July 2002**.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

COPY MAILED
JUL 1 2 2004
OFFICE OF PETITIONS

In re Application of
Shuichi Kawasaki :
Application No. 10/169,666 : ON PETITION
Filed: July 8, 2002 :
Attorney Docket No. 2002-0879A :

This is a decision in response to a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee filed June 23, 2004.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid April 20, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

After the application is received in the Office of Petitions, the file will be forwarded to Technology Center AU 2834 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

18 MAR 2003

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

James E. Piotrowski
Alix, Yale, & Ristas, LLP
750 Main Street
Suite 1400
Hartford, CT 06103

In re Application of	:
GOSAVI, Nataraj et al.	: DECISION ON
US Application No.: 10/169,681	:
PCT Application No.: PCT/US01/00386	: REQUEST FOR
Int. Filing Date: 05 January 2001	:
Priority Date: 19 January 2000	: STATUS UNDER
Attorney's File Reference: DEXNON/100/PC/US	:
For: NONWOVEN LAMINATE WIPING	: 37 CFR 1.42
PRODUCT AND PROCESS FOR ITS	:
MANUFACTURE	:

This decision is in response to applicants' filing, on 05 July 2002, of papers for entry into the US national stage under 35 USC 371 requesting acceptance of the papers under 37 CFR 1.42 on behalf of a deceased inventor.

BACKGROUND

On 05 January 2001, applicants filed international application number PCT/US01/00386 claiming a priority date of 19 January 2000. The application named three co-inventors Nataraj Gosavi (Gosavi), Richard V. Annis (Richard Annis), and Stanley M. Gryskiewicz (Stanley Gryskiewicz).

On 15 August 2001, applicants filed a Demand for international preliminary examination. Accordingly, the 30-month deadline for entry into the US national stage expired at midnight on 19 July 2002.

On 05 July 2002, the applicants filed a letter requesting entry into the US national stage under 35 USC 371. The letter is accompanied by, inter alia, a declaration listing three co-inventors Gosavi, Vaughn R. Annis (Vaughn Annis), and Stanley Gryskiewicz. The declaration also lists Linda M. Gryskiewicz (Linda Gryskiewicz) as the survivor at law and successor in interest of Stanley Gryskiewicz. The declaration includes the signatures of Gosavi, Vaughn Annis, and Linda Gryskiewicz.

DISCUSSION

I. Request for status under 37 CFR 1.42.

37 CFR 1.42, entitled "When the inventor is dead", states:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

The declaration states that Linda Gryskiewicz is the survivor at law and successor in interest of deceased co-inventor Stanley Gryskiewicz. A declaration may be signed by all of the heirs of the deceased inventor if a legal representative of the deceased inventor has not been appointed nor is required under the applicable law to be appointed. MPEP 409.01(a). However, it is not clear that Linda Gryskiewicz is the sole survivor at law and successor in interest, or heir, of deceased co-inventor Stanley Gryskiewicz. If a legal representative has not been, or is not required to be, appointed, then the applicants must provide either 1) a statement making it clear that Linda Gryskiewicz is the sole heir of Stanley Gryskiewicz if this in fact the case or 2) if Linda Gryskiewicz is not the sole heir of Stanley Gryskiewicz, a new oath or declaration must be submitted including the names and signatures of all of the heirs of Stanley Gryskiewicz. Otherwise an oath or declaration, in compliance with 37 CFR 1.497 and 1.42, executed by the legal representative is required.

II. Inventor name discrepancy.

37 CFR 1.497(d) states in part:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application . . . . . applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter) . . . . . .

The international application papers filed 05 January 2001 named Richard Annis as a co-inventor. However, the declaration filed 05 July 2002 does not name Richard Annis as a co-inventor but instead names Vaughn Annis as a co-inventor. Accordingly, if Richard Annis and Vaughn Annis are different persons, the applicants are required to submit statements in compliance with 37 CFR 1.497(d)(1) from both Richard Annis and Vaughn Annis stating that the error in naming Richard Annis instead of Vaughn Annis, in the international application, occurred without deceptive intent on either of their parts. In

addition the applicants are required to submit the $130 processing fee in compliance with 37 CFR 1.17(i) and any written consent of assignee required under 37 CFR 1.497(d)(3).

On the other hand, section 605.04(c) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under **37 CFR 1.182**. . . .. The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Thus, if alternatively, Richard Annis has changed his name to Vaughn Annis, applicants are required to submit a petition under 37 CFR 1.182 including both the $130 petition fee set forth in 37 CFR 1.17(h) and an affidavit signed with both names, Richard Annis and Vaughn Annis, setting forth the procedure whereby the name change was effected or a certified copy of the court order in compliance with MPEP section 605.04(c).

If, on the other hand, the name of co-inventor Annis was incorrectly indicated as Richard Annis upon filing the international application but was later correctly indicated as Vaughn Annis on the declaration, the applicants are required to submit a petition under 37 CFR 1.182 including both the $130 petition fee set forth in 37 CFR 1.17(h) and a statement satisfactorily explaining how the error occurred without deceptive intent.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants' response to this decision must be submitted within **TWO (2) MONTHS** from the mailing date of this decision. **Failure to properly respond to this decision will result in abandonment** of this US national stage application.

Extensions of time may be obtained under 37 CFR 1.136(a).

Applicants are required to submit 1) an oath or declaration in compliance with 37 CFR 1.497 and 1.42 or a statement indicating that Linda Gryskiewicz is the sole heir, as indicated in Part I above and 2) the proper submission indicated in Part II above for resolving the discrepancy in the identified inventive entity.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Affairs.

Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office
Telephone: 703-308-0890

Boris Milef
PCT Legal Examiner
PCT Legal Office

30 MAY 2003

475

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

James E. Piotrowski
Alix, Yale, & Ristas, LLP
750 Main Street
Suite 1400
Hartford, CT 06103

In re Application of	:
GOSAVI, Nataraj et al.	: DECISION ON
US Application No.: 10/169,681	:
PCT Application No.: PCT/US01/00386	: REQUEST FOR
Int. Filing Date: 05 January 2001	:
Priority Date: 19 January 2000	: STATUS UNDER
Attorney's File Reference: DEXNON/100/PC/US	:
For: NONWOVEN LAMINATE WIPING	: 37 CFR 1.42
PRODUCT AND PROCESS FOR ITS	:
MANUFACTURE	:

This decision is in response to applicants' "Response to Decision on Request for Status Under 37 CFR 1.42", filed 18 April 2003.

BACKGROUND

On 18 March 2003, this Office mailed a decision dismissing applicants' request for status under 37 CFR 1.42. The decision stated that it was unclear whether a legal representative of deceased inventor Stanley Gryskiewicz's estate had been appointed or was statutorily required to be appointed. The decision also stated that it was unclear whether or not Linda Gryskiewicz was the sole heir of Stanley Gryskiewicz. The decision explained that the oath/declaration must be executed by the legal representative, if one has been appointed or is statutorily required to be appointed. Alternatively, if there is not a legal representative, the oath/declaration must be executed by all of the heirs of deceased co-inventor Stanley Gryskiewicz. The decision also indicated, inter alia, that if the first name of co-inventor Annis had been incorrectly indicated as Richard upon filing the international application but correctly indicated as Vaughn on the declaration, the applicants must submit a petition under 37 CFR 1.182 explaining how the error occurred without deceptive intent.

On 18 April 2003, applicants filed the present "Response to Decision on Request for Status Under 37 CFR 1.42". The response explains that Linda Gryskiewicz is the legal representative and sole heir of deceased co-inventor Stanley Gryskiewicz. In addition, the response includes a petition under 37 CFR 1.182 and is accompanied by the

$130 petition fee under 37 CFR 1.17(h). The petition explains that the applicants incorrectly, but without deceptive intent, indicated, upon filing the international application, that the first name of co-inventor Annis was Richard when in fact his first name is Vaughan. The petition also explains that the first name of co-inventor Annis is incorrectly spelled on the declaration filed 05 July 2002. The declaration indicates that the first name of co-inventor Annis is Vaughn when in fact his first name is spelled Vaughan.

DISCUSSION

I. Request for status under 37 CFR 1.42.

Applicants response filed 18 April 2003 explains that Linda Gryskiewicz is the legal representative and sole heir of deceased co-inventor Stanley Gryskiewicz. Accordingly, the execution of the declaration by Linda Gryskiewicz, in her capacity as the sole heir and legal representative of deceased co-inventor Stanley Gryskiewicz, is acceptable under 37 CFR 1.42.

II. Inventor name discrepancy.

Applicants' response includes a petition under 37 CFR 1.182 explaining that the applicants incorrectly, but without deceptive intent, indicated, upon filing the international application, that the first name of co-inventor Annis was Richard when in fact his first name is Vaughan. The petition also explains that the first name of co-inventor Annis is incorrectly spelled on the declaration filed 05 July 2002. The declaration indicates that the first name of co-inventor Annis is Vaughn when in fact his first name is spelled Vaughan. Accordingly, a notation has been entered in the left margin of the declaration, in accordance with MPEP section 605.04(g), referencing the correction.

CONCLUSION

For the above reasons, applicants' request for status under 37 CFR 1.42 is **GRANTED**. In addition, applicants' request under 37 CFR 1.182 to correct the first name of co-inventor Annis from Richard to Vaughan is **GRANTED**.

The correct spelling of the name of co-inventor Vaughan R. Annis has been noted.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office
Telephone: 703-308-0890

30 JUL 2003

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Francis C. Hand, Esq.
Carella, Byrne, Bain, Gilfillan,
Cecchi, Stewart & Olstein
6 Becker Farm
Roseland, New Jersey 07068

In re Application of	:	DECISION ON
Odd Sollesnes	:	
PCT No.: PCT/NO01/00031	:	
Application No.: 10/169,701	:	PETITION UNDER
Int. Filing Date: 29 January 2001	:	
Priority Date: 28 January 2000	:	
Attorney's Docket No.: 53550.51	:	37 CFR 1.47(b)
For: METHOD AND APPARATUS FOR	:	
RETRIEVING EQUIPMENT FROM A WELL	:	

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)" submitted on 11 March 2003 that seeks the acceptance of the application without the signature of the inventor Odd Sollesnes and the subsequent communication on 31 March 2003 that included the executed Declaration by Odd Sollesnes. Petitioner has submitted the requisite $130 petition fee by check. However, since the petition and the executed declaration were submitted after March 03, 2003- the petition was submitted on March 04, 2003 has evidenced by the stamped mail envelope and executed declaration received March 31, 2003 a fifth month extension of time of $1,970.00 has been charged to applicant's Deposit Account 03-0678 as stipulated in the petition of March 11, 2003.

BACKGROUND

On 29 January 2001, applicant filed international application PCT/NO01/00031, which claimed priority to earlier application filed 28 January 2000. A copy of the international application was transmitted to the United States from the International Bureau on 09 August 2001. A Demand was filed for this application. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 July 2002.

On 08 July 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 03 September 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification

also indicated that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two months from the date of this notice or 22 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 11 March 2003, *inter alia*, a petition under 37 CFR 1.47(b), and the required petition fee.

On 31 March 2003, applicant filed an executed Declaration of the inventor, Odd Sollesnes, thus satisfying the Notification of Missing Requirements under 35 U.S.C. 371.

DISCUSSION

The petition states that following the submission of the renewed petition, the non-signing inventor, Odd Sollesnes returned to petitioner's undersigned representative, an executed declaration. Thus, the declaration is now signed by the sole non-signing inventor Odd Sollesnes.

Accordingly, the declaration submitted on 08 October 2002 complies with 37 CFR 1.497(a) and (b).

CONCLUSION

The petition under 37 CFR 1.47(b) is **MOOT.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371 date of this application is **31 March 2002**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the USPTO at (703) 308-6459 on the date shown below.

AUGUST 5 2003
Date

Francis C. Hand

Office of Petitions
Attention: Rafael Bacares
PCT Legal Examiner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FAX RECEIVED
OCT 2 8 2003
GROUP 3700

Applicant:	Odd Sollesnes
PCT No.:	PCT/NO01/00031
Serial No:	10/169,701
Deposited:	July 8, 2002
TITLE:	Method and Apparatus for Retrieving Equipment From a Well

Customer No.: 27162

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a copy of a Decision on Petition, dated 30 July 2003.

The Petition indicates that a charge for a Fifth Month Extension of Time of $1,970 has been charged to Deposit Account 03/068. Clarification is requested.

On 11 March 2003, a check in the amount of $720 (small entity) was enclosed for an Extension of Time of Four Months for responding to the Notification of September 3, 2002 to March 3, 2003. The fee for an Extension of Time for a Fifth Month should total $985, less the $720 previously paid. Accordingly, a fee of $265 should have been charged to Deposit Account 03-0678 and not $1,970 (large entity).

Clarification of the charge actually made to Deposit Account 03-0678 is requested.

Respectfully submitted,

Francis C. Hand
Reg. No. 22,280
CARELLA, BYRNE BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN
Six Becker Farm Road
Roseland, NJ 07068
Phone: 973-994-1700
Fax: 973-994-1744

#190331 v1

30 JUL 2003

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DATE RECEIVED: 8-1-03
DATES ENTERED:
1)
2)
3)
4)
5)
DOCKETED BY: PM
DATE: 8-1

Francis C. Hand, Esq.
Carella, Byrne, Bain, Gilfillan,
Cecchi, Stewart & Olstein
6 Becker Farm
Roseland, New Jersey 07068

In re Application of	:	DECISION ON
Odd Sollesnes	:	
PCT No.: PCT/NO01/00031	:	
Application No.: 10/169,701	:	PETITION UNDER
Int. Filing Date: 29 January 2001	:	
Priority Date: 28 January 2000	:	
Attorney's Docket No.: 53550.51	:	37 CFR 1.47(b)
For: METHOD AND APPARATUS FOR	:	
RETRIEVING EQUIPMENT FROM A WELL	:	

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)" submitted on 11 March 2003 that seeks the acceptance of the application without the signature of the inventor Odd Sollesnes and the subsequent communication on 31 March 2003 that included the executed Declaration by Odd Sollesnes. Petitioner has submitted the requisite $130 petition fee by check. However, since the petition and the executed declaration were submitted after March 03, 2003- the petition was submitted on March 04, 2003 has evidenced by the stamped mail envelope and executed declaration received March 31, 2003 a fifth month extension of time of $1,970.00 has been charged to applicant's Deposit Account 03-0678 as stipulated in the petition of March 11, 2003.

BACKGROUND

On 29 January 2001, applicant filed international application PCT/NO01/00031, which claimed priority to earlier application filed 28 January 2000. A copy of the international application was transmitted to the United States from the International Bureau on 09 August 2001. A Demand was filed for this application. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 July 2002.

On 08 July 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 03 September 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification

also indicated that the surcharge for filing the oath or declaration later than 30 months ~~from the~~ priority date as required by 37 CFR 1.492(e) must be filed. The notification set two months from the date of this notice or 22 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 11 March 2003, *inter alia*, a petition under 37 CFR 1.47(b), and the required petition fee.

On 31 March 2003, applicant filed an executed Declaration of the inventor, Odd Sollesnes, thus satisfying the Notification of Missing Requirements under 35 U.S.C. 371.

DISCUSSION

The petition states that following the submission of the renewed petition, the non-signing inventor, Odd Sollesnes returned to petitioner's undersigned representative, an executed declaration. Thus, the declaration is now signed by the sole non-signing inventor Odd Sollesnes.

Accordingly, the declaration submitted on 08 October 2002 complies with 37 CFR 1.497(a) and (b).

CONCLUSION

The petition under 37 CFR 1.47(b) is **MOOT.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371 date of this application is **31 March 2002**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

****
*** RX REPORT ***
****

RECEPTION OK

TX/RX NO	5258
RECIPIENT ADDRESS	
DESTINATION ID	
ST. TIME	08/05 16:42
TIME USE	00'39
PGS.	3
RESULT	OK

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

#7

MAILED

SEP 10 2003

Office of the Director
Group 3600

PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND OH 44114-1484

Paper No. 7

In re application of
Shinya Adachi
Application No.10/169704
Filed: October 16, 2002
For: DIGITAL MAP POSITION
INFORMATION TRANSFER METHOD

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the petition filed on August 20, 2002 and the supplemental petition filed May 2, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII. The delay in deciding this petition is regretted.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references.

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a

prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/ekn 8-29-03

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 7

MAIL

JUN 2 8 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND OH 44114-3108

In re Application of
Shinya Adachi
Application No. 10/169,705
Filed: July 8, 2002
For: DIGITAL MAP SHAPE VECTOR ENCODING METHOD AND POSITION INFORMATION TRANSFER METHOD

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed November 5, 2002 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Sept. 26, 2008

TO SPE OF : ART UNIT 1733

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/169714 Patent No.: 6939421

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

Magdalene Talley
Certificates of Correction Branch
703-308-9390 ext. 116

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☐ **Approved** — **All** changes apply.
- ☒ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: The correction of column 3, line 46, replace "the," with --the-- is approved. All other corrections are denied as being present in the substitute specification filed 3/7/2005 or in the examiner's amendment mailed 5/9/2005.

GLADYS P CORCORAN
SUPERVISORY PATENT EXAMINER

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.	:	6,939,421
APPLICATION NO.	:	10/169,714
ISSUE DATE	:	September 6, 2005
INVENTOR(S)	:	Michel Brement et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

~~**Column 1, line 8, delete "holding elements or"**~~
~~**Column 1, line 9, delete "holding elements or"**~~
~~**Column 1, line 44, delete "holding elements or"**~~
~~**Column 2, line 1, delete "advantageously"**~~
~~**Column 2, line 50, delete "holding elements such as"**~~
~~**Column 2, line 53, delete "holding elements"**~~
Column 3, line 46, replace "the;" with --the--
~~**Column 3, line 67, delete "feet or"**~~

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Thomas E. Anderson
GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C.
2701 Troy Center Drive, Suite 330
Post Office Box 7021
Troy, Michigan 48007-7021

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DICKINSON WRIGHT PLLC
JAMES E. LEDBETTER, ESQ.
INTERNATIONAL SQUARE
1875 EYE STREET, NW., SUITE 1200
WASHINGTON, DC 20006

MAILED

AUG 12 2009

OFFICE OF PETITIONS

In re Application of :
Hiroaki Sudo :
Application No.: 10/169,716 : ON PETITION
Filed: July 9, 2002 :
Attorney Docket No.: L9289.02186 :

This is a decision on the petition, filed August 11, 2009, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July 20, 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2419 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).

/SDB/

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.*

25 JAN 2003

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Surinder Sachar
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314

In re Application of Kazuhiko FUJIIE et al.. US Application No.: 10/169,734 PCT Application No.: PCT/JP01/10049 Int. Filing Date: 16 November 2001 Priority Date: 17 November 2000 Attorney Docket No.: 225683US6PCT For: LASER POWER CONTROLLING METHOD AND APPARATUS FOR SEMICONDUCTOR LASER, AND RECORDING/REPRODUCING/ . . .	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on the papers applicant filed on 12 December 2002, in response to a Notification of Missing Requirements mailed on 12 September 2002. These papers are being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 16 November 2001, applicant filed international application PCT/JP01/10049, which designated the United States and claimed a priority date of 17 November 2000. A copy of the international application was transmitted by the International Bureau on 23 May 2002 to the United States Patent and Trademark Office. Accordingly, the 30-month deadline for entry into the U.S. national stage expired at midnight on 19 May 2003 (17 May 2003 was a Saturday).

On 16 July 2002, applicants filed national stage papers for this international application. These papers included, *inter alia*, the requisite basic national fee, an English translation of the international application and an express request for early processing under 35 U.S.C. 371(f). It is noted that an executed oath or declaration of the inventors was **not** filed with the 16 July 2002 papers; however, the $130.00 surcharge for filing an oath or declaration after the expiration of thirty months from the priority date was paid with this submission.

On 12 September 2002, a Form PCT/DO/EO/905 (NOTIFICAITON OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES

DESIGNATED/ELECTED OFFICE (DO/EO/US) was mailed to applicant. This form required the submission of an Oath or Declaration of the inventors.

On 12 December 2002, applicants responded to the Notification of Missing Requirements with an executed declaration of the inventors. This letter included an application data sheet and a request for a refund of the previously submitted $130.00 surcharge for submission of an oath or declaration beyond the 30-month time limit.

DISCUSSION

35 U.S.C. 371(c) provides in part:

> "(c) The applicant shall file in the Patent and Trademark Office-- . . .
>
> (4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants. . . ."

37 CFR 1.495 provides in part:

> (b) To avoid abandonment of the application, the applicant shall furnish to the united States Patent and Trademark Office not later than the expiration of thirty months from the priority date:
>
> (1) A copy of the international application, unless it has been previously communicated to by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and
>
> (2) The basic national fee (see § 1.492(a)).
>
> (c) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits ether a translation of the international application . . . . or the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 14.7(iv) within the time limits provided for in PCT Rule 26ter.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. . . .The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date. . . ."

In the instant application, applicants paid the basic national and provided an English translation of the international application on 16 July 2002, some 10 months prior to the expiration of thirty months from the priority date. A copy of the international application was submitted on 23 May 2002 to the United States Patent and Trademark Office by the International Bureau. All of these materials were submitted before the expiration of thirty months from the priority date (i.e. before 19 May 2003).

The 12 September 2002 Form PCT/DO/EO/905 was clearly mailed in error since the oath required by this form was not due in the United States Patent and Trademark Office until 19 May 2003.

It is noted that the required declaration of the inventors was submitted on 12 December 2002 some 5 months prior to the thirty month date. Accordingly, no surcharge was required for the submission of the oath or declaration. The $130.00 surcharge paid on 16 July 2002 was thus paid in error.

DECISION

For the above-noted reasons the petition is **GRANTED**.

The 12 September 2002 Form PCT/DO/EO/905 is hereby **VACATED**.

The $130.00 surcharge paid on 16 July 2002 will be refunded to deposit account No. **15-0030.**

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing.

It is noted that the 35 U.S.C. 371(c)(1), (2) and (4) date for this application is **12 December 2002.**

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Paul A. Bell
PCT Special Programs Examiner
Telephone (571) 272-3278

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJR.: 06-06

Paper No: __

J. ANDREW LOWES
HAYNES AND BOONE, LLP
901 MAIN STREET
STE 3100
DALLAS TX 75202-3789

COPY MAILED
JUN 19 2006
OFFICE OF PETITIONS

In re Application of	:	
Berthonnaud, et al.	:	DECISION
Application No.: 10/169,783	:	
Filing Date: 3 July, 2002	:	
Attorney Docket No. 190-68	:	

This is a decision on the petition filed on 30 March, 2006, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181, alternatively, to revive the application under 37 C.F.R. §1.137(a), as having as abandoned due to unavoidable delay, or 37 C.F.R. §1.137(b), as having as abandoned due to unintentional delay.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; the petition under 37 C.F.R. §1.137(a) is **GRANTED**; and the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 17 October, 2005, with reply due under a non-extendable deadline on or before 17 January, 2006;

- the instant application went abandoned after midnight 17 January, 2006;

- the Office mailed the Notice of Abandonment on 22 March, 2006;
- on 30 March, 2006, Petitioner filed the instant petition, averred timely payment, and provided, *inter alia*, a copy of the Fee Transmittal bearing a certificate of mailing dated and signed on 29 December, 2005, however, Petitioner presented no date-stamped receipt card and indicated that it was presumed the materials were not received by the Office following that mail date;
- out of an abundance of caution, Petitioners always are reminded that each request to the Office must be filed as a separate paper (see: 37 C.F.R. §1.4(c)), and those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

It appears that with the petition and fee, the reply in the form of the amendment filed in April 2004 and previously and heretofore unaddressed by the Office, and the statement of unintentional delay, Petitioner has satisfied the requirements under 37 C.F.R. §1.137(b).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not

---

(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.

[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.

constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides:

> * * *
>
> **B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed**
>
> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.
>
> Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been

---

[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).

> 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.
>
> * * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

As of this writing Petitioner appears not to have satisfied and not to be able to satisfy the showing requirements described above.

Allegations as to
Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unavoidable delay, and–where appropriate–a terminal disclaimer and fee.

It appears that Petitioner has satisfied the requirements of the regulation.

Allegations as to
Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and–where appropriate–a terminal disclaimer and fee.

This issue is moot.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **dismissed**; however, Petitioner appears to have satisfied the regulatory requirements and the petition under 37 C.F.R. §1.137(a) is **granted**; and, finally, the petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The application is released to Publications Branch to be processed into a patent in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

15 MAR 2004

14538A-005930US
SWP, SE

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Brian W. Poor
TOWNSEND, TOWNSEND & CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Response Due 05/15/04

In re Application of MILLER, Arthur Dusty *et al* Application No.: 10/169,785 PCT No.: PCT/US01/00429 Int. Filing Date: 05 January 2001 Priority Date: 05 January 2000 Attorney's Docket No.: 14538A-59-2PC For: COMPOSITIONS AND METHODS FOR EFFICIENT AAV VECTOR PRODUCTION	**DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

The decision is in response to applicants' "Petition to Withdraw Abandonment" filed via facsimile on 09 March 2004. No fee is required.

BACKGROUND

On 12 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and a sequence listing must be provided. A two-month time period for response was set with extensions of time available under 37 CFR 1.136(a).

On 04 November 2002, applicants purportedly mailed a response to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, an executed declaration.

On 21 November 2002, applicants purportedly mailed a response to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, a sequence listing and diskette.

On 11 February 2004, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Form PCT/DO/EO/905 within the time period set.

On 09 March 2004, applicants filed the instant petition via facsimile which was accompanied by, *inter alia*, copies of documents purportedly filed 04 November 2002 and 21 November 2002 a stamped postcard receipt for those documents.

DOCKETED BY b3b
040323

DISCUSSION

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In the instant petition, applicants provided a copy of the date-stamped postcard receipts for documents submitted filed 04 November 2002 and 21 November 200.

The 04 November 2002 postcard receipt records that an "Executed Declaration and Power of Attorney" was received in the USPTO. The filing receipt is stamped "OIPE NOV 04 2002" across its face. The U.S. application number and docket number were listed on the postcard receipt. Applicants submitted a copy of the signed declaration with the instant petition. Thus, applicants have provided *prima facie* evidence that the declaration was received by the USPTO on 04 November 2002.

The 21 November 2002 postcard receipt records that a "Response Under 37 CFR 1.821(e), Sequence Listing and Sequence Diskette" were received in the USPTO. The postcard receipt is stamped "11-21-2002" by the USPTO. The U.S. application number and docket number were listed on the postcard receipt.

However, applicants did not submit a copy of the originally filed Computer Readable Form (CFR) of the Biochemical Sequence Listing (Sequence Diskette) with the petition. Instead, applicants filed a photocopy of the diskette as part of the petition. A working copy of the diskette is required for a grantable petition. Applicants must submit a true copy of all the originally filed documents.

CONCLUSION

For the reason discussed above, applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, applicants must submit a renewed response within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a copy of the computer readable diskette as originally filed on 21 November 2002.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for

Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

I hereby certify that this correspondence is being filed via U.S. Post Office Express Mail No. EV 383383065 US to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450 on June 15, 2004

By: [signature]

Rec'd PCT/PTO 15 JUN 2004

#9

PATENT

Attorney Docket No. 14538A-005930US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

ARTHUR DUSTY MILLER *et al.*

Application No.: 10/169,785

Filed: July 3, 2002

For: COMPOSITIONS AND METHODS FOR EFFICIENT AAV VECTOR PRODUCTION

Examiner: Unassigned

Art Unit: Unassigned

RESPONSE TO DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Mail Stop PCT
Assistant Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed in response to the Decision on Petition to Withdraw Holding of Abandonment dated 15 March 2004. The Petition to Withdraw Holding of Abandonment filed 9 March 2004 was found insufficient because a copy of the computer readable form (CRF) of the sequence listing as originally filed was not included. The Office has indicated that the Petition will be reconsidered upon submission of a copy of the CRF.

As requested, Applicants enclose herewith a copy of the originally filed sequence listing on a computer readable form diskette (CRF), as well as a paper copy of the sequence listing. Pursuant to 37 CFR §1.821(f) and (g), it is believed that the content of the paper sequence listing and the CRF are the same. Further, the present submission is not believed to constitute new matter.

PATENT

Applicants respectfully request that the Notification of Abandonment be withdrawn in the above-referenced patent application. Such request is timely, with no intention to delay.

Although Applicants do not believe a fee is due for filing this communication, should a fee (or a credit) be due, please charge (or credit) any fees associated with this response to Townsend and Townsend and Crew LLP Deposit Account No. 20-1430.

Respectfully submitted,

Dated: 15 June 20004

By: Brian W. Poor
Brian W. Poor
Reg. No. 32,928

TOWNSEND and TOWNSEND and CREW, LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111
Telephone: (206) 467-9600
Telefax: (415) 576-0300
60156666v1

28 JUN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

#10

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Brian W. Poor
TOWNSEND, TOWNSEND & CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

In re Application of MILLER, Arthur Dusty *et al* Application No.: 10/169,785 PCT No.: PCT/US01/00429 Int. Filing Date: 05 January 2001 Priority Date: 05 January 2000 Attorney's Docket No.: 14538A-59-2PC For: COMPOSITIONS AND METHODS FOR EFFICIENT AAV VECTOR PRODUCTION	**DECISION** **ON** **RENEWED PETITION**

The decision is in response to applicants' "Response to Decision on Petition to Withdraw Abandonment" filed on 15 June 2004.

BACKGROUND

On 15 March 2004, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed because of a failure to include a working copy of the Computer Readable Form (CFR) of the Biochemical Sequence Listing ("diskette") mailed 21 November 2002.

On 15 June 2004, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a copy of the CRF diskette and paper copy of the sequence listing originally mailed 21 November 2002.

DISCUSSION

In the original petition, applicants provided *prima facie* evidence that the following documents were received by the USPTO on 04 November 2002 and 21 November 2002 respectively: an executed declaration; a CRF diskette. However, applicants failed to provide a working copy of the originally filed CRF diskette. Thus, the petition to withdraw the holding of abandonment was not granted.

In the renewed petition, applicants have provided a copy of the missing diskette as originally submitted on 21 November 2002. The diskette was checked by the Scientific and Technical Information Center (STIC) and found that the sequences were good with no errors found.

Applicants have now satisfied the requirements for a grantable petition.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 11 February 2004 is **VACATED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 05 January 2001, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 04 November 2002.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

COPY MAILED
JUN 22 2006
OFFICE OF PETITIONS

In re Application of	:	
Jie LIU	:	
Application No. 10/169,786	:	DECISION ON PETITIONS
Filed: July 2, 2002	:	UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 3006.000200/KDG	:	

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed September 15, 2005, and resubmitted September 19, 2005 to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition was accompanied by an amendment to the first sentence of the specification following the title to include a reference to the prior-filed applications. While a reference to the prior-filed applications was not included in an ADS or in the first sentence of the specification following the title, a reference nevertheless was made in the declaration filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).[1] In the present case, the Office noted the claim for priority of the prior-filed applications in the declaration filed with the application, as shown by their inclusion on the filing receipt.

Therefore, the petition is unnecessary and is **DISMISSED AS INVOLVING A MOOT ISSUE**.

[1] *Note* MPEP 201.11 (III)(D), pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

In view of the above, the $1370 petition fee submitted is unnecessary and will be refunded to petitioner by Treasury Check in due course.

Any questions concerning this decision on petition may be directed to David Bucci at (571) 272-7099. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 1762 for appropriate action on the amendment filed **September 19, 2005**, including consideration by the examiner of the claim under 35 U.S.C. § 119(e) for benefit of the prior-filed application.

Brian Hearn
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, D.C. 20231
WWW.USPTO.GOV

APR 30 2003

#8

ANTHONY CASTORINA
G E EHRLICH
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

In re Application of	:
Tamar Tenenbaum et al	:
Serial No.: 10/169,801	: PETITION TO MAKE SPECIAL
Filed: July 9, 2002	:
Attorney Docket No.: 00/23960	:

This is in response to applicants' petition filed July 9, 2002, and refiled April 15, 2003, to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on the age of the applicant. The original petition was discovered under the specification in the file wrapper.

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

02 OCT 2006

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Young & Thompson
745 South 23rd Street
2nd Floor
Arlington, VA 22202

In re Application of	:	
Herrmann et al.	:	
Application No.: 10/169,831	:	DECISION
PCT No.: PCT/SE01/00031	:	
Int. Filing Date: 10 January 2001	:	ON
Priority Date: 10 January 2000	:	
Attorney Docket No.:1510-1006	:	PETITION
For: A Method For Detection Of	:	
Pathogenic Organisms	:	

This is in response to the petition for withdrawal of the holding of abandonment filed on 21 March 2006.

BACKGROUND

This international application was filed on 10 January 2001, claimed an earlier priority date of 10 January 2000, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 19 July 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The 30 month time period for paying the basic national fee in the United States expired at midnight on 10 July 2002. Applicants filed *inter alia* the basic national fee on 10 July 2002.

On 13 September 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b).

On 13 November 2002, applicants filed a response including an executed declaration.

On 07 March 2003, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) to be 13 November 2002.

On 03 October 2005, a Notification To Comply With Requirements For Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) was mailed to applicant, requiring an initial computer readable form (CRF) of the sequence listing, an amendment directing its entry into the application, and a statement that the content of the CRF is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter.

On 17 February 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the United States for failure to timely reply to the Notification mailed on 03 October 2005.

DISCUSSION

Petitioner requests withdrawal of the holding of abandonment because "on January 3, 2006, applicants timely filed a response to the Notification." Counsel supports this assertion by presenting a copy of a return postcard receipt stamped as received by "OIPE JAN 03 2006" and itemizing a "copy of NOTIFICATION of October 3, 2005," a "PETITION FOR EXTENSION OF TIME," a "SEQUENCE LISTING in paper and diskette format," and a "fee for one month extension charged to deposit account..." MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Following that practice, the copy of the correspondence accompanying the instant petition is being regarded as a copy of the corresponding correspondence originally filed on 21 March 2006. However, no acceptable CRF appears to have been received into the application file. For this reason, it would not be appropriate to grant the requested relief on the basis of the present record.

DECISION

The petition is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this Decision, extendable under 37 CFR 1.136(a), to file a response.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

United States Patent and Trademark Office

05 MAR 2007

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

In re Application of	:	
Herrmann et al.	:	
Application No.: 10/169,831	:	DECISION
PCT No.: PCT/SE01/00031	:	
Int. Filing Date: 10 January 2001	:	ON
Priority Date: 10 January 2000	:	
Attorney Docket No.: 1510-1006	:	PETITION
For: A Method For Detection	:	
Of Pathogenic Organisms	:	

This is in response to the renewed petition for withdrawal of the holding of abandonment filed on 04 December 2006.

DISCUSSION

In a Decision mailed on 02 October 2006, the petition to withdraw the holding of abandonment filed on 21 March 2006 was dismissed without prejudice because

> Petitioner requests withdrawal of the holding of abandonment because "on January 3, 2006, applicants timely filed a response to the Notification." Counsel supports this assertion by presenting a copy of a return postcard receipt stamped as received by "OIPE JAN 03 2006" and itemizing a "copy of NOTIFICATION of October 3, 2005," a "PETITION FOR EXTENSION OF TIME," a "SEQUENCE LISTING in paper and diskette format," and a "fee for one month extension charged to deposit account..." MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Following that practice, the copy of the correspondence accompanying the instant petition is being regarded as a copy of the corresponding correspondence originally filed on 21 March 2006. However, no acceptable CRF appears to have been received into the application file. For this reason, it would not be appropriate to grant the requested relief on the basis of the present record.

In response, petitioner states that "applicants provide a copy of the CRF at this time and request that the holding of abandonment be withdrawn." Review of the official record reveals that no technically satisfactory CRF (and amendment directing its entry) has yet been received into the application file. Applicants are advised to submit any CRF (and amendment) directly to the address given below to expedite its being promptly matched with the application file.

DECISION

The petition is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this Decision, extendable under 37 CFR 1.136(a), to file a response.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

25 JUN 2007

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

In re Application of	:	
Herrmann et al.	:	
Application No.: 10/169,831	:	DECISION
PCT No.: PCT/SE01/00031	:	
Int. Filing Date: 10 January 2001	:	ON
Priority Date: 10 January 2000	:	
Attorney Docket No.: 1510-1006	:	PETITION
For: A Method For Detection	:	
Of Pathogenic Organisms	:	

This is in response to the renewed petition for withdrawal of the holding of abandonment filed on 04 May 2007.

DISCUSSION

In a Decision mailed on 05 March 2007, the petition to withdraw the holding of abandonment filed on 04 December 2006 was dismissed without prejudice because

> In response, petitioner states that "applicants provide a copy of the CRF at this time and request that the holding of abandonment be withdrawn." Review of the official record reveals that no technically satisfactory CRF (and amendment directing its entry) has yet been received into the application file. Applicants are advised to submit any CRF (and amendment) directly to the address given below to expedite its being promptly matched with the application file.

The renewed petition was accompanied by a CRF which has been electronically associated with the application file. However, review of the record does not reveal the presence of a statement that this CRF is a true copy of the sequence listing itemized on the stamped return postcard receipt. Therefore, it would not be appropriate at this time to regard the CRF filed on 04 May 2007 as a copy of that originally filed on 03 January 2006.

Inspection of the Form PCT/DO/EO/922 mailed on 03 October 2005 reveals that it specifically required "an amendment specifically directing its entry into the application." No such amendment was specifically itemized on the return postcard receipt, nor was such an amendment included in the "Response To Notification To Comply..." filed on 21 March 2006. Petitioner is requested to clarify whether such an amendment was in fact timely filed in response to the Form PCT/DO/EO/922 mailed on 03 October 2005 and, if so, to provide an appropriate showing to that effect.

DECISION

The petition is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this Decision, extendable under 37 CFR 1.136(a), to file a response.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

2 8 APR 2008

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

In re Application of	:	
Herrmann et al.	:	
Application No.: 10/169,831	:	DECISION
PCT No.: PCT/SE01/00031	:	
Int. Filing Date: 10 January 2001	:	ON
Priority Date: 10 January 2000	:	
Attorney Docket No.: 1510-1006	:	PETITION
For: A Method For Detection	:	
Of Pathogenic Organisms	:	

This is in response to the renewed petition for withdrawal of the holding of abandonment filed on 27 August 2007.

DISCUSSION

In a Decision mailed on 25 June 2007, the petition to withdraw the holding of abandonment filed on 04 May 2007was dismissed without prejudice because

> The renewed petition was accompanied by a CRF which has been electronically associated with the application file. However, review of the record does not reveal the presence of a statement that this CRF is a true copy of the sequence listing itemized on the stamped return postcard receipt. Therefore, it would not be appropriate at this time to regard the CRF filed on 04 May 2007 as a copy of that originally filed on 03 January 2006.
>
> Inspection of the Form PCT/DO/EO/922 mailed on 03 October 2005 reveals that it specifically required "an amendment specifically directing its entry into the application." No such amendment was specifically itemized on the return postcard receipt, nor was such an amendment included in the "Response To Notification To Comply..." filed on 21 March 2006. Petitioner is requested to clarify whether such an amendment was in fact timely filed in response to the Form PCT/DO/EO/922 mailed on 03 October 2005 and, if so, to provide an appropriate showing to that effect.

In response, petitioner "states that the CRF filed May 4, 2007 is a true copy of that originally-filed on January 3, 2006." In view of this statement, it now would be appropriate to accept the CRF filed on 04 May 2007 as a copy of the CRF originally filed on 03 January 2006.

With respect to the issue of "an amendment specifically directing its entry into the application," petitioner argues that "the submission itself of January 3, 2006 satisfies this requirement" and that "while the word 'amendment' may not have been used, the response plainly indicates that it is a response to Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures and that the materials are 'provided' to satisfy this requirement."

In response to these arguments, it is respectfully observed that the Notification to Comply... mailed on 03 October 2005 explicitly and separately required "an amendment specifically directing its entry into the application," in addition to the other enumerated requirements. Indeed, this requirement was printed in bold characters for emphasis. Thus, the requirement for a formal amendment "specifically directing" the entry of the CRF into the application was clearly a separate requirement, which was not satisfied by the act of filing other requirements. As petitioner has not shown that such a formal amendment was in fact timely filed, it would not be appropriate to grant the requested relief at this time.

DECISION

The petition is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this Decision, extendable under 37 CFR 1.136(a), to file a response.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

1 5 AUG 2008

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

In re Application of Herrmann et al. Application No.: 10/169,831 PCT No.: PCT/SE01/00031 Int. Filing Date: 10 January 2001 Priority Date: 10 January 2000 Attorney Docket No.: 1510-1006 For: A Method For Detection Of Pathogenic Organisms	:	DECISION ON PETITION

This is in response to the renewed petition for withdrawal of the holding of abandonment filed on 04 June 2008.

DISCUSSION

In a Decision mailed on 28 April 2008, the renewed petition to withdraw the holding of abandonment filed on 27 August 2007was dismissed without prejudice because

> In response to these arguments, it is respectfully observed that the Notification to Comply... mailed on 03 October 2005 explicitly and separately required "an amendment specifically directing its entry into the application," in addition to the other enumerated requirements. Indeed, this requirement was printed in bold characters for emphasis. Thus, the requirement for a formal amendment "specifically directing" the entry of the CRF into the application was clearly a separate requirement, which was not satisfied by the act of filing other requirements. As petitioner has not shown that such a formal amendment was in fact timely filed, it would not be appropriate to grant the requested relief at this time.

In response, petitioner cites to 37 CFR 1.821(g) and argues that applicants were not timely notified that an amendment "specifically directing" entry of the CRF, and that this matter "is not a requirement of the rules." Petitioner has also provided an amendment directing entry of the CRF. While it is noted that the Form PCT/DO/EO/922 mailed on 03 October 2005 did state this requirement (in bold typeface), the Notification of Abandonment was mailed prior to the expiration of the period for response as maximally extended under 37 CFR 1.136(a). Based on the totality of the circumstances present in this case, it would be appropriate to grant the requested relief. The Notification of Abandonment mailed on 17 February 2006 is hereby **VACATED**.

DECISION

The petition is **GRANTED**, and the holding of abandonment is **WITHDRAWN**.

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) remains **13 November 2002**.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

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.
10/169,837	07/10/2002	Noboru Yamamoto	0425-0936	9223

2292 7590 03/07/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
MCKENZIE, THOMAS C

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20060222

DATE : February 22, 2006

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction on Patent No.: 6,906,072

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

SPE: James O. Wilson **Art Unit** 1624

2 7 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#8

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, N.Y. 10036-8403

In re Application of BACQUE *et al* Application No.: 10/169,855 PCT No.: PCT/FR01/00044 Int. Filing Date: 08 January 2001 Priority Date: 06 January 2000 Attorney Docket No.: P/3610-33 For: PROCESS FOR PREPARING DERIVATIVES OF 3-HYDROXYPICOLINIC ACID	:	**DECISION**

This is a decision on the declaration filed 09 January 2003 which has been treated as a petition under 37 CFR 1.42 and 37 CFR 1.43. No fee is required.

BACKGROUND

On 09 September 2002, a Notification of Missing Requirements was mailed indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 was required. A two-month time limit was set for response.

On 09 January 2003, applicants filed the instant response which was accompanied by, *inter alia*, a one-month extension and $110.00 extension fee; the surcharge fee of $130.00; a declaration signed by four of the five listed co-inventors and the legal representative of both heirs of the deceased co-inventor; and a copy of a death certificate in the original French language with a verified English translation.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Applicants have furnished a declaration signed by Mrs. Francoise Tetot as the legal representative of her minor son, William Henri Barriere and her minor daughter, Nathalie Helen Barriere pursuant to 37 CFR 1.43. The citizenship, residence and mailing address of the heirs are both listed on the declaration as required by 37 CFR 1.497(b)(2). Applicants also provided a "Certificate" indicating that the son and

daughter each receive one half of the estate of Mr. Jean Claude Barriere.

However, 37 CFR 1.497(a)(3) requires that the citizenship of each inventor (including any deceased inventor) must be listed on the declaration. 37 CFR 1.497(b)(2) also requires that the citizenship, residence, and last mailing addresses of the legal representative (or heirs) be recorded on the declaration. Here, it appears that the required information for the heirs is provided on the declaration, but that all of the information for the deceased co-inventor, Jean Claude Barriere and the legal representative, Francoise Tetot required by 37 CFR 1.497(a) and (b) has not been provided.

Accordingly, the declaration submitted does not comply with 37 CFR 1.497.

CONCLUSION

For the reasons listed above, applicants' petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136.

Applicants are advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

05 JUN 2003

#10

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, N.Y. 10036-8403

In re Application of	:	
BACQUE *et al*	:	
Application No.: 10/169,855	:	
PCT No.: PCT/FR01/00044	:	
Int. Filing Date: 08 January 2001	:	**DECISION**
Priority Date: 06 January 2000	:	
Attorney Docket No.: P/3610-33	:	
For: PROCESS FOR PREPARING	:	
DERIVATIVES OF 3-	:	
HYDROXYPICOLINIC ACID	:	

This is a decision on the "Response to Decision on Petition Under 37 C.F.R. 1.42" filed 15 May 2003.

BACKGROUND

On 27 March 2003, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed. The declaration submitted did not contain the required information about the deceased inventor and the legal representative of the heirs. Applicants were given two months to respond.

On 15 May 2003, applicants filed the instant response.

DISCUSSION

In the prior decision dismissing applicants petition under 37 CFR 1.42 and 1.43, it was noted that the required information for the heirs was provided on the declaration, but that all of the information for the deceased co-inventor and the legal representative was not provided.

In the renewed petition, counsel argues that the declaration submitted 09 January 2003 complies with 37 CFR 1.497(a) and (b). Counsel claims that the declaration bears the address and citizenship that are held in common by Mrs. Tetot (legal representative of heirs) and her two children (heirs of deceased inventor). Moreover, counsel argues that the declaration was accompanied by a Certificate which identifies the residence of the two children as the residence of Mrs. Tetot. This address is the same address that appears on the declaration along with the citizenship of the two heirs.

Further, counsel states that the "assignee and PCT applicant confirms that this

designation of French citizenship is correct for Ms. Tetot as well as the deceased inventor, Mr. Barriere." Counsel also declares that "[t]he PCT application filed by the assignee and PCT applicant correctly identifies Mr. Barriere's citizenship as French. The application also provides his address at the time the application was filed."

The declaration must meet the requirements of 37 CFR 1.497, *Oath or declaration under 35 U.S.C. 371(c)(4)*, which states, in part:

> (a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 ter.1, he or she must file an oath or declaration that:
> (1) Is executed in accordance with either § § 1.66 or 1.68;
> (2) Identifies the specification to which it is directed;
> (3) Identifies each inventor and the country of citizenship of each inventor; and
> (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
> (b)
> (1) The oath or declaration must be made by all of the actual inventors except as provided for in § § 1.42, 1.43 or 1.47.
> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§ § 1.42, 1.43, or §1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Counsel's arguments have been carefully considered and dismissed without prejudice. Counsel's claim that the address of Mrs. Tetot is the same as her children (the heirs) has been accepted. However, there is no citizenship information in the declaration for Mrs. Tetot. Counsel's statement in the renewed petition is not sufficient.

Moreover, there is no information about the deceased inventor in the declaration. Counsel's argument that the information on the deceased inventor is in the underlying international application is not relevant. A declaration pursuant to PCT Rule 4.17(iv) was not submitted in the international application, PCT/FR01/00044. 37 CFR 1.497(a)(3) requires the citizenship of each inventor to be listed on the declaration. Moreover, the declaration also does not comply with 37 CFR 1.63(c)(1) which requires the listing of the residence and mailing address of each co-inventor. 37 CFR 1.497(c)

states that a supplemental declaration in compliance with 37 CFR 1.63 will be required in accordance with 37 CFR 1.67 if the declaration does not comply with 37 CFR 1.63.

CONCLUSION

For the reasons listed above, applicants' renewed petition under 37 CFR 1.42 and 37 CFR 1.43 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136.

Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

03 AUG 2005

#13

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, N.Y. 10036-8403

In re Application of	:	
BACQUE *et al*	:	
Application No.: 10/169,855	:	
PCT No.: PCT/FR01/00044	:	
Int. Filing Date: 08 January 2001	:	**DECISION**
Priority Date: 06 January 2000	:	
Attorney Docket No.: P/3610-33	:	
For: PROCESS FOR PREPARING DERIVATIVES OF 3-HYDROXYPICOLINIC ACID	:	

This is a decision on the "Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b)" filed 08 July 2005.

BACKGROUND

On 09 September 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 was required.

On 09 January 2003, applicants filed a declaration signed by four of the five listed co-inventors and one of the two heirs and the legal representative of the other heir of the deceased co-inventor. This was treated as a petition under 37 CFR 1.42 and 37 CFR 1.43.

On 27 March 2003, a decision dismissing applicants' petition under 37 CFR 1.42 and 1.43 was mailed.

On 15 May 2003, a response to the decision mailed 27 March 2003 was filed.

On 05 June 2003, a decision dismissing applicants' renewed petition under 37 CFR 1.42 and 1.43 was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 22 October 2004, a Notification of Defective Response Abandonment (Form PCT/DO/EO/918) was mailed.

On 15 May 2003, applicants filed a petition to revive under 37 CFR 1.137(b) which was accompanied by, *inter alia*, a declaration executed by four of the inventors and by an heir and a legal representative of the other heir of a deceased inventor.

DISCUSSION

A petition to revive pursuant to 37 CFR 1.137(b) requires: (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

The petition fee of $1,500.00 has been paid. Applicants' statement in the petition has been interpreted as meaning that the "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). If this is an incorrect interpretation, applicants are requested to notify this office. A terminal disclaimer is not required. Therefore, items (2), (3) and (4) of 37 CFR 1.137(b) are satisfied.

Concerning item (1), a proper reply is to submit a declaration satisfying 37 CFR 1.42 and 1.43. The declaration provided lists the required information for all the joint inventors including the deceased inventor. In addition, the declaration records the required information for one of the two heirs, William Henry Barriere and by the legal representative (Mrs. Francoise Tetot) of the other heir, a minor, Nathalie Helene Barriere pursuant to 37 CFR 1.497(b)(2). Applicants also provided an English translation of a certificate establishing the heirs of the deceased inventor.

This declaration meets the requirements of 37 CFR 1.42 and 1.43 and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (1) of 37 CFR 1.137(b) is also complete.

CONCLUSION

Applicants' petition under 37 CFR 1.137(b) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371. The application has an international filing date of 08 January 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 08 July 2005.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20070201A

DATE : February 1, 2007

TO SPE OF : ART UNIT 3751

SUBJECT : Request for Certificate of Correction on Patent No.: 6,802,664

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

SPE: Huson Gregory **Art Unit** 3751

UNITED STATES PATENT AND TRADEMARK OFFICE
01 OCT 2002
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320

In re Application of	:	
Kirino et al.	:	
Application No.: 10/169,916	:	
PCT No.: PCT/JP01/00126	:	
Int. Filing Date: 12 January 2001	:	DECISION
Priority Date: 13 January 2000	:	
Attorney Docket No.: 113214	:	
For: Magnetic Recording Medium, Method Of	:	
Manufacture Thereof, And Magnetic Recorder	:	

This is a decision on applicants' "Notification Of Change Of Inventor Name And Address" filed on 11 July 2002.

BACKGROUND

This international application was filed on 12 January 2001 and claimed a priority date of 13 January 2000. The International Bureau transmitted a copy of the published international application to the USPTO on 19 July 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 13 July 2002.

On 11 July 2002, applicants filed *inter alia* the basic national fee and the instant "Notification..."

DISCUSSION

Review of the record reveals that the declaration of the inventors filed on 11 July 2002 itemizes a joint inventor, Harumi HIEIDA whose name does not appear in the published international application, and that the published international application itemizes a joint inventor, Harumi SAKAMOTO, whose name does not appear in the declaration of the inventors filed on 11 July 2002. The instant "Notification..." indicates that "This change was a result of marriage. The change has not been registered with WIPO." In that this is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve this matter. Such a petition must be accompanied by the $130.00 petition fee and by verified statements by the inventor and any other individuals having first-hand knowledge of the error. These statements must set forth in detail the specific circumstances as to how and when the error was made (e.g., name change due to marriage) and discovered, and must also state (if appropriate) that the mistake was an inadvertent error made without deceptive intent.

CONCLUSION

The request to accept the declaration filed on 11 July 2002 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Petition Under 37 CFR 1.182" and be accompanied by the required petition fee and an acceptable explanation of the facts as discussed above. Failure to timely file a proper response will result in ABANDONMENT of the application.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

28 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320

In re Application of	:	
Kirino et al.	:	
Application No.: 10/169,916	:	
PCT No.: PCT/JP01/00126	:	
Int. Filing Date: 12 January 2001	:	DECISION
Priority Date: 13 January 2000	:	
Attorney Docket No.: 113214	:	
For: Magnetic Recording Medium, Method Of	:	
Manufacture Thereof, And Magnetic Recorder	:	

This is a decision on applicants' petition under 37 CFR 1.182 filed on 01 November 2002.

DISCUSSION

The declaration of the inventors filed on 11 July 2002 itemizes a joint inventor, Harumi HIEIDA whose name does not appear in the published international application, and that the published international application itemizes a joint inventor, Harumi SAKAMOTO, whose name does not appear in the declaration of the inventors filed on 11 July 2002. Petitioner asserts that this discrepancy is due to Ms. Hieida's marriage. The petition is accompanied by an "Affidavit Regarding Change Of Name" signed by Ms. Hieida and attesting to her name change as a result of marriage. In view of the evidence now of record, it would be appropriate to accept the declaration filed on 11 July 2002.

DECISION

The petition under 37 CFR 1.182 is **GRANTED**.

This application is being returned to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371 (c)(1), (2) and (4) is **11 July 2002**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

17 DEC 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

KENYON & KENYON
ONE BROADWAY
NEW YORK NY 10004

In re Application of LISKOW Application No.: 10/169,963 PCT No.: PCT/DE01/04207 Int. Filing: 12 November 2001 Priority Date: 11 November 2000 Attorney Docket No.: 10191/2520 For: FUEL INJECTION SYSTEM	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicants' "PETITION TO WITHDRAW HOLDING OF ABANDONMENT DUE TO PATENT OFFICE ERROR UNDER 37 CFR 1.181" filed in the United States Patent and Trademark Office (USPTO) on 20 September 2004. No petition fee is required.

BACKGROUND

On 10 July 2002, applicants filed a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 (Form PTO 1390) along with, *inter alia*, the basic national fee.

On 20 September 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing oath or declaration, after the thirty month period, were required.

On 08 September 2004, a Notification of Abandonment was mailed to applicant indicating that applicant had failed to respond to the Notification of Missing Requirements within the time period set therein.

On 20 September 2004, in response to the Notification of Abandonment, applicant filed the instant response with a copy of 11 October 2002 response to Missing Requirements, a copy of the declaration and an itemized USPTO date-stamped postcard indicating that an executed declaration was filed on 11 October 2002.

DISCUSSION

The original declaration filed on 11 October 2002 is not located in the application file. A review of the finance records for 10/169,963 indicates that on 11 October 2002, the $130 surcharge for filing the declaration after the thirty month period was paid.

As stated in section 503 of the Manual of Patent Examining Procedure (Rev. 2, May 2004)(MPEP):

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of

all the items listed thereon on the date stamped thereon by the USPTO.

A review of the USPTO date-stamped, itemized postcard receipt indicates that the executed declaration was deposited with the USPTO on 11 October 2002.

The evidence submitted is sufficient to establish that a declaration for this application was received in the USPTO on 11 October 2002. The communication filed 20 September 2004 includes a copy of the executed declaration. Accordingly, it is appropriate to accept the copy of the declaration as a replacement for the missing original declaration with a deposit date of 11 October 2002. The evidence submitted by applicant, the postcard receipt date-stamped by the USPTO, is sufficient to overcome the *prima facie* evidence of the application file itself.

A review of the declaration reveals that the declaration identifies the inventor, and states the citizenship and mailing address of the inventor. Thus, the declaration is acceptable and the requirements of 37 CFR 1.497 are met.

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED**. The Notification of Abandonment dated 08 September 2004 is hereby **VACATED**.

The copy of the declaration originally submitted on 11 October 2002 and resubmitted on 20 September 2004 is acceptable and meets the requirements of 37 CFR 1.497(a) and (b).

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

COPY MAILED

SEP 23 2005

OFFICE OF PETITIONS

In re Application of	:	
Robert Gerard Wallace et al	:	
Application No. 10/169,968	:	ON PETITION
Filed: October 22, 2002	:	
Attorney Docket No. 3955.123USWO	:	

This is a decision on the petition under 37 CFR 1.137(b), filed September 14, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 6, 2004, 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 January 7, 2005.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 1654.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

15 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Heller Ehrman White & McAuliffe LLP
275 Middlefield Road
Menlo Park, CA 94025-3506

In re Application of	: DECISION
Andreas Gier et al	:
Application No.: 10/169,971	: ON PETITION
PCT No.: PCT/EP01/00333	:
Int. Filing Date: 12 January 2001	: UNDER 37 CFR 1.47(a)
Priority Date: 13 January 2000	:
Attorney's Docket No.: 24448-0036	:
For: Method for producing a microstructured	:
surface relief by embossing thixotropic layers	:

This decision is in response to petitioners' "PETITION TO ACCEPT APPLICATION UNDER 37 CFR 1.47(a)" filed on 10 July 2002 which urges the USPTO to accept the above-captioned application without the signature of the non-signing joint inventor- Mr. Stefan Sepeur. Petitioner has provided the requisite petition fee of $130.00 by check.

BACKGROUND

On 12 January 2001, applicant filed international application PCT/EP01/00333. A Demand electing the US was filed within 19 months from the priority date.

On 10 July 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and the present petition. A declaration was submitted at such time but did not contain the signature of Mr. Stefan SEPEUR.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has satisfied requirements (1), (3) and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

> "...Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration."

In this case, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. Petitioner asserts that documents for US patent application corresponding to PCT/EP01/00333 were sent to Mr. Sepeur on May 22, 2002 by mail. However, it is unclear if the documents forwarded to Mr. Sepeur included a copy of a complete application papers (specification, including claims, drawings, declaration) as required under MPEP 409.03(d) since there is no indication in the statements provided that a complete application was mailed to Mr. Sepeur for his signature.

Consequently, at this time it can not be concluded that Mr. Sepeur's conduct constitutes refusal to sign the required documents.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

09 SEP 2003

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Heller Ehrman White & McAuliffe LLP
275 Middlefield Road
Menlo Park, CA 94025-3506

In re Application of	: DECISION ON
Andreas Gier et al	:
Application No.: 10/169,971	:
PCT No.: PCT/EP01/00333	:
Int. Filing Date: 12 January 2001	: RENEWED PETITION
Priority Date: 13 January 2000	:
Attorney's Docket No.: 24448-0036	:
For: METHOD FOR PRODUCING A	:
MICROSTRUCTURED SURFACE RELIEF BY	: UNDER 37 CFR 1.47(a)
EMBOSSING THIXOTROPIC LAYERS	:

This is in response to the " TRANSMITTAL FOR RENEWED PETITION UNDER 37 C.F.R. §1.47(a)" filed on 07 July 2003.

BACKGROUND

In a decision from this Office on 15 January 2003, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that it has not been sufficiently demonstrated that a copy of the application papers (specification, including claims, drawings) were presented to the nonsigning inventor as required by MPEP Section 409.03(d). Accordingly, the petition did not include sufficient factual proof that Mr. Sepeur refused to sign the required papers.

On 07 July 2003, applicant submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 15 January 2003 with respect to accepting the above application without the signature of nonsigning inventor Mr. Sepeur. Filed with the renewed petition is a declaration by Mr. Peter Barz.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The renewed petition of 07 July 2003 has satisfied the requirements under 37 CFR 1.47(a).

Mr. Barz's averments do sufficiently demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for his signature as stipulated under MPEP 409.03(d). In this instance, Mr. Sepeur, he stated that if the papers were sent to him he would return them unsigned. The conduct of Mr. Sepeur interpreted as a refusal to sign the required papers. Consequently, the current record does sufficiently establish that Mr. Sepeur refusal to join in the application because petitioner has shown a *bona fide* attempt was made to deliver the complete application to him and that he refused to sign the required papers.

Petitioner has now satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given a 35 U.S.C. 371(c) date of **10 July 2002.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 22, 2007

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No./10/169975 patent no.7087589

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: The corrections to claims 1, 22, 25 and 44 with regard to R3 can not be entered because the Certificate of Correction fails to specify which R3 is intended, there are in each case, two.

SPE

1624
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

02 SEP 2003

Jason D. Voight
1350 Connecticut Avenue, N.W.
Washington, D.C. 20036

In re Application of	:	
Martin-Villalba et al.	:	
Serial No.: 10/169,989	:	DECISION ON
PCT No.: PCT/EP00/12224	:	PETITION
Int. Filing Date: 05 December 2000	:	UNDER 37 CFR 1.137(b)
Priority Date: 06 December 1999	:	
Attorney's Docket No.: 0048/01222	:	
For: GD3 SYNTHESIS INHIBITORS FOR	:	
TREATING NEUROPATHOLOGICAL	:	
DISORDERS	:	

This decision is responsive to the "PETITION TO REVIVE UNDER 37 CFR 1.137(b)" filed 12 July 2002. Applicant included the $1280 petition fee.

BACKGROUND

On 05 December 2000 applicants filed international application PCT/EP001/12224, which claimed priority of an earlier Dutch application which was filed 06 December 1999. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 07 June 2001. The thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 06 June 2002.

On 12 July 2002, applicants filed the current petition along with a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a copy of the international application, a translation, a declaration, a petition to revive, a check for the $1280 petition to revive fee and a check for $890 for the basic national fee. These papers were assigned Application No. 10/169,989.

On 12 September 2002, the USPTO mailed applicant the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (form PCT/DO/EO/905) indicating that applicant needed to furnish the $130 surcharge for filing the declaration later than 30 months from the earliest priority date. This form (PCT/DO/EO/905) was sent out in error since the

application was abandoned for failure to pay the basic national filing fee by 30 months from the earliest priority date. Therefore, the form PCT/DO/EO/905 mailed 12 September 2002 is hereby vacated.

On 02 December 2002, the USPTO mailed applicant the "NOTIFICATION OF ABANDONEMENT" (form PCT/DO/EO/909) indicating that the application was abandoned for failure to meet the requirements of 35 U.S.C. 371 and 37 CFR 1.495. This form (PCT/DO/EO/909) was also sent out in error since the application was already abandoned for failure to pay the basic national fee by 30 months from the earliest priority date. Therefore, the form PCT/DO/EO/909 mailed 02 December 2002 is hereby vacated.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied (1) by a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) by a proper reply, (3) by the petition fee required by law (37 CFR 1.17(m)), and (4) if the international filing date of the application is before June 8, 1995, any petition to revive under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer and small entity fee of $55

Applicants have provided a the required statement, a proper reply and the petition fee. .

CONCLUSION

The petition to revive the application is **GRANTED**.

The form PCT/DO/EO/905 mailed 12 September 2002 is hereby **VACATED**.

The form PCT/DO/EO/909 mailed 02 December 2002 is hereby **VACATED**.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision; and, if appropriate, a Notification of Acceptance of Application (Form PCT/DO/EO/903) will be mailed showing a 35 U.S.C. 371 date of 12 July 2002.

Debra Brittingham
PCT Legal Office
DSB/RC:dsb

for Conferee: Richard Cole
PCT Legal Examiner
PCT Legal Office

Tel: (703) 305-3401
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD MA 01742-9133

COPY MAILED

JAN 16 2007

OFFICE OF PETITIONS

In re Application of :
PROCTOR :
Application No. 10/170,015 : DECISION ON PETITION
Filed: June 11, 2002 : TO WITHDRAW
Attorney Docket No. 2479.2112-001 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 22, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to David J. Thibodeau, Jr. of HAMILTON BROOK SMITH & REYNOLDS PC has been revoked by the assignee of the patent application on January 4, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **VOLPE AND KOEING PC**
30 SOUTH 17TH STREET, SUITE 1600
UNITED PLAZA, DEPT. ICC
PHILADELPHIA, PA 19103

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
10/170,015	06/11/2002	James A. Proctor JR.	2479.2112-001

CONFIRMATION NO. 4916

OC000000021996649

21005
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

Date Mailed: 01/16/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/04/2007.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/170,015	06/11/2002	James A. Proctor JR.	2479.2112-001

CONFIRMATION NO. 4916

OC000000021996662

24374
VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

Date Mailed: 01/16/2007

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/04/2007.

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.

MONICA A GRAVES
OP (571) 272-7253

ATTORNEY/APPLICANT 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

VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA PA 19103

COPY MAILED

JUL 24 2007

OFFICE OF PETITIONS

In re Application of :
PROCTOR, James A., Jr. :
Application No. 10/170,015 :
Filed: June 11, 2002 :
Attorney Docket No. **2479.2112-001** :

DECISION ON REQUEST FOR REVOCATION OF POWER OF ATTORNEY

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed January 4, 2007.

The request is **APPROVED.**

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

All future correspondence regarding this application will be directed to the above-noted correspondence address of record.

There is an outstanding Office action mailed June 12, 2007 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 5

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

COPY MAILED

MAY 21 2003

OFFICE OF PETITIONS

In re Application of
Morad et al.
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR §1.47(a), filed February 5, 2003.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on June 11, 2002, without an executed oath or declaration.

Accordingly, on July 8, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and the $130.00 surcharge for its late filing.

In response, on February 5, 2002, applicant submitted the $130.00 surcharge for late filing oath or declaration fee, a partially executed declaration and a petition. To make the petition timely a five (5) month extension of time was submitted.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 ; (3) the petition fee; and, (4) a statement of the last known address of the non-signing inventor.

Applicant lacks items (2) and (4).

As to item (2), the declaration provided is not in compliance with 37 CFR 1.63. Rule 47 applicant has failed to provide the country of citizenship of inventors Amir Morad and Leonid Yavits pursuant to 37 CFR 1.63(a)(3). Petitioner has also failed to provide the mailing addresses of inventors Morad and Yavits pursuant to 37 CFR 1.63 (c)(1)

As to item (4), rule 47 applicant has failed to provide the last known address of inventors Morad and Yavits.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 308-6916
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries related to this decision may 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
www.uspto.gov

Paper No. 7

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

COPY MAILED

JUL 2 4 2003

OFFICE OF PETITIONS

In re Application of
Morad et al.
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR §1.47(a), filed June 12, 2003.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on June 11, 2002, without an executed oath or declaration.

Accordingly, on July 8, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and the $130.00 surcharge for its late filing.

In response, on February 5, 2002, applicant submitted the $130.00 surcharge for late filing oath or declaration fee, a partially executed declaration and a petition. To make the petition timely a five (5) month extension of time was submitted. A petition under 37 CFR 1.47(a) was dismissed on May 21, 2003.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 ; (3) the petition fee; and, (4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (2).

As to item (2), the declaration provided is not in compliance with 37 CFR 1.63. While Rule 47 applicant has filed a declaration which has included the non-signing inventors' citizenship and mailing addresses, it appears that the original declaration was altered

after the signing inventors executed the declaration.[1] As such the declaration submitted with the renewed petition is unacceptable. See MPEP 602.01. Petitioner is required to submit a new declaration which has been executed by the signing inventors and also provides the citizenship and mailing address of the non-signing inventors. See MPEP 601.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 308-6916
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

---

[1] The date of execution of the declaration which did not include non-signing inventors' citizenship and mailing addresses is October 27, 2002; the decision dismissing the first petition was mailed May 21, 2003. Thus it appears petitioner merely typed in the missing information after execution.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 10

COPY MAILED

FEB 17 2004

OFFICE OF PETITIONS

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman, Evegeny Spektor, Michael Khrapkovsky and Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR VIDEO AND AUDIO ENCODING ON A SINGLE CHIP

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37CARR 1.47(a), filed December 19, 2003.

The petition is GRANTED.

Petitioner has shown that the non-signing inventors have refused to join in the filing of the above-identified application after having been presented with the application papers. The petition attest a copy of the application was sent to the non-signing inventors' last known address. The non-signing inventor's failure to respond to the application mailing sufficiently establishes that they refuse to execute the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Gregory Chernov
Ezka Hasofer 915
Herzliya
Israel

COPY MAILED
FEB 17 2004
OFFICE OF PETITIONS

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman,
Evegeny Spektor, Michael Khrapkovsky and
Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR
VIDEO AND AUDIO ENCODING ON A SINGLE
CHIP

LETTER

Dear Mr. Chernov:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, applicant (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petitions Attorney
Office of Petitions

Kevin E. Borg
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael Khrapkovsky
Even Shifzat 25/5
Herzliya
Israel

COPY MAILED

FEB 17 2004

OFFICE OF PETITIONS

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman, Evegeny Spektor, Michael Khrapkovsky and Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR VIDEO AND AUDIO ENCODING ON A SINGLE CHIP

: LETTER

Dear Mr. Khrapkovsky:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, applicant (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petitions Attorney
Office of Petitions

Kevin E. Borg
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Leonid Yavits
Golomb 69
Herzliya
Israel

COPY MAILED
FEB 17 2004
OFFICE OF PETITIONS

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman, Evegeny Spektor, Michael Khrapkovsky and Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR VIDEO AND AUDIO ENCODING ON A SINGLE CHIP

: LETTER

Dear Mr. Yavits:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, applicant (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petitions Attorney
Office of Petitions

Kevin E. Borg
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Gadi Oxman
King Solomon 60
Tel Aviv 64511
Israel

COPY MAILED

FEB 17 2004

OFFICE OF PETITIONS

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman, Evegeny Spektor, Michael Khrapkovsky and Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR VIDEO AND AUDIO ENCODING ON A SINGLE CHIP

: LETTER

Dear Mr. Oxman:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, applicant (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petitions Attorney
Office of Petitions

Kevin E. Borg
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Amir Morad
5 Paternak Street
Tel Aviv 64205
Israel

COPY MAILED

FEB 17 2004

OFFICE OF PETITIONS

In re Application of
Amir Morad, Leonis Yavits, Gadi Oxman, Evegeny Spektor, Michael Khrapkovsky and Gregory Chernov
Application No.10/170,019
Filed: June 11, 2002
Attorney Docket Number: 13757US02
Title of Invention: SYSTEM AND METHOD FOR VIDEO AND AUDIO ENCODING ON A SINGLE CHIP

: LETTER

Dear Mr. Morad:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, applicant (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petitions Attorney
Office of Petitions

Kevin E. Borg
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR NY 10510

COPY MAILED

JUN 19 2007

OFFICE OF PETITIONS

In re Application of	:	
Bruning, Gert W.	:	
Application No. 10/170,034	:	ON PETITION
Filed: June 12, 2002	:	
Attorney Docket No. US020181US	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 26, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an 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 2800 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET, SUITE 1600
CHICAGO, IL 60603-3406

COPY MAILED
SEP 13 2006
OFFICE OF PETITIONS

In re Application of :
Wayne C. Hom et al. :
Application No. 10/170,042 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. 2090.311 :

This is a decision on the petition under 37 CFR 1.137(b)[1], filed April 4, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned September 7, 2005 for failure to timely reply to the final Office Action mailed June 6, 2005. Accordingly a Notice of Abandonment was mailed February 14, 2006.

Petitioner has submitted a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114. The RCE fee in the amount of $790.00 has been charged to deposit account no. 06-1135.

This matter is being referred to Technology Center 2643 for processing of the RCE.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW Jun-06

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

COPY MAILED

JUN 26 2006

OFFICE OF PETITIONS

In re Application of	:	
Fernand Labrie	:	DECISION ON PETITION TO
Application No. 10/170,083	:	WITHDRAW HOLDING OF
Filed: 2 May, 2005	:	ABANDONMENT
Atty Docket No. P/1259-697	:	

This is a decision on the petition filed on 2 May, 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 respond to the non-final Office action mailed on 14 October, 2005, which set a three (3) month shortened statutory period of time for reply. Notice of Abandonment was mailed on 20 April, 2006.

Petitioner asserts that an amendment and three (3) month extension were timely filed on 14 April, 2006. A copy of the reply was supplied with the petition.

A review of the record reveals that an amendment and a three (3) month extension of time and fee were filed on 18 April, 2006. Each bears a proper certificate of mailing dated 14 April, 2006.

The showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

The holding of abandonment is withdrawn, and the Notice of Abandonment is vacated.

The application is being referred to Technology Center Art Unit 1614 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JAE WON SONG
FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

COPY MAILED

SEP 28 2005

OFFICE OF PETITIONS

In re Application of	:	
R. G. Heintz et al.	:	
Application No. 10/170,088	:	DECISION ON PETITION
Filed: June 10, 2002	:	UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 20578-09306	:	

This is a decision on the petition under 37 CFR 1.78(a)(6), filed March 7, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition satisfies the above requirements. Accordingly, the claim for priority is accepted as having been unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date 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. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of

priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Angela Ortiz at (571) 272-6051, or in her absence, the undersigned at (571) 272-3217. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 2137 for appropriate action on the application filed June 10, 2002, 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 application.

Frances Hicks for

Brian Hearn
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW CA 94041

COPY MAILED
SEP 28 2006
OFFICE OF PETITIONS

In re Application of	:	
Heintz, et al.	:	
Application No. 10/170,088	:	DECISION ON PETITION
Filed: June 10, 2002	:	TO WITHDRAW
Attorney Docket No. 20578-09306	:	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 13, 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 Robert R. Sachs on behalf of all attorneys of record who are associated with customer No. 00758.

All attorneys/agents associated with the Customer Number 00758 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed May 24, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: AXCELERANT, INC.
130 THEORY, NO. 100
IRVINE, CA 92612

cc: SCHWEGMAN LUDBERG WOESSNER & KLUTH
DOCKETING DEPARTMENT
121 SOUTH EIGHT 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

DARBY & DARBY P.C.
POST OFFICE BOX 5257
NEW YORK, NY 10150-5257

COPY MAILED

AUG 24 2005

OFFICE OF PETITIONS

In re Application of :
Carter B. Green, et al. :
Application No. 10/170,123 : ON PETITION
Filed: June 10, 2002 :
Attorney Docket No. 9639/OL327US0 :

This is a decision on the petition under 37 CFR §1.78(a)(3), filed January 13, 2005, to accept an unintentionally delayed claim under 35 U.S.C.§ 120 for the benefit of prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR §1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior filed application.

The instant pending nonprovisional application was filed on June 10, 2002, and was pending at the time of filing of the petition. While a reference to the prior-filed non-provisional application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR §1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§1.78(a)(2(ii) and 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the provisional application in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR

1.78(a)(3).[1] In the instant case, the Office noted the claim for priority of nonprovisional Application No. 09/514,554 in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the $1370 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Sherry Brinkley at (571) 272-3204. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Publication Division.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] Note MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : June 10, 2005

TO SPE OF : ART UNIT 1742

SUBJECT : Request for Certificate of Correction on Patent No.: 6,869,520

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:

Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**

If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please see the Foreign Priority claimed

Thank You For Your Assistance

S. Powell

Certificates of Correction Branch

Tel. No. 703-308-9390 x120

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments:

Roy Venkling

SPE

1742

Art Unit

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,869,520

APPLICATION NO.: 10/170,134

ISSUE DATE : March 22, 2005

INVENTOR(S) : Daniel Martin San Lorenzo, et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

(30) FOREIGN APPLICATION PRIORITY DATA

December 17, 1999 (ES) Spain	P9902777
December 1, 2000 (WO)	PCT ES00/00458

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Law Office of John C. McMahon
P.O. Box 30069
Kansas City, MO 64112

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

MAY 16 2005

OIPE
MAY 10 2005
PATENT & TRADEMARK OFFICE

PATENT IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION FOR CERTIFICATE OF CORRECTION

10/170134

Applicant: Daniel Martin San Lorenzo, et al.

Patent No.: 6,869,520 Date: May 6, 2005

Issued: March 22, 2005

For: PROCESS FOR THE CONTINUOUS PRODUCTION OF HIGH PURITY ELECTROLYTIC ZINC OR ZINC COMPOUNDS FROM ZINC PRIMARY OR SECONDARY RAW MATERIALS

- -

Kansas City, Missouri

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Certificate
MAY 13 2005
of Correction

Attn: Certificate of Correction Branch

Sir:

The above noted application issued on March 22, 2005 without any indication of foreign priority data.

Enclosed herewith are copies of documents filed with the application. Included is an application data sheet indicating this application is the National filing of PCT/ES00/00458 originally filed on December 1, 2000 which took priority from Spanish application No. P9902777 filed December 17, 1999.

This same information is referred to in the Declaration for the application.

Also enclosed is a copy of the original PCT application,

MAY 16 2005

MAY 16 2005

which was included in the filed documents, designating the United States and claiming priority from the noted Spanish patent application.

Consequently, it is urged that the information claiming foreign priority was provided by applicant and failure to list the foreign application priority data was not applicant's fault. Therefore, it is believed that applicant should not be required to pay a fee for the certificate of correction. However, if it is deemed that such a fee is required, please charge deposit account No. 50-1253.

Respectfully Submitted,

John C. McMahon
Reg. No. 29,415
Attorney

JCM:lm
PO Box 30069
Kansas City, Missouri
64112
Phone: (816) 531-3470

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 6, 2005.

Daniel Martin San Lorenzo, et al.
(Applicant)

By

May 6, 2005

(Date of Signature)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

COPY MAILED

MAR 0 4 2005

OFFICE OF PETITIONS

In re Application of :
Subramaniam Maiyuran et al :
Application No. 10/170,171 : ON PETITION
Filed: June 11, 2002 :
Attorney Docket No. 42P13633 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 18, 2005, to revive the above-identified application.

The petition is **GRANTED**.

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 10, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on November 11, 2004.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/16/07

TO SPE OF : ART UNIT 1754

SUBJECT : Request for Certificate of Correction on Patent No.: 7074382

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☑ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes do not apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

SPE

1754
Art Unit

OIPE JC141
AUG 0 5 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS
ORIGINALLY FILED

RECEIVED
AUG 2 1 2002
TECHNOLOGY CENTER 2800

DOCKET NO.: SC11942ZP

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Jong-Kai Lin et al.
APPLICATION NO.:	10/170184
FILED:	June 12, 2002
GROUP ART UNIT:	2812
TITLE:	WAFER LEVELS MEMS PACKAGING

Certificate of Mailing

Date of deposit: July 31, 2002

I hereby certify that this paper is being deposited with the United States Postal Service on the date indicated above, as first-class mail, with sufficient postage attached thereto, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C.

Signature of Person Mailing Paper

Sally Hartway
Printed Name of Person Mailing Paper

Assistant Commissioner for Patents
Washington, D.C. 20231

Attention: Customer Service Center
Initial Patent Examination Division

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

Sir:

Responsive to the Notice to File Missing Parts of Application dated July 12, 2002, please find enclosed:

- ☒ 2 page Declaration Combined with Power of Attorney
- ☒ 2 page copy of Notice to File Missing Parts of Application
- ☐ ____ Sheets of formal drawings
- ☐ ____

The Commissioner is hereby authorized to charge all fees due to Account No. **13-4771**. A fee transmittal is enclosed.

Respectfully submitted,

By: _____
DOUGLAS W. GILMORE
Attorney of Record
Reg. No.: 48,690
Telephone: 602-952-3782
Fax No.: 602-952-3945

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department
Customer Number: 23330

OIPE JC144
AUG 0 5 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS ORIGINALLY FILED

RECEIVED
AUG 2 7 2002
TECHNOLOGY CENTER 2800

PTO/SB/21 (08-00)

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in this Submission

Application Number	10/170184
Filing Date	June 12, 2002
First Named Inventor	Jong-Kai Lin
Group Art Unit	2812
Examiner Name	Unknown
Attorney Docket Number	SC11942ZP

ENCLOSURES (check all that apply)

- [X] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/Declaration(s)
- [ ] Extension of time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Documents
- [X] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts Under 37 CFR 1.52 or 1.53
- [ ] Assignment Papers (for an Application)
- [ ] Drawing(s)
- [ ] Licensing-Related papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation, Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CDs
- [ ] After Allowance Communication to Group
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter with appropriate copies
- [X] Other Enclosure(s) (please identify below)
  - [X] Declaration Combined with Power of Attorney
  - [ ] sheet(s) formal drawings
  - [X] copy of Notice to File Missing Parts of Application

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Douglas W. Gilmore	Registration No.	48,690
Signature	D.W. Gilmore		
Date	07/31/02		

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage thereon, as first-class mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on the date listed below:

Typed or printed name	Sally Hartway		
Signature	Sally Hartway	Date	7-31-02

OIPE JC144
AUG 0 5 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS ORIGINALLY FILED

RECEIVED
AUG 2 1 2002
TECHNOLOGY CENTER 2800

PTO/SB/17 (11-00)

FEE TRANSMITTAL

Patent fees are subject to annual revision

TOTAL AMOUNT OF PAYMENT ($)130.00

Complete if Known	
Application Number	10/170184
Filing Date	June 12, 2002
First Named Inventor	Jong-Kai Lin et al.
Examiner Name	Unknown
Group Art Unit	2812
Attorney Docket No.	SC11942ZP

METHOD OF PAYMENT

1. [X] The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number: 13-4771

Deposit Account Name: Motorola, Inc.

[X] Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

[ ] Applicant claims small entity status. See 37 CFR 1.27

2. [ ] Payment Enclosed:

[ ] Check [ ] Credit Card [ ] Money Order [ ] Other

FEE CALCULATION

1. BASIC FILING FEE

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)		Fee Paid
101	710	201	365	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

			Extra Claims		Fee from below		Fee Paid
Total Claims		-20** =		X	18	=	
Independent Claims		- 3** =		X	80	=	
Multiple Dependent					270	=	

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	** Reissue independent claims Over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**OR NUMBER PREVIOUSLY PAID, IF GREATER. For 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	
105	130	205	65	Surcharge – late filing fee or oath	
127	50	227	25	Surcharge – late Provisional filing	
139	130	139	130	Non-English specification	
147	2520	147	2520	For filing a request for ex parte Reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1840*	113	1840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1390	218	695	Extension for reply within fourth month	
128	1890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1510	138	1510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1240	241	620	Petition to revive - unintentional	
142	1240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	130.00
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of IDS	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a)	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b0	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

* Reduced by Basic Filing Fee paid

SUBTOTAL (3) ($)130.00

SUBMITTED BY

Name (Print/Type)	Douglas W. Gilmore	Registration No.	48,690	Telephone	602-952-3782
Signature		Mail Date			

OIPE JC144
AUG 0 5 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS
ORIGINALLY FILED

 43 DWK

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
10/170,184	06/12/2002	Jong-Kai Lin	SC11942ZP

CONFIRMATION NO. 7286

FORMALITIES LETTER

OC000000008446187

23330
MOTOROLA, INC.
CORPORATE LAW DEPARTMENT - #56-238
3102 NORTH 56TH STREET
PHOENIX, AZ 85018

JUL 22 2002
DA 7/23

Date Mailed: 07/12/2002

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

ACT. DUE:	Missing Pts
DATE DUE:	12-26-2002

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 signature of the following inventor(s) is missing from the oath or declaration:
  Ananda P. De Silva
- 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.

08/07/2002 HDEMESS1 00000091 134771 10170184

01 FC:105 130.00 CH

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 1 - ATTORNEY/APPLICANT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA22313-1450
www.uspto.gov

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON DC 20037

COPY MAILED

AUG 0 6 2007

OFFICE OF PETITIONS
ON PETITION

In re Application of
Chang-nam Chu
Application No. 10/170,202
Filed: June 13, 2002
Attorney Docket No: Q70455

This is a decision on the petition to re-issue the Office Action and reset the period for reply filed May 18, 2007, which is being treated as a petition to withdraw the holding of abandonment, under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

This application became abandoned on November 23, 2006, for failure to file a timely response to the non-Final Office Action mailed August 22, 2006, which set a three (3) month statutory period for reply. The instant petition and this decision precede the mailing of the Notice of Abandonment. Petitioner asserts that the non-Final Office Action was never received.

The file record discloses that the Office Action was mailed to the address of record which is the same address used on all correspondences from the USPTO. Petitioner has provided a copy of the docket to show that the Office Action mailed August 22, 2006 was not received. Petitioner also explains that after searching the file and docket records, where receipt of the office action would have been indicated if it had been received, it was concluded that no correspondence was received for this matter from the USPTO.

In that the statement from the petitioner and the exhibit from the docket record for the instant matter show no entry indicating receipt of the non-Final Office Action mailed August 22, 2006, it is apparent that it was not received. The evidence submitted corroborates non-receipt of the Office Action.

In view of the facts set forth in the petition, it is concluded that the Office Action was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and no petition fee is due.

This matter is being referred to Technology Center 2136 for a re-mailing of the non-Final Office Action and for a restarting of the period for response.

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